TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

Second Edition
June 2003

United States Patent and Trademark Office

PREFACE TO THE SECOND EDITION

When we issued the first edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) in 1995, we expressed the hope that it would serve as a comprehensive and ready resource for practitioners. That has proved to be so, if we can judge by the enthusiastic reception the TBMP has received. With this second edition, we hope to make a good thing better.

This edition of the TBMP reflects changes in TTAB practice resulting from statutory changes and new rules promulgated since 1995 and, in particular, from the changes made in many of the TTAB rules in 1998. We have revised the format of the manual to add a comprehensive table of contents for each chapter. We have shifted case citations to footnotes to make the text easier to read and have enhanced case citations to include parenthetical explanations of the significance of the cited cases. We have added appendices with additional case law citations. We have reorganized some of the chapters to help users locate relevant information more quickly and have expanded some sections to explain TTAB practice more clearly or to reflect changes in practice.

This edition of the manual reflects also the Office's commitment to electronic government. We will not publish this edition of the TBMP in paper form but will make it available only on line at the TTAB web page of the USPTO web site. By using electronic technology, we can update the manual more quickly and, we hope, enhance its ultimate value to practitioners.

Special thanks to TTAB Interlocutory Attorney Linda Skoro and Administrative Trademark Judge Terry Holtzman, whose countless hours of work and applied creativity have made this edition of the TBMP not a mere update of the first edition but, in many respects, a new and even more useful guide to TTAB practice.

J. David Sams
Chief Administrative Trademark Judge
Trademark Trial and Appeal Board

May 1, 2003

INTRODUCTION

The purpose of this manual is to provide practitioners with basic information generally useful for litigating cases before the Trademark Trial and Appeal Board. The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board, its reviewing tribunals, the Director, or the USPTO. *Cf.*, *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989).

Rather, the manual describes current practice and procedure under the applicable authority, as of the date the manual is issued.

The manual is devoted primarily to opposition and cancellation proceedings, the two most common types of inter partes proceedings before the Board. Nonetheless, the manual includes a chapter of general information useful for all proceedings and chapters on interference proceedings, concurrent use proceedings, and ex parte appeals to the Board.

The manual will be updated periodically. In particular, after implementation of the Madrid Protocol, the Board will update the manual to reflect the resulting changes in Board practice.

The Board welcomes suggestions for improving the content of the manual. Suggestions and comments should be addressed as follows:

Commissioner for Trademarks
Attention: Chief Administrative Trademark Judge
2900 Crystal Drive
Arlington, Virginia 22202-3514

The title of the manual is abbreviated as "TBMP". A citation to a section of the manual may be written as "TBMP § _____ (2d ed. June 2003)" (e.g. "TBMP § 110.01 (2d ed. June 2003)").

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Chapter 100
GENERAL INFORMATION

101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("TTAB" or "Board") are governed by the Lanham Trademark Act of 1946, as amended, ("Act of 1946" or "Act"), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Part 2 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Part 3 of 37 CFR; and the rules relating to representation of others before the United States Patent and Trademark Office which may be found in Part 10 of 37 CFR. In addition, Trademark Rule 2.1, 37 CFR § 2.1, makes certain rules of practice in patent cases from Part 1 of 37 CFR applicable to trademark cases. The United States Patent and Trademark Office (USPTO) rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings.[1]

A copy of Title 37 of the CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Title 37 of the CFR may also be found on the Internet at the Government Printing Office website at: www.access.gpo.gov/nara/cfr or at the USPTO website at: www.uspto.gov.

Information regarding proposed and final rule changes to Title 37 is also posted on the USPTO website at www.uspto.gov.

101.02 Federal Rules

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure ("Fed. R. Civ. P."), except as otherwise provided in the Trademark Rules of Practice, and "wherever applicable and appropriate";[2] and by the Federal Rules of Evidence ("Fed. R. Evid.").[3]

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[1] *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

[2] *See* 37 CFR § 2.116(a).

[3] *See* 37 CFR §§ 2.116(a), 2.120(a), and 2.122(a); *Young v. AGB Corp.,* 152 F.3d 1377, 47 USPQ2d 1752, 1753 n.3 (Fed. Cir. 1998); and *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 392 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated "[t]he Federal Rules of Evidence generally apply to TTAB proceedings.").

There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the Board. However, certain of the principles embodied in the Federal Rules of Evidence are applied by the Board, in practice, in evaluating the probative value of evidence submitted in ex parte cases.[4]

101.03 Decisional Law

Proceedings before the Board are also governed, to a large extent, by precedential decisions in prior cases. These decisions include those of the Board itself, as well as the decisions of the Court of Appeals for the Federal Circuit (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Director of The United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks), who determines petitions seeking review of Board actions on procedural matters.

Decisions of the Board, the Director, and the Court of Appeals for the Federal Circuit appear in the *United States Patent Quarterly* ("USPQ"), a periodical publication of The Bureau of National Affairs, Inc., Washington, D.C., and may also be found in Reed Elsevier, Inc.'s "LEXIS" legal database, and in the Intellectual Property Library of West Publishing Company's WESTLAW database.

Decisions which are designated by the Board "citable as precedent" or "for publication in full" are citable as precedent. Decisions which are not so designated, or which are designated for publication only in digest form, are not citable authority.[5] A nonprecedential or digest decision will, however, be considered in determining issues of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like, provided that (1) a party to the pending Board proceeding, or its privy, was also a party to the prior proceeding, and (2) a complete copy of the decision is submitted.[6]

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[4] *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles from general and business publications are not hearsay and are probative of descriptive usage); *In re Broadway Chicken, Inc.,* 38 USPQ2d 1559, 1565 (TTAB 1996) (listings from telephone directories and Dun & Bradstreet databases are not inadmissible hearsay)*; and In re American Olean Tile Co.*, 1 USPQ2d 1823, 1824 n.2 (TTAB 1986) (affidavit consisting of third-hand report by unidentified person is inadmissible hearsay). *See also In re Foundry Products, Inc.*, 193 USPQ 565 (TTAB 1976). *For further information concerning the treatment of evidence in Board ex parte proceedings, see* TBMP § 1208 and authorities cited therein.

[5] *See In re Polo International, Inc.,* 51 USPQ2d 1061, 1063 n.3 (TTAB 1999) (non-precedential case disregarded); *In re Catepillar Inc.,* 43 USPQ2d 1335, 1336 (TTAB 1997) *citing General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992); and *In re American Olean Tile Co.*, *supra* at 1825 n.3 (published digests do not indicate the facts on which the determinations were based). *See also Marcon, Ltd. v. Merle Norman Cosmetics, Inc.*, 221 USPQ 644, 645 n.4 (TTAB 1984) and *Roberts Proprietaries, Inc. v. Rumby International, Inc.*, 212 USPQ 302, 303 (TTAB 1981).

[6] *See General Mills Inc. v. Health Valley Foods, supra*.

101.04 Director's Orders and Notices

Occasionally, the Director of the United States Patent and Trademark Office (formerly known as the Commissioner of Patents and Trademarks), or another USPTO official acting under the Director's authority, publishes in the *Official Gazette* an Order or Notice relating to a particular USPTO policy, practice, procedure, or other such matter of interest to the public. Some of these Orders and Notices affect practice and procedure before the Trademark Trial and Appeal Board. Such notices are also posted on the USPTO's website at www.uspto.gov.

102 Nature of Board Proceedings

102.01 Jurisdiction of Board

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office within the Office of General Counsel. The Board is empowered to determine only the right to register.[7]

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition.[8]

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[7] *See* Sections 17, 18, 20, and 24 of the Act of 1946, 15 U.S.C. §§ 1067, 1068, 1070, and 1092.

[8] *See Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002), *aff'd,* 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (cannot adjudicate unfair competition issues); *Ross v. Analytical Technology Inc.,* 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Section 43(a) of the Act, 15 U.S.C. 1125(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Section 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); and *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board's authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); and *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction); *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.,* 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.,* 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective

Similarly, the Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional.[9]

102.02 Types of Board Proceedings

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration of a mark" may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, under Section 12(a) of the Act, 15 U.S.C. § 1062(a), in the *Official Gazette* of the Patent and Trademark Office ("USPTO").[10]

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a trademark. A petition for cancellation may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark.[11]

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are

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August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Section 43(c) in opposition and cancellation proceedings); and *British-American Tobacco Co. v. Philip Morris Inc.,* 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board since it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

See also The Scotch Whiskey Association v. United States Distilled Products Co., 13 USPQ2d 1711, 1715 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240, 1243 (TTAB 1990) (Board cannot consider claims of unfair competition standing alone, but can consider such claims in determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation), *dismissed*, 18 USPQ2d 1391, 1394 (TTAB 1991) (where petitioner did not plead a separate ground on which to base the petition to cancel, petitioner's claims under Articles 10 and 10bis of the Paris Convention could not be considered), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

[9] *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828, 1832-33 (TTAB 1994) (no authority to declare provisions of the Act unconstitutional nor to determine whether Section 2(a) is overbroad or vague) and *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1735 n.88 (TTAB 1999); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (no jurisdiction to determine whether Section 7(c) of the Act, the constructive use provision, violates the commerce clause of the constitution). *See also, for example, Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc.,* 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (no authority to determine whether private activities rendered to members of private club constitute "commerce").

[10] *See* Section 13 of the Act of 1946, 15 U.S.C. § 1063.

[11] *See* Sections 14 and 24 of the Act of 1946, 15 U.S.C. §§ 1064 and 1092.

in conflict), is entitled to registration.[12] The proceeding is declared by the USPTO only upon petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference.[13] Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding.[14] An interference that has been declared by the Director is not instituted by the Board until after all of the marks that are to be involved in the proceeding have been published in the *Official Gazette* for opposition.[15]

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers).[16] The proceeding may be generated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the *Official Gazette*, and all oppositions thereto (if any) have been withdrawn or dismissed.[17]

The Board also has jurisdiction over ex parte appeals, that is, appeals from an Examining Attorney's final refusal to register a mark in an application.[18]

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[12] *See* Section 18 of the Act, 15 U.S.C. § 1068.

[13] *See* Section 16 of the Act of 1946, 15 U.S.C. § 1066; 37 CFR § 2.91; and TBMP § 1002 (Declaration of Interference).

[14] *See* 37 CFR § 2.91(a).

[15] *See* TBMP § 1003 (Institution of Interference). *For further information concerning interference proceedings, see* TBMP chapter 1000.

[16] *See* TBMP § 1101.01 and authorities cited therein.

[17] *See* TBMP §§ 1102.01 (Means of Generation) and 1105 (Applications and Registrations not Subject to Proceeding), and authorities cited therein. *For further information concerning concurrent use proceedings, see* TBMP chapter 1100.

[18] *See* Sections 12(b) and 20 of the Trademark Act, 15 U.S.C. §§ 1062(b) and 1070; 37 CFR §§ 2.141 and 2.142; and TBMP chapter 1200 (Ex Parte Appeals). *See also, e.g., In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994) citing *In re BankAmerica Corp.,* 231 USPQ 873 (TTAB 1986).

102.03 General Description of Board Proceedings

An inter partes proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; discovery; and briefs, followed by a decision on the case.[19] However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts.[20] The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pre-trial conference pursuant to 37 CFR § 2.120(i)(2), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding).

An ex parte appeal, being appellate in nature, is a much simpler and shorter procedure, involving only the filing of briefs by the applicant and Examining Attorney, and, if requested by the applicant, an oral hearing.

The Board includes both interlocutory attorneys and administrative trademark judges (known also as Board members). Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge or by a single interlocutory attorney to whom such authority has been delegated.[21] Decisions on the case, and on complex or contested motions which are potentially dispositive of the case, are rendered by a panel of at least three Board judges.[22] Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be decided per curiam by the Board.

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[19] *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing the procedures are designed to approximate the proceedings in a courtroom trial).

[20] *See Yamaha International Corp. v. Hoshino Gakki Co.*, *supra* at 1004. *See also La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). *Cf.* TBMP §§ 502.01 (Available Motions) and 702 (Manner of Trial and Introduction of Evidence).

[21] *See* 37 CFR § 2.127(c).

[22] *See, e.g.,* 37 CFR §§ 2.129(a) and 2.142(e)(1).

103 Location and Address of Board

The Board is located at 2900 Crystal Drive, Ninth Floor, Arlington, Virginia 22202-3514. The mailing address of the Board is Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.[23]

104 Business to be Conducted in Writing

37 CFR § 1.2 *All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.*

All business with the Board should be transacted in writing. The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pre-trial conference as provided in 37 CFR § 2.120(i)(2), or upon oral argument at final hearing, if a party so desires, as provided in 37 CFR § 2.129. Decisions of the Board will be based exclusively on the written record before it.[24]

105 Contact With Board Personnel

37 CFR § 10.93(b) *In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:*

(1) In the course of official proceedings in the cause.
(2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.
(3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.
(4) As otherwise authorized by law.

Parties or their attorneys or other authorized representatives may telephone the Board, or come to the offices of the Board, to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or of any particular issue. The telephone number of the

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[23] Mail box designations (BOX TTAB) and fee notations (FEE – NO FEE) are no longer required.

[24] *Cf. In re Sovran Financial Corp.,* 25 USPQ2d 1537, 1538 (Comm'r 1992) (regarding actions taken by Examining Attorneys); *In re Merck & Co*., 24 USPQ2d 1317, 1318 n.2 (Comm'r 1992) (regarding oral representation by Board employee); and *In re Investigacion Y Desarrollo de Cosmeticos S.A.,* 19 USPQ2d 1717 (Comm'r 1991).

Board is (703) 308-9300. If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question.

106 Identification, Signature, and Form of Papers

106.01 Identification of Papers

A paper filed in a proceeding before the Board should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name and number of the inter partes proceeding (or, in the case of an ex parte appeal, the application) to which it relates.[25] The paper should also include a title describing its nature, *e.g.*, "Notice of Opposition," "Answer," "Motion to Compel," "Brief in Opposition to Respondent's Motion for Summary Judgment," "Notice of Reliance."

Papers filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, and should bear at the top of its first page both the application serial number, and the inter partes proceeding number and title. Similarly, requests under Section 7 of the Act, 15 U.S.C. § 1057, to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title.[26]

106.02 Signature of Papers

37 CFR § 2.119(e) *Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.*

37 CFR § 10.14(e) *No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if*

[25] *Cf.* 37 CFR § 1.5(c).

[26] *Cf.* 37 CFR § 1.5(c).

such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

37 CFR § 10.18(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.*

(b) *By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) *Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Director, or the Director's designee, which may include, but are not limited to, any combination of-*

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).*

37 CFR § 1.4(d)(1) *Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, trademark registration file, or other proceeding in the Office which requires a person's signature, must:*

(i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or
(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original; or
(iii) Where an electronically transmitted trademark filing is permitted, the person who signs the filing must either:

(A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; or
(B) Sign the verified statement using some other form of electronic signature specified by the Director.

(2) *The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of §10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).*

37 CFR § 1.4(f) *When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.*

Every paper filed in an inter partes or ex parte proceeding before the Board, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate.[27]

[27] *See* 37 CFR §§ 1.4(d); 2.119(e); and 10.18(a).

Documents filed through the electronic filing systems available at the Board do not require a conventional signature. Instead the party or its representative enters a "symbol" that they have adopted as a signature. The Board will accept *any* combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash ("/") symbols.[28]

A party may act in its own behalf in a proceeding before the Board, or the party may be represented by an attorney or other authorized representative.[29] When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any papers that he or she files with the Board. If a party which is a partnership elects to act in its own behalf, papers filed by the partnership should be signed by a partner. If a party which is a corporation or association elects to act in its own behalf, papers filed by the corporation or association should be signed by an officer thereof who is authorized to sign for the corporation or association.[30]

If a paper is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be signed by, that attorney or other representative, unless it is a paper required to be signed by the party. An attorney or other authorized representative who signs a paper, and then files it with the Board on behalf of a party, should remember that his or her signature to the paper constitutes a certification of the elements specified in 37 CFR § 10.18(b), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action.[31]

It is not appropriate for one person to sign a paper for another person, as, for example, "John Smith, for John Doe" or "John Doe, by John Smith."[32]

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[28] *See* 37 CFR § 1.4(d)(1)(ii). *See also* TMEP § 804.05.

[29] *See* 37 CFR § 10.14 and TBMP § 114 (Representation of a Party). *Cf.* 37 CFR § 2.11.

[30] *See* 37 CFR § 10.14(e).

[31] *See* 37 CFR § 10.18. *Cf.* Fed. R. Civ. P. 11 and TBMP § 527.02 (regarding motions for Rule 11 sanctions). *See also, for example, The Clorox Co. v. Chemical Bank,* 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected). *For information concerning the meaning of the designation "other authorized representative," see* TBMP § 114.04.

[32] *See* 37 CFR §§ 2.119(e) and 10.18(a). *See also Boyds Collection Ltd. v. Herrington & Co.,* 65 USPQ2d 2017 (TTAB 2003) (response to motion to suspend signed by person on behalf of practitioner is inappropriate); *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989) (Section 8 declaration signed by someone other than named person, while perhaps unacceptable, does not constitute fraud), *aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.,* 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989) and *In re Cowan*, 18 USPQ2d 1407, 1409 (Comm'r 1990) (Section 8 declaration in name of sole proprietor, but signed for him by his attorney, not acceptable).

On a paper filed in a proceeding before the Board there should appear the name, in typed or printed form, of the person who signed; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; as the filing party's attorney); and his or her business address and telephone number. The inclusion of the signing person's address and phone number on the paper itself is vital because mail sent to the USPTO is opened in the USPTO Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the USPTO. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings.

In accordance with 37 CFR § 1.4(d) either the original of the signed paper, or a legible copy thereof, may be filed with the Board. If a paper copy is filed, the original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the USPTO may require submission of the original.[33]

Notwithstanding the requirement that a paper filed before the Board be signed, an unsigned paper will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board.[34]

106.03 Form of Papers

Apart from proper identification and signature, there is no particular form which written papers filed in proceedings before the Board must follow. Nor does the USPTO have printed forms for any papers filed in such proceedings. As an aid to litigants, however, the USPTO has prepared suggested formats for certain types of papers filed in Board proceedings. These include the notice of opposition, petition for cancellation, notice of appeal to the Board, designation of domestic representative, certificate of mailing or certificate of transmission under 37 CFR § 1.8(a), and a certificate of service. Copies of all of these formats can be found in an appendix to this manual (Appendix of Forms) and certain formats may also be included in this manual at the place where the particular type of paper or certificate is discussed (e.g., the suggested format for a notice of ex parte appeal to the Board is included in the chapter on ex parte appeals).

Recently the Board has made available the Electronic System for Trademark Trials and Appeals (ESTTA) on the USPTO web site. Using ESTTA, a person can complete and submit forms to the Board over the Internet, making an official filing online, or print out the completed form for mailing to the Board. ESTTA gives step-by-step instructions for properly completing a form. Available forms and instructions can be found at: http://estta.uspto.gov.

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[33] *See* 37 CFR § 1.4(d)(1)(ii). *For information concerning fax copies, see* TBMP § 107.

[34] *See* 37 CFR § 2.119(e).

A paper filed with the Board may be either the original or a legible copy thereof, on good quality paper.[35] Ordinarily, extra copies of a paper should not be submitted.[36] In inter partes cases, filings which require more than one copy include: briefs at final hearing must be submitted in triplicate;[37] stipulations to extend trial dates should be submitted in multiple form, i.e., one copy for the Board proceeding file plus as many other copies as there are parties;[38] and the notice of opposition and petition for cancellation must be submitted in duplicate.[39] In addition, requests for extensions of time to oppose should be filed in triplicate.[40]

With the exception of deposition transcripts, exhibits thereto, and inter partes briefs on the case, papers filed with the Board should not be bound.

Prior to trial, discovery requests and responses are not to be submitted to the Board unless filed in conjunction with a motion to compel. The Board no longer accepts written discovery requests with a plaintiff's complaint.

Briefs at final hearing in inter partes cases, briefs on motions, and appeal briefs in ex parte cases, are subject to page limitations and are required to be submitted in typewritten or printed form, double spaced, on letter-size paper.[41] The Board prefers that other papers, too, be submitted in the same format. Letter-size paper is recommended as it is the size preferred by many Federal district courts, and their size preference is significant because review of a final decision of the Board may be had either by way of appeal to the Court of Appeals for the Federal Circuit or by way of civil action in a Federal district court.[42]

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[35] *See, with respect to fax copies*, TBMP § 107.

[36] *See DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only unless otherwise required by rule); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (unnecessary copies and attachments to motions resulted in undue delay and a waste of Board resources); and *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 n.1 (TTAB 1994).

[37] *See* 37 CFR § 2.128(b).

[38] *See* 37 CFR § 2.121(d).

[39] *See* 37 CFR §§ 2.104(a) and 2.112(a).

[40] *See* 37 CFR § 2.102(d).

[41] *See* 37 CFR §§ 2.127(a), 2.128(b) and 2.142(b)(2).

[42] *See* Section 21 of the Act of 1946, 15 U.S.C. § 1071; 37 CFR § 2.145; and TBMP §§ 901-903 (Appeals).

107 How and Where to File Papers and Fees

37 CFR § 1.6 Receipt of correspondence.

(a) Date of receipt and Express Mail date of deposit.
Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.
(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.
(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.
(4) Trademark-related correspondence transmitted electronically will be stamped with the date on which the Office receives the transmission.

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(c) Correspondence delivered by hand.
In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) Facsimile transmission.
Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

(1) Correspondence as specified in § 1.4(e), requiring an original signature;
(2) Certified documents as specified in § 1.4(f);
(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), § 1.8(a)(2)(ii)(A), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;
(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;
(5) A request for reexamination under § 1.510, or § 1.913;
(6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;
(7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);
(8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;
(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, cross-interrogatories, or recorded answers under § 1.684(c); or an evidentiary record and exhibits under § 1.653.

(e) Interruptions in U.S. Postal Service.
If interruptions or emergencies in the United States Postal Service which have been so designated by the Director occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:
(1) Promptly filed after the ending of the designated interruption or emergency; and
(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

Papers relating to proceedings before the Board, and ***not accompanied by a fee***, may be filed during regular office hours by hand delivery or by courier service to the Board at 2900 Crystal Drive, South Tower Building, Ninth Floor, Arlington, Virginia 22202-3514; or at the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Arlington, Virginia 22202-3514; or at the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, First Floor, Arlington, Virginia 22202; or (by courier delivery only) to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, First Floor, Arlington, Virginia 22202 (*delivery of papers intended for the Board to one of the Crystal Plaza Building 2 locations is NOT recommended, because papers delivered to these locations, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board*). Such papers may also be filed by depositing them in the mail

addressed to the Board's mailing address (Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514).

Papers relating to proceedings before the Board, and ***accompanied by fees*** may be filed by mailing them to the Board's mailing address , i.e., Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514. Papers with fees may also be filed during regular business hours by hand delivery to the Finance Window at 2900 Crystal Drive, South Tower Building, Arlington, Virginia 22202-3514 (where the fee will be "received" or "posted" immediately and the paper then forwarded to the Intake Processing Unit on the same floor); or to the Customers' Window on the first floor at 2011 S. Clark Place, Crystal Plaza Building 2, Arlington, Virginia 22202; (*delivery of papers intended for the Board to the Crystal Plaza Building is NOT recommended, because papers delivered to this location, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board*).

Fee papers filed in person must be filed at one of the locations identified above because the Board does not have the mechanism to process financial transactions.

With the exception of the notice of ex parte appeal to the Board, or in the absence of a specific request by the Board, papers to be filed with the Board may not be filed by facsimile transmission ("fax").[43] If papers other than the notice of appeal in an ex parte appeal are filed with the Board by fax transmission, they will not receive a filing date.

However, the Board will accept, and give filing dates to, papers which had been faxed to, for example, local counsel, when the fax copies are in turn hand delivered to the Board, or are sent to the Board by mail or courier service. In addition, the Board may request that a party send by fax transmission a copy of a paper which has already been filed in the USPTO by one of the acceptable methods described above, such as by mail, but which paper has not yet been received by the Board and/or entered in the proceeding file for which it is intended. The Board may make such a request when, for example, (1) a Board attorney needs a copy of the paper in order to make an immediate ruling, by telephone conference, on a motion, or (2) the Board needs to see a copy of a paper which was assertedly filed in the USPTO, but which the Board does not have or cannot locate. When the Board requests that a copy of a paper be sent to the Board by fax transmission, the name of the Board employee making the request must appear on the cover sheet of the transmission, so that the Board staff member receiving the transmission will know that the transmission is authorized, and can immediately give the paper to the employee who requested it. If the name of the requesting Board employee does not appear on the cover sheet, the staff member receiving the transmission will presume that the transmission is unauthorized, and the paper will be disregarded.

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[43] *See* 37 CFR § 1.6(d)(8).

When a fax transmission is authorized, the requirements of 37 CFR § 1.6(d) should be met. In addition, it is recommended that the fax cover sheet specify the number of pages being transmitted, and the name, address, fax number, and telephone number of the transmitting party, as well as the proceeding number to which the document pertains.

A document transmitted by fax must be legible. The document that is used as the original for the fax transmission should be retained by the sender as evidence of the content of the transmission.[44]

Correspondence filed by fax transmission should be transmitted to the fax number of the USPTO location for which it is intended. Transmission of correspondence to the fax number of the wrong USPTO location will cause delay in matching the correspondence with the file to which it pertains. The Board itself has several different fax numbers. The Board fax number to be used for a notice of ex parte appeal to the Board is (703) 308-9333. In those cases where the Board requests that a party send a copy of some other paper by fax transmission, the party will be provided with the appropriate fax number.

The Board's fax machines are attended between the business hours of 8:30 a.m. and 5:00 p.m., Eastern Standard Time, Monday through Friday, excluding holidays. Normally, the machines may be accessed 24 hours a day. However, there may be times when reception is not possible because of equipment failure or maintenance requirements. Accordingly, persons transmitting correspondence to the Board by fax should be cautious about relying on the availability of this service near time deadlines, such as the end of the six-month period for filing a notice of appeal in an ex parte appeal to the Board.[45]

For information on how to pay fees, see TBMP § 118.

108 Filing Receipts

When a paper (with or without a fee) intended for the Board is filed in the USPTO, it is possible to obtain a receipt evidencing the date of such filing. In the case of a paper sent by mail, a receipt may be obtained by submitting with the paper a stamped, self-addressed postcard with sufficient information to identify clearly the paper, the party in whose behalf the paper is being filed, and the proceeding or application in connection with which the paper is being filed. When the USPTO receives the paper and the postcard, it will date-stamp both of them and mail the postcard back.

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[44] *See* 37 CFR § 1.4(d).

[45] *Cf.* TMEP § 306.02.

If a paper intended for the Board is delivered by hand or by courier service to the offices of the Board, or to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, Virginia 22202-3514, or to the Finance Window on the same floor of that building, the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the paper, or a duplicate copy of the transmittal letter with appropriate identifying information. The receipt and the paper will be date-stamped and the receipt will be handed back to the person who delivered the paper. If a paper is delivered by hand or by courier service to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B03, Arlington, Virginia 22202, the receipt may be in the form of a postcard, or, alternatively, a handwritten receipt will be furnished. If a paper is delivered by courier service to the U.S. Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202, the postcard receipt must be used.

When a paper is submitted to the Board by fax transmission, the Board will not formally acknowledge receipt of the paper. However, the Board fax machine usually will confirm to the sending unit that the transmission is complete. Parties are reminded that, with the exception of the notice of ex parte appeal to the Board. or unless otherwise specifically authorized by the Board, papers intended for the Board may not be filed by fax transmission.[46]

109 Filing Date

37 CFR §1.6 Receipt of correspondence.
(a) Date of receipt and Express Mail date of deposit*. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:*

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph(a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.
(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.
(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.
(4) Trademark-related correspondence transmitted electronically will be stamped with the date on which the Office receives the transmission.

[46] *See* 37 CFR § 1.6(d)(8). *See also* TBMP § 107 (How and Where to File Papers).

* * * *

(c) Correspondence delivered by hand. *In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.*

(d) Facsimile transmission. *Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

(1) Correspondence as specified in § 1.4(e), requiring an original signature;
(2) Certified documents as specified in § 1.4(f);
(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), § 1.8(a)(2)(ii)(A), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under §1.53(d) may be transmitted to the Office by facsimile;
(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;
(5) A request for reexamination under § 1.510, or § 1.913;
(6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;
(7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);
(8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;
(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, cross-interrogatories, or recorded answers under § 1.684(c); or an evidentiary record and exhibits under § 1.653.

(e) Interruptions in U.S. Postal Service. *If interruptions or emergencies in the United States Postal Service which have been so designated by the Director occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:*

(1) Promptly filed after the ending of the designated interruption or emergency; and

> *(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.*

Correspondence received in the USPTO is stamped with the date of receipt (i.e., the "filing" date) unless the correspondence is filed by the "Express Mail" procedure provided in 37 CFR § 1.10, or by fax transmission (for correspondence which is permitted to be filed by fax) in accordance with 37 CFR § 1.6(d), in which case the correspondence is date-stamped as described below.[47] The "date of receipt" of correspondence mailed to the USPTO is the date stamped by the Post Office on the mail bags in which the correspondence is delivered to the USPTO.[48]

When correspondence intended for the Board is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service the paper will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). If the deposit date cannot be determined, the correspondence will be stamped with the date of actual receipt.[49]

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR § 1.8(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence.[50] The date of receipt of the transmission, as described in 37 CFR § 1.6(a)(3), is used for all other purposes.[51]

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 CFR § 1.8(a), it is stamped with the date of receipt of the correspondence in the USPTO, i.e., the date on the mail bags in which the correspondence is delivered to the USPTO. The mailing date specified in the certificate of

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[47] *See* 37 CFR § 1.6(a).

[48] *See* 37 CFR § 1.6(b); *In re Amethyst Investment Group*, 37 USPQ2d 1735 (Comm'r 1995); and *In re Klein,* 6 USPQ2d 1528, 1536 (Dep't Comm. 1986).

[49] *See* 37 CFR §§ 1.6(a)(2) and 1.10. *See* 37 CFR § 1.10 *regarding procedures for petitioning the Director for any filing date discrepancy.*

[50] *See* 37 CFR § 1.8(a). *For further information concerning correspondence that may be filed by fax transmission to the Board, see* TBMP § 107.

[51] *See* 37 CFR § 1.8(a). *For further information concerning correspondence that may be filed by fax transmission to the Board, see* TBMP § 107.

mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes.[52]

110 Certificate of Mailing or Transmission Procedure

110.01 In General

37 CFR § 1.8 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in Sec. 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with Sec. 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following:

(i) Relative to Patents and Patent Applications--

* * * *

(ii) Relative to Trademark Registrations and Trademark Applications--

(A) The filing of a trademark application.

(B)-(F) [Reserved]

(iii) Relative to Disciplinary Proceedings--

(A) Correspondence filed in connection with a disciplinary proceeding under part 10 of this chapter.

(B) [Reserved]

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[52] *See* 37 CFR §§ 1.6(a) and 1.8(a). *For information concerning the date stamped by the USPTO on correspondence when interruptions or emergencies occur in the United States Postal Service, see* 37 CFR § 1.6(e).

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

Except in certain instances, specified in 37 CFR § 1.8(a), as amplified by 37 CFR § 1.6(d), correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the USPTO until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the USPTO by first-class mail, with the proper address, or (for correspondence which is permitted to be filed by fax) is transmitted to the USPTO by fax, in accordance with 37 CFR § 1.6(d), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR § 1.8(a).[53]

In effect, the certificate of mailing or transmission procedure permits certain types of correspondence, as specified in 37 CFR §§ 1.8(a) and 1.6(d), to be sent to the USPTO by first-class mail, or by fax transmission, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the USPTO until after the due date, or that the fax transmission may not, because of equipment failure or maintenance requirements, be completed until the next day.[54]

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[53] *See* 37 CFR § 1.8(a) and *In re LS Bedding*, 16 USPQ2d 1451, 1452-53 (Comm'r 1990) (certificate of mailing procedure is used to determine timeliness, while the actual receipt date is used for all other purposes, such as an application filing date). *See also Hornblower & Weeks Inc. v. Hornblower & Weeks Inc*., 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (no certificate of mailing).

[54] *See Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) (motion to extend filed by a certificate of mailing dated next business day was timely).

However, the USPTO, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate.[55]
The certificate of mailing procedure applies to the filing of all types of correspondence in Board proceedings.

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board.[56]

110.02 Requirements for Certificate

37 CFR § 1.1 Addresses for correspondence with the United States Patent and Trademark Office.

(a) In general. *Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1),(a) (2) and (3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.*

* * * *

(2) ***Trademark correspondence****.*

(i) ***In general.*** *All trademark-related documents filed on paper, except documents sent to the Assignment Services Division for recordation and requests for copies of trademark documents, should be addressed to:*

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

(ii) ***Electronic applications.*** *An applicant may transmit an application for trademark registration electronically, but only if the applicant uses the Patent and Trademark Office's electronic form.*

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[55] *See* 37 CFR § 1.8(c); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997) (where prima facie proof of certificate of mailing is rebutted by other evidence, person signing certificate must submit an affidavit specifying the date of actual deposit); and *In re Klein*, 6 USPQ2d 1547, 1551-52 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), *cert. denied*, 490 U.S. 1091, 109 S.Ct. 2432 (1989).

[56] *See* 37 CFR §§ 1.6(d) and 1.8(a), and TBMP § 107 (How and Where to File Papers).

(4) ***Office of Public Records correspondence.***

(i) ***Assignments.*** *All … trademark-related documents to be recorded by Assignment Services Division, except for documents filed together with a new application or under § 3.81 of this chapter, should be addressed to:*

Mail Stop Document Services
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

See § 3.27

(ii) ***Documents.*** *All requests for certified or uncertified copies of patent or trademark documents should be addressed to:*

Mail Stop Document Services
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

The requirements for filing trademark-related papers (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents) by the certificate of mailing or transmission procedure are as follows:[57]

1. *Prior to the expiration of the set period*, the correspondence must be either (i) deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the USPTO by fax, in the manner described in 37 CFR § 1.6(d); and

2. Each piece of correspondence must include a certificate which states the date of deposit or transmission, and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed or transmitted on or before the date indicated.

Trademark-related documents sent to the Assignment Services Division for recordation should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States

[57] *See* 37 CFR § 1.8(a).

Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. If a certificate of mailing is used on such correspondence, it should specify that address.

Requests for copies (certified or uncertified) of trademark documents pertaining to applications and registrations are handled by the Certification Division, Office of Public Records. With the exception of coupon orders for uncertified copies of registrations, the address for all such requests mailed to the USPTO is: Mail Stop Document Services, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.[58]

The Assignment Services Division of the Office of Public Records also has an electronic trademark assignment recording form on the USPTO website. The system is called ETAS (Electronic Trademark Assignment System) and allows customers to create and submit a Trademark Assignment Recordation Coversheet by completing on-line web forms and attaching the supporting legal documentation. The form and additional information can be accessed by going to www.uspto.gov, going to "Trademarks" and then "File Assignment Documents On-line."

The certificate of mailing procedure may not be used for mail sent to the United States Patent and Trademark Office from a foreign country, because U.S. Postal Service first-class mail services are not available in foreign countries.

A certificate of mailing or a certificate of transmission should be clearly labeled as such and should include a reference to the proceeding number to which it pertains, the date of transmission, and the signature of the person attesting that the document is being transmitted on a certain date. When possible, the certificate should appear on the paper being transmitted, rather than on a separate sheet of paper.

110.03 Suggested Format

Shown below is a suggested format for a certificate of mailing, under 37 CFR § 1.8, for trademark-related mail (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents)

Certificate of Mailing

I hereby certify that this correspondence
is being deposited with the United States
Postal Service with sufficient postage as

[58] *See* 37 CFR §§ 1.1(a)(4)(i) and (ii).

first-class mail in an envelope addressed to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on _____ _____
Date Signature

_____
Typed or printed name of
person signing certificate

Shown below is a suggested format for a certificate of transmission under 37 CFR § 1.8:

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on _____ _____
Date Signature

_____
Typed or printed name of
person signing certificate

110.04 Location of Certificate

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP § 110.03 is used, it may be applied by rubber stamp to the first page of the correspondence, if feasible. Otherwise, it should be stamped or typed in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing or certificate of transmission format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there

will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

In some cases, there may not be room for a certificate of mailing or a certificate of transmission on a piece of correspondence. In such a case, the certificate may be typed on a separate sheet of paper securely attached to the correspondence.

However, the simple certificate formats shown in TBMP § 110.03 are not appropriate for use on a separate sheet of paper. Rather, a certificate placed on a separate sheet of paper must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or USPTO proceeding in connection with which the correspondence is being filed. If there is any doubt concerning the identity of the correspondence to which a certificate of mailing or certificate of transmission on a separate sheet pertains, the certificate will not be accepted.

110.05 Loss of Certificate of Mailing

If a certificate of mailing is typed on a separate sheet of paper attached to a piece of correspondence, and the certificate becomes detached, after the correspondence is filed in the USPTO, and does not contain identifying information sufficient to enable the USPTO to associate the certificate with the appropriate piece of correspondence, the USPTO will accept, as evidence that the certificate was filed with the specified correspondence, a postcard receipt (*see* TBMP § 108) which identifies the separate certificate of mailing sheet and the correspondence to which it was attached; accompanied by a copy of the certificate of mailing sheet as originally mailed.

110.06 Nonreceipt of Correspondence Bearing Certificate

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing or certificate of transmission, pursuant to 37 CFR § 1.8, but is not received in the USPTO, and there is a resulting USPTO action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the USPTO of the previous mailing or facsimile transmission of the correspondence promptly after becoming aware that the USPTO has no evidence of receipt of the correspondence, (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Director, to the previous timely mailing or transmission. The statement must be verified if it is made by a person other than a practitioner, as defined in 37 CFR § 10.1(r). If the correspondence was appropriate for filing by fax transmission, a copy of the sending fax machine's report confirming transmission may be used to support the statement.[59]

[59] *See* 37 CFR § 1.8(b).

If the document is not one authorized to be filed by facsimile transmission, the document will not be accepted.

For lost or misplaced correspondence intended for the Board, the evidence required by 37 CFR § 1.8(b) should be submitted to the Board for consideration. If the requirements of 37 CFR § 1.8(b) cannot be met, the only alternative is a petition to the Director.

110.07 Excluded Filings

The certificate of mailing procedure is not applicable to the filing of certain types of correspondence. The excluded filings include:

(1) The filing of a trademark application; and
(2) Certain other filings, as specified in 37 CFR § 1.8(a), which do not pertain to Board proceedings.

The certificate of mailing procedure is applicable to all types of filings in Board proceedings, including a notice of opposition; a petition to cancel; a request for an extension of time to oppose; a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Section 21(a)(1) of the Act of 1946, 15 U.S.C. § 1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit.

At present, the certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board.[60]

110.08 What a Certificate of Mailing or Transmission is Not ...

As is evident from the requirements for a certificate of mailing, specified in 37 CFR § 1.8(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 CFR § 1.8(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the USPTO, and that date will be used for all purposes, including the timeliness of the filing of the correspondence.[61]

Further, a certificate of mailing or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence

[60] *See* 37 CFR § 1.6(d). *See also* TBMP § 107 (How and Where to File Papers).

[61] *See* 37 CFR §§ 1.6 and 1.8.

was sent *to the USPTO* pursuant to the provisions of 37 CFR § 1.8(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served (by hand delivery, first-class mail, "Express Mail," or overnight courier) *upon another party*. A certificate of service cannot be used to prove the timeliness of the filing of the correspondence.[62]

111 "Express Mail" Procedure

111.01 In General

37 CFR § 1.10 Filing of correspondence by "Express Mail."
(a)

(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS, except for documents described in the following paragraphs (a)(1)(i) and (ii) of this section:

* * * *

(2) The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

(b) *Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.*

(c) *Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:*

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[62] *See* TBMP § 113 *for information concerning a certificate of service.*

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) *Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:*

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) *Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:*

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";
(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was

the date the correspondence was deposited in the "Express Mail Post Office to addressee" service prior to the last scheduled pickup for that day; and
(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) *The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.*

Certain papers or fees to be filed in the USPTO, including any paper or fee intended for the Board, can be filed utilizing the "Express Mail Post Office to Addressee" service (not the "Express Mail Post Office to Post Office" service) of the United States Postal Service, and be considered as having been filed in the USPTO on the date appearing on the "date-in" portion of the "Express Mail" mailing label.[63]

In effect, the "Express Mail" procedure permits all types of correspondence intended for the Board to be sent by the "Express Mail Post Office to Addressee" service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received by the Board until after the due date. This filing procedure applies only to the "Express Mail" of the United States Postal Service, not any third-party carrier that offers overnight delivery.[64]

111.02 Requirements for "Express Mail"

Trademark Rule 1.10(b) provides that prior to the original mailing, the "Express Mail" mailing label number should be placed on correspondence filed under Rule 1.10. The number of the mailing label should be placed on each separate submission and each fee transmitted, either directly on the document or on a separate paper firmly and securely attached to the document.

A party which wishes to send mail to the Board by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office" service. Mail sent to the USPTO, pursuant to 37 CFR § 1.10, by the "Express Mail Post Office to Addressee" service of the United States Postal Service is delivered to a USPTO employee. Mail sent to an addressee by the "Express Mail Post

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[63] *See* 37 CFR § 1.10(a)(1) and TMEP § 305.03 for "Express Mail" procedures for the Trademark Examining Operation.

[64] *See In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994).

Office to Post Office" service, on the other hand, is sent to a post office near the addressee, where it is held for 15 days for pickup by the addressee and then, if no pickup is made, returned to the sender. The USPTO does not pick up mail from post offices. Thus, correspondence sent to the USPTO by the "Express Mail Post Office to Post Office" service will not reach the USPTO but instead will be returned to the sender.

111.03 Questionable Date of Mailing

If the "date-in" appearing on the "Express Mail" label is illegible, the filing date will be the actual receipt date by the USPTO. If there is a discrepancy between the filing date assigned by the Office and the date of deposit, the person who filed the correspondence may petition the Director to accord the "date-in" date by providing the evidence set forth in 37 CFR §§ 1.10 (c), (d) and (e).[65]

112 Times for Taking Action

37 CFR § 1.7 Expiration on Saturday, Sunday or Federal holiday.
Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the Patent and Trademark Office falls on Saturday, Sunday or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or Federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, testimony depositions may be taken, and other evidence may be offered, on the next business day.[66]

If, because of some unscheduled event, such as adverse weather conditions, the USPTO is officially closed by Executive Order of the President or by the Office of Personnel Management

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[65] *For further information on petition procedures, see* Section 305.03(h) of the TMEP.

[66] *See, for example*, *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990) (when the five-year anniversary date of a registration falls on a weekend or holiday, petition filed on next business day is considered to have been filed within five years from the issue date).

for an *entire* day, that day will be regarded by the USPTO as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the USPTO is open. If, because of an unscheduled event, the USPTO is closed for *part* of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m., any action due to be taken, or fee due to be paid, on that day remains due on that day.[67] Notification of any change in this policy, given the particular circumstances of an unscheduled event, will be posted on the USPTO website at www.uspto.gov.[68]

113 Service of Papers

37 CFR § 2.119 Service and signing of papers.
(a) *Every paper filed in the Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties except the notice of interference (§ 2.93), the notification of opposition (§ 2.105), the petition for cancellation (§ 2.113), and the notice of a concurrent use proceeding (§ 2.99), which are mailed by the Patent and Trademark Office. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.*

(b) *Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and may be made in any of the following ways:*

(1) By delivering a copy of the paper to the person served;
(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;
(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;
(4) Transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered;
(5) Transmission by overnight courier.
Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the Official Gazette.

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[67] *See "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office,"* 1076 TMOG 6 (March 10, 1987).

[68] *See, for example,* "Notifications Related to Security Issues and Emergencies - Emergency Closure – September 11, 2001" posted on the USPTO website.

(c) *When service is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, "Express Mail," or overnight courier, 5 days shall be added to the prescribed period.*

* * * *

113.01 Requirement for Service of Papers

Every paper filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. The only exceptions to this rule are the notice of opposition and petition for cancellation, which are mailed by the Board to the defendant or defendants.[69]

The requirement for service of papers applies not only to papers filed in an inter partes proceeding before the Board, but also to papers filed in an application or registration which is the subject of such a proceeding, if the papers could have an effect on the inter partes proceeding. For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding; an abandonment of the application; or a voluntary surrender of the registration, must all be served by the defendant upon every other party to the proceeding.

113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a paper required by 37 CFR § 2.119(a), to be served upon every other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the paper will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a paper which does not include the required proof of service. For example, if an applicant in an opposition files an abandonment of its involved application without the written consent thereto of the opposer, and the abandonment does not include proof of service upon the opposer, the Board does not send out an action stating that the abandonment will not be considered until proof of service has been submitted. Rather, the Board itself mails a copy of the abandonment to the opposer, along with a copy of an action by the Board entering judgment in opposer's favor pursuant to 37 CFR § 2.135 (which provides, in part, that after the commencement of an opposition, if the applicant files a written abandonment of its application

[69] *See* 37 CFR § 2.119(a).

or mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant*)*.[70]

113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address. The statement must appear on, or be securely attached to, the paper being filed. If the statement is on a separate sheet attached to the paper being filed, it should clearly identify the paper and proceeding to which it relates.[71]

Suggested Format

Shown below is a suggested format for a certificate of service:

> I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).

113.04 Manner of Service

When a party to an inter partes proceeding before the Board files a paper required by 37 CFR § 2.119(a), to be served upon every other party to the proceeding, service may be made in any of the ways specified in 37 CFR § 2.119(b). They are: (1) by hand delivering a copy of the paper to the person being served; (2) by leaving a copy of the paper at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the paper at the person's address, with a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; and (5) transmission by overnight courier.

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[70] *See also, for example, Central Manufacturing Inc. v. Third Millennium Technology Inc.,* 61 USPQ2d 1210, 1212 n.3 (TTAB 2001) (unserved copy of objection to further extensions of time to oppose filed prior to institution of proceeding forwarded to opposer).

[71] *See* 37 CFR § 2.119(a).

In addition, whenever it is satisfactorily shown to the Director that none of the specified modes of serving the paper is practicable, service may be made by notice published in the *Official Gazette* of the USPTO.

When service of a paper is made by mail, pursuant to 37 CFR § 2.119(b)(4), the Board considers the mailing date of the paper to be the date when the paper is deposited with the United States Postal Service, i.e., the date when custody of the paper passes to the Postal Service. As provided in 37 CFR § 2.119(a), the Board ordinarily accepts, as prima facie proof of the date of mailing, the statement signed by the filing party, or by its attorney or other authorized representative, as to the date and manner of service. However, where the prima facie proof of the certificate of service is rebutted by other evidence, and the paper would be timely served if mailed on the date specified in the certificate of service, but untimely served if not mailed until the date indicated by the rebutting evidence, the Board may request that the person who signed the certificate of service submit an affidavit specifying the date when the paper was actually deposited with the United States Postal Service.

A party filing a paper in a Board inter partes proceeding may always, as a courtesy, send a copy of the paper to an adverse party by telephonic facsimile transmission ("fax"). However, transmission of the paper by fax does not constitute "service" thereof under the provisions of 37 CFR § 2.119.

Notwithstanding the fax transmission, the paper must still be served upon the adverse party by one of the methods specified in 37 CFR § 2.119(b), and the date of service of the paper upon the adverse party is the date when service is made by one of those specified methods.

113.05 Additional Time for Taking Action After Service by Mail

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a paper upon that party by another party to the proceeding, and the paper is served by first-class mail, "Express Mail," or overnight courier, the time for taking action is enlarged by 5 days.[72]

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery, and service of the motion is made by first-class mail, "Express Mail," or overnight courier, the served party's time for filing a response to the motion will be 20 days from the date of service of the motion, that is, from the date of mailing or of delivery to the overnight courier. Because the service was made by first-class mail, "Express Mail," or overnight courier, 5 days are added to the 15-day period prescribed in 37 CFR § 2.127(a) for filing a response to a motion.

[72] *See* 37 CFR § 2.119(c).

Trademark Rule 2.119(c), 37 CFR § 2.119(c), applies *only* when a party has to take some action within a prescribed period after the service of a paper upon it *by another party*, and service of the paper was made in one of three specified ways. It does *not* apply to an action that must be taken by a party within a time set in a communication *from the Board*. Thus, for example, when a Board action notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the date of the notification in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day.

113.06 A Certificate of Service is Not...

A certificate of service is not the equivalent of a certificate of mailing or transmission *for any purpose*.[73]

114 Representation of a Party

37 CFR § 10.14 Individuals who may practice before the Office in trademark and other non-patent cases.
(a) Attorneys. *Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.*

(b) Non-lawyers. *Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to Jan. 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.*

(c) Foreigners. *Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

[73] *Cf.* TBMP § 110.08 (What a Certificate of Mailing or Transmission is Not…).

(d) *Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.*

(e) *No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.*

114.01 Party May Represent Itself

A party may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative.[74]

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it.[75]

However, because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that a party be represented by an attorney familiar with trademark law.

114.02 Selection of Attorney

The Board cannot aid a party in the selection of an attorney, nor does the USPTO maintain a register or list of trademark attorneys.[76]

114.03 Representation by Attorney

Any attorney, as that term is defined in 37 CFR § 10.1(c) [i.e., "an individual who is a member in good standing of the bar of any United States court or the highest court of any state"], is eligible to represent others before the USPTO in trademark cases, including proceedings before the Board, and in other non-patent cases. Such an attorney is not required to apply to the USPTO for

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[74] *See* 37 CFR § 10.14(e).

[75] *See* 37 CFR § 10.14(e).

[76] *See* 37 CFR § 2.11.

registration or recognition to practice before the USPTO in trademark and other non-patent cases.[77]

An attorney, as defined in 37 CFR § 10.1(c), will be accepted as a representative of a party in a proceeding before the Board if the attorney either (1) makes an appearance in the proceeding (as, for example, by filing a paper) on behalf of the party and satisfactorily identifies himself or herself as an attorney,[78] or (2) files a written power of attorney signed by the party the attorney represents.

When representation has been established by the filing of a paper, a new notice of appearance is sufficient to change the attorney of record. However, if representation has been established by the filing of a power of attorney, and thereafter another attorney or other authorized representative appears on behalf of the party, a new power of attorney is required to change the attorney of record.

When an attorney, as defined in 37 CFR § 10.1(c), acting in a representative capacity signs a paper or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes, inter alia, a representation to the USPTO that, under the provisions of 37 CFR § 10.14 (which specifies the types of individuals who may practice before the USPTO in trademark and other non-patent cases) and the laws of the jurisdiction where the attorney is licensed to practice that he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required.[79]

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., "to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith"), and be signed by the party granting the power. The USPTO requires that a power of attorney specify the names of one or more individuals. A power which specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s).[80] A power that specifies only the

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[77] *See* 37 CFR §§ 10.1(c) and 10.14(a), and *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993).

[78] S*ee Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).

[79] *See* 37 CFR § 2.17(a).

[80] *See, e.g., HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (other named attorneys appointed by petitioner were authorized to represent petitioner and assume responsibility for the case.)

name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent.[81]

114.04 Representation by Non-lawyer (i.e., "Other Authorized Representative")

The only non-lawyers permitted to represent others in trademark cases before the USPTO, including proceedings before the Board, are those who were recognized to practice before the USPTO in trademark cases under Chapter 1 of 37 CFR prior to January 1, 1957.[82] Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party which he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record).[83]

114.05 Representation by Foreign Attorney or Agent

37 CFR § 10.14(c) Foreigners. *Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

Under certain conditions, specified in 37 CFR § 10.14(c), a foreign attorney or agent who is not a resident of the United States may be recognized for the limited purpose of representing, in trademark cases before the USPTO, parties located in the country in which the attorney or agent resides or practices. For information on how to meet the specified conditions, contact the USPTO's Office of Enrollment and Discipline. When a foreign attorney is recognized to practice before the Office, the parties are reminded that the certificate of mailing procedure is not available for use on mail which originates in a foreign country.

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[81] *See* TMEP § 602.01 and TBMP § 117 (Correspondence – With Whom Held).

[82] *See* 37 CFR § 10.14(b); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from practice before the Office); and *Weiffenbach v. Frank*, 18 USPQ2d 1397, 1400 (Comm'r 1991) (patent agent engaged in unauthorized representation).

[83] *See* 37 CFR § 2.17(b).

Currently, Canada provides substantial reciprocal privileges to attorneys in the United States to practice before its trademark office. Therefore, Canada is recognized by the USPTO's Office of Enrollment and Discipline as qualifying for the limited exception provided in § 10.14(c) permitting the Canadian attorney to represent a Canadian party before the Office. The Office of Enrollment and Discipline maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office.

However, the certificate of mailing procedure is not available for use on mail which originates in Canada, as it is not deposited in the United States mail as required by the certification.

114.06 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the USPTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board.[84]

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the USPTO in trademark cases, is attempting to represent a party in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a paper on behalf of a party to a Board proceeding, the paper will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the USPTO in trademark cases, is filed. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the USPTO in trademark cases.[85]

114.07 Designation of Domestic Representative

37 CFR § 2.24 Designation of representative by foreign applicant.

If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize

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[84] *For information concerning who is entitled to practice before the USPTO in trademark cases, see* TBMP §§ 114.03-114.05. *Cf.* TMEP § 602.

[85] *See* 37 CFR § 2.18 and TBMP § 117 (Correspondence – With Whom Held).

the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 10.14 of this subchapter and authorized under § 2.17(b).

37 CFR § 2.119(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 10.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under § 10.14(b) and authorized under § 2.17(b).*

Shown below is a suggested format for the designation of a domestic representative (the suggested format should appear below information identifying the proceeding in connection with which it is filed):

Designation of Domestic Representative

(Name of Domestic Representative), whose postal address is _____
_____,
is hereby designated (Name of Designating Party)'s representative upon whom notice or process in this proceeding may be served.

_____
(Signature of Designating Party)

_____
(Identification of Person Signing)

_____
(Date of Signature)

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized

representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 10.14(c).[86]

If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.[87]

114.08 Adverse Parties Represented by Same Practitioner

37 CFR § 10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.

(a) *A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.*

(b) *A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.*

(c) *In the situations covered by paragraphs (a) and (b) of this section a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.*

(d) *If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.*

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the USPTO. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if

[86] *See* TBMP § 117.06 (Correspondence with Foreign Party).

[87] *See* 37 CFR § 2.119(d).

the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests.[88]

However, a practitioner may represent multiple clients under the particular circumstances specified in 37 CFR § 10.66(c).

If it comes to the attention of the Board that two or more parties whose interests are in conflict appear to be represented by the same practitioner, or by different practitioners within the same firm, each of the parties and their practitioner(s) will be notified by the Board, in writing, of the possible conflict of interest.

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subjected to disciplinary action.[89]

115 Conduct of Practitioner

115.01 Applicable Rules

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 10 of 37 CFR. Part 10 contains both Canons (set out in Rules 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110) and Disciplinary Rules (set out in Rules 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112). Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while

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[88] *See* 37 CFR §§ 10.66(a) and (b) and *Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm'r 1991) (petitioner's former attorney in patent matter not disqualified from representing respondent in trademark cancellation proceeding); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684, 685 (Comm'r 1984) (opposer has no right to seek disqualification of applicant's counsel based on any possible conflict between applicant and third parties); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 221 USPQ 1077, 1082 (Comm'r 1984) (attorney was disqualified, but law firm was not); *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071, 1075 (Comm'r 1984) (attorney representing respondent in an opposition disqualified in view of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues); and *Halcon International, Inc. v. Werbow*, 228 USPQ 611, 613 (Comm'r 1980) (attorney representing one party in a patent interference proceeding disqualified in view of his previous representation of the adverse party in connection with a process similar to the process involved in the interference). *See also* Rules 1.7 and 1.9 of the American Bar Association's Model Rules of Professional Conduct.

[89] *See* 37 CFR § 10.20(b).

Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action."[90]

115.02 Disciplinary Proceedings

37 CFR § 1.4 Nature of correspondence and signature requirements.
(d) ** * * **

(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).

37 CFR § 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

* * * *

(b) *By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

[90] 37 CFR § 10.20.

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 CFR § 10.130 Reprimand, suspension or exclusion.

(a) *The Commissioner may, after notice and opportunity for a hearing, (1) reprimand or (2) suspend or exclude, either generally or in any particular case, any individual, attorney, or agent shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule.*

(b) *Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.*

By rule change effective December 1, 1997, 37 CFR § 1.4(d)(2) was amended to provide that by presenting a paper to the Office, the signer makes the certifications set forth in 37 CFR § 10.18(b), and is subject to sanctions under 37 CFR § 10.18(c) for violation of 37 CFR § 10.18(b)(2), regardless of whether the party is a practitioner or non-practitioner.[91]

The rules governing disciplinary proceedings are set out in 37 CFR §§ 10.130-10.170. Such a proceeding is instituted only under the circumstances specified in 37 CFR §§ 10.131-10.132.

115.03 Petitions to Disqualify

37 CFR § 10.130(b) *Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.*

[91] *For examples of cases involving disciplined practitioners, see Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558, 1560 (Fed. Cir. 1989) (patent attorney excluded from practice for certificate of mailing violations); *Weiffenbach v. Logan*, 27 USPQ2d 1870, 1875 (Comm'r 1993) (patent attorney suspended from practice before USPTO for five years for altering an office action in a patent application and engaging in other unethical conduct); and *McCandlish v. Doe*, 22 USPQ2d 1223, 1227 (Comm'r 1992) (patent attorney reprimanded by Commissioner for misrepresenting facts and knowingly allowing documents to remain of record which had been withdrawn).

Petitions to disqualify practitioners representing parties in ex parte or inter partes cases before the Board are *not* disciplinary proceedings and hence are not governed by 37 CFR §§ 10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR § 10.130(b).[92]

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition.

For further information concerning petitions to disqualify, see TBMP § 513.02.

116 Termination of Representation

116.01 Revocation of Authority

37 CFR § 2.19 Revocation of power of attorney or of other authorization to represent; withdrawal.

(a) *Authority to represent an applicant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Director; and when it is so revoked, the Office will communicate directly with the applicant or party to the proceeding or with such other qualified person as may be authorized. The Patent and Trademark Office will notify the person affected of the revocation of his or her authorization.*

Authority to represent a party in a proceeding before the Board may be revoked, at any stage of the proceeding, by filing a written revocation with the Board. Thereafter, the Board will not recognize that person as a representative in the case, or give any consideration to any papers which he or she may file therein, unless a new written authorization of that person, signed by the party, is filed in the proceeding.

116.02 Withdrawal as Representative--In General

37 CFR § 2.19(b) *An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Director.*

37 CFR § 10.40 Withdrawal from employment.
(a) *A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this subchapter). In any event, a practitioner*

[92] *For examples of cases involving petitions to disqualify, see the decisions cited in* TBMP § 114.08 (Adverse Parties Represented by Same Practitioner).

shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) Mandatory withdrawal. *A practitioner representing a client before the Office shall withdraw from employment if:*

(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

(c) Permissive withdrawal. *If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:*

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;

(ii) Personally seeks to pursue an illegal course of conduct;

(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;

(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;

(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
(5) The practitioner's client knowingly and freely assents to termination of the employment; or
(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Under certain circumstances, a practitioner may withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board. A practitioner who wishes to withdraw must file a written request with the Board for permission to do so. The practitioner may not withdraw until he or she has complied with the conditions specified in 37 CFR § 10.40(a).

116.03 When Withdrawal is Mandatory

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is mandatory under the circumstances specified in 37 CFR § 10.40(b).

116.04 When Withdrawal is Permissive

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is permissive under the circumstances specified in 37 CFR § 10.40(c).

116.05 Request to Withdraw

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§ 10.40(b) and (c). Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a). *See* 37 CFR §§ 2.19(b) and 10.40.[93]

The propriety of a request for permission to withdraw as counsel in an application which is the subject of a potential opposition is determined by the Board, and not the examining operation.[94]

For further information concerning the requirements for a request to withdraw as representative, and the action taken by the Board when such a request is granted, see TBMP § 513.01.

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[93] *Cf. In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r 1992).

[94] *See* TBMP § 212.01 (Jurisdiction to Consider Amendment).

117 Correspondence - With Whom Held

37 CFR § 2.18 Correspondence, with whom held.
If papers are transmitted by an attorney at law, or a written power of attorney is filed, the United States Patent and Trademark Office will send correspondence to the attorney at law transmitting the papers, or to the attorney at law designated in the power of attorney. If an application or proceeding is not being prosecuted by an attorney at law, and the applicant, registrant or party to a proceeding before the Office has appointed a domestic representative, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another address to which correspondence is to be sent. If the application or proceeding is not being prosecuted by an attorney and the applicant, registrant or party has not designated a domestic representative, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another address to which correspondence is to be sent. Correspondence will continue to be sent to such address until the applicant, registrant or party, or the attorney or other authorized representative of the applicant, registrant or party, indicates in writing that correspondence is to be sent to another address. The Office will not undertake double correspondence, and if more than one attorney at law or other authorized representative appears or signs a paper, the Office's reply will be sent to the address already established in the record until another correspondence address is specified by the applicant, registrant or party or by the attorney or other authorized representative of the applicant, registrant or party.

37 CFR § 2.24 Designation of representative by foreign applicant.
If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of §10.14 of this subchapter and authorized under §2.17(b).

37 CFR § 2.119(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 10.14(c) of this subchapter. If the party has not*

appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under § 10.14(b) and authorized under § 2.17(b).

117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney or other authorized representative. If a party is domiciled in the United States, such correspondence will be sent to the party at the party's address of record in the proceeding, unless an appearance is made on behalf of the party by an attorney (as defined in 37 CFR § 10.1(c)), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the party for correspondence.[95] Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address.[96]

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence.[97]

117.02 When There is More Than One Attorney or Other Authorized Representative

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests

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[95] *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079 (TTAB 1992) (new power of attorney filed); and *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 (TTAB 1991) (appearance made by filing motion in the proceeding).

[96] *See* 37 CFR § 2.18.

[97] *See Jack Lenor Larsen Inc. v. Chas. O. Larson Co*., 44 USPQ2d 1950, 1953 (TTAB 1997).

otherwise in writing. This is because the typing of a large number of names on a proceeding file, correspondence, and final decision consumes an excessive amount of space and time, and hence is impractical and burdensome. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.

Double correspondence, that is, the sending of correspondence to two addresses on behalf of a single party, ordinarily will not be undertaken by the Board. If more than one attorney or other authorized representative makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other authorized representative(s) will be accepted, but the Board will send correspondence to only one of them, to be determined according to the circumstances in the case.[98]

For example, if one attorney or other authorized representative ("A") makes an appearance on behalf of a party, and his or her address is thus established in the proceeding file as the correspondence address, following which a second attorney or other authorized representative ("B") makes an appearance on behalf of the party, *and files a written request that correspondence be sent to him or her*, the correspondence address on the proceeding file will be changed, and future correspondence will be sent to B, rather than A. No requirement will be made that B submit authorization, from the party or from A, for the change of correspondence address, nor will B be required to serve a copy of the request upon A. If B does not file a written request that correspondence be sent to him or her, correspondence will continue to be sent to A.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter another attorney or other authorized representative ("B") makes an appearance on behalf of the party and files a written request that correspondence be sent to him or her, B ordinarily will be required to submit authorization, from the party or from A, for the requested change in the correspondence address. *However*, if B's request for change of correspondence address bears proof of service of a copy thereof upon both the party and A, and neither files an objection to the request, the correspondence address will be changed, and future correspondence will be sent to B, rather than to A.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter a power of attorney from the party to another attorney ("B") is filed, the second power of attorney will be construed, even if there is no revocation of the first power, as a written request to change the correspondence address from A to B, unless the party or A directs otherwise. *Cf.* TMEP § 603. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a

[98] *See* 37 CFR § 2.18.

written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter A files an "associate power of attorney" to another attorney ("B"), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise.[99]

If a power of attorney from a party to several attorneys ("A," "B," and "C") in the same firm ("XYZ") has been filed, and thereafter A leaves the firm but does not file a request that all future correspondence be sent to him or her, rather than to B and/or C, the Board will continue to send correspondence to B and/or C. If A, after leaving firm XYZ, does file a request that all future correspondence be sent to him or her, rather than to B and/or C, the correspondence address will be changed as requested. If, however, B and C object, and maintain that it is they, rather than A, who continue to represent the party and are entitled to receive correspondence, proceedings in the case will be suspended until a designation of correspondence address by the party has been submitted.

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the Board, in its discretion, may request that the plaintiffs appoint one lead counsel, to whom the Board may send correspondence intended for the plaintiffs.[100] After the lead counsel has been appointed, the Board will send one copy of any forthcoming Board order, decision, or other communication to the applicant or its attorney or other authorized representative, and one copy to plaintiffs' lead counsel. Lead counsel in turn will be responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs' cases. A Board action requesting the appointment of lead counsel normally includes a detailed explanation of the anticipated duties and responsibilities of lead counsel.

In special circumstances, the Board, in its discretion, may send a particular item of correspondence to more than one address on behalf of a single party. However, the Board will

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[99] *Cf.* TMEP § 603.

[100] *Cf. Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, 1436 n.2 (TTAB 1996) (in three proceedings where defendant in one case was one of two plaintiff's in the two other cases, and where each plaintiff retained separate counsel, Board indicated that it would send correspondence to attorneys for the plaintiff which was a party to all three cases unless otherwise advised).

not send correspondence to more than one address on behalf of a single party on a continuing basis.

117.03 Continuation of Correspondence With Representative in Application or Registration When Inter Partes Proceeding Commences

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address.[101] Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself or its domestic representative unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent.[102]

Changes of attorney addresses or powers of attorney in registration files are accepted by the Office when submitted with post-registration filings, such as those under Sections 7, 8, 9 or 15 of the Act, 15 U.S.C. §§ 1057, 1058, 1059 or 1065; as well as in a cancellation or concurrent use proceeding before the Board. The attorney representing the registrant is responsible for insuring that registrant's correspondence address is updated. Separate address changes for registrants and domestic representatives are accepted by the Office, but global changes of address (when one paper is filed listing all involved registrations) will be returned by the Office.

117.04 Continuation of Correspondence with Representative of Potential Opposer After Opposition is Filed

When an attorney is appointed in a power of attorney accompanying an opposition, or makes an appearance by filing an opposition on behalf of the opposer, correspondence will be sent by the Board to that attorney, notwithstanding the fact that another attorney or attorneys may have obtained one or more extensions of time to oppose on behalf of the opposer. If, however, a

[101] *See* 37 CFR § 2.105.

[102] *See* 37 CFR §§ 2.18 and 2.113.

power of attorney filed with an opposition names several attorneys, and there is no transmittal letter and no other indication as to which of them is to have primary responsibility for the case and receive correspondence, but one of the named attorneys obtained an extension of time to oppose, correspondence will be sent to that attorney; if none of the named attorneys obtained an extension of time to oppose, correspondence will be sent to the first named attorney. Thereafter, the correspondence address may be changed in appropriate circumstances.

117.05 Correspondence After Revocation or Withdrawal

If the authority of a practitioner (i.e., attorney or other authorized representative) to represent a party in a proceeding before the Board is revoked, or the practitioner is granted permission to withdraw upon request therefor to the Board, and the party is not represented by any other practitioner, correspondence will be sent to the party at its address of record unless another practitioner puts in an appearance, or a written appointment of another practitioner is filed, or the party designates in writing another address to which correspondence is to be sent.

117.06 Correspondence With Foreign Party

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 10.14(c), correspondence will be sent to the party's domestic representative, if one has been appointed. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.[103]

117.07 Change of Address

If a party to a Board proceeding or its attorney or other authorized representative moves, a separate written notice of the change of address should be filed with the Board and should reference the proceeding number. It is the responsibility of a party to a proceeding before the Board to ensure that the Board has the party's current correspondence address. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party.

A party or its attorney or other authorized representative should not assume that the inclusion of a new address on a paper directed to another matter, or on the envelope in which the paper is filed, is sufficient to notify the Board of a change of address. Mail sent to the USPTO is opened in the USPTO Mail Room, and ordinarily the envelopes are discarded there before the mail is

[103] *See* 37 CFR § 2.119(d).

sent on to its ultimate destination within the USPTO. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings. Moreover, while it is the normal practice of the Board to check the address on newly filed papers and to change its records to reflect any noted change of address, the Board has no obligation to do so. The responsibility for any failure to receive correspondence due to a change of address of which the Board has not been given separate written notice lies with the party or its attorney or other authorized representative.

117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the USPTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file papers on behalf of the party.[104] If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chief Administrative Trademark Judge, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the USPTO in trademark cases.[105]

118 Payment of Fees

118.01 Lists of Fees and Charges

A list of the fees and charges established by the USPTO for trademark cases may be found in 37 CFR § 2.6, and are usually posted on the USPTO website at www.uspto.gov.

A list of fees and charges established by the USPTO for miscellaneous services may be found in 37 CFR § 1.21, as well as on the USPTO website.

118.02 Fees Payable in Advance

37 CFR § 1.22 Fees payable in advance.
(a) *Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under § 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.*

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[104] *Cf.* TMEP § 602.03.

[105] *See* 37 CFR § 2.18.

(b) *All fees paid to the United States Patent and Trademark Office must be itemized in each individual application, patent, trademark registration file, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.*

118.03 Method of Payment--In General

37 CFR § 1.23 Method of payment.

(a) *All payments of money required for United States Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Office will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.*

(b) *Payments of money required for United States Patent and Trademark Office fees may also be made by credit card. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.*

It is the practice of the USPTO to routinely accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment.[106] An unsigned check will be returned to its sender, but the Director has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor.[107]

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[106] *See In re Cantatore*, 231 USPQ 742, 744 (Comm'r 1986) (petition to revive was denied because filing fee check was returned for insufficient funds).

[107] *See Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985), *on remand, In re Dubost*, 231 USPQ 887, 889 (Comm'r 1986) (sufficient cause not shown).

The USPTO cannot accept U.S. Treasury checks that have been issued to the applicant or to another party as payment of USPTO fees. This is true for all refund checks whether issued from the USPTO or any other government agency. Office rules require that money orders and checks be made payable to the Director of Patents and Trademarks and do not permit the acceptance of U.S. Treasury checks endorsed by the applicant in payment of fees.

Papers accompanied by fees may be filed by delivery to the finance window at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, VA.[108]

118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the USPTO, deposit accounts may be established in the USPTO.[109] The USPTO has an automated financial system, the Revenue Accounting and Management (RAM) system, which allows transactions to occur over the Internet through the USPTO website at www.uspto.gov. Deposit accounts can be maintained through the Internet and funds replenished using a credit card.

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR § 1.25 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee.[110] Thus, the overdrawing of a deposit account may result in the loss of a vital date.[111]

It is Office policy not to accept ex parte appeals if the notice of appeal is not accompanied by at least a $100 fee or specific authorization to charge the deposit account for that fee, as opposed to a general authorization which may have been provided when the application was filed. A general authorization to charge a deposit account will only be effective upon petition to the Director.[112] Because the general authorization can only be invoked on petition, the Board itself cannot accept the general authorization as a basis for treating the appeal fee as timely submitted.

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[108] *For further information concerning how and where to file fees, see* TBMP § 107.

[109] *For information concerning the establishment of a deposit account in the USPTO, see* 37 CFR § 1.25.

[110] *See* 37 CFR § 1.25(b).

[111] *See* Notice at 824 TMOG 1200 (February 23, 1966).

[112] *See In re Sky is the Ltd.,* 42 USPQ2d 1799, 1800 (Comm'r Pats. 1996).

119 Papers and Fees Generally Not Returnable

119.01 Fee Refunds--General Rule

37 CFR § 1.26 Refunds.
(a) *The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.*
(b) *Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.*

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119.02 Papers and Fees--Ex Parte Cases

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not normally be returned.[113]

If a notice of appeal to the Board from an Examining Attorney's final refusal is late filed, the appeal will not be entertained, the application will be abandoned, the notice of appeal will be retained in the application file, and any appeal fee submitted therewith will be refunded. If a notice of appeal is filed prematurely, the appeal will not be entertained, the notice of appeal will be retained in the application file, the application will be returned to the Examining Attorney for further appropriate action, and applicant will be advised that if a timely appeal is subsequently filed in the case, any fee submitted with the premature appeal will be applied thereto, or, if no timely appeal is filed, applicant may request a refund of any such fee.

[113] *See* 37 CFR § 2.25.

If a final refusal to register is withdrawn by the Examining Attorney, and the application is approved for publication, following which the applicant, not knowing that the application has been approved for publication, files a notice of appeal, the appeal will not be instituted, the notice of appeal will be retained in the application file, and any appeal fee submitted therewith will be refunded. In such a case, the notice of appeal, and appeal fee, are considered to have been filed in excess, rather than by change of purpose, since at the time of its filing, the appeal was unnecessary. If, however, the Examining Attorney withdraws the refusal to register, and approves the application for publication, *after* an appeal to the Board has been filed, the appeal will be dismissed as moot, and the appeal fee will not be refunded (the appeal having been necessary at the time of its filing).

119.03 Papers and Fees--Inter Partes Cases

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith normally will not be returned, unless filed in contravention of Board rules. Exhibits to testimony and confidential materials filed under a protective order ordinarily are returned after the conclusion of a proceeding, including any appeal period, to the party which filed them.[114]

However, if because of a defect in an opposition or a petition for cancellation filed with the Board, a proceeding is not instituted, the papers will be returned to the party which filed them, and any fee submitted therewith will be refunded.

No proceeding will be instituted, the opposition papers will be returned, and any filing fee submitted therewith will be refunded in the following circumstances:

> (1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake, no proceeding will be instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.
>
> (2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the *Official Gazette* for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively), no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

[114] *Cf.* TBMP § 806 (Termination of Proceeding).

(3) If an opposition is filed after the time for opposing has expired; or is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee, and the fee is not submitted within the time allowed by the Board; or if the opposed application was abandoned before the opposition was filed.[115]

Proceedings will be instituted and the filing fee charged in the following circumstances:

(1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Section 14 of the Act of 1946, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Any fee submitted therewith will not be refunded.

(2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (e.g., the time for filing an affidavit of use under Section 8 of the Act of 1946, 15 U.S.C. § 1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding), the proceeding will be instituted, and then dismissed as moot. Any fee submitted with the petition for cancellation will not be refunded.

(3) If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request ordinarily will be denied, and the proceeding will be instituted, unless there is a defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

When a proceeding is erroneously instituted, the proceeding will be dismissed as a nullity, rather than vacated, so as to maintain the integrity of the proceeding numbers. All papers will be retained by the Board.

120 Access to Files

37 CFR § 2.27(d) *Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating*

[115] *See* TBMP § 218 (Abandonment of Application).

thereto are available for public inspection and copies of the papers may be furnished upon paying the fee therefor.

37 CFR § 2.27(e) *Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or a registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.*

120.01 Nonconfidential Files

Except for materials filed under seal pursuant to a protective agreement, the files of applications and registrations which are the subject matter of pending proceedings before the Board, all pending proceeding files and exhibits thereto, and the files of applications which are the subject matter of "potential oppositions," are available for public inspection and copying at the offices of the Board.[116]

An individual who wishes to inspect and/or copy one of the these files may come to the Board's reception desk, where the Board maintains an electronic log of file requests, and ask for the file. The individual must identify the file by its number, so that it may be located by the Board. If the request is logged in before noon, the file is generally available that afternoon. When the individual returns, the file will be given to him or her for inspection and/or copying on the premises of the Board. Files or portions thereof may *not* be taken away from the offices of the Board, and a person who removes papers from a file for copying at the offices of the Board should always return the papers to the file *in their proper order*.

To save time, an individual who wishes to inspect a file that is in the possession of the Board may call and ask that the file be located. When the file has been located, the Board will call the individual back to tell him or her that the file is available.

The electronic image files on TTABIS are available to the public in the Trademark Search Library.

For information concerning access to the files of cases that are on appeal from a decision of the Board, see TBMP § 904.

[116] *See* 37 CFR § 2.27.

120.02 Confidential Materials

Materials filed with the Board under seal pursuant to a protective order entered by any court or by the Board and filed in compliance with TBMP § 412.06, will be kept confidential and will *not* be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information.[117]

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying. Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion which disclose confidential information should be filed under seal pursuant to a protective order. If a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.[118] Confidential materials filed in the absence of a protective order may not be kept confidential by the Board.[119]

120.03 Files of Terminated Proceedings

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over, the USPTO takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the "termination" of the proceeding. For example, when a decision dismissing an opposition has become final, the word "TERMINATED" is stamped on the file of the opposition proceeding, the opposition file is sent to the warehouse where the files of terminated proceedings are stored, and the registration sought by the applicant is issued.[120]

Pursuant to the National Archives retention schedule, terminated inter partes proceeding files which result in a final decision by the Board, e.g., motion for summary judgment, motion to

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[117] *See* 37 CFR §§ 2.27(e); 2.120(f), and 2.125(e); and TBMP §§ 412.02 (Protective Orders Upon Stipulation), 526 (Motion for Protective Order) and 703.01(p) (Confidential or Trade Secret Material).

[118] *See* 37 CFR § 2.27(d) and (e); *Duke University v. Haggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000); and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

[119] *See Harjo v. Pro-Football, Inc.,* 50 USPQ2d 1705, 1714 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of motion for protective order but advised that in absence of such motion the exhibits would be placed in the proceeding file).

[120] *See* TBMP § 806 (Termination of Proceeding).

dismiss, or final decision on the merits, are transferred to a warehouse for 3 years, then to the Federal Records Center for 27 years and then to the National Archives for permanent retention. All other terminated proceedings are transferred to a warehouse for 3 years and then transferred to the National Records Center where they remain for 27 years before destruction. The files of existing registrations are also stored at the warehouse. The files of cancelled and expired registrations are destroyed two years after the date of cancellation or expiration; the files of abandoned applications are destroyed two years after the date of abandonment. In addition, the files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect and/or copy a file stored by the USPTO in a warehouse can go to the Public Service Window located on the second floor of the South Tower building, 2900 Crystal Drive, Arlington, Virginia, and place an order for the file. Alternatively, the individual can order the file electronically from a computer terminal located in the Trademark Search Library, or from a computer terminal located in the Patent Search Room. Within a few days, the USPTO will obtain the ordered file from the warehouse, and make it available to the individual for inspection and/or copying at the Trademark Search Library. The file may not be taken away from the premises of the Trademark Search Library.[121]

121 Copying of Files

The Board has, on its office premises, a photocopier which is intended for use by members of the public who wish to photocopy files, exhibits, or other materials in the possession of the Board. Payment for use of the machine is made by way of a magnetic card, known as a "copy card," which may be purchased at, inter alia, the USPTO Finance Window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia, or from a machine located in the Trademark Search Library on the second floor of the South Tower Building. The photocopier will not operate until such a card has been inserted in it.

Files or portions thereof *may not* be taken away from the offices of the Board, and a person who removes papers from a file for copying at the offices of the Board should always return the papers to the file *in their proper order*.

Alternatively, the USPTO Office of Public Records will furnish photocopies (either certified or uncertified) of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in 37 CFR § 2.6. The USPTO will also furnish, upon written request and payment of the fee prescribed in 37 CFR § 2.6, printed copies of trademark registrations, certified copies of

[121] *See* TMEP § 109.

registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified and uncertified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the USPTO's Document Services, Office of Public Records. A written request (with the required fee) for copies should be addressed to Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The written request, with fee, may also be hand delivered to the Public Service Window at 2900 Crystal Drive, South Tower Building, Second Floor, Arlington, Virginia 22202-3514; or to the Office of Public Records, Crystal Gateway 4, Third Floor, 1213 Jefferson Davie Highway, Arlington, Virginia 22202-3513; or to the Attorneys' Window at 2201 S. Clark Place, Crystal Plaza Building 4, First Floor, Arlington, Virginia 22202. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by facsimile transmission to (703) 305-8759.[122] Orders may also be placed over the Internet through the USPTO homepage at www.uspto.gov.

122 Certification

122.01 Court Requirements

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a district court, the court may require a certified copy (which bears a seal). This may be obtained from the USPTO Document Services of the Office of Public Records.

A paper cannot be certified by the USPTO as being a true copy of a paper filed in a Board proceeding unless and until it has, in fact, been filed therein. The paper may be filed at the same time that the request for certification is made.

122.02 Certified Copies

Certified copies, bearing a seal, of USPTO proceeding files, including Board proceeding files, or portions thereof, may be ordered from the USPTO's Document Services, Office of Public Records, upon written request and payment of the required fee.[123]

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[122] *See "Notice of a Change in Procedure Regarding Requests for Certification Services,"* 1165 TMOG 13 (August 2, 1994).

[123] *See* TBMP §§ 121 (Copying of Files) and 122.02 (Certified Copies).

123 Status Information for Applications, Registrations and Board Proceedings

The USPTO maintains a Trademark Status Line which provides access, by push-button telephone, to current status, status date (i.e., the date that a record entered its current status), and status location information for all active Federal trademark application and registration records maintained in the automated Trademark Reporting and Monitoring (TRAM) System.[124] The line is available on (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday (except for Federal holidays). The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at 703-308-9000. Trademark application and registration information can also be obtained through the USPTO website at www.uspto.gov and through the Trademark Applications and Registrations Retrieval (TARR) database at http://tarr.uspto.gov. The status of Board proceedings and of requests for extensions of time to oppose can be obtained through the Board Information Systems Index (BISX) at www.uspto.gov. Electronic images of proceeding files on TTABIS and the electronic filing system, ESTTA, are both available to the public in the Trademark Library Search Room.

For further information concerning the Trademark Status Line, see TMEP § 1707.05, and TMEP §§ 108 *et seq.*

124 Action by Assignee

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted.[125] Similarly, when a mark which is not the subject of a Federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding (either itself, or through its attorney or other authorized representative) in place of the assignor, provided that proof of the assignment has been submitted in the proceeding.[126]

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[124] *See In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992).

[125] *See* 37 CFR §§ 3.71 and 3.73(b).

[126] *See* TBMP § 512.01 (Assignment of Mark).

Chapter 200
EXTENSIONS OF TIME TO OPPOSE

201 In General

15 U.S.C. § 1063 (a) *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.*

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

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

(c) *The opposition must be filed within thirty days after publication (§2.80) of the application being opposed or within an extension of time (§2.102) for filing an opposition.*

* * * *

37 CFR § 2.102 Extension of time for filing an opposition.
(a) *Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.*

(b) *The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.*

(c) *The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any*

extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. A first extension of time for not more than thirty days will be granted upon request. Further extensions of time may be granted by the Board for good cause. In addition, extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.

(d) *Every request to extend the time for filing a notice of opposition should be submitted in triplicate.*

Any person (whether natural or juristic--*see* TBMP § 303.02) who believes that he, she, or it would will be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the USPTO, stating the grounds therefor, within 30 days after the publication of the mark in the *Official Gazette* for purposes of opposition.[1]

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition.[2] Requests for extensions of time to oppose are determined by the Board.[3]

An extension request, though it does not invest the Board with technical jurisdiction over the application, requires the Board to take custody of the file to process the extension. Thus, communications with the Office in regard to an application that is subject to an extended opposition period must be directed to the Board.

The time for filing a request for an extension of time to oppose is governed by Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102(c*). For further information concerning the time for filing a request for extension of time to oppose, see* TBMP § 202.

Other requirements for a request for extension of time to oppose are specified in 37 CFR § 2.102. Moreover, certain requirements for papers filed in inter partes proceedings before the Board also

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[1] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.101. *For further information concerning the filing of an opposition, see* TBMP chapter 300.

[2] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102.

[3] *See* 37 CFR § 2.102(c), and *Cass Logistics Inc. v. McKesson Corp.,* 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (Trademark Rule 2.102(c) delegates the authority to the Board to grant, ex parte, extensions of time to oppose).

apply to a request for extension of time to oppose. *For information concerning the requirements (other than the time requirement) for a request for extension of time to oppose, see* TBMP §§ 203-208. The Electronic System for Trademark Trials and Appeals (ESTTA) is available for filing extensions of time to oppose electronically. Available forms and instructions can be found at www.uspto.gov.

202 Time for Filing Request

202.01 In General

U.S.C. § 1063 (a) *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.*

37 CFR § 2.102(c) *The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. ...*

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for purposes of opposition. Any request for a further extension of time to oppose must be filed prior to the expiration of an extension granted to the requesting party or its privy.[4]

The timely filing of documents in the USPTO requires that the documents actually be received in the USPTO within the set time period unless such documents are filed in accordance with 37 CFR §§ 1.8 and 1.10 which provide for filing of papers by certificate of mailing and Express Mail, respectively. Papers filed in accordance with these rules are considered as having been filed on the date of deposit as first class mail or Express Mail even though the mailed

[4] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102(c). *See also In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived).

correspondence will not be received in the USPTO until after the due date.[5] The Express Mail filing procedure applies only to the "Express Mail" of the United States Postal Service, not any third-party carrier that offers overnight delivery.[6]

In the event that a particular extension request is timely filed with an appropriate certificate of mailing, pursuant to 37 CFR § 1.8, but is not received in the USPTO, the correspondence will be considered timely if the party that submitted it supplies an additional copy of the previously mailed extension request and certificate, and includes a statement attesting to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as defined in § 37 CFR 10.1(r).[7] The only evidence accepted by the Office to prove deposit of the missing extension request is an exact copy of the disputed document including a copy of the executed original certificate of mailing.[8] A reconstructed request and certificate of mailing will not suffice.

A potential opposer that has requested an extension of time to oppose should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request. The extension will run from the expiration of the thirty-day opposition period after publication. In the case of a subsequent extension, it will run from the date of expiration of the previously granted extension.[9] While the Board attempts to notify a potential opposer of the grant of an extension request before a granted extension expires, particularly when the length of the granted extension is less than that requested, the Board is under no obligation to do so, and in many cases cannot.[10]

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[5] *See In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994) and TBMP § 110.01 (Certificate of Mailing or Transmission Procedure).

[6] *See In re Pacesetter Group, Inc.*, *supra*.

[7] *See* 37 CFR § 1.8(b) and TBMP § 110.01 (Certificate of Mailing or Transmission Procedure – In General).

[8] *See In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (a declaration attesting to the filing and to the certificate of mailing is not acceptable as evidence of timely filing).

[9] *See In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990).

[10] *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (where misdirection of initial extension prevented Board from addressing calculation error in the request) and *In re Societe Des Produits Nestle S.A., supra* (potential opposer was not notified of partial grant of extension request until after date had passed). *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (no statute or regulation imposes obligation on Office to notify parties of defects in sufficient time to allow correction); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (no obligation to notify of defective statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (no obligation to discover deficiencies within a specified time).

202.02 Date of Publication of Mark

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

202.03 Premature Request

Section 13(a) of the Act, 15 U.S.C. § 1063(a), provides that an opposition to the registration of a mark upon the Principal Register may be filed "within thirty days after" the publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for opposition. Section 13(a) also provides for extensions of this time for filing an opposition under certain conditions. Thus, any opposition, and any request for an extension of time to oppose, filed before the publication of the mark sought to be opposed, is premature, and the Board will reject the opposition even if the mark has been published by the time of the Board's action.[11]

202.04 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication (for opposition) of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension.[12] Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can the Director upon petition waive them.[13] Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must be denied by the Board as late, even if the applicant has consented to the granting of the late filed request.

Moreover, once the time for opposing the registration of a mark has expired, the USPTO will not withhold issuance of the registration while applicant negotiates for settlement with a party that failed to timely oppose. This is so even if the applicant itself requests that issuance be withheld.

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[11] *Cf.* TBMP §§ 119.03 (Papers and Fees Generally Not Returnable) and 306.03 (Premature Opposition).

[12] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR §§ 2.102(b) and (c). *See also In re Cooper*, 209 USPQ 670 (Comm'r Pats 1980) and TBMP § 206.02 (regarding further extension requests filed by privy).

[13] *See In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of Rule 1.8 would effectively waive Section 13 and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of Rule 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r Pats 1980).

203 Form of Request

203.01 In General

37 CFR § 2.102(a) *Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.*

* * * *

(c) *The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. ...*

(d) *Every request to extend the time for filing a notice of opposition should be submitted in triplicate.*

A request for an extension of time to oppose must be made in writing.[14] The request should specify the period of extension desired, and should be addressed to the mailing address of the Trademark Trial and Appeal Board (*see* TBMP § 103).

In addition, every request for an extension of time to oppose should be filed in triplicate, so that if the request is approved, it may be so stamped; one copy may be placed in the application file; and the other copies may be mailed to the potential opposer and the applicant.[15] If only a single copy of an extension request is filed, the request will not be refused consideration, but action thereon may be delayed because the Board itself will have to make the extra copies.

203.02 Identifying Information

203.02(a) In General

A request for an extension of time to oppose should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying

[14] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR §§ 2.102(a) and 1.2.

[15] *See* 37 CFR § 2.102(d).

the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the *Official Gazette.*[16] The request should also bear an appropriate title describing its nature, such as "Request for Extension of Time to Oppose" or "Request for Further Extension of Time to Oppose."

203.02(b) Requirement for Identification of Potential Opposer

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty.[17] If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, before the expiration of the thirty-day opposition period following publication of the subject mark in the case of a first request, or of the previous extension in the case of a request for a further extension.[18]

If a request for a further extension of time to oppose does not specifically name the potential opposer, but it is clear from the circumstances that the request is being submitted on behalf of the same potential opposer which obtained an earlier extension, the request may be construed by the Board as identifying the potential opposer with reasonable certainty. However, the better, and safer, practice is to specifically name the potential opposer in each request for an extension of time to oppose.

203.03 Signature

37 CFR § 2.102(a) *Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an*

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[16] *Cf.* 37 CFR § 1.5(c), and *In re Merck & Co.*, 24 USPQ2d 1317, 1318 (Comm'r 1992) (Board's refusal to institute opposition as untimely was proper where potential opposer had misidentified applicant and serial number in its extension request).

[17] 37 CFR § 2.102(b).

[18] *See In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (since extension request failed to identify any party except attorney filing request, and since privity does not include attorney/client relationship, subsequent notice of opposition was untimely).

Cf. In re Su Wung Chong, 20 USPQ2d 1399, 1400 (Comm'r 1991) (inadvertence is not extraordinary circumstance to waive rule requiring that statement indicating consent or showing extraordinary circumstances for extension over 120 days must be submitted at time extension request is filed, not after the fact); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (subsequently obtained consent is not sufficient and omission, in itself, is not extraordinary circumstance to waive requirement that consent accompany extension request); and *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent oversight does not constitute extraordinary circumstance to waive [former] requirement for proof of service).

opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

A request for an extension of time to oppose may be signed either by the potential opposer or by its attorney or other authorized representative.[19] Under the written signature there should appear the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); and his or her business address (to which correspondence relating to the request will be sent) and telephone number. Requests for extensions of time to oppose filed through the electronic filing system, ESTTA, do not require a conventional signature. Instead the party or its representative enters a "symbol" that they have adopted as a signature. The Board will accept *any* combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash ("/") symbols.[20]

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the written notification of this defect by the Board.[21]

A potential opposer which has submitted an unsigned request for an extension of time to oppose should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has acted on the request, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a request for a further extension. If no opposition or request for further extension of time to oppose is filed prior to the expiration of any extension ultimately granted (after submission of a signed copy of the request) to the potential opposer, the time for opposing will be deemed to have expired, and the application which was the subject of the request will be sent to issue.[22]

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[19] *See* 37 CFR § 2.102(a). *See also La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (petition filed by applicant denied; extension requests were filed on behalf of potential opposer by its attorney as its representative not as another party).

[20] 37 CFR § 1.4(d)(1)(ii). *See also* TMEP § 804.05.

[21] *See* 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Papers).

[22] *Cf.* TBMP § 202.01 (Time for Filing Request).

203.04 Service

Trademark Rule 2.119(a), 37 CFR § 2.119(a), requires, in part, that with certain stated exceptions, every paper filed in the USPTO in inter partes cases must be served upon the other parties, and that proof of such service must be made before the Board will consider the paper. Trademark Rule 2.101(a), 37 CFR § 2.101(a), provides that the filing of an opposition in the USPTO commences an opposition proceeding. Inasmuch as a request for an extension of time to oppose is a paper filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not include proof of service upon the applicant.[23] Once the Board has acted upon a request for an extension of time to oppose, the Board will send the applicant a copy of the extension request together with the Board's action thereon.[24]

203.05 Duplicate Requests

It sometimes happens that duplicate requests for an extension of time to oppose are filed on behalf of the same party by two attorneys from the same firm, or from differing firms, or by an attorney from a firm and in-house counsel. Attorneys should make every effort to avoid the filing of such duplicate requests, which waste the time and resources, both of the Board and the attorneys.

When duplicate requests have been filed and the first request has been granted, the second request is given no consideration, and the attorneys are notified in writing of the duplicate filings and are requested to take appropriate action to avoid filing duplicate requests in the future. If requests filed by different attorneys on behalf of the same party are duplicates but for the fact that the second request seeks a longer extension than the first, the second request will be granted, if otherwise appropriate, but the attorneys will be requested in writing to avoid the filing of further duplicate requests.

204 Fee

There is no fee for filing a request for an extension of time to oppose.[25]

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[23] *See* 37 CFR § 2.102(c) and, *for example*, *In re Docrite Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996) (request for extension of time aggregating more than 120 days does not have to include proof of service on applicant or applicant's attorney when the request includes a statement that applicant has consented to the extension); and *La Maur, Inc. v. Andis Clipper Co.*, *supra.*

[24] *See* Section 13 of the Act, 15 U.S.C. § 1063.

[25] *Cf.* 37 CFR § 2.6.

205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not.[26] If it appears after examination of an application to register a mark on the Supplemental Register, that applicant is entitled to the registration; a certificate of registration is issued without any publication for opposition.[27] Upon issuance of the registration, the mark appears in the *Official Gazette*, not for opposition, but rather to give notice of the registration's issuance.[28]

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued.[29]

206 Who May File an Extension of Time to Oppose

37 CFR § 2.102 Extension of time for filing an opposition.
(a) *Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.*

(b) *The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.*

206.01 General Rule

Any person (whether natural or juristic--*see* TBMP § 303.02) who believes that he, she, or it would will be damaged by the registration of a mark upon the Principal Register may, upon

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[26] *See* Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§ 1062(a), 1063(a), and 1092, and 37 CFR § 2.82.

[27] *See* Sections 23(b) and 24 of the Act, 15 U.S.C. §§ 1091(b) and 1092, and 37 CFR § 2.82.

[28] *See* Section 24 of the Act, 15 U.S.C. § 1092; 37 CFR § 2.82; and TMEP § 1502.

[29] *See* Section 24 of the Act, 15 U.S.C. § 1092.

payment of the prescribed fee, file an opposition in the USPTO, stating the grounds therefor, within 30 days after the publication of the mark in the *Official Gazette* for purposes of opposition.[30]

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition.[31] Moreover, a request for an extension of time to oppose must identify the potential opposer with reasonable certainty.[32]

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party.[33] For this reason, a request for a further extension of time to oppose, or an opposition filed during an extension of time, ordinarily must be filed in the name of the party to which the extension was granted.[34] A request for a further extension, or an opposition, filed in a different name will be accepted if a person in privity with the person granted the previous extension files it, or if the person that requested the extension was misidentified through mistake.

206.02 Request for Further Extension Filed by Privy

A request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension.[35] The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its action requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more

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[30] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.101. *For further information concerning the filing of an opposition, see* TBMP chapter 300, *generally*, and § 303 *regarding who may file an opposition.*

[31] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102.

[32] 37 CFR § 2.102(b). *For a discussion of this matter, see* TBMP § 203.02.

[33] *See Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (a party cannot claim the benefit of an extension granted to another, unrelated party).

[34] *See* 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). *Cf.* TBMP § 206.02 (Request by Privy)

[35] *See* 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (two unrelated entities that merely share same objection to registration are not in privity).

different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

In the field of trademarks, the concept of privity generally includes, inter alia, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§ 1055 and 1127.[36] It does not, however, include the attorney/client relationship.[37]

If, at the time when a first request for an extension of time to oppose is being prepared, it is not clear which of two or more entities will ultimately be the opposer(s), the better practice is to name each of them, in that and any subsequent extension request, as a potential opposer, thereby avoiding any need for a showing of privity when an opposition or subsequent extension request is later filed by one or more of them.

206.03 Misidentification of Potential Opposer

A request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake.[38] The phrase "misidentification by mistake," as used in 37 CFR § 2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named.[39]

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[36] *See International Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (discussion of various 'privity' relationships). *Cf. Rolex Watch U.S.A., Inc. v. Madison Watch Co.*, 211 USPQ 352, 358 (TTAB 1981) (regarding right of owner, or one in privity with owner, to maintain opposition or cancellation based on Section 2(d)); *In re Cooper, supra* (two unrelated entities that merely share same objection to registration are not in privity); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (motion to suspend granted in view of privity of applicant with parties in civil action); and *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm'r 1963) (parent in privity). *But see Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973) (respondent's motion to suspend for civil action between respondent and third party denied where petitioner as nonexclusive licensee of third party was not in privity with third party).

[37] *See In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

[38] *See* 37 CFR § 2.102(b), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

[39] *See Cass Logistics Inc. v. McKesson Corp.*, *supra* (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). *See also* TMEP § 1503.04.

Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a

The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

207 Requirements for Showing of Cause; Extraordinary Circumstances

37 CFR § 2.102(c) *The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. A first extension of time for not more than thirty days will be granted upon request. Further extensions of time may be granted by the Board for good cause. In addition, extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.*

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partner in a firm which no longer existed was not fatal); and *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407, 409 (TTAB 1964) (sole owner substituted for partnership where original plaintiff identified as partnership composed of that individual since originally named plaintiff was not actually in existence when opposition was filed and even it were, as a partner, he is a successor to the partnership).

Cf. also TMEP § 803.06; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlantic Blue Print Co.*, 19 USPQ2d 1078, 1079 (Comm'r 1990) (permitted to amend name of registrant in Sections 8 and 15 declaration where trade name was inadvertently substituted for corporate name); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 620 (TTAB 1982) (allowed to correct application where applicant was identified by only a portion of its earlier used name and earlier name had already been supplanted by new name at time application was filed, but at all times was one single entity); *Argo & Company v. Springer, et al.,* 198 USPQ 626, 634 (TTAB 1978) (Board granted applicant's motion to change its name from corporation which was defectively incorporated to individuals who were true owners of mark at time of filing); *In re Eucryl, Ltd.*, 193 USPQ 377, 378 (TTAB 1976) (exclusive U.S. distributor is owner only if it has agreement providing for right to apply; since distributor had no right to apply, subsequent assignment to proper applicant did not cure defect); *Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (defendant can be substituted when originally named party was not in existence at time of filing complaint); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" permissible).

207.01 First Extension of Thirty Days

A first extension of time to oppose for not more than thirty days will be granted upon written request, if the request is otherwise appropriate (e.g., is timely filed; identifies the potential opposer with reasonable certainty). No showing of cause is required.[40]

207.02 Further Extensions

The Board may grant extensions of time to oppose beyond the first thirty-day extension for good cause, provided that the extensions do not aggregate more than 120 days from the date of publication of the subject mark.[41] Thus, a potential opposer may seek up to a 90-day extension of time, even in a single request, provided good cause for the extension is shown. If a request for extension of time to oppose beyond the first thirty-day extension does not include a showing of good cause, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, before the previous extension expires.[42] A showing of good cause for a further extension of time to oppose should set forth the reasons why additional time is needed for filing an opposition. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension.

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days.[43] If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a

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[40] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a); 37 CFR § 2.102(c); and *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991).

[41] *See* 37 CFR § 2.102(c), and *Lotus Development Corp. v. Narada Productions, Inc.*, *supra*.

[42] *Cf. In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (defect of failure to identify potential opposer with reasonable certainty may not be corrected after opposition period has expired). *Cf. also, regarding requirements for extensions beyond 120 days, In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (since potential opposer failed to submit required showing of extraordinary circumstances with extension request as required by Rule 2.102(c)(3), question on petition was not whether any such extraordinary circumstances existed at time of request but instead whether potential opposer showed extraordinary circumstances existed that prevented compliance with that rule); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent failure to provide proof of service not extraordinary circumstance to waive [former] rule requiring proof of service); and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (extraordinary circumstances not shown so as to waive requirement that showing of extraordinary circumstances be submitted with extension request).

[43] *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (potential opposer only entitled to extension of 30 days where initial request exceeded thirty days by two days and potential opposer did not assert good cause for additional days); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial request for 60 days with showing of good cause in compliance with the rules).

showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days. However, a request for a further extension, showing good cause, may be submitted during that thirty-day extension period.

If a request for a further extension of time to oppose includes a showing which constitutes good cause for part, but not all, of the requested extension, any extension granted to a potential opposer will be limited to the time for which good cause has been shown.

207.03 Extensions Beyond 120 Days From Publication

Extensions of time to oppose aggregating more than 120 days from the date of publication of the subject mark will not be granted unless the potential opposer submits, in addition to the showing of good cause required for extensions of time beyond the first thirty-day extension period, one of the following: (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request,[44] or (3) a showing of extraordinary circumstances.[45] Consent must be express, though it may be provided orally, and the extension request must state that such consent has been provided. It is not sufficient to indicate in the request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension.[46] In addition, the statement of consent should appear in the body of the request, not merely in the title (e.g. "Consented Request to Extend") of the filing.

If one of these elements (i.e., the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension.[47]

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[44] *NOTE: Proof of service of the request on applicant is no longer required. See* 37 CFR § 2.102(c), as amended. *See* also *In re Docrite Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996).

[45] *See* 37 CFR § 2.102(c).

[46] *See In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (mere existence of settlement discussions does not constitute extraordinary circumstances).

[47] *See In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (since potential opposer failed to submit required showing of extraordinary circumstances with extension request as required by Rule 2.102(c)(3), question on petition was not whether any such extraordinary circumstances existed at time of request but instead whether potential opposer showed extraordinary circumstances existed that prevented compliance with that rule); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent failure to provide proof of service not extraordinary circumstance to waive [former] rule requiring proof of service); and *In re Societe Des Produits Nestle S.A.*, *supra* at 1094 (extraordinary circumstances not shown to waive requirement that showing of

If an acceptable showing of extraordinary circumstances is submitted in support of a request for an extension running beyond 120 days from the date of publication, the requirement for a showing of good cause is satisfied. If a request for an extension running beyond 120 days from publication is based upon applicant's consent, but includes no recitation of other facts relating to good cause, applicant's consent will be construed as good cause for that request, but the potential opposer will be advised by the Board, in writing, that any further extension request based upon applicant's consent must include also a recitation of circumstances showing good cause for the request.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR § 2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication.[48]

208 Essential Element Omitted

If any element (e.g., identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant's written consent, statement that applicant has consented) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension.[49]

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extraordinary circumstances be submitted with extension request and subsequently obtained consent insufficient). *Cf. In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (identification of potential opposer omitted).

[48] *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (mistake in calculating expiration of initial request resulted in request for extension beyond thirty days with no showing of cause and ran subsequent requests beyond 120 days without meeting requirements for that period), and *In re Societe Des Produits Nestle S.A., supra.*

[49] *See In re Su Wung Chong*, *supra*; (showing of extraordinary circumstances omitted); *In re Societe Des Produits Nestle S.A.*, *supra*; (extraordinary circumstances not shown and subsequently obtained consent untimely); and *In re Spang Industries, Inc.*, *supra* (identification of potential opposer omitted).

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the written notification of this defect by the Board.[50]

209 Action by Board on Request

209.01 Suspension; Grant or Denial of Extensions - General Policy

209.01(a) Suspension Policy

The Board will not suspend the running of an extension of time to oppose for any reason. A potential opposer must either continue to file timely requests for extensions of time, if it wishes to preserve its right to oppose, or go forward with the notice of opposition.

209.01(b) Grant or Denial of Extensions

The time for filing an opposition generally will not be extended beyond 360 days from the date of publication pending, for example, the final determination of another proceeding between the potential opposer and the applicant, or the conclusion of unduly prolonged settlement negotiations, or the filing of a new application, and its prosecution to publication or registration by the potential opposer or applicant.

After 120 days from the date of publication of applicant's mark, the Board as a general rule will not grant extensions for more than sixty days at a time for requests made without the consent of the applicant, or more than ninety days at a time for requests made with the applicant's consent. Again, however, the general rule will be applied flexibly and reasonably, depending upon the circumstances in a particular case.

Extension requests based on settlement discussions. When a potential opposer files repeated extension requests based upon applicant's consent coupled with an assertion that the parties are negotiating for settlement, the Board ordinarily will require, for extensions aggregating more than 180 days from the date of publication of applicant's mark, that the extension request include also a report on the status of their settlement negotiations. In such a case, the Board, in writing, will advise potential opposer that any further extension requests made on the basis of consent and settlement negotiations should include a summary of the progress of the negotiations. If the subsequent request fails to include this summary, the request may be denied.

As a general rule, the Board will not grant extensions of time to oppose beyond 360 days from the date of publication, unless settlement has been reached and only needs to be

[50] *See* 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Papers).

executed. The general rule, however, will be applied flexibly and reasonably, depending upon the circumstances in a given case. For example, if a foreign party is involved, or if parties are trying to settle several cases at once, or if numerous parties are involved, more time may be allowed.

209.02 Determination of Extension Expiration Date

The extension expiration date stamped on an approved request, or stated in an action granting an extension, is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a Federal holiday within the District of Columbia. If the expiration date falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday will be considered timely.[51] However, the beginning date for calculating the further extension is the actual expiration date of the previous extension, regardless of whether the expiration date fell on a weekend or Federal holiday.[52]

A first request for an extension of time to oppose sometimes asks for an extension of "thirty days," (for which a showing of good cause is not required) but specifies an extension expiration date which is different from the expiration date of the requested "thirty days." In this case, the extension, if granted, will be set to expire on whichever date is later, provided that, if the date specified by the potential opposer is beyond thirty days, potential opposer has shown good cause for the time in excess of thirty days. If good cause for the time beyond thirty days has not been shown, the time will be set to expire on the thirtieth day.[53]

Similarly, a request for a further extension of time to oppose (that is, beyond the first thirty day request) sometimes asks for a certain number of days, but specifies an extension expiration date which is longer or shorter than the expiration date of the requested number of days. In this case, the extension, if granted, will normally be set to expire on whichever date is later. However, if part of the extension would fall beyond 120 days from the date of publication, and the request does not meet the 37 CFR § 2.102(c) requirements for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented), the extension, if granted, will be set to expire no later than 120 days from the date of publication.[54]

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[51] *See* 37 CFR § 1.6; *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (potential opposer miscalculated first 30-day extension request and threw off all subsequent periods); and TBMP § 112 (Time for Taking Action).

[52] *See Lotus Development Corp. v. Narada Productions, Inc.*, *supra* at 1312.

[53] *Cf.* 37 CFR § 2.102(c), and TBMP § 207.02 (Further Extensions).

[54] *See Lotus Development Corp. v. Narada Productions, Inc. supra*, and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990). *See also* 37 CFR § 2.102(c), and TBMP § 207.03 (Extensions Beyond 120 Days).

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days.[55] If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a showing of good cause for the time in excess of thirty days, potential opposer will be granted an extension of only thirty days.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR § 2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication.[56]

210 Objections to Request

Since a request for an extension of time to oppose is ex parte in nature, there is no requirement that a copy has to be served upon the applicant.[57] For the same reason, an applicant is not notified of the filing of an extension request before the Board has acted on it. Not until after the Board has acted on an extension request does the Board send the applicant a copy of the request (if there is no proof of service by potential opposer), together with notification of the Board's action.

An applicant may learn of the filing of an extension request, and file objections thereto, before applicant receives anything from the Board about the request. This may happen, for example, when potential opposer serves a courtesy copy of the request upon applicant. If the Board receives objections before it acts upon the request, the Board will consider them. If the objections are received after action on the request, and the request has been granted, they will be treated as a request for reconsideration.

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[55] *See* 37 CFR § 2.102(c); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial request for 60 days with required showing granted); and TBMP § 207.02 (Further Extensions).

[56] *See* 37 CFR § 2.102(c); *Lotus Development Corp. v. Narada Productions, Inc., supra; In re Societe Des Produits Nestle S.A., supra;* and TBMP § 207.03.

[57] *See* TBMP § 203.04 (Service).

An applicant that receives notification from the Board that an extension request has been filed and granted may submit objections in the form of a request for reconsideration.[58]

Further, an applicant who receives notification from the Board that a request for extension of time to oppose has been granted may submit objections to the granting of any further extensions of time to the potential opposer. In such a case, the objections will be considered by the Board in determining any subsequent request, filed by the potential opposer, for an extension of time to oppose. If the Board does not receive objections until after it has granted a subsequent extension request, they will be treated as a request for reconsideration of the Board's action.

Any paper objecting to a request for an extension of time to oppose, or to the granting of any further extensions of time to oppose, should state clearly the reasons for objection. There is no requirement that the paper be served upon the potential opposer. If there is no indication that service has been made, the Board will send potential opposer a copy of the paper together with the Board's action on the extension request, or, if the paper is treated by the Board as a request for reconsideration, with the Board's action on the request for reconsideration.

211 Relief From Action of Board

211.01 Request for Reconsideration

If an applicant or potential opposer is dissatisfied with an action of the Board on a request for an extension of time to oppose, it may file a request for reconsideration of the action, stating the reasons. The request should be filed promptly after the filing party receives the Board's action.

A request for reconsideration of a Board action relating to a request for an extension of time to oppose is examined by one of the Board's administrative staff members, who will prepare a letter granting or denying the request. One copy of the letter is placed in the file of the subject application, one copy is mailed to the applicant, and one copy is mailed to the potential opposer.

There is no requirement that a request for reconsideration be served upon the nonfiling party. If there is no indication that service has been made, the Board will send the nonfiling party a copy of the request together with that party's copy of the Board's letter granting or denying the request.

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the relevant extension.[59]

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[58] *For information concerning a request for reconsideration of an action of the Board relating to a request for extension of time to oppose, see* TBMP § 211.01.

[59] *Cf.* 37 CFR § 2.89(g).

211.02 Relief after Institution of Opposition

If an applicant is dissatisfied with an action of the Board on a request for an extension of time to oppose and the opposition has been filed and instituted, the applicant may raise the issue by means of a motion to dismiss the opposition for lack of jurisdiction.[60]

211.03 Petition to the Director

If an applicant or potential opposer is dissatisfied with an action of the Board on a request for an extension of time to oppose, it may file a petition to the Director, pursuant to 37 CFR § 2.146, for review of the action in question.[61]

The petition to the Director must include a statement of the facts relevant to the petition; the points to be reviewed; the action or relief requested; and the requisite fee, as specified in 37 CFR § 2.6. Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of affidavits or declarations in accordance with 37 CFR § 2.20, and these affidavits or declarations, with any exhibits thereto, must accompany the petition.[62]

A petition from the denial of a request for an extension of time to oppose must be filed within 15 days from the mailing date of the denial of the request and must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided in 37 CFR § 2.119(a).[63] Applicant may file a response within 15 days from the date of service of the petition. A copy of the response must be served upon the petitioner, with proof of service as provided by 37 CFR § 2.119(a). No further paper relating to the petition may be filed.[64]

Trademark Rule 2.146(e)(1), 37 CFR § 2.146(e)(1), the provisions of which are summarized in the preceding paragraph, presently makes no reference to a petition from the granting of a

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[60] *See Cass Logistics Inc. v. McKesson Corp.,* 27 USPQ2d 1075, 1075 n.2 and, *generally*, TBMP § 502 (regarding motions). *See also See Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (motion to dismiss granted where it was found that opposer's allegations of consent and good cause [i.e., that the parties were engaged in settlement discussions] to extend beyond 120 days were untrue).

[61] *See also* TMEP § 1704.

[62] *See* 37 CFR § 2.146(c).

[63] *See also* TBMP §§ 113.03 (Elements of Certificate) and 113.04 (Manner of Service).

[64] *See* 37 CFR § 2.146(e)(1).

request for an extension of time to oppose. However, the provisions of the rule may appropriately be followed in the case of such a petition.

The filing of a petition by the potential opposer from the denial or by the applicant from the granting of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition.[65] The filing of a petition will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If the petition is resolved during the running of an extension of time unfavorably to opposer any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected as untimely.

If opposer files a timely opposition during the pendency of its petition to the Director, the Board will institute the opposition. At the same time, the Board will normally suspend the opposition pending resolution of the petition. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending petition as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending resolution of the petition to the Director. A copy of the Board's action will be sent to both parties and a copy of the notice, along with a copy of the motion to suspend, will be sent to the applicant.

If the decision on the petition is unfavorable to opposer, the opposition will be dismissed as a nullity, and the fee will be refunded

212 Amendment of Application During or After Extension

212.01 Jurisdiction to Consider Amendment

The Board has no jurisdiction over an application unless and until the application becomes involved in a Board inter partes proceeding.[66] In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to any requested extension(s) of time to oppose.

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[65] *See, e.g., In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

[66] *Compare* Trademark Rules 2.84 and 2.133.

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other paper (such as a request for republication, a request for reconsideration of a refusal to approve an amendment) relating to the application is filed by the applicant, and the application is not involved in any Board inter partes proceeding, it is the Examining Attorney who must determine the propriety of the amendment or other paper.[67]

However, the Board does determine the propriety of a request filed by an attorney or other authorized representative to withdraw as applicant's representative, in an application which is the subject of a request for an extension of time to oppose. The Board has jurisdiction to consider the request to withdraw as representative in such a case, because applicant's representative of record acts in applicant's behalf in matters relating to the requested extension(s) of time to oppose.

Any amendment proposed by an applicant, whether of its own volition or to accommodate a concern of a potential opposer must be sent to the Board's attention, not to the Examining Attorney who approved the mark for publication. The Board will note the amendment and transfer the file to the Examining Attorney. Because the Examining Attorney eventually will consider the amendment, any phone inquiry for discussion of the content of the amendment should be directed to the Examining Attorney.

212.02 Conditions for Examining Attorney Approval of Amendment

During the time between the publication of a mark in the *Official Gazette* for opposition, and the printing of a certificate of registration or notice of allowance, an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant, provided that the amendment does not necessitate issuance of a refusal or requirement by the Examining Attorney. If a refusal or requirement by the Examining Attorney would be needed, the amendment cannot be made unless applicant (1) successfully petitions the Director to restore jurisdiction over the application to the Examining Attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction.[68]

Examples of the types of amendments which may be made under the conditions described above include acceptable amendments to the identification of goods, to the drawing, to add a disclaimer, and (in the case of an application under Section 1(a) of the Act, 15 U.S.C. § 1051(a),

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[67] *See* 37 CFR § 2.84, and *In re MCI Communications Corp.,* 21 USPQ2d 1534 (Comm'r 1991). *Cf. Groening v. Missouri Botanical Garden,* 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by Examining Attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

[68] *See* 37 CFR § 2.84(b) and TMEP §§ 1504.01 and 1505 *et seq*

or an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), in which an acceptable amendment to allege use has been filed) to convert an application for an unrestricted registration to one for concurrent use registration.[69]

An applicant who files an amendment to its application during an extension of time to oppose need not have potential opposer's consent thereto.

212.03 Form of Amendment

An amendment or other paper relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other document relating to an application, except that it should be directed to the attention of the Trademark Trial and Appeal Board (i.e., Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514).

212.04 Action by Board -- Upon Receipt of Amendment

When an amendment relating to an application which is the subject of a request for an extension of time to oppose is filed, a Board administrative staff member will issue an action acknowledging receipt of the amendment, forwarding the application file to the Examining Attorney for consideration of the amendment, and explaining the effect the filing of the amendment has on the extension of time to oppose.[70]

If an amendment is filed during the running of a well taken request for an extension of time, the action will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; approve the extension (or if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); indicate the application is forwarded to the Examining Attorney for consideration of the amendment; instruct the Examining Attorney to act on the amendment (either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, further appropriate action will be taken with respect to the potential opposition. The action will also advise potential opposer that the filing of the amendment does not relieve the potential opposer of the

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[69] *See In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (disclaimer). *Cf. In re Little Caesar Enterprises, Inc.,* 48 USPQ2d 1222 (Comm'r 1998) (regarding request to divide certain items out of a class of goods during extension of time to oppose, and petition to waive rule requiring that request to divide be filed before application is approved for publication).

[70] *See, for example, In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (entry of disclaimer as means of settling potential opposition).

responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

If an amendment is filed after the expiration of potential opposer's extension of time to oppose, and no opposition or request for a further extension of time to oppose has been timely filed, the Board's action will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's extension of time to oppose has expired, and that no opposition or request for a further extension of time to oppose has been timely filed; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication[71] and need not return the application to the Board after consideration of the amendment.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is not granted, the letter will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the Examining Attorney; deny the request; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication[72] and need not return the application to the Board after consideration of the amendment.

If an amendment is filed after a request for an extension of time to oppose has been denied by the Board, but before the Board has forwarded the application to issue, the action will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's request for an extension of time to oppose has been denied; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication[73] and need not return the application to the Board after consideration of the amendment.

When the Board's action is ready for mailing, one copy is placed in the file of the subject application, one copy is mailed to the applicant, and one copy each of the amendment and letter is mailed to the potential opposer. The application is then forwarded to the Examining Attorney for consideration of the amendment.

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[71] TMEP §§ 1504.01 and 1505 *et seq.*.

[72] TMEP §§1504.01 and 1505 *et seq.*

[73] TMEP §§ 1504.01 and 1505 *et seq.*

If an amendment is filed prior to the Board's institution of a timely opposition, the Board will institute the opposition, and at the same time suspend the opposition pending consideration of the amendment by the Examining Attorney.

212.05 Action by Board -- During Consideration of Amendment by Examining Attorney

The filing of the amendment will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If a timely opposition is filed while the amendment is still pending before the Examining Attorney, the Board will institute the opposition, and at the same time the Board will normally suspend the opposition pending consideration of the amendment by the Examining Attorney. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending amendment as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending consideration of the amendment by the Examining Attorney. A copy of the institution order will be mailed to both parties, and a copy of the notice of opposition and motion to suspend will be mailed to the applicant.

212.06 Action by Board -- After Consideration of Amendment by Examining Attorney

When an amendment in an application which is the subject of an extension of time to oppose is forwarded to the Examining Attorney for consideration, the Examining Attorney acts on the amendment, either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved and placing a record of the telephone call in the file.[74] The Examining Attorney then returns the application to the Board (unless the time for opposing expired prior to the filing of the amendment).

If the application is returned to the Board during the running of a well taken request for an extension of time, a Board administrative staff member will issue an action approving the extension (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date); indicating whether or not the amendment was approved; and taking further appropriate action relating thereto.

For example, sometimes a potential opposer, in a request for an extension of time to oppose or in a separate document, states that it has agreed not to oppose if applicant's application is amended

[74] *See In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (entry of voluntary disclaimer).

in a certain manner. If the amendment submitted by applicant conforms to the agreement and the Examining Attorney approves it, the Board's action will indicate that the amendment has been approved; that potential opposer has agreed not to oppose if the amendment is approved; and that the application is accordingly being forwarded to issue. If the amendment was not approved, the action will so state, and potential opposer will be advised that it will need to continue to file timely requests for extensions of time or file its notice of opposition.

If there is no statement by potential opposer that it will not oppose if the amendment submitted by applicant is approved, the Board's action will state whether the amendment was approved, and will advise the potential opposer that it will need to continue to file timely requests for extensions of time, or file its notice of opposition.

Sometimes an Examining Attorney considering an amendment to an application that is the subject of an extension of time to oppose, does not approve the amendment submitted by the applicant, but instead makes a different amendment by Examiner's Amendment.[75] In such a case, the Board, in its action, will so state; specify the amendment made by Examiner's Amendment; and advise potential opposer that it will need to continue to file timely requests for extensions of time, or file its notice of opposition.

When the Board's action is ready for mailing, one copy is placed in the file of the subject application, one copy is mailed to the applicant, and one copy is mailed to the potential opposer.

If an opposition was instituted prior to the Examining Attorney's action on the amendment, and the amendment is subsequently approved, the Board will prepare an action notifying the parties that the amendment was approved; advising the parties that the opposition will go forward on the basis of the application as amended; and allowing opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed as a nullity and the fee refunded. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set.

212.07 Amendment During Opposition

If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board.[76]

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[75] *See* TMEP § 707.

[76] *See* 37 CFR § 2.133, and TBMP § 514 (Motion to Amend Application or Registration).

213 Effect of Restoration of Jurisdiction

If the Examining Attorney wishes to refuse registration or make a requirement in an application that is the subject of a request for an extension of time to oppose, the Examining Attorney must request the Director to restore jurisdiction over the application to the Examining Attorney for that purpose.[77] If the application is also the subject of an opposition, the Examining Attorney's request for jurisdiction must be directed to the Board.[78]

A request for jurisdiction, which is granted during an unexpired extension of time to oppose, does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the previous request. After the Board learns that the Examining Attorney's jurisdiction has been restored, a Board administrative staff member will prepare an action advising potential opposer and applicant thereof and taking further appropriate action. Examples are described below.

If the restoration of jurisdiction occurs during the running of an extension of time to oppose, the action will inform the potential opposer and applicant that jurisdiction over the application has been restored to the Examining Attorney; approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); instruct the Examining Attorney that if the application is subsequently approved, and the mark is not republished, the application must be returned to the Board; and advise potential opposer that the filing of the amendment does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

The restoration of jurisdiction (or the filing of a request for jurisdiction) will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

One copy of the Board's action will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the Board's action and of the Examining Attorney's Office action will be mailed to the potential opposer. Before the application is sent to the Examining Attorney, the administrative staff member will attach to the front of the file a note reading: "EXAMINER NOTE: IF THIS APPLICATION IS ULTIMATELY APPROVED, APPLICATION FILE MUST BE RETURNED TO TTAB FOR ACTION WITH RESPECT TO EXTENSION OF TIME TO OPPOSE."

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[77] *See* 37 CFR § 2.84(a); TMEP §§ 1504.01 and 1504.02 and *In re Hershey*, 6 USPQ2d 1470, 1471 n.2 (TTAB 1988) (restoration of jurisdiction to Examining Attorney by [Director] is not subject to review by the Board).

[78] *See* 37 CFR § 2.130 and TMEP § 1504.02.

If, during the running of an extension of time, the Examining Attorney approves the application, and the mark is not republished, the Board administrative staff member will issue an action so advising the potential opposer and applicant. The action will also approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date). If the mark is republished, or if registration is ultimately denied, the extension request, if not yet approved, will be moot. No further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence on the date of republication.

If a timely opposition is filed while the question of registrability is still before the Examining Attorney, the Board will institute the opposition. At the same time, the Board will normally suspend proceedings until the registrability of the mark has been finally determined. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and indicate that the opposition is suspended pending final determination of the registrability of the mark. A copy of the Board's action will be sent to both parties and a copy of the notice of opposition, along with a copy of the motion to suspend, will be sent to the applicant.

If the Examining Attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one which might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set.

If registration is ultimately denied, the opposition will not be instituted, or if already instituted, will be dismissed as a nullity and the fee refunded.

214 Effect of Republication

The Examining Attorney may determine that the mark in an application that is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the mark was originally published in the wrong class; when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included in the original publication; or when the application has been amended after

publication (but before the filing of an opposition), and the amendment is of such nature as to require republication.[79]

If a mark is republished by order of the Examining Attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. If the change reflected in the republication is one which might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition not instituted.

However, once the Board learns that a mark that is the subject of a request for an extension of time to oppose has been or will be republished by order of the Examining Attorney, no further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence with the republication of applicant's mark. Thus, if there is a pending request for an extension of time to oppose, a Board administrative staff member will issue an action notifying potential opposer and applicant of the republication and taking appropriate action with respect to the extension request. Normally, the extension request will be deemed moot. However, if the extension request was filed within thirty days after the date of republication, it may be treated as a request for an extension of the new opposition period.

If there has been an error in the first publication, or the application has been amended thereafter, republication is often necessary in order to give potential opposers fair notice of the registration sought by applicant. Sometimes, however, a mark that has been published correctly, and has not been amended thereafter, is republished not because there is any need for republication, but by inadvertence. When there is no need for republication, and a mark is republished solely by mistake (as, for example, when an application has survived an opposition, and is ready to go to issue, but is inadvertently sent to publication rather than to issue), the application may not properly be subjected to another opposition period.

Accordingly, when it comes to the attention of the Board that an application has been republished by mistake, the Board will not entertain any opposition or request for an extension of time to oppose filed in response to the republication. An opposition filed in response to the inadvertent republication will be returned to the opposer, and the opposition fee will be refunded. The remedy of a would-be opposer or potential opposer in such a case lies in the filing of a petition for cancellation, under Section 14 of the Act, 15 U.S.C. § 1064, after applicant's registration has been issued.

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[79] *See* TMEP § 1505.01. *See also, for example, Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by Examining Attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

215 Effect of Letter of Protest

A third party that has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the USPTO by filing, with the Office of the Commissioner for Trademarks, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence.[80] The Administrator for Trademark Identifications, Classifications and Practice (Administrator) will determine whether the letter of protest should be "granted," that is, whether the information should be given to the Examining Attorney for consideration.[81]

A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication ordinarily must be filed within thirty days after publication in order to be considered timely.[82] Moreover, even if the Director decides to grant a post-publication letter of protest, the Examining Attorney cannot consider the submitted information unless the Commissioner for Trademarks, upon written request by the Administrator, concurs in the decision to grant the letter of protest and restores jurisdiction over the application to the Examining Attorney.[83] If the application is the subject of an opposition, the request for jurisdiction should be directed to the Board.[84]

The filing of a letter of protest does not stay the time for filing an opposition to the subject mark, regardless of when the letter of protest was filed.[85] If a party that files a letter of protest after publication wishes to preserve its right to oppose in the event that the letter of protest is denied, it must file a timely request for an extension of time to oppose.[86]

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[80] *See* TMEP § 1715; *In re Urbano,* 57 USPQ2d 1776, 1778 n.5 (TTAB 1999) (letter of protest provided additional information to the Examining Attorney to maintain a refusal); *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1379 (Comm'r 1988) (Director committed clear error by allowing Examining Attorney to be involved in deciding whether the letter of protest was to be granted); and *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987) (guidelines for timeliness of letter of protest).

[81] *See* TMEP § 1715. *For information concerning the standard applied by the Administrator in determining whether a letter of protest should be granted, see* TMEP § 1715 *et seq*.

[82] *See In re G. Heileman Brewing Co., Inc.,* 34 USPQ2d 1476, 1478 (Comm'r 1994) (letter of protest, filed more than a year after publication and accompanied by evidence of descriptiveness which was available 2 months prior to publication, was untimely); *In re BPJ Enterprises Ltd.*, *supra* (filed 44 days after publication but before timeliness standard enunciated); *In re Pohn*, *supra*; and TMEP § 1715.03.

[83] *See* TMEP § 1715.03.

[84] *See* 37 CFR § 2.130 and TMEP § 1504.02.

[85] *Cf.* TMEP § 1715.03(b).

[86] *Cf. In re BPJ Enterprises Ltd., supra*.

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that it has filed a letter of protest (not yet determined by the Administrator) with respect to the subject mark (even if filed more than thirty days after publication) such filing will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark. However, the filing will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

The filing by a third party of a letter of protest (not yet determined by the Administrator), with respect to a mark which is the subject of a request for an extension of time to oppose, will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer.

Following determination of a letter of protest filed with respect to an application that is the subject of a request for an extension of time to oppose, the Board will take further appropriate action. Examples are described below.

Often, when the application comes to the Board for further appropriate action, the letter of protest has been granted; jurisdiction over the application has been restored to the Examining Attorney; and the Examining Attorney has issued an Office action asserting a refusal or a requirement. If a well taken request for an extension of time to oppose is running at this time, a Board administrative staff member will prepare an action notifying the potential opposer and applicant that the letter of protest has been granted; that jurisdiction over the application has been restored to the Examining Attorney; that an Office action has been issued by the Examining Attorney; that the extension request is approved (or, if already approved, that potential opposer has been granted an extension of time to oppose until a specified date); that if the application is subsequently approved, and the mark is not republished, that the application must be returned to the Board; and that the filing of the amendment does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

If, during the running of a well taken request for an extension of time, the Examining Attorney ultimately approves the application, and the mark is not republished, the Board administrative staff member will issue an action so advising potential opposer and applicant and approving the extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date). If the mark is republished, or if registration is ultimately denied, the extension request, if not yet granted, will be moot. No further extension of the original opposition period will be granted. Rather a potential opposer's time for opposing will recommence on the date of republication.

If, during the running of an extension of time, the letter of protest is denied, the Board will so advise potential opposer and applicant and take appropriate action on the extension request.

One copy of the Board's action will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the Board's action and of the Examining Attorney's Office action will be mailed to the potential opposer.

If opposer files a timely opposition while its letter of protest is pending (or if the letter of protest is granted, while the question of registrability is still before the Examining Attorney), the Board will institute the opposition. At the same time, however, the Board will normally suspend the opposition until the letter of protest is decided (or, if the letter of protest has already been granted, until the registrability of the mark has been finally determined). If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the filing of its letter of protest (or the restoration of jurisdiction) as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending a decision on the letter of protest (or if the letter of protest has already been granted, pending final determination of the application before the Examining Attorney). A copy of the Board's letter will be sent to both parties, and a copy of the notice of opposition along with a copy of the motion to suspend will be sent to the applicant.

If the Examining Attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication. The Board will inform them of the reason for republication; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow the opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded and the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed, and appropriate dates will be set.

If registration is ultimately denied, the opposition will not be instituted, or if already instituted, will be dismissed as a nullity and the fee refunded.

216 Inadvertently Issued Registration

Sometimes a registration is issued, mistakenly, from an application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. Such a registration is called an "inadvertently issued" registration.

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Director who has such authority, and the Director exercises this authority with caution.[87] A registration will ordinarily be deemed to have been issued inadvertently if a

[87] *See In re Trademark Registration of Mc Lachlan Touch Inc.*, 6 USPQ2d 1395, 1396 (Comm'r 1987).

notice of opposition or a request for extension of time to oppose was timely and properly filed but inadvertently overlooked by the Board.[88] The Director will not find that a registration issued inadvertently if (1) the notice of opposition was defective in some manner, and (2) that defect prevented the Office from identifying the application in question, and from withholding the issuance of a registration.[89]

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application that is the subject of an unexpired extension of time to oppose, the Board will issue an action approving the extension of time, if appropriate (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date), and advising potential opposer that if it wishes to preserve its right to oppose should the registration be cancelled as inadvertently issued, potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition. The Board will then forward the registration file to the Director for such action, as the Director deems appropriate. The Director, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

The inadvertent issuance of the registration will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If, during the running of an extension of time, the Director cancels and restores to application status a registration that issued inadvertently during an extension of time to oppose, the potential opposer and applicant will be informed of the inadvertent issuance of the registration, its cancellation by the Director, and the status of the extension request in an action prepared by a Board administrative staff member.

If a registration that issued inadvertently during an extension of time to oppose is not cancelled by the Director and restored to application status, any opposition that may have been filed by the potential opposer will be returned, and any submitted opposition fee will be refunded. The potential opposer's substantive remedy will, under the statute, be through a petition to cancel the registration.

If a timely opposition is filed while the matter of the registration is pending before the Director, the Board will institute the opposition. At the same time, however, the Board will normally

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[88] *See Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.,* 60 USPQ2d 1703, 1704 (Comm'r 2000).

[89] *See Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc., supra* at 1704 (where notice of opposition misidentified the serial number of opposed application, Director declined to cancel registration finding that error which caused the registration to issue was made by opposer not as result of inadvertent act by the Office).

suspend the opposition until the matter is resolved. If, with the notice of opposition, the opposer files a motion to suspend the opposition, citing the inadvertently issued registration as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending a decision on the matter of the registration. A copy of the Board's action will be sent to both parties, and a copy of the notice of opposition, will be sent to the applicant with a copy of the motion to suspend.

If the Director cancels and restores the registration to application status, the opposition will be resumed and appropriate dates will be set. If the Director declines to cancel the registration, the opposition will be dismissed as a nullity and the fee will be refunded.

If a registration issues inadvertently during a timely opposition, the Director normally will cancel the registration as inadvertently issued, and restore it to application status. However, if the opposition has already been finally determined in applicant's favor when the inadvertent issuance is discovered, applicant may either keep the registration, or request that it be cancelled as inadvertently issued, restored to application status, and then reissued.

217 Relinquishment of Extension

If a potential opposer whose request for an extension of time to oppose is pending, or whose granted extension has not yet expired, files a letter notifying the Board that it will not oppose, the Board will immediately forward to issue the application that was the subject of the request or extension.

If a potential opposer that has requested or obtained an extension of time to oppose thereafter agrees unconditionally in writing not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the subject application to issue.[90]

218 Abandonment of Application

If an applicant files an express abandonment of an application that is the subject of a pending request for an extension of time to oppose, or of a granted extension, the application stands abandoned and any pending request for an extension of time to oppose is moot. An application that has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will be returned by the Board to the opposer, and the opposition fee will be refunded.[91]

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[90] *Cf.* TBMP § 212.06 (Action by Board—After Consideration of Amendment).

[91] *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1081 n.1 (TTAB 1992) and *In re First National Bank of Boston*, 199 USPQ 296, 297 (TTAB 1978) (notice of opposition and abandonment both filed on same day; no opposition). *Cf.* TBMP § 602.01 (Withdrawal by Applicant).

The express abandonment of an application that is not the subject of an inter partes proceeding before the Board (i.e., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant. It is not necessary that applicant obtain a potential opposer's consent thereto.[92]

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if an applicant files an express abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant.[93] However, if an applicant files an abandonment after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, the applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgment shall be entered against applicant.[94]

An applicant may expressly abandon its application by filing in the USPTO a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or other authorized representative.[95]

When an applicant files an express abandonment of an application which is the subject of a pending request for an extension of time to oppose, or of a granted extension, a Board administrative staff member will prepare a letter acknowledging receipt of the abandonment, and notifying potential opposer that the application is no longer subject to the filing of a new opposition.

219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. § 1051(c), filed in an intent-to-use application (i.e., an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b)) after approval for publication is late-filed.[96] Thus, *an amendment to allege use filed during an extension of time to oppose or during an opposition is late-filed*.

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[92] *See* 37 CFR § 2.68.

[93] *See* 37 CFR § 2.135.

[94] *See In re First National Bank of Boston, supra*. *Cf.* TBMP § 602.01 (Withdrawal by Applicant).

[95] *See* 37 CFR § 2.68.

[96] *See* 37 CFR § 2.76(a); and *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (amendment to allege use filed during blackout period denied as untimely).

A statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).[97] A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the time for opposing has expired and all oppositions filed have been dismissed.[98] Thus, *a statement of use filed during an extension of time to oppose or during an opposition is premature*.

Any late-filed amendment to allege use or premature statement of use will be returned to the applicant, and any fee submitted therewith will be refunded.[99]

If an intent-to-use application has been published and is under a well taken request for an extension of time to oppose when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board will issue an action approving the extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date) and advise the potential opposer that if it wishes to preserve its right to oppose should the amendment to allege use be ultimately withdrawn by the applicant or approved by the Examining Attorney, the potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition.

The Board will then return the application to the Trademark Examining Attorney for appropriate action with respect to the amendment to allege use. The Examining Attorney, in turn, will process the amendment to allege use in the same manner[100] as any other timely filed amendment to allege use that is not associated with the application file until after publication. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the Examining Attorney should return the application to the Board (before any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose.[101] If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

The filing of the amendment to allege use will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not

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[97] *See* Section 1(d)(1) of the Act, 15 U.S.C. § 1051(d)(1), and 37 CFR § 2.88(a).

[98] *See* Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2), and 37 CFR § 2.81(b).

[99] *See* 37 CFR §§ 2.76(a) and 2.88(a).

[100] Described in TMEP § 1104.04.

[101] *See* TMEP § 1104.04.

constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the Trademark Examining Attorney for appropriate action[102] with respect to the amendment to allege use. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the Examining Attorney should return the application to the Board (prior to any scheduled republication of applicant's mark) for further appropriate action with respect to the opposition.[103] If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

220 Inadvertent Issuance of a Notice of Allowance

Sometimes a notice of allowance is issued mistakenly in an intent-to-use application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an unexpired extension of time to oppose or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled (by the Intent To Use Division of the Office of Trademark Services) as inadvertently issued. The statement of use will be returned, and the fee submitted therewith will be refunded. If the inadvertently issued notice of allowance has already been cancelled when the Board receives the statement of use, the Board itself will return the statement of use and refund the fee submitted therewith. If the inadvertently issued notice of allowance has not already been cancelled when the Board receives the statement of use, the Intent To Use Division will return the statement of use and refund the fee when it cancels the notice of allowance.

Sometimes a notice of allowance issues between the time an extension request is submitted but not yet approved. Additionally, by the time the Board receives the file for action the extension requested has expired, and no opposition or further extension requests have been filed. In that case, the Board will issue an action acknowledging the extension request; indicating that it was well taken but that time has since expired and no opposition or further request has been filed. The Board will also indicate that a notice of allowance was inadvertently issued during the requested extension period, but since the requested time period has run without subsequent action by the potential opposer, the notice of allowance will not be withdrawn.

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[102] As described in TMEP § 1104.04.

[103] *See* TMEP § 1104.04.

Chapter 300
PLEADINGS

301 Types of Board Proceedings

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration of a mark" may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, under Section 12(a) of the Act, 15 U.S.C. § 1062(a), in the *Official Gazette* of the Patent and Trademark Office ("USPTO").[1]

> **Mark on Supplemental Register Not Subject to Opposition:**
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> ***15 U.S.C. § 1092 [Section 24 of the Trademark Act]*** *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. ...*
>
> Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not.[2]
>
> Accordingly, the Board must reject any opposition filed with respect to the mark in an application for registration on the Supplemental Register. The opposition papers will be returned to the person who filed them, and any opposition fee submitted will be refunded. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued.[3]

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a trademark. The proceeding may only be filed after the issuance of the

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[1] *See* Section 13 of the Act of 1946, 15 U.S.C. § 1063.

[2] *See* Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§ 1062(a), 1063(a), and 1092. *See also* TBMP § 205 (Mark on Supplemental Register).

[3] *See* Section 24 of the Act, 15 U.S.C. § 1092.

registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark.[4]

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict), is entitled to registration.[5] The proceeding is declared by the USPTO only on petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference.[6]

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, ordinarily as to the geographic scope of the applicant's mark or the goods and/or services on or in connection with which the mark is used.[7]

302 Commencement of Proceeding

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

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

37 CFR § 2.116(b) *The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

37 CFR § 2.116(c) *The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

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[4] *See* Sections 14 and 24 of the Act of 1946, 15 U.S.C. §§ 1064 and 1092.

[5] *See* Section 18 of the Act, 15 U.S.C. § 1068.

[6] *See* Section 16 of the Act of 1946, 15 U.S.C. §1066; 37 CFR §2.91; and TBMP § 1002 (Declaration of Interference).

[7] *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 n.9 (TTAB 1995) and TBMP § 1101.01 (Nature of Concurrent Use Proceeding) and authorities cited therein.

An opposition proceeding is commenced by the timely filing of a notice of opposition in the USPTO.[8] Similarly, a cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the USPTO.[9]

The notice of opposition, or the petition for cancellation, and the answer thereto correspond to the complaint and answer in a court proceeding.[10] The opposer in an opposition proceeding, or the petitioner in a cancellation proceeding, is in the position of plaintiff, and the applicant in an opposition proceeding, or the respondent in a cancellation proceeding, is in the position of defendant.[11]

An interference proceeding commences when the Board mails a notice of interference to each of the parties to the proceeding, as described in 37 CFR § 2.93.[12]

A concurrent use proceeding commences when the Board mails a notice of the proceeding to each of the parties thereto, as described in 37 CFR §§ 2.99(c) and 2.99(d)(1).

For further information concerning interference and concurrent use proceedings, see TBMP chapters 1000 and 1100, respectively.

303 Who May Oppose or Petition to Cancel

303.01 In General

15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act] *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. ...*

15 U.S.C. § 1064 [Section 14 of the Trademark Act] *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of*

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[8] *See* 37 CFR § 2.101(a). *See also Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). *Cf.* Fed. R. Civ. P. 3.

[9] *See* 37 CFR § 2.111(a).

[10] *See* 37 CFR § 2.116(c).

[11] *See* 37 CFR §2.116(b). *See also Yamaha International Corp. v. Hoshino Gakki Co., supra.*

[12] *See* 37 CFR § 2.93.

dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....

15 U.S.C. § 1092 [Section 24 of the Trademark Act] *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. ...*

15 U.S.C. § 1127 [Section 45 of the Trademark Act: Construction and Definitions] *In the construction of this Act, unless the contrary is plainly apparent from the context--*

* * * *

Person; Juristic Person. *The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.*

The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

The term "person" also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.

* * * *

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

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

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

303.02 Meaning of the Term "Person"

The term "person," as used in the Act, includes both natural and juristic persons.[13] A juristic person is a "firm, corporation, union, association, or other organization capable of suing and being sued in a court of law."[14]

If an operating division of a corporation is not itself incorporated or is not otherwise a legal entity which can sue and be sued, it does not have legal standing to own a mark or to file an application for registration, an opposition, or a petition for cancellation.[15] In such a case, the application, opposition, or petition for cancellation should be filed in the name of the corporation of which the division is a part. If an opposition or a petition for cancellation is filed in the name of a division, and there is no indication that the division is incorporated, the Board will make written inquiry as to whether the division is incorporated or is otherwise a legal entity that can sue and be sued. If the opposer or petitioner responds in the negative, the opposition or petition for cancellation will go forward in the name of the corporation of which the division is a part.[16]

The term "person" as used in the Act also includes the United States, any agency and instrumentality thereof, or any individual, firm or corporation which acts for the United States and with the authorization and consent of the United States, as well as any state, any instrumentality of a state, and any officer or employee of a state or instrumentality of a state acting in his or her official capacity.

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[13] *See* Section 45 of the Act, 15 U.S.C. § 1127. *Cf.* 37 CFR § 2.2(b).

[14] Section 45 of the Act, 15 U.S.C. § 1127. *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992) (a "person" may be a corporation or other entity); *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 720-21 (CCPA 1969) (a corporation, is a "person" within the meaning of Section 45 of the Act, and can base an opposition on Section 2(a) of the Act, 15 U.S.C. §1052(a)); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685, 1686 n.2 (TTAB 1987) (Commonwealth of Aruba is a "person" within the meaning of Sections 13 and 45 of the Act); *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254, 1257 (TTAB 1987) (U.S. Navy is a juristic person within the meaning of Section 45 of the Act); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 410 n.6 (TTAB 1986) (Alabama Board of Trustees, a corporate body, may be considered either a "person" or an "institution" within the meaning of Section 2(a) of the Act); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 n.2 (TTAB 1985) (corporations as well as individuals are "persons" for purposes of Section 2(a) of the Act); and *In re Mohawk Air Services Inc.*, 196 USPQ 851, 855 (TTAB 1977) (a government agency is a juristic person and as such may file an application for registration, an opposition, or a petition for cancellation).

[15] *See In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986), and TMEP § 1201.02(d).

[16] *Cf. In re Cambridge Digital Systems, supra*, and TMEP § 1201.02(d).

303.03 Meaning of the Term "Damage"

The term "damage," as used in Sections 13 and 14 of the Act, 15 U.S.C. §§ 1063 and 1064, concerns specifically a party's standing to file an opposition or a petition to cancel, respectively. A party may establish its standing to oppose or to petition to cancel by showing that it has a "real interest" in the case, that is, a personal interest in the outcome of the proceeding and a reasonable basis for its belief in damage.[17] There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding.[18]

303.04 Federal Trade Commission

15 U.S.C. § 1064 *Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required.*

The proviso at the end of Section 14 of the Lanham Act, 15 U.S.C. § 1064, provides statutory standing for the Federal Trade Commission to cancel a registration on the Principal Register on the grounds specified in paragraphs (3) and (5) of the section.[19]

For information concerning the grounds for cancellation specified in paragraphs (3) and (5) of Section 14 of the Act, see TBMP § 307.01.

303.05 Opposition Filed During Extension of Time to Oppose

37 CFR § 2.102(b) *The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through*

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[17] *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) and TBMP § 309.03(b) (Standing).

[18] *See Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *Universal Oil Products Co. v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 1124, 174 USPQ 458, 459-60 (CCPA 1972). *For additional case cites see the Appendix of Cases. For a discussion of standing, see* TBMP § 309.03(b).

[19] *See also Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 647 (CCPA 1979), and *Federal Trade Commission v. Formica Corp.*, 200 USPQ 182, 191 (TTAB 1978).

mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

303.05(a) General Rule

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party.[20] For this reason, an opposition filed during an extension of time to oppose ordinarily must be filed in the name of the party to which the extension was granted.[21] An opposition filed in a different name will be accepted only if the opposition is filed by a person in privity with the person granted the extension of time or if the person that requested the extension was misidentified through mistake.

303.05(b) Opposition Filed by Privy

A party in privity with a potential opposer may step into the potential opposer's shoes and file a notice of opposition or may join with the potential opposer as a joint opposer.[22] Thus, an opposition filed during an extension of time to oppose may be filed by a party other than the party to which the extension was granted, if it is shown to the satisfaction of the Board that the differing party is in privity with the party granted the extension.[23] If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the opposition will not be accepted as to any different party that fails to make a satisfactory showing of privity.

The "showing" of privity should be in the form of a recitation of the facts on which the claim of privity is based, and must be submitted either with the opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more differing parties, an explanation will be requested as to each

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[20] *See Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (a party cannot claim the benefit of an extension granted to another, unrelated party).

[21] *See* 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). *Cf.* TBMP § 206.02.

[22] *See SDT Inc. v. Patterson Dental Co., supra* (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose); Trademark Rule 2.102(b); and *In re Cooper*, *supra*.

[23] *See* 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, *supra*; and *In re Cooper*, *supra* (fact that two entities share same objection is not a basis for finding privity). *Cf.* TBMP § 206.02.

differing party, and the opposition will not be accepted as to any differing party that fails to make a satisfactory showing of privity.

Once a timely notice of opposition has been filed, and the time for opposing has expired, the right to pursue the filed case is a right individual to the timely filer. While this right may be transferred to another party, as by an assignment of the mark with the associated goodwill, it may not be shared.[24]

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

303.05(c) Misidentification of Opposer

If the name of the opposer, in an opposition filed during an extension of time to oppose, differs from the name of the party to which the extension was granted, the opposition will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake.[25]

The phrase "misidentification by mistake," as used in 37 CFR § 2.102(b), means a mistake in the form of the opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named.[26] The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts on which the claim of misidentification by mistake

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[24] *SDT, Inc. v. Patterson Dental Co., supra* at 1709; and *In re Cooper*, *supra* at 671 (licensee, having failed to join opposer in filing opposition during extension of time to oppose, may not be joined after opposition is filed).

[25] *See* 37 CFR § 2.102(b), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

[26] *See Cass Logistics Inc. v. McKesson Corp., supra* at 1077 (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). *See also* TMEP § 1503.04.
Cf. William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1870 (TTAB 1994) (motion to substitute party that acquired mark from opposer prior to commencement of proceeding granted where opposition had been mistakenly filed in name of original owner); *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a partner in a firm which no longer existed was not fatal); and TBMP § 512.04 (Misidentification). *Cf. also* TMEP §§ 803.03 and 1201.02(c)*; In re Columbo Inc.*, 33 USPQ2d 1530, 1531 (Comm't 1994) (fact that statement of use was signed by officer of true owner was irrelevant where statement of use was filed in name of wrong party); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1640 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r 1974) (deletion of "company" was correctable mistake).

is based, and must be submitted either with the opposition or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

303.06 Joint Opposers or Petitioners

Two or more parties may file an opposition or a petition for cancellation jointly. However, the required fee must be submitted for each party joined as opposer or petitioner for each class in the application for which registration is opposed or for each class in the registration for which cancellation is sought.[27]

When parties file jointly, the notice of opposition or petition for cancellation must name each party joined as plaintiff. In addition, the notice of opposition or petition for cancellation should include allegations concerning the standing of each party plaintiff and the ground or grounds for opposition or cancellation.[28] If the case is ultimately determined on the merits, rather than by default, withdrawal, stipulation, etc., any joint plaintiff whose standing has not been proved cannot prevail, even though a ground for opposition or cancellation has been proved.[29]

On the other hand, the fact that two or more parties may have an interest in a mark to be pleaded in a notice of opposition, or a petition for cancellation does not mean that each such party must be joined as opposer, or petitioner. Joint filing is elective, not mandatory.[30]

304 Proceeding Against Multiple Class Application or Registration

When an opposition is filed with respect to an application which contains goods and/or services in multiple classes (*see* 37 CFR § 2.86(b)), or a petition for cancellation is filed with respect to a registration which contains goods and/or services in multiple classes, the class or classes

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[27] *See* 37 CFR §§ 2.101(d)(1) and 2.111(c)(1); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee was not permitted to join as co-opposer after notice of opposition was filed, but even if permitted, would have had to submit fee); and TBMP § 308. *For information concerning the filing of an opposition by two or more parties jointly where the opposition is filed during an extension of time obtained by only one of the parties see* TBMP § 303.05.

[28] *See* TBMP § 309.03(b) and (c) *for a discussion of standing and grounds for oppositions and cancellations.*

[29] *See Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (of three joint opposers, owner of registration and its licensee as user of marks had real interest in proceeding, but opposer who only held software copyright had no standing and was given no further consideration). *See also Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (Board found that one of the two opposers did not prove standing).

[30] *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992) (respondent's motion to dismiss and its alternative motion to join petitioner's parent as owner of pleaded registrations and real party in interest denied since issue concerned what rights petitioner has in pleaded marks vis a vis defendant, not anyone else).

opposed, or sought to be cancelled, should be specified in the plaintiff's pleading. In addition, the required opposition or cancellation fee must be submitted for each party joined as plaintiff for each class sought to be opposed or cancelled.[31]

305 Consolidated and Combined Complaints

37 CFR § 2.104(b) *Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.*

37 CFR § 2.112(b) *Petitions to cancel different registrations owned by the same party may be joined in a consolidated petition when appropriate, but the required fee must be included for each party joined as petitioner for each class sought to be cancelled in each registration against which the petition to cancel is filed.*

When appropriate, a party may oppose, in a single (i.e., "consolidated") notice of opposition, different applications owned by the same defendant. However, the required fee must be submitted for each party joined as opposer, for each class in which registration is opposed, in each application against which the opposition is filed.[32] When such a pleading is filed, the Board sets up a single opposition file, identified by a single opposition proceeding number, but bearing on its front, in the place where the number of the opposed application is written, the number of each application opposed in the consolidated notice of opposition.

Similarly, when appropriate, a party may seek to cancel, in a single ("consolidated") petition for cancellation, different registrations owned by the same defendant. Again, the required fee must be submitted for each party joined as petitioner, for each class sought to be cancelled, in each registration against which the petition for cancellation is filed.[33] When such a pleading is filed, the Board sets up a single cancellation file, identified by a single cancellation proceeding number, but bearing on its front the number of each registration sought to be cancelled in the consolidated petition to cancel.

In addition, a party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations,

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[31] *See* 37 CFR §§ 2.101(d) and 2.111(c), and TBMP § 308.04.

[32] *See* 37 CFR § 2.104(b) and TBMP § 308.05.

[33] *See* 37 CFR § 2.112(b) and TBMP § 308.05.

provided that each subject application and registration is owned by the same defendant.[34] However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the pleading is filed.[35] When such a pleading (referred to as a "combined" opposition and petition to cancel) is filed, the Board sets up both an opposition and a cancellation proceeding file, each with its own identifying number, and each marked "Combined with _____" followed by the number of the other proceeding. The opposition is treated as the "parent" case, and both proceeding numbers are placed on all papers relating to the combined proceedings.[36]

A consolidated notice of opposition, or petition to cancel, or a combined notice of opposition and petition to cancel, is appropriate if the plaintiff's claims against each of the defendant's subject applications, and/or registrations, involve common (i.e., similar) questions of law or fact.[37]

306 Time for Filing Opposition

306.01 In General

15 U.S.C. § 1062(a) [Section 12(a) of the Trademark Act] *Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1(d) of this Act, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office....*

15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act] *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result*

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[34] *See, e.g., Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993) (combined opposition and cancellation).

[35] *See* TBMP § 308 (Filing Fees). *Cf.* 37 CFR §§ 2.104(b) and 2.112(b).

[36] *Cf.* TBMP § 511.

[37] *See Nabisco Brands Inc. v. Keebler Co., supra* at 1238 n.2 (defendant who believes marks and issues are sufficiently different such that combined proceeding is not appropriate may file motion to separate proceedings). *Cf.* Fed. R. Civ. P. 42(a); TBMP § 511 (motions to consolidate); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (oppositions involving similar marks and similar issues consolidated); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441 (TTAB 1973) (applicant's motion to consolidate denied in view of extent of differences in the involved issues). *Cf. also Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (joint motion to consolidate granted in view of identity of parties and issues), and *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985) (consolidation permitted; issues of fact and law substantially similar).

of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. ...

37 CFR § 2.101(c) *The opposition must be filed within thirty days after publication (§2.80) of the application being opposed or within an extension of time (§2.102) for filing an opposition.*

An opposition to the registration of a mark on the Principal Register must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette* for opposition, or within an extension of time to oppose granted to the opposer or its privy.[38] The certificate of mailing by first-class mail procedure described in 37 CFR § 1.8 and the "Express Mail" procedure described in 37 CFR § 1.10 are both available for the filing of a notice of opposition; the certificate of (fax) transmission procedure described in 37 CFR § 1.8 is not.[39]

For information concerning the effect of such matters as restoration of jurisdiction, republication, amendment, letter of protest, petition to the Director, abandonment, or the inadvertent issuance of a registration, on the filing of an oppositions or a request to extend time to oppose, see generally, TBMP chapter 200.

306.02 Date of Publication of Mark

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

306.03 Premature Opposition

Section 13 of the Act, 15 U.S.C. § 1063(a), requires that an opposition to the registration of a mark on the Principal Register be filed within a specified time *after* the publication of the mark in the *Official Gazette.*

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[38] *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a); 37 CFR §§ 2.102(b) and (c); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and TBMP § 303 (Who May Oppose or Petition to Cancel).

[39] *See* 37 CFR §§ 1.8(a) and 1.10(a). *See also* TBMP §§ 110 (Certificate of Mailing or Transmission) and 111 ("Express Mail" Procedure).

Thus, any opposition filed prior to the publication of the mark sought to be opposed, is premature, and will be rejected by the Board, even if the mark has been published by the time of the Board's action. No proceeding will be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded.[40]

306.04 Late Opposition

Because the timeliness requirements of Section 13(a) of the Act, 15 U.S.C. § 1063(a), for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Director on petition.[41]

Accordingly, an opposition filed after the expiration of the would-be opposer's time for opposing must be denied by the Board as late. No proceeding will be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded. The would-be opposer's remedy lies in the filing of a petition for cancellation, pursuant to Section 14 of the Act, 15 U.S.C. § 1064, when and if a registration is issued.

307 Time for Filing Petition to Cancel

15 U.S.C. § 1064 [Section 14 of the Trademark Act] *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(a), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:*

> ***(1)*** *Within five years from the date of the registration of the mark under this Act.*
>
> ***(2)*** *Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.*
>
> ***(3)*** *At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such*

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[40] *Cf.* TBMP §§ 119.03 (Papers and Fees) and 202.03 (Premature Request).

[41] *See In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of Rule 1.8 would effectively waive Section 13 and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of Rule 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

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

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

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

15 U.S.C. § 1092 [Section 24 of the Trademark Act] *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. The Director shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be cancelled by the Director. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).*

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

the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases the petition and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

307.01 Petition That May Be Filed At Any Time After Registration

A petition to cancel a registration may be filed at any time in the case of a registration issued on the Supplemental Register under the Act of 1946, 15 U.S.C. §1051 *et seq.*, or under the Act of 1920, or a registration issued under the Act of 1881 or the Act of 1905 which has not been published under Section 12(c) of the Act of 1946, 15 U.S.C. § 1062(c).[42]

In addition, a petition to cancel any registration may be filed at any time on any ground specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. § 1064(3) or 1064(5).[43] As permitted by Section 14(3), a petition to cancel may be filed at any time on grounds that, for example, the mark has been abandoned; the registration was obtained by fraud; the mark is generic; the mark is geographically deceptive,[44] or disparaging, or falsely suggests a connection with a person's name or identity;[45] the mark comprises matter that, as a whole, is functional;[46] or the mark comprises the flag of the United States[47] or the name of a living individual without the individual's consent.[48]

For additional information on selected grounds for opposition and cancellation, see TBMP § 309.03(c).

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[42] *See* Sections 14 and 24 of the Act, 15 U.S.C. §§ 1064 and 1092, and 37 CFR § 2.111(b).

[43] *See* Sections 14 and 24 of the Act, 15 U.S.C. §§ 1064 and 1092, and 37 CFR § 2.111(b).

[44] *See* Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). *Cf., for example, Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (registration over five years old may not be challenged on ground that mark is geographically descriptive under Section 2(e)(2)).

[45] *See* Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

[46] *See* Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5).

[47] *See* Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b).

[48] *See* Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c).

307.02 Petition That Must Be Filed Within Five Years from the Date of Registration

307.02(a) In General

A petition to cancel a registration issued on the Principal Register under the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. § 1064(3) or 1064(5), must be filed within five years from the date of the registration of the mark.[49] Similarly, a petition to cancel a registration issued on the Principal Register under the Act of 1881 or the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c), 15 U.S.C. 1062(c).[50]

Although a petition to cancel filed after the expiration of the five-year period, in the case of such a Principal Register registration, must recite one of the grounds specified in Section 14(3) or 14(5) of the Act, a petition to cancel filed prior to the expiration of the five-year period may be based on any ground which could have prevented registration initially.[51] The grounds for cancellation which are thus available in these cases for a petition filed within the five-year period, but not thereafter, include all of the grounds specified in Sections 14(3) and (5) as well as likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); [52] all of the grounds specified in Section 2(e) of the Act, 15 U.S.C. § 1052(e), including a claim that respondent's mark is merely descriptive or deceptively misdescriptive, that respondent's mark is geographically descriptive or deceptively misdescriptive, or that respondent's mark is primarily merely a surname; that respondent is not the owner of the registered mark; and that there was no bona fide use of respondent's mark in commerce to support the original registration.

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[49] *See Arman's Systems, Inc. v. Armand's Subway, Inc.,* 215 USPQ 1048, 1050 (TTAB 1982) (the filing date of the petition is the operative date, not the date that the notice of the proceeding is mailed to the parties). *Cf. British-American Tobacco Co. Limited v. Philip Morris Inc.,* 55 USPQ2d 1585 (TTAB 2000) (Section 14 does not limit Board's authority to entertain an action under Article 8 of the Pan American Convention against a registration over five years old).

[50] *See* Sections 14(1) and 14(2) of the Act, 15 U.S.C. §§ 1064(1) and 1064(2), and 37 CFR § 2.111(b).

[51] *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142, 142 (Fed. Cir. 1986); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

[52] *Cf. Liberty Trouser Co. v. Liberty & Co.,* 222 USPQ 357, 358 (TTAB 1983) (claim of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment). *For a discussion of standing to file a petition to cancel or a notice of opposition, see* TBMP § 309.03(b).

For additional information on selected grounds for opposition and cancellation, see TBMP § 309.03.

A petitioner may not seek to cancel a registration over five years old on the *ground* of likelihood of confusion. However, under Section 18 of the Trademark Act, 15 U.S.C. § 1068, a petitioner may seek to partially cancel a registration over five years old by restricting the goods or services therein in order to avoid a likelihood of confusion. *For a discussion of a petition to partially cancel a registration under Section 18 of the Trademark Act, see* TBMP § 309.03(d).

The five-year period specified in Section 14(1), 15 U.S.C. § 1064(1), (i.e., "Within five years from the date of the registration of the mark under this Act") includes the fifth anniversary date of the registration.[53] Similarly, the five-year period specified in Section 14(2), 15 U.S.C. § 1064(2), ("Within five years from the date of publication under Section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905"), includes the fifth anniversary date of the publication under Section 12(c).[54]

The filing date of the petition is the date of receipt in the USPTO of the petition with the required fee.[55] The Certificate of Mailing procedure described in 37 CFR § 1.8 and the "Express Mail" procedure described in 37 CFR § 1.10 are available for the filing of a petition to cancel.[56]

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

The five-year time limit specified in Section 14, 15 U.S.C. § 1064, barring certain attacks on a Principal Register *registration*, "is not dependent on the filing of a declaration under Section 15 which provides incontestable rights of *use* to a limited extent (15 U.S.C. §1065)."[57]

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[53] *See Strang Corp. v. Stouffer Corp.,* 16 USPQ2d 1309 (TTAB 199) (fifth-year anniversary falling on a weekend or holiday). *Cf.* TMEP §§ 1605.05 and 1606.03.

[54] *Cf. Strang Corp. v. Stouffer Corp., supra*, and TMEP §§ 1605.05 and 1606.03.

[55] 37 CFR § 2.111(c)(3).

[56] *See* 37 CFR §§ 1.8(a) and 1.10(a).

[57] *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1392 n.5 (Fed. Cir. 1990) (emphasis in original). *See also Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990), and *Strang Corp. v. Stouffer Corp., supra* at 1311 (concept of incontestability of a registration is irrelevant to a cancellation proceeding under Section 14).

307.02(c) Factors Affecting the Five-Year Period

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

If an opposer relies on a Principal Register registration of its pleaded mark, and the five-year period has not yet expired when the opposition is filed, the limitation does not apply to any counterclaim filed in response to the petition for cancellation of that registration. This is so even if the five-year period has expired by the time the counterclaim is filed. In such cases, the filing of the opposition tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds on which a counterclaim may be based.[58]

Similarly, the limitation would not apply to a counterclaim to cancel such a Principal Register registration relied on by the petitioner in a cancellation proceeding, if the five-year period had not yet expired with respect to the registration at the time of the filing of the petition to cancel.

307.02(c)(2) Amendment of Registration

When a Principal Register registration has been amended, the registration is subject to attack under Section 14 of the Act, 15 U.S.C. § 1064, to the extent that the amendment of the registration has in any way enlarged registrant's rights, as though the registration had issued on the date of the amendment. That is, even though the Section 14 five-year period following issuance of the registration, or publication under Section 12(c), 15 U.S.C. § 1062(c), may have expired, if a petition to cancel the registration is filed within the five years following the amendment of the registration, the petition is not limited to Section 14(3) or 14(5) (15 U.S.C. § 1064(3) or 1064(5)) grounds, to the extent that the amendment has in any way enlarged the registrant's rights. Rather, during the five years after the amendment, "the modified registration, not having been in existence for five

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[58] *See e.g., Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); *UMC Industries, Inc. v. UMC Electronics Co*., 207 USPQ 861, 862 n.3 (TTAB 1980); *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan,* 165 USPQ 597, 598 n.4 (TTAB 1970) (grounds were not limited where, although petition to cancel was not properly filed until after fifth anniversary date of registration, opposition wherein opposer relied on said registration was filed before anniversary date); and *Sunbeam Corp. v. Duro Metal Products Co.,* 106 USPQ 385, 386 (Comm'r 1955). *See also* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:67 (4th ed. 2001).

Cf., *regarding concurrent use proceedings*, *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (5-year period tolled where applicant, prior to expiration of 5-year period files a proper concurrent application or an amendment converting an unrestricted application to one seeking concurrent use naming registrant as exception to applicant's right to exclusive use).

years, may be challenged in a cancellation proceeding as long as petitioner states grounds [not limited to Section 14(3) or 14(5) grounds] for the cancellation indicating how he believes he is or will be damaged by the modified registration."[59]

307.03 Premature Petition to Cancel

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

Thus, if a petition to cancel a registration is filed prior to the issuance of the registration, it is premature, and will be rejected by the Board, even if the registration has issued by the time of the Board's action. No proceeding will be instituted; rather, the petition papers will be returned, and any submitted petition fee will be refunded. Petitioner's remedy lies in the filing of a new petition to cancel after the registration has issued.

307.04 Late Petition to Cancel

A petition to cancel a registration issued on the Principal Register under the Act of 1946 on a ground not specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. § 1064(3) or 1064(5), must be filed within five years from the date of the registration of the mark. Similarly, a petition to cancel a registration issued on the Principal Register under the Act of 1881 or the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, 15 U.S.C. § 1062(c), on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c).[60]

If a petition to cancel one of these Principal Register registrations is filed after the expiration of the five-year period and does not plead one or more of the grounds specified in Section 14(3) or 14(5) of the Act, the petition is late, and will be rejected by the Board. No proceeding will be instituted; rather, the petition papers will be returned, and any submitted petition fee will be refunded. However, the rejection of the petition is without prejudice to petitioner's right to file, at any time thereafter, a new petition to cancel the registration, and to plead therein one or more of the grounds specified in Section 14(3) or 14(5).

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[59] *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 423 (CCPA 1976). *See Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 824-25 (TTAB 1984) (counterclaim would be proper where defendant pleads that the amendment to the mark in the subject registration resulted in a mark materially different from originally registered mark, representing enlargement of rights conferred by original certificate of registration; that defendant used its mark prior to opposer's first use of amended mark; and that confusion with amended mark is likely).

[60] *See* Section 14 of the Act, 15 U.S.C. § 1064, and 37 CFR § 2.111(b).

For information concerning the effect of signature and fee requirements on the timing of a petition to cancel, see TBMP §§ 308.02(d) (Insufficient Fee) and 309.02(b) (Signature).

308 Filing Fees

308.01 Fee for Filing Opposition

308.01(a) In General

15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act] *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office....*

37 CFR §2.101(d)*(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6). If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.*

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

(3) If persons are joined as party opposers, and the fees submitted are sufficient to pay for one person to oppose registration in at least one class but are insufficient for each named party opposer, the Office will issue a written notice allowing the named party opposers until a set time in which to submit the required fee(s) or to specify the opposer(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party opposer and additional parties will be deemed to be party opposers to the extent that the fees submitted are sufficient to pay the fee due for each

party opposer. If persons are joined as party opposers against the registration of a mark in more than one class, the fees submitted are insufficient, and no specification of opposers and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending order.

The rules governing opposition fees are specified in 37 CFR §§ 2.101(d)(1)-(d)(3). The amount of the required filing fee is specified in 37 CFR § 2.6(a)(17).

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

308.01(b) Insufficient Fee

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

308.02 Fee for Filing Petition to Cancel

308.02(a) In General

15 U.S.C. § 1064 [Section 14 of the Trademark Act] *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....*

15 U.S.C. § 1092 [Section 24 of the Trademark Act] *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. ...*

37 CFR § 2.111(c)*(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see § 2.6). If the fee submitted*

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

(2) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are insufficient for each named party petitioner, the Office will issue a written notice allowing the named party petitioners until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the petitioner(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party petitioner and additional parties will be deemed to be party petitioners to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a registration sought to be cancelled in more than one class, the fees submitted are insufficient, and no specification of parties and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the petition against the classes in the registration in ascending order.

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

The rules governing cancellation fees are specified in 37 CFR §§ 2.111(c)(1)-(c)(3). The amount of the required fee is specified in 37 CFR § 2.6(a)(16). The required fee for a petition to cancel must be submitted with the petition; the effective filing date of a

petition to cancel (and, hence, the date of commencement of the cancellation proceeding) is the date of receipt in the USPTO of both the petition to cancel and the required fee.[61]

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

308.02(b) Insufficient Fee

The required fee for a petition to cancel must be submitted with the petition.[62] The filing date of a petition to cancel is the date of receipt in the PTO of the petition and the required fee.[63] Moreover, Section 14 of the Act, 15 U.S.C. § 1064, limits, after a specified five-year period, the grounds on which a Principal Register registration issued under the Act of 1946, 15 U.S.C. § 1051 *et seq.*, or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. § 1062(c), may be cancelled.[64] If a petition to cancel such a registration is submitted to the USPTO prior to the expiration of the five-year period, but the required fee is not submitted until after the expiration thereof, the filing date of the petition is the date of receipt in the USPTO of the required fee, and the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after expiration of the five-year period.[65]

Except to the extent that the five-year period of Section 14 is applicable in a particular case, there is no time limit for the filing of a petition to cancel an issued registration. Thus, if no fee, or an insufficient fee, is submitted with a petition to cancel, the defect may be cured as specified in 37 CFR §§ 2.111(c)(1)-(c)(3), *provided that the five-year period, if applicable, has not expired, or, if expired, that the petition recites a ground permitted after the expiration of the five-year period*. The petition will not be rejected (except to the extent that it is barred by the five-year limit) if the required fee is submitted to the USPTO within the time limit set in the Board's written notification of the defect. The responsibility for filing proper documents and fees rests with the party filing them. Although the Board makes every effort to notify plaintiffs of insufficiencies in fees

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[61] *See* 37 CFR §§ 2.111(a), 2.111(c)(1), and 2.111(c)(3); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966); and TBMP § 308.02(b) (Insufficient Fee).

[62] *See* 37 CFR § 2.111(c)(1).

[63] *See* 37 CFR § 2.111(c)(3) and *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966).

[64] *See* Section 14 of the Act, 15 U.S.C. § 1064, and TBMP § 307.02(a) (petition filed within 5 years).

[65] *See* Section 14 of the Act, 15 U.S.C. § 1064; *Williamson-Dickie Manufacturing Co. v. Mann Overall Company, supra;* and TBMP § 307.04 (Late Petition to Cancel).

before the expiration of any applicable statutory deadline, so that the insufficiencies may be corrected prior to the deadline, the Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time.[66]

308.02(c) Petition Filed by Federal Trade Commission

There is no fee for a petition filed by the Federal Trade Commission to cancel a registration on the Principal Register.[67]

308.02(d) Fee for Counterclaim

For information concerning fees for counterclaims, see TBMP § 313.02.

308.03 Fees for Joint Opposers or Petitioners

Two or more parties may file an opposition, or a petition for cancellation, jointly. However, the required fee must be submitted for each party joined as opposer, or petitioner, for each class in the application for which registration is opposed, or for each class in the registration for which cancellation is sought.[68]

308.04 Fees for Proceeding Against Multiple Class Application or Registration

The required opposition or cancellation fee must be submitted for each party joined as plaintiff for each class sought to be opposed or cancelled.[69]

308.05 Fees for Consolidated and Combined Complaints

When appropriate, a party may oppose, in a single (i.e., "consolidated") notice of opposition, different applications owned by the same defendant. However, the required fee must be

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[66] *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (regarding defective renewal application in sufficient time to permit refiling), and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

[67] *See* Section 14 of the Act, 15 U.S.C. § 1064. *Cf.* TBMP § 303.04 (Federal Trade Commission).

[68] *See* 37 CFR §§ 2.101(d)(1) and 2.111(c)(1); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and TBMP §§ 308.01 and 308.02 (Filing Fees). *See also* TBMP § 303 (Who May Oppose or Petition to Cancel).

[69] *See* 37 CFR §§ 2.101(d) and 2.111(c), and TBMP §§ 308.01 (Filing Fee for Opposition) and 308.02 (Filing Fee for Cancellation). *See also* TBMP § 304 (Multiple Classes).

submitted for each party joined as opposer, for each class in which registration is opposed, in each application against which the opposition is filed.[70]

Similarly, when appropriate, a party may seek to cancel, in a single ("consolidated") petition for cancellation, different registrations owned by the same defendant. Again, the required fee must be submitted for each party joined as petitioner, for each class sought to be cancelled, in each registration against which the petition for cancellation is filed.[71]

In addition, a party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant.[72] However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the complaint is filed.[73]

309 Form and Content of Oppositions and Petitions to Cancel

309.01 In General

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

37 CFR § 2.111(b) *Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. ...*
37 CFR § 2.116(c) *The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

37 CFR § 2.119(e) *Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused*

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[70] *See* 37 CFR § 2.104(b). *See* TBMP §§ 305 (Consolidated Complaints) and 308.01 (Filing Fee for Opposition).

[71] *See* 37 CFR § 2.112(b). *See also* TBMP §§ 305 and 308.02 (Filing Fee for Cancellation).

[72] *See, e.g., Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993) (combined opposition and cancellation).

[73] *Cf.* 37 CFR §§ 2.104(b) and 2.112(b). *See* TBMP § 305 (Consolidated and Combined Complaints).

consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

The notice of opposition, or petition to cancel, corresponds to the complaint in a court proceeding.[74] For purposes of simplicity, the term "complaint" is often used hereafter to refer to a notice of opposition or a petition to cancel.

309.02 Form of Complaint

309.02(a) Format for Complaint

The Board prefers that complaints be submitted in typewritten or printed form, double-spaced. A complaint may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended.[75]

The USPTO has no printed form for use in filing a notice of opposition or petition for cancellation. However, as an aid to litigants, the USPTO has prepared suggested formats for these complaints.[76] A complaint need not follow the suggested format, as long as it includes the necessary information. *For suggested formats for complaints, see Appendix of Forms.*

The complaint should include the following information:

Heading: The complaint should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD."

Identification of subject application or registration: The heading should be followed by information identifying the application or registration that is the subject of the complaint with the wording "Serial No._____" for an opposition or "Registration No._____" for a petition to cancel.

Name of proceeding: The application or registration number should be followed by the name of the proceeding (i.e., "ABC Corporation v. XYZ Company"), the wording

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[74] 37 CFR § 2.116(c).

[75] *See* TBMP § 106.03 (Form of Papers).

[76] *See DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1223 n.2 (TTAB 2000) (the guide to the format of the opposition should not to be used as a form to be filled in and returned to the Board).

"Opposition No. _____" or "Cancellation No. _____" (the Board will insert, in the blank space, the number assigned to the proceeding).

Title of Paper: The title should describe the nature of the paper (i.e., "Notice of Opposition" or "Petition to Cancel").

Plaintiff information: The complaint should also include plaintiff's name, entity type (i.e., individual, partnership, corporation, association, etc.), and business address; the names of the partners, if the plaintiff is a partnership, or the state or country of incorporation, if the plaintiff is a corporation.

Registrant information in petition to cancel: A petition to cancel should indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration.[77] Petitioner may comply with this requirement simply by furnishing the Board with whatever information it has concerning the name and address of the current owner of the registration; a special investigation made solely for purposes of complying with the rule is not necessary. The purpose of the requirement is to provide the Board with whatever information petitioner may have concerning the name and address of the current owner of the registration, so that the Board can notify that party of the filing of the petition.[78] If petitioner has no information concerning the name and address of the current owner of the registration, petitioner may simply use the name and address of registrant stated on the registration certificate.

Substance of complaint: The complaint must also include a pleading of the substance (i.e., standing and grounds) of the complaint.[79]

Signature: The complaint must be signed and include a description of the capacity in which the signing individual signs.[80]

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[77] *See* 37 CFR § 2.112(a). *See also Informix Software Inc. v. Oracle Corp.*, 40 USPQ2d 1153, 1155 (N.D. Cal. 1996) (the proper defendant in suit for cancellation of a registration is the owner of that registration. not an exclusive licensee).

[78] *Cf.* TBMP §§ 310.01 (Notification of Proceeding) and 310.02 (Defendant's Copy Returned).

[79] *See* TBMP § 309.03 (Substance of Complaint).

[80] *See* TBMP § 309.02 (Form of Complaint).

309.02(b) Signature

The complaint need not be verified, and it may be signed by the plaintiff or by the plaintiff's attorney or other authorized representative.[81] If an attorney signs the complaint, it need not be accompanied by a written power of attorney, but if a written power of attorney is filed, the plaintiff must sign it. If a plaintiff signing for itself is a partnership, the signature must be made by a partner. If a plaintiff signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the plaintiff who has authority to sign for the plaintiff and whose title is given. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as plaintiff, if plaintiff is an individual; as counsel for plaintiff; as a partner of plaintiff, if plaintiff is a partnership; as an officer of plaintiff identified by title, if plaintiff is a corporation; etc.).

Although a complaint must be signed, an unsigned complaint will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the Board's letter notifying plaintiff of this defect.[82] However, Section 14 of the Act, 15 U.S.C. § 1064, limits, after a specified five-year period, the grounds on which certain Principal Register registrations may be cancelled.[83] If an unsigned petition to cancel such a registration is filed prior to the expiration of the five-year period, but a signed copy thereof is not filed until after the expiration of the period, the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after the expiration of the five-year period.[84] Although the Board makes every effort to notify petitioners of unsigned complaints before the expiration of any applicable statutory deadline, so that the informality may be corrected prior to the deadline, the

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[81] *See* 37 CFR §§ 2.101(b) and 2.111(b), and TBMP § 106.02 (Signature of Papers).

[82] *See* 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Papers).

[83] *See* Section 14 of the Act, 15 U.S.C. § 1064; 37 CFR § 2.111(b); and TBMP § 307.02(a) (Petition filed within 5 years).

[84] *Cf., e.g., cases involving former requirement for verification ,Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966) (the filing date of a petition to cancel is the date of receipt in the USPTO of the verified petition and filing fee); *Texas Instruments Inc. v. Conklin Instrument Corp.*, 161 USPQ 740, 741 (TTAB 1969) (unverified petition timely filed but ineffective; verified substitute petition untimely); TBMP § 308.02(b) (Insufficient Fee); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 329 (1985). *Cf. also In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (timely payment of filing fee for statement of use is statutory and cannot be waived).

Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time.[85]

309.02(c) Complaint Must Be Filed in Duplicate

The complaint, and any exhibits thereto, must be filed in duplicate.[86] The complaint need not be served by the plaintiff on the defendant. Rather, the duplicate copy of the complaint, and any exhibits thereto, will be forwarded to the defendant by the Board itself.[87]

While a complaint must be filed "in duplicate," there is no requirement that one of the duplicates filed be the original. The duplicates may consist either of the original and one copy, or of two copies. However, all copies must be legible, and on good quality paper.[88]

309.03 Substance of Complaint

15 U.S.C. § 1068 [Section 18 of the Trademark Act] *In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, ...*

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

37 CFR § 2.99(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

37 CFR § 2.133(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

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

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[85] *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (regarding rejection of renewal application); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (regarding rejection of statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

[86] *See* 37 CFR §§ 2.104(a) and 2.112(a).

[87] *See* 37 CFR §§ 2.105, 2.113, and 2.119(a).

[88] *See* TBMP § 106.03 (Form of Papers).

37 CFR § 2.112(a) *The petition to cancel must set forth a short and plain statement showing why the petitioner believes it is or will be damaged by the registration, state the grounds for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration. ...*

309.03(a) In General

309.03(a)(1) Scope of Opposition and Petition to Cancel

In an opposition, the registration sought by an applicant may be opposed in whole, or in part. Similarly, a petitioner may seek to cancel a registration in whole, or in part.[89] However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding.[90]

The Board is an administrative tribunal which is empowered to determine only the right to register; it may not determine the right to use, or broader questions of infringement or unfair competition (-- *see* TBMP § 102.01).

309.03(a)(2) Elements of Complaint – In General

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding (*see* TBMP §§ 303.03 and 309.03(b)), and (2) a short and plain statement of one or more grounds for opposition.[91]

Similarly, a petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing to maintain the proceeding -- *see*

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[89] *See* Section 18 of the Trademark Act, 15 U.S.C. § 1068. See also TBMP § 309.03(d).

[90] *See* 37 CFR §§ 2.99(h) and 2.133(c).

[91] *See* 37 CFR § 2.104(a); *Young v. AGB Corp.*, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) (standing and grounds are distinct inquiries; allegation of "economic damage" while relevant to standing does not constitute a ground); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985) (allegation of priority without direct or hypothetical pleading of likelihood of confusion is insufficient pleading of Section 2(d) ground). *Cf.* Fed. R. Civ. P. 8(a).

TBMP §§ 303.03 and 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation.[92]

The elements of a claim should be stated simply, concisely, and directly.[93] However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim.[94]

All averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances.[95] Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded.[96] A paragraph may be referred to by number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint.[97]

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[92] *See* 37 CFR § 2.112(a); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992); and *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). *Cf.* Fed. R. Civ. P. 8(a).

For a discussion of the grounds for opposition and cancellation, see TBMP § 309.03(c) and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition,* §§ 20:13 et seq. (4th ed. 2001). *For a discussion of the grounds upon which a Principal Register registration over five years old may be cancelled, see* TBMP §§ 307.01 and 307.02. *See also* J. Thomas McCarthy*, McCarthy on Trademarks and Unfair Competition,* §§ 20:52 et seq. (4th ed. 2001).

[93] *See* Fed. R. Civ. P. 8(e)(1).

[94] *See McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985) (petitioner's Section 2(a) allegations were merely conclusory and unsupported by factual averments). *See also Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (since purpose of pleadings is to give fair notice of claims Board may in its discretion decline to strike even objectionable pleadings where their inclusion will not prejudice adverse party but rather will provide fuller notice of basis for claim); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1471 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328, 1330 (TTAB 1994) (although pleading need not allege particular "magic words" pleading of mere descriptiveness in this case could not be logically interpreted as asserting that applicant is not the owner of the mark); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (since function of pleadings is to give fair notice of claim, a party is allowed reasonable latitude in its statement of its claims); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[95] *See* Fed. R. Civ. P. 10(b) and *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 794 (TTAB 1974) (while paragraphs were numbered, none of the paragraphs were limited to a statement of a single set of circumstances).

[96] *See* Fed. R. Civ. P. 10(b).

[97] *See* Fed. R. Civ. P. 10(b) and (c).

A plaintiff may state as many separate claims as it has, regardless of consistency; a plaintiff may also set forth two or more statements of a claim alternatively or hypothetically, either in one count or in separate counts.[98]

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient.[99]

Evidentiary matters (such as, for example, lists of publications or articles in which a term sought to be registered by an applicant is alleged to be used descriptively) should not be pleaded in a complaint. They are matters for proof, not for pleading.[100]

In inter partes proceedings before the Board, as in civil cases before the United States district courts, all pleadings are so construed as to do substantial justice.[101]

309.03(b) Standing

Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint.[102] At the pleading stage, all that is required is that a plaintiff allege

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[98] *See* Fed. R. Civ. P. 8(e)(2); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, notwithstanding that it is the senior user, because the subject registration has been cited as a reference by the Examining Attorney). *See also, Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before Examining Attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as basis for standing).

[99] *See* Fed. R. Civ. P. 8(e)(2).

[100] *See McCormick & Co. v. Hygrade Food Products Corp.,* 124 USPQ 16, 17 (TTAB 1959). *Cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (if evidentiary facts are pleaded, and they aid in giving a full understanding of the complaint as a whole, they need not be stricken).

[101] *See* 37 CFR § 2.116(a); Fed. R. Civ. P. 8(f); and *The Scotch Whiskey Association v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991).

[102] *See* Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, and TBMP § 303 (Who May Oppose or Petition).

facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis for its belief of damage."[103] To plead a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding.[104] The allegations in support of plaintiff's belief of damage must have a reasonable basis "in fact."[105]

Allegations in support of standing which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial (or on summary judgment).[106] However, there is no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in an opposition or cancellation proceeding.[107]
A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads (and later proves):

> A claim of likelihood of confusion that is not wholly without merit;[108]
>
> Plaintiff has been refused registration of its mark because of defendant's registration, or has been advised that it will be refused registration when defendant's application matures into a registration, or has a reasonable belief that registration of its application will be refused because of defendant's registration;[109]

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[103] *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also Herbko International Inc. v. Kappa Books, Inc.,* 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) and *International Order of Job's Daughters v. Lindeburg and Company,* 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984).

[104] *Ritchie v. Simpson, supra* at 1026. *See also Lipton Industries, Inc. v. Ralston Purina Co., supra.*

[105] *Ritchie v. Simpson*, *supra* at 1027 (citing *Universal Oil Products v. Rexall Drug & Chemical Co*., 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972) and stating that the belief of damage alleged by plaintiff must be more than a subjective belief).

[106] *See Ritchie v. Simpson*, *supra* at 1029 *citing Lipton Industries, Inc. v. Ralston Purina Co., supra*. *See also, e.g., Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (at final decision, inquiry is not whether pleading of standing is sufficient but whether allegations have been proven).

[107] *See* TBMP § 303.03 (Meaning of "Damage"), and cases cited therein.

[108] *See Lipton Industries, supra; Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1209 (TTAB 1993); *Selva & Sons, Inc. v. Nina Footwear, Inc. ,* 705 F.2d 1316, 1326, 217 USPQ 641, 648 (Fed. Cir. 1983); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002); *The Nestle Company Inc. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1087 (TTAB 1987); and *Liberty Trouser Co. v. Liberty & Co.,* 222 USPQ 357, 358 (TTAB 1983) (allegation of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment).

[109] *See Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc*., 55 USPQ2d 1298, 1300 (TTAB 2000) and *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990).

> Plaintiff has a bona fide intent to use the same mark for related goods, and is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of respondent's registration;[110]
>
> Defendant has relied on its ownership of its application or registration in another proceeding between the parties, or defendant has asserted a likelihood of confusion in another proceeding between the parties involving the same marks.[111]

A counterclaimant's standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding.[112]

A plaintiff need not assert proprietary rights in a term in order to have standing.[113] For example, when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its standing by alleging that it is engaged in the sale or the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using the term descriptively in its business.[114]

309.03(c) Grounds

In addition to standing, a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition or cancellation.[115] A plaintiff may raise any available statutory

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[110] *See American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

[111] *See Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 859 (TTAB 1986) (petitioner has standing to cancel registration that has been asserted, even defensively, in a civil action) and *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984).

[112] *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1881 (TTAB 1990); and *Bankamerica Corp. v. Invest America,* 5 USPQ2d 1076, 1078 (TTAB 1987); and *General Mills, Inc. v. Natures Way Products,* 202 USPQ 840, 841 (TTAB 1979) (counterclaimant's position as defendant in the opposition gives him a personal stake in the controversy). *See also* TBMP § 313.03 (Form of Counterclaim).

[113] *See International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1496 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); and *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.,* 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987) ("This is true irrespective of the grounds upon which the opposer relies in asserting the nonregistrability of applicant's mark").

[114] *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp., supra* at 2024; *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); and *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

[115] *See Young v. AGB Corp.,* 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

ground for opposition or cancellation that negates the defendant's right to registration.[116] Grounds for petitions to cancel a Principal Register registration that is more than 5 years old are more limited and are specified in Sections 14(3) and (5) of the Act, 15 U.S.C. §§ 1064(3) and 1064(5).[117]

A plaintiff cannot rely upon an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.[118]

Examples of available grounds for opposition and for cancellation are listed below. [NOTE: The grounds identified in examples 3 and 4, and 12 through 14 are available for cancellation of a Principal Register registration over five years old.] This list is exemplary, not exhaustive.

(1) Section 2(d) of the Act, 15 U.S.C. § 1052(d): That defendant's mark so resembles a mark registered in the USPTO, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.[119]

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[116] *See Young v. AGB Corp., supra* at 1754; *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 , 1386 (TTAB 1991); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); and *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, n.10 (TTAB 1984) (Board cannot decline to consider an issue because it is ex parte in nature). *See also* TBMP § 102.01 (Jurisdiction of Board) and cases cited therein.

Cf. Young v. AGB Corp., supra at 1755 (Fed. Cir. 1998) ("economic damage" is not a ground for opposition although it is relevant to issue of opposer's standing); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (laches and acquiescence are affirmative defenses, not grounds for opposition); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (opposer's failure to submit copy of the foreign registration, which was the basis for issuance of opposer's pleaded registration, was an examination error and did not constitute a ground for counterclaim); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n.39 (TTAB 1994) (equitable defenses are not grounds for opposition); *Marshall Field & Co. v. Mrs. Fields Cookies,* 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, per se, does not constitute grounds for cancellation; the proper ground for cancellation is that the term has not been used as a mark) and *Century 21 Real Estate Corp. v. Century Life of America*, 11 USPQ2d 1355, 2035 (TTAB 1989) ("it is not the adequacy of the specimens, but the underlying question of service mark usage which would constitute a proper ground for opposition").

[117] *See* TBMP § 307.01 (Petition That May be Filed at Any Time).

[118] *See* TBMP § 314 (Unpleaded Matters).

[119] *See, e.g.*, *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

(2) The grounds specified in Section 2(e) of the Act, 15 U.S.C. § 1052(e); for example, that defendant's mark, when used on or in connection with the goods or services of the defendant, is merely descriptive or deceptively misdescriptive of them,[120] or that defendant's mark is primarily geographically descriptive[121] or primarily geographically deceptively misdescriptive of them;[122] and that defendant's mark is primarily merely a surname.[123]

(3) The grounds specified in Section 2(a) of the Act, 15 U.S.C. § 1052(a); for example, that defendant's mark is geographically deceptive,[124] that defendant's mark disparages members of a particular group,[125] or that defendant's mark falsely suggests a connection with plaintiff's name or identity.[126]

(4) That defendant's product design is de jure functional, and if not de jure functional, that the product design has not acquired distinctiveness.[127]

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[120] *See* Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). *See also, e.g., The Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (deceptive misdescriptiveness) and *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919 (TTAB 2002) (mere descriptiveness).

[121] *See* Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2). *See also, e.g., University Book Store v. University of Wisconsin Board of Regents,* 33 USPQ 1385 (TTAB 1994).

[122] *See* Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3). *See also In re California Innovations, Inc.,* 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003); *In re Save Venice New York, Inc.,* 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); and *In re Wada,* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

[123] *See* Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4). *See also e.g., Michael S. Sachs Inc. v. Cordon Art B.V.,* 56 USPQ2d 1132 (TTAB 2000); *Kellogg Co. v. Pack'Em Enterprises Inc.,* 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)*; Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 391-92 (TTAB 1979); and *Food Specialty Co. v. Carnation Co.*, 170 USPQ 522, 523 (TTAB 1971).

[124] *See, e.g., Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.,*.23 USPQ2d 1894 (TTAB 1992) (mark's geographic deceptiveness must be established as of the time the registration issues). *Cf. K-Swiss Inc. v. Swiss Army Brands Inc.*, 58 USPQ2d 1540, 1543 (TTAB 2001) (can be cancelled if a registrant, through its own actions, causes its mark to become geographically deceptive subsequent to the issuance of the registration).

[125] *See, e.g., Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (women in general and African American women in particular); *Order Sons of Italy in America v. The Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (members of plaintiff's Order and Italian-Americans in general); and *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Native Americans).

[126] *See, e.g., Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) and *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

[127] *See* Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), and, *e.g.*, *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.,* 61 USPQ2d 1086 (TTAB 2001). *See also, e.g., Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002).

(5) That there was no bona fide use of defendant's mark in commerce prior to the filing of the use-based application for its registration under Section 1(a) of the Act, 15 U.S.C. § 1051(a).[128]

(6) That defendant did not have a bona fide intent to use the mark in connection with the identified goods/services as of the filing date of the application.[129]

(7) That defendant's mark is a mere background design that does not function as a mark separate and apart from the words displayed thereon.[130]

(8) That defendant is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark.[131]

(9) That defendant's mark, consisting of a particular color combination applied to its goods, is ornamental and has not become distinctive as an indication of the source of defendant's goods.[132]

(10) That the term for which registration is sought or for which registration has been obtained has not been used as a trademark or service mark.[133]

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[128] *See, e.g., International Mobile Machines Corp. v. International Telephone and Telegraph Corp.,*800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *Paramount Pictures Corp. v. White,* 31 USPQ 1768 (TTAB 1994) *aff'd (unpub'd)* 108 F.3d 1392 (Fed.Cir. 1997) ("use in commerce" involves the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542, 558 (TTAB 1983); and *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537, 543 (TTAB 1983).

[129] *See, e.g., Lane Ltd. V. Jackson International Trading Co.*, 33 USPQ2d 1351, 1352 (TTAB 1994) and *Commodore Electonics Ltd. v. CBM Kabushiki Kaisha* , 26 USPQ2d 1503, 1504 (TTAB 1993).

[130] *See, e.g., General Foods Corp. v. Ito Yokado Co., Ltd*., 219 USPQ 822, 825 (TTAB 1983).

[131] *See, e.g., Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993); *Treadwell's Drifters Inc. v. Marshak,* 18 USPQ2d 1318, 1320 (TTAB 1990); and *Kemin Industries, Inc. v. Watkins Products, Inc.,* 192 USPQ 327, 328 (TTAB 1976). *Cf., e.g., Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) (where opposer was asserting that applicant's mark is a descriptive term which cannot be owned exclusively by anyone, rather than alleging that someone other than applicant is the owner of the term as a mark).

[132] *See, e.g., Goodyear Tire & Rubber Co. v. Vogue Tyre & Rubber Co*., 47 USPQ2d 1748 (TTAB 1998) and *Kassnar Imports v. Plastilite Corp.*, 180 USPQ 156, 157 (TTAB 1973), *aff'd sub nom.,* 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975).

[133] *See, e.g., Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland, Inc*., 29 USPQ2d 1146 (TTAB 1993) (allegation that slogan was used as mere advertising and not as a trademark) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989).

(11) That defendant's mark represents multiple marks in a single application (or registration) ("phantom mark").[134]

(12) That defendant's mark has been abandoned due to nonuse;[135] or due to a course of conduct that has caused the mark to lose significance as an indication of source.[136]

(13) That defendant's mark consists of or comprises the name of a particular living individual without the individual's consent.[137]

(14) That defendant's product design is generic.[138]

(15) That defendant's mark would dilute the distinctive quality of plaintiff's famous mark.[139]

The following is a brief discussion of the elements of a claim of likelihood of confusion, the most frequently encountered issue in Board inter partes proceedings.

Pursuant to Section 2(d) of the Act, 15 U.S.C. § 1052(d), plaintiff must assert, and then prove at trial, that defendant's mark, as applied to its goods or services, so resembles plaintiff's previously

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[134] *See, e.g., Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres*, 56 USPQ2d 1538 (TTAB 2000). *See also In re International Flavors & Fragrances Inc.*, 47 USPQ2d 1314 (TTAB 1998) *aff'd* 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999).

[135] *See, e.g., Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. V. Philip Morris Inc*., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); and *Auburn Farms, Inc. v. McKee Foods Corp.,* 51 USPQ2d 1439 (TTAB 1998).

[136] *See, e.g., Woodstock's Enterprises Inc. v. Woodstock's Enterprises Inc*., 43 USPQ2d 1440 (TTAB 1997), *aff'd (unpub'd)*, Appeal No. 97-1580 (Fed. Cir. Mar. 5, 1998).

[137] *See* Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c). *See also Ross v. Analytical Technology, Inc.,* 51 USPQ2d 1269 (TTAB 1999) (plaintiff must establish that the "name," as used on the goods or services, points uniquely to plaintiff as a "particular living individual") and *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (party asserting Section 2(c) ground must have cognizable or proprietary right in the name).

[138] *See Sunrise Jewelry Mfg. Corp. v. Fred, S.A*., 175 F.3d 1322, 50 USPQ2d 1532 (Fed. Cir. 1999) (the term "generic name" as used in 15 U.S.C. § 1064(3) includes trade dress such as product design or configuration).

[139] *See* Sections 13(a) and 14 of the Trademark Act, as amended, 15 U.S.C. §§ 1063(a) and 1064, as amended, and *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). *See also Moseley v. Secret Catalogue Inc*., 537 US 418, 65 USPQ2d 1801 (2003) and, *for example, Enterprise Rent-A-Car Company v. Advantage Rent-A-Car, Inc.,* 62 USPQ2d 1857 (TTAB 2002), *aff'd,* 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003).

used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception.

A. 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.[140] 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;[141] prior trademark or service mark use;[142] or prior use analogous to trademark or service mark use.[143]

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[140] *See Herbko International Inc. v. Kappa Books, Inc.,* 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp*., 7 USPQ2d 1628, 1632 (Fed. Cir. 1988); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); *Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435 (TTAB 1996); *Holmes Products Corp. v. Duracraft Corp.,* 30 USPQ2d 1549 (TTAB 1994): *Jimlar Corporation v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216 (TTAB 1992); and *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc*., 211 USPQ 352 (TTAB 1981) (proprietary right is a right residing in owner of mark and those in privity).

[141] *See Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995) (owner of an intent-to-use application may rely on its application filing date as a constructive use date for purposes of priority); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991). *See also Brewski Beer Co. v. Brewski Brothers Inc.,* 47 USPQ2d 1281, 1284 (TTAB 1998) (if the underlying application filing date of petitioner's pleaded registration was earlier than the filing date of respondent's underlying application, petitioner could take its chances and elect to make of record simply a copy of its registration as proof of first use as of the filing date of the underlying application); *American Standard Inc. v. AQM Corporation,* 208 USPQ 840, 842 (TTAB 1980); and *Gor-Ray Limited v. Garay & Co., Inc.,* 167 USPQ 694 (TTAB 1970) (a cancellation petitioner is entitled to rely on the filing date of its pleaded registration as prima facie evidence of its first use of the mark).

[142] *See Corporate Document Services Inc. v. I.C.E.D. Management Inc.,* 48 USPQ2d 1477, 1479 (TTAB 1998) (interstate or intrastate commerce is sufficient) and *Jimlar Corporation v. The Army and Air Force Exchange Service*, 24 USPQ 1216, 1221 (TTAB 1992).

[143] *See T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996) (must show that the activities claimed to constitute analogous use have had "substantial impact" on the purchasing public); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993) (trade name use); *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) (trade name use); *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993) (priority of use against ITU application may be established with prior use analogous to trademark use) and *Corporate Document Services Inc. v. I.C.E.D. Management Inc*., *supra* (owner of ITU application may rely on prior use analogous to trademark use).

However, priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark,[144] provided that any counterclaim or separate petition to cancel the pleaded registration by the applicant is ultimately dismissed and the registration remains uncancelled.[145]

A plaintiff may be permitted to assert the proprietary rights or registration(s) of a third-party as a basis for a Section 2(d) ground if plaintiff can show a legitimate interest in preventing confusion between the pleaded mark(s) and the defendant's mark.[146]

B. 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

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[144] *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); ("Board must consider existing registrations of subsequent-user opposers because ... [Section 2(d) provides that] an applicant can register, unless his mark is likely to cause confusion with a mark '*registered* in the Patent Office *or* * * * previously used * * *'..."); *SCOA Industries, Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 413 (TTAB 1975), *appeal dismissed*, 189 USPQ 15 (CCPA 1976); and *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280 (TTAB 1998).

Cf., regarding cancellation proceedings, Brewski Beer Co. v. Brewski Brothers Inc., 47 USPQ2d 1281, 1284 (TTAB 1998) (in a cancellation proceeding the registrations of each party offset each other and petitioner must, in the first instance, establish prior rights); *SCOA Industries, Inc. v. Kennedy & Cohen, Inc.,* 188 USPQ 411, 413 (TTAB 1975); and *American Standard Inc. v. AQM Corp., supra* at 841 (priority must be proven in cancellation proceeding).

[145] *See, e.g., Contour Chair-Lounge Co., Inc. v. The Englander Company, Inc.,* 139 USPQ 285, 286 (CCPA 1963) (as long as a registration relied on by an opposer remains uncancelled, it will be treated as valid and entitled to all statutory presumptions; having dismissed petition to cancel pleaded registrations, and since no appeal was taken, Board was obligated to treat opposer's registrations as valid and as though no such petition had been filed). *Cf. Penguin Books Ltd. v. Eberhard, supra* (petition or counterclaim to restrict the scope of goods in registration under Section 18 of the Trademark Act was not a collateral attack on the validity of that registration).

Note: In cases where a plaintiff has relied on its ownership of a pleaded registration, any counterclaim or petition to cancel that registration is normally decided before the issues in the underlying opposition. *See, for example, Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321, 1328 (TTAB 1992) and *General Mills Inc. v. Health Valley Foods,* 24 USPQ2d 1270, 1272 (TTAB 1992).

[146] *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1632 (Fed. Cir. 1988) (interest of trade association found sufficient); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) (petitioners failed to allege that they, or anyone else, possessed proprietary rights in the term); and *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549, 1552 (TTAB 1994) (no legitimate interest in preventing confusion alleged).

extent of any actual confusion, and the fame of the prior mark.[147] The relevance and weight to be given the various factors may differ from case to case.[148]

Direct or Hypothetical Pleading of Likelihood of Confusion: A plaintiff may plead likelihood of confusion directly or hypothetically.[149] A hypothetical pleading may consist of assertions that if, as the Trademark Examining Attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then plaintiff will be damaged by the registration of defendant's mark.[150] Of course, in order to state a claim upon which relief can be granted, a hypothetical pleading of likelihood of confusion must be coupled with a pleading of one or more grounds for opposition or cancellation, such as, that defendant's mark has been abandoned; that plaintiff has priority of use (here, the hypothetical pleading of likelihood of confusion serves both as a pleading of plaintiff's standing and as part of the pleading of a ground under Section 2(d) of the Act, 15 U.S.C. §1052(d)); etc. Thus, a plaintiff wishing to plead likelihood of confusion hypothetically in a proceeding based upon Section 2(d) might assert, for example, that if, as the Trademark Examining Attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then the registration sought by defendant should be refused (or defendant's registration should be cancelled) because plaintiff has priority of use.[151]

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[147] *See In re E.I. du Pont de Nemours & Co., supra and, e.g., Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002).

[148] *Opryland USA Inc. v. The Great American Music Show Inc.,* 970 F.2d 847, 850, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992). *See Herbko International Inc. v. Kappa Books, Inc.,* 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) and *Sports Authority Michigan Inc. v. PC Authority Inc.,* 63 USPQ2d 1782, 1800 (TTAB 2001).

[149] *See* Fed. R. Civ. P. 8(e)(2).

[150] *See Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1978).

[151] *See Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, notwithstanding that it is the senior user, because the subject registration has been cited as a reference by the Examining Attorney). *See also, Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before Examining Attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

309.03(d) Remedy Under Section 18 (Partial Opposition or Partial Cancellation)

15 U.S.C. § 1068 [Section 18 of the Trademark Act] *In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings....*

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

37 CFR § 2.133(b) *If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party.*

37 CFR § 2.99(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

37 CFR § 2.133(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

Under Section 18 of the Trademark Act, 15 U.S.C. § 1068, the Board has the authority to cancel registrations in whole or in part, to restrict the goods or services identified in an application or registration, or to "otherwise restrict or rectify...the registration of a registered mark."[152] (However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding).[153]

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[152] *See* Section 18 of the Trademark Act, 15 U.S.C. § 1068; 37 CFR §§ 2.111(b) and 2.133(b); *Wellcome Foundation Ltd. v. Merck & Co.,* 46 USPQ2d 1478, 1479 (TTAB 1998); and *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG,* 34 USPQ2d 1266, 1270 (TTAB 1994).

[153] *See* 37 CFR §§ 2.99(h) and 2.133(c), and *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

For example, a plaintiff may seek to partially cancel a registration, or partially oppose registration only as to specific items in the identification of goods or services, or only to the extent of restricting the goods or services in a particular manner in terms of type, use, customers, trade channels, etc.[154]

A claim in which the plaintiff seeks to delete specific items on the grounds that the defendant is no longer using, and has no intent to resume use of its mark on those goods or services, is essentially a "straightforward" pleading of abandonment.[155]

A claim in which the plaintiff seeks to restrict or modify the goods or services in a particular manner, that is, by the addition of wording that identifies the goods or services with greater particularity in terms of type, use, channels of trade, etc., is in the nature of an equitable remedy under Section 18 and does not require pleading and proof of specific grounds for cancellation or opposition, such as abandonment.[156] However, the Board will not permit an action to restrict or modify the goods or services in this manner where such a claim is divorced from the question of likelihood of confusion.[157] Thus, a party seeking to restrict an opponent's broadly worded identification of goods or services, in a case involving likelihood of confusion, must plead and prove that (i) the entry of a proposed restriction to the goods or services in its opponent's application or registration will avoid a finding of likelihood of confusion and (ii) the opponent is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered.[158]

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[154] *See DAK Industries Inc. v. Daiichi Kosho*, 35 USPQ2d 1434, 1437 (TTAB 1995) and *Eurostar*, *supra* at 1270.

[155] *DAK*, *supra* at 1437 (because applicant sought to strike from opposer's registration goods specifically listed therein, such as "open reel audio tape" it was proper to plead abandonment and applicant did not need to plead that a finding of likelihood of confusion will be avoided by the restriction it sought). *See also Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996) (respondent's counterclaim alleging that it may have prior use of the mark in the trade channels sought to be excluded in petitioner's registration, was legally insufficient pleading of either likelihood of confusion or abandonment because likelihood of confusion is not available ground for cancellation of registration over five years old and because a counterclaim to restrict an identification of goods, as opposed to a counterclaim to delete specific identified items, is not a proper claim of abandonment).

[156] *See Eurostar, supra* at 1271, and 1271 n.3. *See also DAK, supra* at 1437.

[157] *See DAK*, *supra* at 1437 and *Eurostar, supra* at 1270. [**Note:** To the extent that cases decided prior to *Eurostar* permitted a restriction petition in the absence of a pleading that the restriction sought will avoid a likelihood of confusion, and to the extent that those cases required the pleading and proof of a separate ground of nonuse or abandonment, those cases were expressly overruled by *Eurostar.*]

[158] *See Eurostar, supra* at 1270. *See also, for example*, *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (applicant's attempt to restrict opposer's registration for computer programs to "computer programs except computer programs for maintenance management" was rejected as it did not serve to avoid likelihood of confusion since proposed restriction failed to delineate different users or different channels of trade).

In considering a restriction of a registration, the Board will look to the nature of the use made by registrant as of the time the restriction is sought, not as of the time registration was sought.[159]

A petition to partially cancel a registration by restricting the goods or services in a particular manner in terms of type, use, channels of trade, etc., in order to avoid a likelihood of confusion can be made against registrations over 5 years old as well as those less than 5 years old.[160] Such claim is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration.[161]

A petition to restrict or clarify the description of a mark in a registration would fall under the provision giving Board authority to "restrict or rectify" the register.[162] As in the case of a petition to restrict goods or services, a proper pleading to restrict the description of a mark could include allegations that, for example, the description of the mark in the registration is ambiguous or overly broad and not specific to the mark actually used by the defendant, and that the limitation would avoid a finding of a likelihood of confusion.[163]

That same provision, along with the authority to "register the mark...for the person...entitled thereto," allows the Board to correct, respectively, a registration or application, to identify the true owner, if such correction is warranted.[164]

As in the case of any other claim, a claim for partial opposition or partial cancellation ordinarily should be asserted prior to trial in order to give the defendant fair notice thereof.[165] In addition, the claim must be specific in nature so that the defendant has fair

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[159] *See Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996).

[160] *See Eurostar*, *supra* at 1271 n.3.

[161] *See, for example, Penguin Books Ltd. v. Eberhard*, *supra* at 1286 (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

[162] *See Wellcome Foundation Ltd, supra* at 1479.

[163] *See Wellcome Foundation Ltd., supra* at 1479-80.

[164] *See 8440 LLC v. Midnight Oil Company,* 59 USPQ2d 1541 (TTAB 2001) (Board where the record showed that plaintiff, rather than defendant, was the true owner of the marks in the challenged application and registration and where the parties filed a joint motion that registration be issued in the name of plaintiff and that the register be rectified to show plaintiff as the owner of the existing registration, Board exercised authority under Section 18 and granted motion).

[165] *See Penguin Books Ltd., supra* (restriction proposed for first time in reply brief untimely); *Eurostar, supra*; and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 n.10 (TTAB 1990) (petitioner's request to restrict

notice of the specific restriction being sought.[166] Any claim that is not pleaded in the complaint, as originally filed or as amended (or deemed amended) pursuant to Fed. R. Civ. P. 15(a) or 15(b), will not be entertained by the Board.[167]

A defense which seeks to restrict a plaintiff's pleaded registration will not be entertained in the absence of a timely counterclaim, or separate petition, to cancel the registration in whole or in part.[168]

For information on a request by defendant to restrict its identification of goods or services under Section 18, see TBMP §§ 311.02(b); 507 (Motion to Amend Pleading) and 514 (Motion to Amend Application or Registration).

For information concerning the extent of default for failure to file an answer to a claim for partial opposition or cancellation, see TBMP § 312.01.

309.04 Defects in Complaint That May Affect Institution of Proceeding

No proceeding will be instituted, the opposition papers will be returned, and any filing fee submitted therewith will be refunded in the following circumstances:

(1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake, no proceeding will be

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channels of trade for respondent's goods denied when raised at end of rebuttal period). *See also* TBMP §§ 309.03 (Substance of Complaint), 314 (Unpleaded Matters) and 507 (Motion to Amend Pleading).

[166] *See Eurostar, supra* at 1272 (party that seeks to restrict a registration or application should state with as much precision as possible the restriction it seeks, so that the issue is properly framed for trial); *Aries Systems Corp. v. World Book Inc*., 23 USPQ2d 1742, 1749 (TTAB 1992) (counterclaim failed to specify the least restrictive language applicant would accept); *Space Base Inc. v. Stadis Corp*., 17 USPQ2d 1216 (TTAB 1990) (counterclaim that opposer's registration should be amended "to accurately describe the services" was vague); and *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 (TTAB 1985).

[167] *See Eurostar, supra*, and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 n.10 (TTAB 1990) (petitioner's request to restrict channels of trade for respondent's goods denied when raised at end of rebuttal period). *See also* TBMP §§ 309.03 (Substance of Complaint), 314 (Unpleaded Matters) and 507 (Motion to Amend Pleading).

[168] *See* TBMP § 313.01 (Counterclaims).

instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.[169]

(2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the *Official Gazette* for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively), no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.[170]

(3) If an opposition is filed after the time for opposing has expired; or is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee, and the fee is not submitted within the time allowed by the Board; or if the opposed application was abandoned before the opposition was filed.[171]

Proceedings will be instituted and the filing fee charged in the following circumstances:

(1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Section 14 of the Act of 1946, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Any fee submitted therewith will not be refunded.

(2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (e.g., the time for filing an affidavit of use under Section 8 of the Act of 1946, 15 U.S.C. § 1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding), the proceeding will be instituted, and then dismissed as moot. Any fee submitted with the petition for cancellation will not be refunded.

(3) If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request ordinarily will be denied, and the proceeding will be instituted, unless there is a

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[169] *See* TBMP § 303.05 (Opposition filed during Extension of Time to Oppose).

[170] *See* TBMP §§ 306.03 (Premature Opposition) and 307.03 (Premature Petition to Cancel).

[171] *See* TBMP §§ 218 (Abandonment of Application); 306.04 (Late Opposition); 309.02(b) (Signature); and 308 (Filing Fees).

defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

When a proceeding is erroneously instituted, the proceeding will be dismissed as a nullity, rather than vacated, so as to maintain the integrity of the proceeding numbers. The Board will retain all papers.

310 Notification of Proceeding and Setting Time to Answer

310.01 Notification of Proceeding

37 CFR § 2.105 Notification of opposition proceeding[s].
When an opposition in proper form has been filed and the correct fee(s) have been submitted, a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the opposer, if any, or to the opposer. The duplicate copy of the opposition and exhibits shall be forwarded with a copy of the notification to the attorney or other authorized representative of the applicant, if any, or to the applicant.

37 CFR § 2.113 Notification of cancellation proceeding.
When a petition for cancellation has been filed in proper form (see §§ 2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the petitioner, if any, or to the petitioner. The duplicate copy of the petition for cancellation and exhibits shall be forwarded with a copy of the notification to the respondent (see § 2.118), who shall be the party shown by the records of the Patent and Trademark Office to be the current owner of the registration or registrations sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration or registrations. When the party identified by the petitioner, pursuant to § 2.112(a), as the current owner of the registration or registrations is not the record owner thereof, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner, which may file a motion to be joined or substituted as respondent. If the petition is found to be defective as to form, the party filing the petition shall be so advised and allowed a reasonable time for correcting the informality.

When a timely opposition in proper form has been filed, and the required fee has been submitted, the Board obtains the file of the opposed application and sets up an opposition proceeding file.[172] The defendant in the opposition is the party shown by the records of the USPTO to be the current owner of the opposed application, except that the Board, in its discretion, may join or substitute as defendant a party which makes a showing of a current ownership interest in the application.[173] When a timely petition to cancel in proper form, together with the required fee, has been filed (*see* 37 CFR §§ 2.111(a) and 2.113), the Board obtains the file of the registration sought to be cancelled and checks the assignment records of the USPTO to determine whether there is any recorded assignment of the registration, and, if so, the identity of the assignee. After the title search has been completed, the cancellation proceeding file is set up.[174] The defendant in the cancellation proceeding is the party shown by the records of the USPTO to be the current owner of the registration sought to be cancelled, except that the Board, in its discretion, may join or substitute as defendant a party which makes a showing of a current ownership interest in the registration.[175]

Next, the Board prepares a letter wherein it, *inter alia*, notifies the defendant of the filing of the complaint, and notifies both parties of the formal institution of the proceeding. The notification letter includes the identification information described in 37 CFR § 2.105, for an opposition, or in 37 CFR § 2.113, for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice and specifies the due date for the filing of defendant's answer to the complaint. The notice also includes a trial order specifying the opening and closing dates for the discovery period and assigning each party's time for taking testimony.[176]

One copy of the notification letter is mailed to the attorney or other authorized representative of the plaintiff, or, if the plaintiff is representing itself, to the plaintiff itself. In an opposition, a second copy of the letter is mailed, together with a copy of the notice of opposition and any exhibits thereto, to the attorney or other authorized representative of the applicant, or, if the applicant is representing itself, to the applicant itself.[177] In a cancellation, a second copy of the notification letter is mailed, together with a copy of the petition to cancel and any exhibits

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[172] *See* 37 CFR § 2.105.

[173] *See* TBMP § 512 (Motion to Join). *Cf.* 37 CFR § 2.113.

[174] *Cf.* TBMP § 124 (Action by Assignee).

[175] *See* 37 CFR § 2.113, and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976). *Cf.* TBMP § 512 (Motion to Join or Substitute).

[176] *See* 37 CFR § 2.120(a). *An example of a trial order can be found in the Appendix of Forms.*

[177] *See* 37 CFR § 2.105 and *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 (TTAB 1993).

thereto, to the respondent itself (even if there is an attorney or other authorized representative of record in the application file after the mark has registered).[178]

The reason why the complaint and notification letter are sent to the defendant's attorney or other authorized representative, if any, in an opposition, but are always sent to the defendant itself in a cancellation, is that any appearance or power of attorney (or designation of other authorized representative) of record in an application file at the time of the commencement of an opposition is considered to be effective for purposes of the proceeding, whereas any representation which may be of record in an application file after the mark has registered at the time of the commencement of a cancellation is not considered to be effective for purposes of the proceeding. Typically, a power of attorney in an application appoints the named attorney "to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration." That is, the power extends only up to the issuance and receipt of a registration. As a practical matter, the representation in an application file usually is, of necessity, current and active, whereas often the attorney or other authorized representative of record in a registration file has not taken any action on behalf of the client registrant for some years, may no longer represent registrant, may not know where registrant is currently located or may no longer be in practice, etc. However, if the Board is unable to locate the registrant for purposes of serving a copy of the complaint and notification letter on it, and the registration file reflects that an attorney or other authorized representative has appeared therein on registrant's behalf within the last five years or so, the Board will, if necessary, contact the attorney or other authorized representative and ask for information concerning registrant's current address.[179]

In a cancellation proceeding, if the party identified by the petitioner pursuant to 37 CFR § 2.112(a) as the current owner of the registration sought to be cancelled is not the record owner thereof, the Board will send to the alleged current owner a courtesy copy of the notification letter, together with a copy of the petition to cancel and any exhibits thereto. If the alleged current owner believes that it is, in fact, the current owner of the registration and wishes to defend the registration against the petition to cancel, it may file a motion, supported by a showing of its current ownership interest in the registration, to be joined or substituted as respondent.[180]

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[178] *See* 37 CFR § 2.113.

[179] *See* the Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34891, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 30.

[180] *See* 37 CFR § 2.113 and TBMP § 512 (Motion to Join or Substitute).

310.02 Defendant's Copy of Complaint Returned as Undeliverable

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

If, in a cancellation proceeding, the respondent's copies of the petition to cancel and notification letter are returned to the Board as undeliverable, the Board will send a letter to the petitioner asking the petitioner for information concerning respondent's current address. If the petitioner files a response indicating that the respondent is no longer in business, notice of the filing of the petition to cancel will be published in the *Official Gazette*, pursuant to 37 CFR § 2.118. If the petitioner fails to file a response to the Board's letter, or files a response indicating that it is unable to furnish respondent's current address, the Board will make all reasonable efforts to locate the respondent.[181] If the Board is unable to locate the respondent after reasonable investigation, notice of the filing of the petition to cancel will be published in the *Official Gazette*.[182]

When notice of the filing of a petition to cancel is published in the *Official Gazette*, the published notice allows the respondent thirty days from the publication date thereof in which to appear in the cancellation proceeding. If respondent fails to appear within the time allowed, default judgment may be entered against respondent.

For information concerning the procedure followed by the Board in a concurrent use proceeding when a communication sent by the Board to a specified excepted user is returned as undeliverable, see TBMP § 1105.

310.03 Setting Time for Filing Answer

310.03(a) In General

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

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[181] *See* the Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34891, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 30.

[182] *See* 37 CFR § 2.118.

When an opposition in proper form has been filed and the correct fee(s) have been submitted, a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. ...

37 CFR § 2.113 Notification of cancellation proceeding.
When a petition for cancellation has been filed in proper form (see §§ 2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. ...

Trademark Rules 2.105 and 2.113, 37 CFR §§ 2.105 and 2.113, provide, in part, that the Board's letter notifying a defendant of the filing of an opposition or petition to cancel "shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed." A defendant is under no obligation to file an answer to the complaint in an opposition or cancellation proceeding until it receives the Board's notification letter setting the time for filing an answer.[183] It is the general practice of the Board to allow the defendant in an opposition or cancellation proceeding 40 days from the mailing date of the notification letter in which to file its answer.

For information on the time for filing an answer to a counterclaim, see TBMP § 313.06.

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

Trademark Rule 2.119(c), 37 CFR § 2.119(c), provides, in part, that "[w]henever a party is required to take some action within a prescribed period after the service of a paper on the party by another party and the paper is served by first-class mail, 'Express Mail' or overnight courier, 5 days shall be added to the prescribed period." This provision, by its very terms, applies only when a party has to take some action within a prescribed period after the service of a paper on it by another party (and service of the paper was made in one of three specified ways). It does not apply to an action that must be taken by a party within a time set in a communication from the Board.

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

[183] *See Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 (TTAB 1993).

on the 45th day. Similarly, when the Board allows a counterclaim defendant 30 days from the mailing date of the Board's letter in which to file an answer to the counterclaim, the answer is due on or before the 30th day, not on the 35th day.

310.03(c) Extension of Time to File Answer

The time for filing an answer may be extended or reopened by stipulation of the parties, approved by the Board, or on motion granted by the Board, or by order of the Board.[184]

311 Form and Content of Answer

311.01 Form of Answer

An answer to a notice of opposition or petition to cancel corresponds to an answer to a complaint in a court proceeding.[185]

The form for an answer is similar to a complaint. An answer should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name of the proceeding (e.g., "ABC Corporation v. XYZ Company"), the proceeding number (e.g., "Opposition No. 56,789" or Cancellation No. 12,345"), and a title describing the nature of the paper (e.g., "ANSWER," "ANSWER AND COUNTERCLAIM," etc.).[186]

An answer need not be verified, but it must be signed. The signature may be made by the defendant or by the defendant's attorney or other authorized representative.[187] If a defendant signing for itself is an individual, the individual must make the signature. If a defendant signing for itself is a partnership, a partner must make the signature. If a defendant signing for itself is a corporation, association, or similar juristic entity, the signature must be made by an individual who is an officer of defendant and who is authorized to represent it. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as defendant, if defendant is an individual; as counsel for defendant; as a partner of defendant, if defendant is a partnership; as an officer of defendant identified by title, if defendant is a corporation; etc.).

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[184] *See* Fed. R. Civ. P. 6(b), and TBMP § 509 (Motion to Extend Time).

[185] *See* 37 CFR § 2.116(c).

[186] *See, for example,* TBMP § 309.02(a) (Format for Complaint).

[187] *See* 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

Although an answer must be signed, an unsigned answer will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the Board's letter notifying the defendant of this defect.[188]

The Board prefers that answers be submitted in typewritten or printed form, double-spaced. An answer should be submitted on letter-sized paper. While legal-sized paper is permitted, letter-size paper (the size preferred by many Federal district courts) is recommended.[189]

One copy of the answer, and any exhibits thereto, must be filed in the USPTO. Another copy of the answer, with any exhibits thereto, must be served by the defendant upon the attorney for the plaintiff, or on the plaintiff if there is no attorney. The answer must bear proof (e.g., a certificate of service, consisting of a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made) that such service has been made before the paper will be considered by the Board.[190]

For information on the time for filing an answer, see TBMP § 310.03.

311.02 Substance of Answer

37 CFR § 2.106(b)*(1) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original notice of opposition or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.*

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer.

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[188] *See* 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

[189] *See* TBMP § 106.03 (Form of Papers).

[190] *See* 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

37 CFR § 2.114(b)*(1) An answer shall state in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the respondent is without knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original petition for cancellation or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.*

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

37 CFR § 2.133(d) *A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.*

311.02(a) Admissions and Denials

The defendant should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied.[191] If the defendant does not have sufficient information to admit or deny an allegation, the defendant may so state, and this statement will have the effect of a denial. If the complaint consists of numbered paragraphs setting forth the basis of plaintiff's claim of damage, the defendant's admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

A denial of an allegation should fairly meet the substance of the allegation denied, and may take any of the forms described in Fed. R. Civ. P. 8(b).[192] An answer that fails to deny a portion of an allegation may be deemed admitted as to that portion.[193] Thus, if a defendant intends in good faith to deny only a part or a qualification of an allegation, the defendant should admit so much of the allegation as is true and material and should deny only the remainder. If a defendant intends in good faith to controvert all of the allegations contained in a complaint, the defendant may do so by general denial, subject to the obligations set forth in Fed. R, Civ. P. 11 (for a discussion of Fed. R. Civ. P. 11 in relation to pleadings, see TBMP § 318). If a defendant does not intend in good faith to controvert all of the allegations contained in a complaint, the defendant may make its denials as specific denials of designated allegations or paragraphs, or may generally deny all the allegations except those designated allegations or paragraphs which are expressly admitted.

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

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[191] *See* 37 CFR §§ 2.106(b)(1) and 2.114(b)(1); Fed. R. Civ. P. 8(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Turner Entertainment Co. v. Ken Nelson,* 38 USPQ2d 1942 (TTAB 1996) (applicant's answers were argumentative and nonresponsive and Board was ultimately forced to interpret the answer); *National Football League v. Jasper Alliance Corporation*, 16 USPQ2d 1212 (TTAB 1990) (applicant's answer was more in the nature of argument than answer); and *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 (TTAB 1985).

[192] *See* 37 CFR §§ 2.106(b)(1) and 2.114(b)(1). *See also, for example, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982) (regarding equivocal admissions or denials).

[193] *See* Fed. R. Civ. P. 8(d).

311.02(b) Affirmative Defenses

An answer may also include a short and plain statement of any defenses that the defendant may have to the claim or claims asserted by the plaintiff.[194] These defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense.[195] They may also include a pleading that defendant is at least entitled to a registration with a particular restriction (described in the pleading in sufficient detail to give plaintiff fair notice of the basis for the defense);[196] except that geographic restrictions will be considered and determined by the Board only in the context of a concurrent use registration proceeding.[197] A request by defendant to restrict its identification of goods or services under Section 18 of the Trademark Act, 15 U.S.C. § 1068, must be made either by way of an affirmative pleading in the answer (as originally filed, or as amended, or deemed amended) or by way of motion under 37 CFR § 2.133, in order to be considered by the Board.[198]

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[194] *See* 37 CFR §§ 2.106(b)(1) and 2.114(b)(1), and Fed. R. Civ. P. 8(b).

[195] *See* 37 CFR §§ 2.106(b)(1) and 2.114(b)(1). *See, for example, Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b) permits a defendant to assert in the answer the "defense" of failure to state a claim upon which relief can be granted).

See, e.g., with respect to estoppel, *Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (licensee estoppel); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (licensee estoppel); and *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.,* 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel).

See, e.g., with respect to "Morehouse" defense, *Morehouse Manufacturing Corp. v. J. Strickland & Co.,* 407 F.2d 881, 160 USPQ 715 (CCPA 1969) (that defendant already owns a substantially similar registered mark for substantially similar goods and/or services such that the second registration (or second registration sought) causes no added injury to the plaintiff). *See also O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) (*Morehouse* defense).

See, e.g., with respect to prior judgment, International Nutrition Co. v. Horphag Research Ltd., 220 F.3d 1325, 55 USPQ2d 1492 (Fed. Cir. 2000) (res judicata); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000), (res judicata, claim preclusion); *Boston Chicken Inc. v. Boston Pizza International, Inc*., 53 USPQ2d 1053 (TTAB 1999) (judicial estoppel); and *Treadwell's Drifters Inc. v. Marshak,* 18 USPQ2d 1318 (TTAB 1990) (claim preclusion, issue preclusion).

Cf., e.g., Hornblower & Weeks Inc. v. Hornblower & Weeks Inc., 60 USPQ2d 1733, 1738 (TTAB 2001) (defendant not entitled to rely on asserted ownership of "family" of marks as defense to Section 2(d) claim).

[196] *See* 37 CFR § 2.133(a). *Cf.* 37 CFR §§ 2.133(b) and 2.133(c).

[197] *See Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990). *Cf.* TBMP § 514 (Motion to Amend Application or Registration).

[198] *See* 37 CFR § 2.133(a) and (b). *See also Brunswick Corp. v. British Seagull Ltd.,* 35 F.3d 1527, 32 USPQ2d 1120, 1125 (Fed. Cir. 1994) (Board had no duty to address defendant's offer to amend in final brief where defendant failed to file a motion or include as affirmative defense in pleading); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863, 1865 (TTAB 1991) (mere request by respondent in its trial brief to have its

Equitable defenses may not be available against certain grounds for opposition or cancellation or under certain circumstances. For example, the availability of laches and acquiescence is severely limited in opposition and cancellation proceedings because these defenses, in Board proceedings, start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use.[199] Moreover, for public policy reasons, the defenses of laches and acquiescence cannot be asserted against such claims as genericness, descriptiveness, fraud, abandonment and functionality and, further, will not apply in a case of likelihood of confusion if it is determined in the case that confusion is inevitable.[200]

Similarly, the "prior registration" or *Morehouse* defense, an equitable defense in the nature of laches or acquiescence,[201] is not available in all cases.[202] In addition, the

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identification of goods amended rejected where petitioner was not put on notice before petitioner presented its case); and *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972 (TTAB 1991) (applicant's argument on summary judgment that parties' channels of trade were different not persuasive where applicant's claim of entitlement to narrower range of goods was not put in issue by motion or amendment to its pleading).

[199] *See National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); and *Turner v. Hops Grill & Bar Inc.,* 52 USPQ2d 1310, 1312 (TTAB 1999). *But see Aquion Partners L.P. v. Envirogard Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1991) (laches defense in an opposition may be based on opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods).

[200] *See Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.,* 66 USPQ2d 1355, 1359 (TTAB 2003) (it is within the public interest to have certain registrations removed from the register and this interest, quoting *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.,* 146 USPQ 313, 316 (TTAB 1965), *aff'd*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967), "cannot be waived by the inaction of any single person or concern no matter how long the delay persists."). *See also, e.g., Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002) (equitable defenses of laches, acquiescence and estoppel cannot be asserted against claim of descriptiveness); *Turner v. Hops Grill & Bar Inc*., *supra* at 1313 (laches will not prevent cancellation where it is determined that confusion is inevitable); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (same).

Compare Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France, 245 F.3d 1359, 58 USPQ2d 1460, 1463 (Fed. Cir. 2001) (laches is available defense against Section 2(a) claim of false suggestion of connection because rights protected under that provision "are not designed primarily to protect the public but to protect persons and institutions from exploitation of their persona"); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1294 (TTAB 1999) (estoppel not available against claims of mere descriptiveness or geographic descriptiveness); *Ross v. Analytical Technology, Inc*., 51 USPQ2d 1269. (TTAB 1999) (laches, acquiescence and estoppel can be asserted against Section 2(c) claim that mark comprises name of opposer without his consent in view of personal nature of claim with no overriding public interest precluding assertion of equitable defenses);.and *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990) (equitable defenses can be asserted against Section 2(a) claim of "false suggestion of a connection").

[201] *TBC Corp. v. Grand Prix Ltd.,* 12 USPQ2d 1311, 1313 (TTAB 1989).

Morehouse defense will not be applied where defendant's prior registration is on the Supplemental Register, or if the prior registration did not issue until after commencement of the proceeding in which it is asserted as basis for this defense, or if plaintiff has petitioned to cancel the prior registration.[203]

The elements of a defense should be stated simply, concisely, and directly.[204] However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.[205] When one of the special matters listed in Fed. R. Civ. P. 9 (including, *inter alia*, capacity, fraud, and judgment) is pleaded, the provisions of Fed. R. Civ. P. 9 governing the pleading of that special matter should be followed.[206]

A defendant may state as many separate defenses as it has, regardless of consistency; a defendant may also set forth two or more statements of a defense alternately or hypothetically, either in one count or in separate counts.[207] For example, an applicant whose application for registration has been opposed under Section 2(d) of the Act, 15 U.S.C. § 1052(d), on the ground of opposer's alleged prior use of its mark, coupled with an allegation of likelihood of confusion, might deny that there is any likelihood of confusion with respect to its mark and goods as set forth in the application. At the same time, the applicant might plead alternatively that it actually uses its mark only on a specific type (identified in the pleading) of the goods covered by the broad identification

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[202] *See TBC Corp. v. Grand Prix Ltd., supra* (abandonment, descriptiveness, fraud) and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497 (TTAB 1986) (ornamentation, fraud).

[203] *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001). *See also TBC Corp. v. Grand Prix Ltd.,* 12 USPQ2d 1311, 1313-14 (TTAB 1989) (unavailable where issue is abandonment, descriptiveness or fraud).

[204] *See* Fed. R. Civ. P. 8(e)(1).

[205] *Cf. McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985) (bald allegations in the language of the statute, did not provide fair notice of basis of petitioner's Section 2(a) claim).

[206] *See* 37 CFR §§ 2.106(b)(1) and 2.114(b)(1).

[207] *See* Fed. R. Civ. P. 8(e)(2). *Cf. Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, albeit it is the senior user, because the subject registration has been cited as a reference by the Examining Attorney). *Cf. also Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before Examining Attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

in its application; that there is no likelihood of confusion with respect to applicant's actual goods; and that even if the Board ultimately finds that opposer is entitled to judgment with respect to applicant's goods as broadly identified, applicant would be entitled to a registration of its mark with a restricted identification reflecting the actual nature of its goods.[208]

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient.[209]

Evidentiary matters (such as, for example, lists of third-party registrations on which defendant intends to rely) should not be pleaded in an answer. They are matters for proof, not for pleading.[210]

The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration.[211] Moreover, a defense which seeks to restrict a plaintiff's pleaded registration as, for example, by limiting the goods or services therein, or by deleting some of the goods or services, will not be entertained in the absence of a timely counterclaim, or separate petition, to cancel the registration in whole or in part.[212] Geographic restrictions will be considered and determined by the Board only within the context of a concurrent use registration proceeding.[213]

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[208] *Cf.* 37 CFR § 2.133(b), and TBMP § 514 (Motion to Amend Application or Registration).

[209] *See* Fed. R. Civ. P. 8(e)(2).

[210] *See McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959).

[211] *See* 37 CFR §§ 2.106(b) and 2.114(b); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) (allegededly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration); *Contour Chair-Lounge Co., Inc. v. The Englander Company, Inc.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition had been dismissed); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). *See also Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840 (TTAB 1977); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975) and TBMP § 313 (Counterclaims).

[212] *See* 37 CFR § 2.133(d) and *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1287 (TTAB 1998) (applicant's request raised in reply brief for a restriction of opposer's registration [beyond applicant's initial counterclaim to restrict] was untimely as it should have been raised by promptly moving to amend). *See also* TBMP §§ 309.03(d) (regarding claims for partial cancellation under Section 18) and 313 (regarding counterclaims).

[213] *See* 37 CFR §§ 2.99(h) and 2.133(c). *See also Snuffer & Watkins Management Inc. v. Snuffy's Inc.,*17 USPQ2d 1815 (TTAB 1990).

Although Trademark Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii), 37 CFR §§2.106(b)(2)(ii) and 2.114(b)(2)(ii), specifically permit a defense attacking the validity of a plaintiff's pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim.[214] If the defense is raised as a separate petition to cancel, however, the petition itself and any covering letter filed therewith should include a reference to the original proceeding.[215]

When a defense is raised by way of a counterclaim, it should not also be pleaded as an affirmative defense, because the pleading of it as an affirmative defense is unnecessary and redundant.[216]

311.02(c) Unpleaded Affirmative Defenses

Except as provided in Fed. R. Civ. P. 12(b) and 12(h)(2) (which allow a defendant to raise certain specified defenses by motion), an unpleaded defense cannot be relied upon by the defendant unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter.[217]

For additional information concerning unpleaded matters, see TBMP § 314.

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[214] *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

[215] *See Vitaline Corp. v. General Mills Inc.*, *supra* at 1174. *See also* TBMP § 313 (Counterclaims).

[216] *See Space Base Inc. v. Stadis Corp.,* 17 USPQ2d 1216, 1220 (TTAB 1990); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (motion to strike affirmative defense predicated on same facts alleged in counterclaim granted as representing, in effect, a collateral attack on registration); and *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (motion to strike affirmative defense which allegations formed basis for counterclaim granted since, although Board did not find that applicant was attempting to collaterally attack registration, the affirmative defense was repetitious and unnecessary).

[217] *See* Fed. R. Civ. P. 8(b), 8(c), and 12(b); and Section 19 of the Trademark Act, 15 U.S.C. § 1069. *See also Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense that opposer lacks proprietary rights in its common law mark raised for first time in final brief was neither pleaded nor tried); *United States Olympic Committee v. Bata Shoe Co.,* 225 USPQ 340, 341 (TTAB 1984) (laches is an affirmative defense which must be specifically pleaded); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748, 754 (TTAB 1978) (defense of laches, which was raised by applicant in its final brief, was not pleaded in answer but was tried by implied consent of opposer); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 304 n.5 (TTAB 1977) (the equitable defenses set forth in Section 19 of the Trademark Act are affirmative defenses which must be affirmatively pleaded and in this case were neither pleaded nor tried); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 590 (TTAB 1977) (laches, while not affirmatively pleaded, was nevertheless tried and briefed by both parties without objection); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 251 (TTAB 1977) (laches and acquiescence were neither pleaded nor tried); and *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975) (laches is affirmative defense that must be pleaded in order to be considered).

311.02(d) Other Affirmative Pleadings - Amplifying Denials

An answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant's denial of one or more of the allegations in the complaint. These amplifications of denials, whether referred to as "affirmative defenses," "avoidances," "affirmative pleadings," or "arguments," are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.[218]

311.03 Reply to Answer Should Not be Filed

Although Trademark Rules 2.106(b) and 2.114(b) require that an answer to a counterclaim be filed, within the time designated by the Board, they specifically provide that a reply to an affirmative defense need not be filed.[219] Similarly, Fed. R. Civ. P. 7(a) provides that there shall be a complaint and an answer and a reply to a counterclaim denominated as such; that certain other specified pleadings, not relevant to Board proceedings (and not including a reply to an answer), shall be allowed; but that "[n]o other pleading shall be allowed, except that the court may order a reply to an answer."

Thus, while a plaintiff must file an answer to a counterclaim, a reply to an answer need not, and should not, be filed.

312 Default

312.01 In General

37 CFR § 2.106(a) *If no answer is filed within the time set, the opposition may be decided as in case of default.*

37 CFR § 2.114(a) *If no answer is filed within the time set, the petition may be decided as in case of default.*

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[218] *See Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986) (same); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (objection to certain paragraphs of answer as verbose and argumentative not well taken); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959) (allegation that registered mark is weak does not constitute a collateral attack on validity of opposer's registrations). *Cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1572 (TTAB 1988).

[219] *See* 37 CFR §§ 2.106(b)(1) and (2)(iii), and 2.114(b)(1) and (2)(iii).

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board may issue a notice of default. The notice states that neither an answer nor any extension of time to answer has been filed; that notice of default under Fed. R. Civ. P. 55(a) is entered; and that defendant is allowed 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response that does not show good cause, default judgment may be entered against it.[220]

If the defendant fails to file a response to the notice, or files a response which does not show good cause in a case where the plaintiff is seeking to partially cancel a registration or partially oppose an application under Section 18 of the Trademark Act, 15 U.S.C. § 1068, default judgment will be entered only to the extent that the restriction requested by plaintiff will be entered.[221]

The issue of whether default judgment should be entered against a defendant for failure to file a timely answer to the complaint may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its late-filed answer be accepted.[222] However the issue is raised, the standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the Fed. R. Civ. P. 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it.[223]

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[220] *See* 37 CFR §§ 2.106(a) and 2.114(a); Fed. R. Civ. P. 55(a), 55(b) and 55(c); *DeLorme Publishing Co v. Eartha's Inc.,* 60 USPQ2d 1222, 1224 (TTAB 2000); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990) and *Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977) *Cf.* TBMP § 508 (Motion for Default Judgment).

[221] *See Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG,* 34 USPQ2d 1266 (TTAB 1994) (*concurring opinion* at n.4). *Compare Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997) (where registrant defaulted in case involving petition to partially cancel registration to delete certain items identified therein on ground of abandonment and registration was cancelled in its entirety, Board, while noting that it may have been error to order cancellation of registration in its entirety, declined to set aside order, finding that default was properly entered and therefore not "void" under Fed. R. Civ. P. 60(b)(4)).

[222] *See, e.g., DeLorme Publishing Co v. Eartha's Inc., supra* (motion for default judgment); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990) (plaintiff's motion for default judgment and defendant's motion to accept late answer) and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (motion to accept late answer filed before notice of default issued). *Cf.* TBMP § 508 (Motion for Default Judgment)**.**

[223] *See, for example, Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc., supra* at 1557 (motion to accept late answer filed before notice of default issued was treated as response to notice of default). *See also DeLorme Publishing Co v. Eartha's Inc., supra* at 1224 and *Paolo's Associates Limited Partnership v. Paolo Bodo, supra.*

When a defendant who has not yet filed an answer to a complaint files a response to a notice of default, or to a motion for default judgment, the late answer normally should be submitted with the response. However, in some cases it may not be necessary for the defendant to submit its answer with the response. Examples include cases where the defendant has not received the copies of the complaint and notification letter sent to it by the Board, or where the parties have settled the case or agreed to an extension of the defendant's time to file an answer.

312.02 Setting Aside Notice of Default

If a defendant who has failed to file a timely answer to the complaint responds to a notice of default by filing a satisfactory showing of good cause why default judgment should not be entered against it, the Board will set aside the notice of default.[224] Similarly, if the defendant files such a showing in response to a motion by the plaintiff for default judgment, or in support of its own motion asking that its late-filed answer be accepted, default judgment will not be entered against it.

Good cause why default judgment should not be entered against a defendant, for failure to file a timely answer to the complaint, is usually found when the defendant shows that (1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action.[225] The showing of a meritorious defense does not require an evaluation of the merits of the case. All that is required is a plausible response to the allegations in the complaint.[226]

The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board.[227] In exercising that discretion, the Board must be mindful of the

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[224] *See* Fed. R. Civ. P. 55(c).

[225] *See DeLorme Publishing Co v. Eartha's Inc.,* 60 USPQ2d 1222, 1224 (TTAB 2000) (willful conduct shown where although applicant may not have intended that proceedings be resolved by default, applicant admittedly intended not to answer for six months); *Paolo's Associates Limited Partnership v. Paolo Bodo, supra* at 1903-04 (no evidence that failure was willful; costs incurred in preparing and filing motion not sufficient to support finding of prejudice); and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, *supra* at 1557 (failure to answer due to inadvertence on part of applicant's counsel; answer had been prepared and reviewed by applicant but counsel inadvertently failed to file it; nine-day delay would cause minimal prejudice; by submission of answer which was not frivolous meritorious defense was shown). *Cf., regarding a motion to set aside judgment under Fed. R. Civ. P. 60(b), Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (the two other factors having been shown, applicant was allowed time to show meritorious defense by submission of answer).

[226] *See DeLorme Publishing Co v. Eartha's Inc., supra* at 1224.

[227] *See, e.g.*, *Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977) (fact that in response to order to show cause applicant filed answer but no response to show cause order does not mandate entry of default judgment; applicant allowed time to show cause).

fact that it is the policy of the law to decide cases on their merits. Accordingly, the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant. Nevertheless, entry of default judgment may be necessary in some cases.[228]

312.03 Setting Aside Default Judgment

The standard for setting aside default judgment is stricter than the standard for setting aside a notice of default.

A notice of default may be set aside on a showing of good cause.[229] However, once default judgment has actually been entered against a defendant pursuant to Fed. R. Civ. P. 55(b), the judgment may be set aside only in accordance with Fed. R. Civ. P. 60(b), which governs motions for relief from final judgment. The stricter standard reflects public policy favoring finality of judgments and termination of litigation.[230]

The factors considered in determining a motion to set aside notice of default are also considered in determining a motion for relief from a default judgment entered pursuant to Fed. R. Civ. P. 55.[231] Among the factors to be considered in determining a motion to vacate a default judgment for failure to answer the complaint are (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action.[232]

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[228] *See DeLorme Publishing Co v. Eartha's Inc., supra* (although no specific prejudice to opposer, and while meritorious defense was shown, Board found applicant's conduct amounted to gross neglect and granted motion for default judgment where applicant filed its answer six months late, viewing the notice of opposition as "incomplete," instead of filing appropriate motion or taking other appropriate action).

[229] *See* Fed. R. Civ. P. 55(c) and TBMP § 312.02 (Setting Aside Notice of Default).

[230] *See Waifersong Ltd. Inc. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632, 1634 (6th Cir. 1992) and *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997).

[231] *Compare, for example, Paolo's Associates Limited Partnership v. Paolo Bodo,* 21 USPQ2d 1899, 1902-03 (Comm'r 1990), and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (both of which involved the question whether default judgment should be entered against defendant), *with Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991), and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991) (both involving relief from default judgment). *See also* Wright, Miller & Kane, *Federal Practice and Procedure: Civil 3d* § 2692 (1998) and *Waifersong Ltd. Inc. v. Classic Music Vending, supra*.

[232] *See Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, *supra* (motion based on alleged failure to receive correspondence from the Board denied given presumption of receipt of correspondence, passage of 12 years and resulting hardship to third parties); *Djeredjian v. Kashi Co.*, *supra* at 1615 (motion granted pending showing of meritorious defense where other two elements were established) and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (motion granted; respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings).

However, the showing submitted by the defendant is likely to be viewed with less leniency when defendant seeks relief from default judgment than when defendant seeks to show cause why default judgment should not be entered against it.[233]

Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are other motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments such as default judgments entered against plaintiffs for failure to prosecute the case.[234]

For information concerning motions under Fed. R. Civ. P. 60(b) for relief from final judgment, see TBMP § 544.

313 Counterclaims

313.01 In General

37 CFR § 2.106(b)(2)*(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

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[233] *See Waifersong Ltd. Inc. v. Classic Music Vending*, *supra*.(while the factors are similar, the methodology for considering the factors in deciding motion under 60(b)(1) and the weight to be accorded them differs); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co*., *supra* (a significant factor is the hardship that reopening a judgment may cause to others and whether other actions have been taken in reliance on the judgment); and Wright, Miller & Kane, *Federal Practice and Procedure*: *Civil 3d* § 2692 (1998).

[234] *Compare, for example, Djeredjian v. Kashi Co., supra* and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (both of which involved default judgments for failure to answer) *with Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982) (motion to set aside judgment against opposer for failure to prosecute denied; incompetent attorney); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735, 736 (TTAB 1976) (motion to set aside judgment for failure to prosecute denied; inattention and carelessness not excusable); and *Williams v. Five Platters, Inc.*, 181 USPQ 409, 410 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (motion to set aside default judgment for failure to respond to motion for summary judgment denied; carelessness and inattention of counsel). *See also* Wright, Miller & Kane, *Federal Practice and Procedure*: *Civil 3d* § 2693 (1998).

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

37 CFR § 2.114(b)(2)*(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs, or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

The Board cannot entertain an attack upon the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration.[235]

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[235] *See* 37 CFR §§ 2.106(b)(2)(ii) and 2.114(b)(2)(ii); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) (since no counterclaim had been filed, Court disregarded applicant's claims that opposer had admitted periods of nonuse); *Contour Chair-Lounge Co. v. The Englander Company, Inc.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition to cancel had been dismissed); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). *See also Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840 (TTAB 1977); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Although Trademark Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii) specifically permit a defense attacking the validity of a plaintiff's pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim.[236] If the defense is raised as a separate petition to cancel, however, the petition itself and any covering letter should include a reference to the original proceeding. Further, a defendant that fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel.[237]

The only type of counterclaim that may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party.[238]

As provided in Section 18 of the Trademark Act (15 U.S.C. § 1068) a counterclaim may seek to cancel a registration in whole or in part. In the latter case, the counterclaimant may seek to cancel the registration only, for example, as to some of the listed goods or services or only to the extent of restricting the goods or services in a particular manner (described in sufficient detail to give the respondent fair notice thereof).[239] However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding.[240] A counterclaim to partially cancel a registration by restricting the manner of use of the goods or services therein in order to avoid a likelihood of confusion is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration.[241]

A counterclaim is the legal equivalent of a petition to cancel. Thus, the provisions of 37 CFR §§ 2.111 through 2.115, governing petitions to cancel, are applicable to counterclaims.[242]

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[236] *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989).

[237] *See Vitaline Corp. v. General Mills Inc.*, *supra* at 1174. *See also* TBMP § 313.04 (Compulsory Counterclaims), and cases cited therein.

[238] *See Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 n.2 (TTAB 1990) (counterclaim to cancel "any registration which might issue in the future from pleaded application" was improper), and *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (counterclaim to "refuse any application filed by petitioner" was improper).

[239] *See* Section 18 of the Act, 15 U.S.C. § 1068; 37 CFR §§ 2.111(b) and 2.133(b); and TBMP § 309.03(d) (Remedy Under Section 18), and cases cited therein.

[240] *See* 37 CFR §§ 2.99(h) and 2.133(c), and *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

[241] *See, e.g., Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

[242] *See* 37 CFR §§ 2.106(b)(2)(iii) and 2.114(b)(2)(iii).

When necessary to enable a party fully to present or meet a counterclaim or separate petition to cancel a registration, the times for pleading, discovery, testimony, briefs and/or oral argument will be reset or extended. A party that believes that such a resetting or extension is necessary should file a motion therefor with the Board.[243]

313.02 Fee For Counterclaim

37 CFR §§ 2.106(b)(2)(iii) *The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

37 CFR §§ 2.114(b)(2)(iii) *The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

A counterclaim for cancellation of a plaintiff's registration is the legal equivalent of a separate petition to cancel. The required filing fee must be paid when a petition to cancel takes the form of a counterclaim, just as it must be paid when a petition to cancel takes the form of a separate proceeding.[244] That is, the required fee (*see* 37 CFR § 2.6) must be paid for each party joined as counterclaimant for each class sought to be cancelled in each registration against which the counterclaim is filed.[245]

If no fee or an insufficient fee is submitted, the Board will ordinarily prepare a letter noting the counterclaim, advising that the counterclaim cannot be entertained because the proper fee has not been paid and allowing the counterclaimant time to submit the appropriate fee.[246]

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[243] *See* 37 CFR §§ 2.106(b)(2)(iv) and 2.114(b)(2)(iv). *See also* TBMP § 509 (regarding motions to extend).

[244] *See* 37 CFR §§ 2.106(b)(2)(iii) and 2.114(b)(2)(iii); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966) (payment of fee is necessary to give Board jurisdiction); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1748 (TTAB 1992), *summ. judgment granted in part*, 26 USPQ2d 1926 (TTAB 1993) (same); and *Sunway Fruit Products, Inc. v. Productos Caseros, S. A.*, 130 USPQ 33, 33 (Comm'r 1960) (requirement for fee is statutory and cannot be waived).

[245] *See* 37 CFR §§ 2.111(c) and 2.112(b). *Cf.* TBMP § 308.02 (Fee for Filing Petition to Cancel).

[246] *See, e.g., Raccioppi v. Apogee Inc.,* 47 USPQ2d 1368 (TTAB 1998) (allowed time to submit fee); *Jet-Pak, Inc. v. United States Plywood Corp.*, 124 USPQ 385, 386 (TTAB 1960) (allowed time to submit fee failing which, counterclaim would be stricken); *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17-18 (TTAB 1959) (counterclaim not entertained until fee is paid) and *Jet-Pak, Inc. v. United States Plywood Corp.*, 125 USPQ 491, 492 (Comm'r 1960).

313.03 Form and Substance of Counterclaim; Service of Counterclaim

A counterclaim should be generally similar in form to a petition to cancel (for information concerning the form of a petition to cancel, *see* TBMP § 309.02). However, a counterclaim filed as part of the counterclaimant's answer to the adverse party's complaint necessarily differs somewhat in format from a separate petition to cancel.

Moreover, a plaintiff filing a separate petition to cancel must file the petition (and any exhibits thereto) in duplicate, and need not serve a copy thereof on the defendant(s).[247] A counterclaimant, on the other hand, need file only one copy of its counterclaim (and any exhibits thereto) with the Board, but must serve a copy thereof (with any exhibits thereto) on every other party to the proceeding, and must make proof of such service before the Board will consider the counterclaim.[248]

The pleading of the substance of a counterclaim may also differ somewhat from the pleading of the substance of a separate petition to cancel. For example, a counterclaimant need not plead its standing to assert a counterclaim to cancel a registration pleaded by the plaintiff in its complaint. The counterclaimant's standing in such a case is inherent in its position as defendant to the complaint.[249]

In some instances, the grounds for cancellation available in the case of a counterclaim differ from those available in the case of a petition to cancel that are not in the nature of a counterclaim. Section 14 of the Act, 15 U.S.C. § 1064, limits, after a five-year period, the grounds upon which most Principal Register registrations may be cancelled. If the plaintiff in a proceeding before the Board relies on such a registration and the five-year period has not yet expired when the plaintiff's complaint is filed, the limitation does not apply to a counterclaim filed by the defendant therein for cancellation of that registration. This is so even if the five-year period has expired by the time the counterclaim is filed. In such cases, the filing of the plaintiff's

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[247] *See* 37 CFR §§ 2.112(a) and 2.119(a), and TBMP § 309.02(c) (Complaint filed in Duplicate).

[248] *See* 37 CFR § 2.119(a).

[249] *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (finding of no likelihood of confusion in the opposition did not remove defendant's standing to counterclaim for abandonment); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987) (defendant seeking to cancel pleaded registration on ground of descriptiveness or genericness in an opposition based on likelihood of confusion need not allege that it has an interest in using the term sought to be cancelled); *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 95 (TTAB 1984) (counterclaimant clearly has personal stake in the controversy); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 856 (TTAB 1981) (damage assumed, and with properly pleaded ground is sufficient to place validity of registration in issue); and *General Mills, Inc. v. Natures Way Products,* 202 USPQ 840, 841 (TTAB 1979).

complaint tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds on which a counterclaim may be based.[250]

313.04 Compulsory Counterclaims

37 CFR § 2.106(b)(2)(i) *A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

37 CFR § 2.114(b)(2)(i) *A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

Counterclaims for cancellation of pleaded registrations in Board proceedings are governed by 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).[251] If the defendant knows the grounds for a

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[250] *See e.g., Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 862 n.3 (TTAB 1980); *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan,* 165 USPQ 597, 598 n.4 (TTAB 1970) (grounds were not limited where, although petition to cancel was not properly filed until after fifth anniversary date of registration, opposition wherein opposer relied on said registration was filed before anniversary date); and *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385, 386 (Comm'r 1955). *See also* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition,* § 20:67 (4th ed. 2001).

Cf., *regarding concurrent use proceedings, Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (5-year period tolled where applicant, prior to expiration of 5-year period files a proper concurrent application or an amendment converting an unrestricted application to one seeking concurrent use naming registrant as exception to applicant's right to exclusive use).

[251] *See* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by Trademark Rule 2.106(b)(2)(i)). *But see See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1397 (TTAB 1989) (Board applied 13(f) "when justice requires" standard where grounds for counterclaim filed as a separate petition to cancel were known at time of answer to opposition).

counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the answer.[252] If grounds are learned during the course of the proceeding, the counterclaim must be pleaded promptly after the grounds therefore are learned.[253]

A defendant who fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. In such a case, the separate petition will be dismissed, on motion, on the ground that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that it was not timely asserted.[254]

If a defendant confronted with a motion for summary judgment knows of grounds for a counterclaim that might serve to defeat the motion, the counterclaim should be asserted in response to the motion, even if no answer to the complaint has yet been filed.[255]

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[252] *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) (since it was unclear from applicant's submissions to amend whether counterclaim was timely, i.e., whether grounds were known by applicant at time original answer was filed, applicant was allowed time to explain why it was not pleaded with answer); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987) (motion to amend answer to add additional ground to existing counterclaim denied since such ground was available at time of original answer); and *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986) (petitioner cannot avoid effect of its failure to timely assert counterclaim at time it filed its answer as defendant in prior opposition since grounds existed and were known to petitioner at that time).

But see See's Candy Shops Inc. v. Campbell Soup Co., *supra* (although counterclaim (filed as separate petition to cancel) was premised on facts known by applicant at time it filed its answer in the opposition, Board allowed the petition to go forward, notwithstanding that the petition was filed two weeks after answer was filed in the opposition).

[253] *See Vitaline supra; Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992), *summ. judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) (counterclaim pleaded promptly after obtaining the information necessary to assert counterclaim during discovery and before discovery had closed); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); and *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984). *See also J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (if applicant learns through discovery that grounds exist for counterclaim, applicant may move to amend answer to assert such counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975) (applicant would not be barred by the dismissal with prejudice of its counterclaim in prior proceeding thirteen years earlier from asserting new counterclaim on same ground, i.e., that registered mark has become common descriptive name of identified goods, provided new counterclaim is based solely on circumstances occurring subsequent to termination of prior proceeding); *Neville Chemical Co. v. Lubrizol Corp.,* 183 USPQ 184, 187 (TTAB 1974) (same); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[254] *See Vitaline, supra* and *Consolidated Foods Corp., supra*.

[255] *See Libertyville Saddle Shop, supra*.

A plaintiff which fails to plead a registration, and later seeks to rely thereon, will not be heard to contend, if defendant then moves to amend its answer to assert a counterclaim to cancel the registration, or then files a separate petition to cancel the registration, that the counterclaim or separate petition is untimely because it was not pleaded when defendant filed its answer. A plaintiff may not, by failing to plead a registration on which it intends to rely, deprive a defendant of its right to petition to cancel the registration, either by counterclaim or by separate petition, at such time as opposer seeks to rely upon the registration. Even if the defendant knows grounds for cancellation of a plaintiff's unpleaded registration when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration unless and until the plaintiff pleads the registration.[256]

313.05 Permissive Counterclaims

A party may counterclaim to cancel a registration that is owned, but not pleaded, by an adverse party. A counterclaim to cancel a registration owned, but not pleaded, by an adverse party is a permissive counterclaim.[257]

313.06 Answer to Counterclaim

37 CFR § 2.106(b)(2)(iii) *The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

37 CFR § 2.114(b)(2)(iii) *The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

37 CFR § 2.114(a) *If no answer is filed within the time set, the petition may be decided as in case of default.*

When a counterclaim (together with the required cancellation fee) is filed, the Board prepares an order acknowledging its receipt and allowing the plaintiff (defendant to the counterclaim) a set time, not less than 30 days, within which to file an answer to the counterclaim.[258] In practice, the Board usually allows 30 days.[259] A copy of the order is sent to each party to the proceeding, or

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[256] *See* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i), and *M. Aron Corporation v. Remington Products, Inc.,* 222 USPQ 93 (TTAB 1984). *See also* Notice of Final Rulemaking published in the *Federal Register* of January 22, 1981 at 46 FR 6940.

[257] *See* Fed. R. Civ. P. 13(b). *Cf.* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).

[258] *See* 37 CFR §§ 2.106(b)(2)(iii) and 2.114(b)(2)(iii).

[259] *See* TBMP § 310.03(b) (five-day addition under 37 CFR § 2.119(c) does not apply to deadlines set by Board).

to each party's attorney or other authorized representative. The order will also include a trial schedule and briefing dates to accommodate the counterclaim.[260]

If no answer to the counterclaim is filed during the time allowed, the counterclaim may be decided as in case of default. [261]

An answer to a counterclaim should be in the same form as an answer to a complaint. *For information on the proper form for an answer to a complaint, see* TBMP § 310.01.

An answer to a counterclaim, like any other answer, may include a counterclaim for cancellation of a registration owned by the counterclaimant. A defense attacking the validity of any registration pleaded by the counterclaimant is a compulsory counterclaim if grounds for such counterclaim exist at the time when the plaintiff's answer to the defendant's counterclaim is filed. If the plaintiff knows grounds for a counterclaim when the plaintiff's answer to the defendant's counterclaim is filed, the counterclaim must be pleaded with or as part of the plaintiff's answer. If, during the course of the proceeding, the plaintiff learns, through discovery or otherwise, that grounds for a counterclaim exist, the counterclaim should be pleaded promptly after the grounds therefor are learned.[262]

A plaintiff's counterclaim to cancel a registration owned by the defendant, but not pleaded in the defendant's counterclaim, is a permissive counterclaim.[263]

For information on the fee for a counterclaim, see 37 CFR § 2.6(a)(16) and TBMP § 313.02. *For information on the form for a counterclaim, see* TBMP § 313.03.

314 Unpleaded Matters

A plaintiff may not rely on an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.[264]

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[260] *An example of a trial order for a proceeding with a counterclaim can be found in the Appendix of Forms.*

[261] *See* 37 CFR §§ 2.114(a) and 2.114(b)(2)(iii). *For information concerning default for failure to answer, see* TBMP § 312.

[262] *Cf.* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i), and TBMP § 313.04 (Compulsory Counterclaims).

[263] *Cf.* Fed. R. Civ. P. 13(b), and TBMP § 313.05 (Permissive Counterclaims).

[264] *See P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801, 804 (CCPA 1978) (registrant did not have fair notice that petitioner was attempting to establish a two-year period of nonuse extending beyond two-year period alleged in petition); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1471 n.11 (TTAB 1993) (only ground pleaded and tried was descriptiveness, not likelihood of confusion); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1439-40 (TTAB 1993) (issue of abandonment argued in final brief was neither pleaded nor tried); *Riceland Foods*

Similarly, except as provided in Fed. R. Civ. P. 12(b) and (h)(2) (which allow a defendant to raise certain specified defenses by motion), the defendant may not rely on an unpleaded defense unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter.[265]

If, after the filing of its pleading, a party learns, through discovery or otherwise, of information which would serve as the basis for an additional claim (in the case of a plaintiff), or defense or counterclaim (in the case of a defendant), the party should move promptly to amend its pleading to assert the additional matter.[266]

A party may not obtain summary judgment on an unpleaded issue, nor may a party defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. However, a party that seeks to obtain, or to defend

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Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883, 1884 (TTAB 1993) (only mark pleaded by opposer and tried was registered design mark and applicant had no notice that opposer intended to rely on use of unregistered word mark appearing on opposer's packaging); *Micro Motion, Inc. v. Danfoss A/S,* 49 USPQ2d 1628 (TTAB 1992) (motion to amend opposition filed with final brief denied where pleaded issue was genericness and applicant was not on notice of unpleaded issue of mere descriptiveness so that applicant could have put on defense of acquired distinctiveness); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1139 (TTAB 1992) (to have valid 2(d) claim in this case opposer was advised to amend pleading to state that its pleaded mark is merely descriptive and had acquired distinctiveness prior to any establishment by applicant of acquired distinctiveness of applicant's mark); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1128 (TTAB 1990). *For additional case cites, see Appendix of Cases.*

Cf. The Hoover Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) (unpleaded issue will not be addressed for the first time on appeal).

[265] *See* Fed. R. Civ. P. 8(b), 8(c), and 12(b); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995) (applicant allowed time to amend pleading to allege acquisition of secondary meaning as an affirmative defense in the answer); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, *supra* (in defending against 2(d) claim where opposer's unregistered mark is merely descriptive, applicant was advised to amend pleading to affirmatively assert priority of acquired distinctiveness); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense raised for first time in final brief that opposer lacks proprietary rights in its common law mark was neither pleaded nor tried); and *United States Olympic Committee v. Bata Shoe Co.,* 225 USPQ 340, 342 (TTAB 1984). *See also Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748 (TTAB 1978); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301 (TTAB 1977); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246 (TTAB 1977); and *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975).

[266] *See* Fed. R. Civ. P. 15(a); *Hilson Research Inc. supra; Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748 (TTAB 1978); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); and *Neville Chemical Co. v. Lubrizol Corp*., 183 USPQ 184 (TTAB 1974). *See also* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).

against, summary judgment on the basis of an unpleaded issue may move to amend its pleading to assert the issue.[267]

315 Amendment of Pleadings

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

37 CFR § 2.115 Amendment of pleadings in a cancellation proceeding.
Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

Pleadings in inter partes proceedings before the Board may be amended in the same manner and to the same extent as pleadings in a civil action before a United States district court. *See* 37 CFR §§ 2.107 and 2.115. *For further information concerning the amendment of pleadings, see Fed. R. Civ. P. 15, and* TBMP § 507. *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

316 Motions Relating to Pleadings

In opposition and cancellation proceedings, there is a wide range of motions relating to pleadings, including motions to dismiss, for a more definite statement, to strike, for judgment on the pleadings, to amend pleadings, etc. *For information concerning these motions, see* TBMP chapter 500.

317 Exhibits to Pleadings

37 CFR § 2.122(c) *Exhibits to pleadings. Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.*

37 CFR § 2.122(d) *Registrations. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...*

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[267] *See*, *e.g., Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (opposer's pleading deemed amended where nonmoving party did not object to summary judgment motion as seeking judgment on unpleaded claim); and TBMP § 528.07 (Unpleaded Issue), and cases cited therein.

A plaintiff or defendant may attach exhibits to its pleading. However, with one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits.[268]

The one exception to the foregoing rule is a current status and title copy, prepared by the Patent and Trademark Office, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff.[269]

318 Fed. R. Civ. P. 11 Applicable

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

(b) Representations to Court.
By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances,--

> *(1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;*
> *(2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*
> *(3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*
> *(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.*

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[268] 37 CFR § 2.122(c). *See Republic Steel Co. v. M.P.H. Manufacturing Corp.*, 312 F.2d 940, 136 USPQ 447, 448 (CCPA 1963); *Hard Rock Café Intl (USA) Inc. v. Elsea,* 56 USPQ2d 1504, 1511 (TTAB 2000); *Home Juice Co. v. Runglin Companies Inc.*, 231 USPQ 897, 898 (TTAB 1986); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 155 n.3 (TTAB 1985); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.5 (TTAB 1978); *A-1-A Corp. v. The Gillette Co.*, 199 USPQ 118, 119 n.2 (TTAB 1978); and *Permatex Co. v. California Tube Products, Inc.*, 175 USPQ 764, 765 n.2 (TTAB 1972).

[269] *See* 37 CFR §§ 2.122(c) and 2.122(d)(1), and TBMP § 704.03(b)(1)(A) (Registration Owned by Party).

(c) Sanctions.
If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the attorneys, law firms, or parties that have violated subdivision (b) or are responsible for the violation.

The quoted provisions are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board.[270]

319 Amendment to Allege Use; Statement of Use

For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application that is the subject of the opposition, see TBMP § 219.

[270] *See* 37 CFR § 2.116(a) and TBMP § 527.02 (Motion for Rule 11 Sanctions), and authorities cited therein. *See also Central Manufacturing, Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (the Board will also consider the conduct of a party relating to the requests to extend time to oppose).

Chapter 400
DISCOVERY

401 In General

Through the use of the various discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in inter partes proceedings before the Board; a party may ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case, may simplify the issues, or may reveal a basis for a motion for summary judgment, an additional claim (in the case of a plaintiff), or an additional defense or counterclaim (in the case of a defendant). At the very least, discovery enables the discovering party to better prepare for trial.[1]

The conduct of discovery in Board inter partes proceedings is governed by 37 CFR § 2.120. Discovery before the Board under 37 CFR § 2.120 is similar in many respects to discovery before the Federal district courts under the Federal Rules of Civil Procedure. Ordinarily, the discovery provisions of the Federal Rules of Civil Procedure are applicable in Board inter partes proceedings, except as otherwise provided in 37 CFR § 2.120. However, the provisions of the Federal Rules relating to automatic disclosure and pretrial conferences are not applicable in Board proceedings. *See* 37 CFR § 2.120(a). Specifically, the following provisions do not apply: Rules 16(b); 26(a)(1)-26(a)(4); 26(b)(4); 26(d) first sentence; 26(e)(1); 26(f); 26(g)(1); 30(a)(2)(C); 33(a) last sentence; 34(b) last sentence of first paragraph; 36(a) last sentence of first paragraph; 37(a)(2)(A); 37(c)(1); and 37(g).[2]

The differences that exist between the two discovery systems are due primarily to the administrative nature of Board proceedings.[3]

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those that do not.[4]

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[1] *For a discussion of the purposes served by discovery, see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979). *See also Bison Corporation v. Perfecta Chemie B.V.,* 4 USPQ2d 1718, 1720 (TTAB 1987) and *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978).

[2] *See* "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). *See also, for example, Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999) (petitioners need not prepare list of trial witnesses and documents), *appeal filed, Pro-Football, Inc. v. Harjo, mot. to dismiss denied*, *(not reported in F.Supp.2d)*, 57 USPQ2d 1140 (D.D.C. 2000).

[3] *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing procedure in inter partes proceedings are adapted from the Federal Rules with modifications appropriate to the administrative process).

[4] *See* TBMP § 408.01 (Duty to Cooperate).

402 Scope of Discovery

402.01 In General

The general scope of the discovery that may be obtained in inter partes proceedings before the Board is governed by Fed. R. Civ. P. 26(b)(1), which provides, in part, as follows:[5]

> *Parties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party, including the existence, description, nature, custody, condition, and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. ... Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. ...*

A party may take discovery not only as to matters specifically raised in the pleadings,[6] but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim.[7]

A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way.[8]

Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding.[9]

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[5] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988) (admissibility not necessary). *See also Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975) (relevancy construed liberally).

[6] *See Varian Associates v. Fairfield-Noble Corp.*, *supra* and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition).

[7] *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information concerning possible abandonment, if revealed, may provide basis for counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (the mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, cannot be construed as a collateral attack on the registration); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974).

[8] *See Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (scope of discovery limited only by restrictions in Rule 26(b)(1) of Federal Rules).

[9] Fed. R. Civ. P. 26(g). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984); and TBMP § 408.01 (Duty to Cooperate).

In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of Fed. R. Civ. P. 26(g), a certification by the party or its attorney that, *inter alia*, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary.[10] A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another.[11]

402.02 Limitations on Right to Discovery

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, *inter alia*, it is unreasonably cumulative or duplicative; or is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive; or "where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information."[12]

For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by

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[10] *See Fed. R. Civ. P. 26(g). See also Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (petitioner estopped to challenge respondent's interrogatories as excessive in number having served virtually identical set on respondent); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties served identical discovery requests on each other and are constrained to answer each completely). *See also Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (applicant, having served 114 interrogatories, is estopped from challenging opposer's 122 interrogatories as excessive); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 623 (TTAB 1974); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477 (TTAB 1974); and TBMP § 408.01 (Duty to Cooperate).

Cf. Brawn of California Inc. v. Bonnie Sportswear Ltd., 15 USPQ2d 1572 (TTAB 1990) as cited in *Miss America Pageant v. Petite Productions, Inc., supra* at 1069 (no estoppel where opposer served a different, albeit also excessive, set of interrogatories on applicant).

[11] *See Miss America Pageant v. Petite Productions, Inc., supra* at 1069 (Board was persuaded that certain interrogatories would be burdensome).

[12] *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696, 1699 (Fed. Cir. 1990) and Fed. R. Civ. P. 26(b)(2). *See also, for example, Haworth Inc. v. Herman Miller Inc.*, 998 F.2d 975, 27 USPQ2d 1469, 1472 (Fed. Cir. 1993) (must first seek discovery from party before burdening nonparty); *Katz v. Batavia Marine & Sporting Supplies Inc.*, 984 F.2d 422, 25 USPQ2d 1547, 1549 (Fed. Cir. 1993) (in response to nonparty's prima facie showing that discovery was burdensome, party did not meet burden of showing need for information sought), and *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1763 (TTAB 1999) (motion for protective order to prohibit deposition of "very high-level official of a large corporation" granted).

providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.[13]

In addition, a party will not be permitted to obtain, through a motion to compel, discovery broader in scope than that actually sought in the discovery request(s) to which the motion pertains.[14]

The Board may refuse to permit the discovery of confidential commercial information, or may allow discovery thereof only under an appropriate protective agreement or order.[15] Similarly, information protected by the attorney-client privilege is not discoverable unless the privilege has been waived;[16] and documents and things prepared in anticipation of litigation or for trial by or

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[13] *See, for example, See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 115 S.Ct. 1426 (1995) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, objection to evidence introduced by applicant at trial was overruled)**;** *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) (production of representative sample was not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 148 (TTAB 1985) (representative sample of invoices from identified calendar quarters is sufficient where there are so many items as to make respondent's task unduly burdensome); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (permitted to identify reasonable number of corporate officers most knowledgeable); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (burden of calculating sales and advertising figures in round numbers for six categories of goods for each year since 1936 mitigated by limiting sales figures to five most recent years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (applicant allowed to produce ten representative samples of documents pertaining to the marketing of each copy machine or as alternative, may allow opposer's representative to visit sites where relevant documents are kept); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowed to furnish representative samples of advertisements).

[14] *See Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980).

[15] *See, for example*, Fed. R. Civ. P. 26(c); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1862 (TTAB 2001) (protective agreement would adequately protect against disclosure of trade secret manufacturing and technical information); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (unless issue is abandonment or first use, party need not reveal names of its customers, including dealers, it being sufficient to identify classes of customers and types of businesses); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980) (need for names of customers, as in case where issue is abandonment, outweighs justification for protecting customer confidentiality); and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (protective order must contain provision that customer names will be revealed only to applicant's attorneys). *See also Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Ortho Pharmaceutical Corp. v.Schattner*, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) and TBMP § 412 (Protective Orders).

[16] *See, for example,* Fed. R. Civ. P. 26(b)(5) and *Red Wing Co. v. J. M. Smucker Co.,* 59 USPQ2d 1861, 1864 (TTAB 2001) (party making claim of privilege must do so expressly and otherwise describe the nature of the withheld information as provided in Rule 26(b)(5).

for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means.[17]

403 Timing of Discovery

403.01 In General

37 CFR § 2.120(a) ***…*** *The Trademark Trial and Appeal Board will specify the opening and closing dates for the taking of discovery. The trial order setting these dates will be mailed with the notice of institution of the proceeding. The discovery period will be set for a period of 180 days. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.* ***…***

When a timely opposition or petition to cancel in proper form has been filed, and the required fee has been submitted (or at the time described in 37 CFR § 2.92 for an interference and 37 CFR § 2.99(c) for a concurrent use proceeding); the Board sends out a notice advising the parties of the institution of the proceeding.[18] The notice includes a trial order setting the opening and closing dates for the discovery period and assigning each party's time for taking testimony.[19] The date set for the close of discovery is 180 days after the opening of discovery.

The discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period.[20] A party has no obligation to respond to an untimely request for discovery.

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[17] *See, for example*, Fed. R. Civ. P. 26(b)(3) and (b)(5); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975). *See also Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974) and TBMP § 412 (Protective Orders).

[18] *See* 37 CFR §§ 2.105 and 2.113; and TBMP §§ 310, 1003 and 1106.

[19] *See* 37 CFR §§ 2.120(a) and 2.121(a).

[20] *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (although a specific time period is not provided in Rule 34, it is implicit that utilization thereof is limited to the discovery period) and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978).

403.02 Time for Service of Discovery Requests

37 CFR § 2.120(a) … *Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.*

Interrogatories, requests for production of documents and things, and requests for admission may be served on an adversary from the day the discovery period opens through the last day of the discovery period, even though the answers thereto will not be due until after the discovery period has closed.[21] However, discovery depositions must be not only noticed but also taken during the discovery period (unless the parties stipulate that the deposition may be taken outside of the period).[22]

403.03 Time for Service of Discovery Responses

37 CFR § 2.120(a) … *Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days from the date of service of such discovery requests. ...*

Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days after the date of service of the request for discovery.[23] If service of the request for discovery is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the request.[24]

Discovery in proceedings before the Board is not governed by any concept of priority of discovery or deposition. That is, a party which is the first to serve a request for discovery does not thereby gain a right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Rather, a party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor

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[21] *See Luemme Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999). *See also Rhone-Poulenc Industries v. Gulf Oil Corp.*, *supra*; *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974); *AMP Inc. v. Raychem Corp.*, 179 USPQ 857 (TTAB 1973); and *Deere & Co. v. Deerfield Products Corp.*, 176 USPQ 422 (TTAB 1973).

[22] *See* 37 CFR § 2.120(a). *See also Smith International, Inc. v. Olin Corp.*, *supra*; and *Rhone-Poulenc Industries v. Gulf Oil Corp., supra* .

[23] *See* 37 CFR § 2.120(a) and Fed. R. Civ. P. 33(b)(3), 34(b), and 36(a).

[24] *See* 37 CFR § 2.119(c), and TBMP § 113.05. *See also Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987).

under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery.[25]

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits.[26] Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.[27] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.[28]

403.04 Extensions of Discovery Period and/or Time to Respond to Discovery Requests

37 CFR § 2.120(a) *... The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.*

* * * *

... The time to respond [to interrogatories, requests for production of documents and things, and requests for admission] may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery

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[25] *See* Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986).

[26] *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding time to answer); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (party seeking discovery is required to make good faith effort to determine why no response has been made before coming to Board with motion to compel).

[27] *See No Fear Inc. v. Rule*, *supra* at 1554.

[28] *See No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

37 CFR § 2.121(a)(1) *... The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party.*

The closing date of the discovery period may be extended by stipulation of the parties approved by the Board, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. An extension of the closing date for discovery will result in a corresponding extension of the testimony periods without action by any party.[29]

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period.[30] Thus, a party which waits until the waning days of the discovery period to serve interrogatories, requests for production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto after the close of the discovery period, that it needs an extension of the discovery period in order to take "follow-up" discovery.[31]

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, rob its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion.[32]

The time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. However, an extension of a party's time to respond to an outstanding request for discovery will not result in an automatic corresponding extension of the discovery and/or

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[29] *See* 37 CFR § 2.121(a)(1). *For information concerning stipulations to extend, see* TBMP § 501.03. *For information concerning motions to extend, see* TBMP § 509.

[30] *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed); and Janet E. Rice, *TIPS FROM THE TTAB: The Timing of Discovery*, 68 Trademark Rep. 581 (1978).

[31] *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1316 n. 4 (TTAB 1992).

[32] *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975).

testimony periods.[33] Such periods will be rescheduled only on stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.

A stipulation to extend or reopen only the time for responding to a request for discovery (that is, not to extend or reopen also the closing date for the discovery period and/or testimony periods) does not have to be filed with the Board. However, to avoid any misunderstanding between the parties as to the existence and terms of such a stipulation, it is recommended that the stipulation be reduced to writing, even if it is not filed with the Board.

403.05 Need for Early Initiation of Discovery

403.05(a) To Allow Time for "Follow-up" Discovery

If a party wishes to have an opportunity to take "follow-up" discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and serve additional discovery requests prior to the expiration of the discovery period.[34]

403.05(b) To Facilitate Introduction of Produced Documents

37 CFR § 2.120(j)(3)(ii) *A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).*

37 CFR § 2.122(e) Printed publications and official records. *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered, and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official*

[33] *See* 37 CFR §§ 2.120(a) and 2.121(a); and *PolyJohn Enterprises Corp.* v. *1-800-TOILETS, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002) (mistaken belief that resetting time to respond to discovery also extended discovery and testimony periods did not constitute excusable neglect to reopen).

[34] *See* TBMP § 403.04 (Extensions of Discovery and Time to Respond).

record of the [United States] Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Documents produced in response to a request for production of documents may not be made of record by notice of reliance alone, except to the extent that the documents are admissible by notice of reliance as printed publications or official records under 37 CFR § 2.122(e). However, there are a number of different methods by which documents produced in response to a request for production of documents that do not qualify for submission under Rule 2.122(e) may be made of record.[35] Three of the easiest methods are available for use only if the request for production of documents is served relatively early in the discovery period.

First, if the discovery period has not yet expired, a party that has obtained documents from another party through a request for production of documents may serve on its opponent a request for admission of the genuineness of the subject documents, which should be attached as exhibits to the request for admission.[36] Then, during its testimony period, the propounding party may file a notice of reliance, pursuant to 37 CFR § 2.120(j)(3)(i), on the request for admission, the exhibits thereto, and its adversary's response.

Second, if the discovery period has not yet expired, the party which obtained the documents may make them of record by taking a discovery deposition of its adversary, marking the documents as exhibits thereto, and having the witness identify the documents during the deposition. The propounding party may then submit the deposition and identified exhibits during its testimony period under a notice of reliance.

Third, the request for production of documents may be combined with a notice of the taking of the adversary's discovery deposition; that is, the combined request and notice may ask that the deponent bring the requested documents to his or her deposition. However, a party served with a request for production of documents has 30 days from the date of service of the request in which to respond thereto, plus an extra 5 days if service of the request was made by first-class mail, "Express Mail," or overnight courier.[37]

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[35] *See* TBMP § 704.09 (Discovery Depositions). *For a full discussion of making evidence of record in a Board proceeding, see* Chapter 700.

[36] *See* Fed. R. Civ. P. 36(a).

[37] *See* TBMP § 403.03 (Time for Discovery Responses).

Moreover, in proceedings before the Board, a discovery deposition must be both noticed and taken before the end of the discovery period.[38] Thus, a combined notice of deposition and request for production of documents normally must be served at least 35 days prior to the close of the discovery period.

404 Discovery Depositions

404.01 When and By Whom Taken

Discovery depositions must be both noticed and taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period).[39] Discovery depositions generally may be taken by any party.

404.02 Who May be Deposed

A discovery deposition generally may be taken of any person, whether or not the person is a party, and whether or not the person resides in the United States. However, the Board's permission must be obtained under the following circumstances:[40]

(1) If the person to be examined is confined in prison; or

(2) If, without written stipulation of the parties, (i) a proposed deposition would result in more than ten depositions being taken by the plaintiffs, or by the defendants, or (ii) the person to be examined already has been deposed in the case.

For information concerning limitations on the right to discovery, see TBMP § 402.02.

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[38] *See* TBMP § 403.02 (Time for Discovery Requests).

[39] *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (it is clear from the language of Fed. R. Civ. P. 30 and 33 that while interrogatories need only be "served" during the discovery period, depositions must be "taken" during the discovery period); and TBMP § 403.02 (Time for Service of Discovery Requests)

[40] *See* Fed. R. Civ. P. 30(a).

404.03 Place of Deposition; Oral or Written Deposition; Securing Attendance of Deponent

404.03(a) Person Residing in the United States – In General

37 CFR § 2.120(b) Discovery deposition within the United States.
The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. ...

The discovery deposition of a person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation.[41] The deposition may be taken either orally, or on written questions in the manner described in 37 CFR § 2.124.[42]

404.03(a)(1) Person Residing in United States – Party

If a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, the deposition may be taken on notice alone.[43]

404.03(a)(2) Person Residing in United States – Nonparty

37 CFR § 2.120(b) Discovery deposition within the United States.
... The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure.

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[41] *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (general rule in Federal district court that a plaintiff is required to make itself available for examination in district where suit is brought does not apply in Board proceedings).

[42] *See* Fed. R. Civ. P. 26(a)(5), 30, and 31. *For information on the taking of a discovery deposition on written questions, see* TBMP § 404.07.

[43] *See* 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). *For information concerning notices of deposition, see* TBMP § 404.05. *For information concerning testimonial depositions of adverse witnesses residing in United States, see* TBMP § 703.01(f)(2).

If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent.[44] If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45.[45] The subpoena must be issued from the United States district court in the Federal judicial district where the deponent resides or is regularly employed.[46]

If a person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States District Court that issued the subpoena; the Board has no jurisdiction over such depositions.[47]

404.03(b) Person Residing in a Foreign Country – Party

37 CFR § 2.120(c) Discovery deposition in foreign countries.
(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the

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[44] *See* 37 CFR § 2.120(b).

[45] *See Kellogg Co. v. New Generation Foods Inc.,* 6 USPQ2d 2045, 2048-49 (TTAB 1988) (deposition of former employee can only be taken by voluntary appearance or by subpoena); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board,* 75 Trademark Rep. 323, 383-384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board,* 75 Trademark Rep. 296 (1985); and Fed. R. Civ. P. 30(a)(1) and 45.

Cf., regarding testimony depositions, Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409, 1410 (TTAB 1990) (testimony deposition on written questions of adverse party); *Consolidated Foods Corp. v. Ferro Corp.,* 189 USPQ 582, 583 (TTAB 1976) (testimony deposition of adverse witness); and TBMP § 703.01(f)(2) (Unwilling Witness Residing in U.S.).

[46] *See generally* cases cited in preceding footnote.

[47] *See, for example, Luehrmann v. Kwik Kopy Corp*., 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (motion to quash subpoenaed third-party depositions due to scheduling problems denied). *See also In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201 (D.Del. 1973); *PRD Electronics Inc. v. Pacific Roller Die Co.,* 169 USPQ 318 (TTAB 1971); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383-384 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

The discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party may be taken on notice alone.[48]

However, if the discovery deposition of such a person is taken in a foreign country, it must be taken on written questions, in the manner described in 37 CFR § 2.124, unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination.[49]

For information concerning the procedure for taking discovery depositions on written questions, see TBMP § 404.07. *For information on a motion to take a foreign deposition orally, see* TBMP § 520.

The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition.[50]

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[48] *See* 37 CFR §§ 2.120(c) and 2.124. *Compare* TBMP § 703.01(g) (Persons Before Whom Depositions may be Taken); the *testimony* deposition of an adverse party, unless obtained voluntarily, may be taken in a foreign country, if at all, only by the letter rogatory procedure or by procedures provided under the Hague Convention or other applicable treaties.

[49] *See Jain v. Ramparts Inc.,* 49 USPQ2d 1429, 1431 (TTAB 1998); 37 CFR § 2.120(c)(1); and TBMP § 520 (Motion to take Foreign Deposition Orally). *See also Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1925 (TTAB 1989) (by motion); *Fischer Gesellschaft m.b.H. v. Molnar and Company, Inc.,* 203 USPQ 861, 866 (TTAB 1979) (by motion); *Jonergin* Co. *v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (by stipulation); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984). *Cf.* TBMP § 703.01(b) (Form of Oral Testimony Depositions).

[50] *See Jain v. Ramparts Inc., supra at* 1431 and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978) (deposition may only be taken by written questions unless otherwise stipulated, or unless the party is present in the U.S.). *See also Miller v. N. V. Cacao-En Chocoladefabrieken Boon*, 142 USPQ 364 (E.D. N.Y. 1964); and Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253 (1980) and *Jonergin Co. v. Jonergin Vermont Inc., supra*.

404.03(c) Person Residing in a Foreign Country – Nonparty

404.03(c)(1) Willing Nonparty

The discovery deposition of a natural person who resides in a foreign country, and is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party, i.e., in the manner described in TBMP § 404.03(b).[51]

404.03(c)(2) Unwilling Nonparty

There is no certain procedure for obtaining, in an inter partes proceeding before the Board, the discovery deposition of a natural person who resides in a foreign country, is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, and does not agree to appear voluntarily to be deposed. However, a party may be able to obtain the discovery deposition of such a person through the letter rogatory procedure, whereby an unwilling nonparty witness in a foreign country sometimes may be compelled to respond to questions routed through diplomatic channels to an appropriate judicial authority in the foreign country.[52]

The term "Letters rogatory" is defined in *Black's Law Dictionary* (Fifth Edition 1979) as follows:

> *A request by one court of another court in an independent jurisdiction, that a witness be examined upon interrogatories sent with the request. The medium whereby one country, speaking through one of its courts, requests another country, acting through its own courts and by methods of court procedure peculiar thereto and entirely within the latter's control, to assist the administration of justice in the former country. The Signe, D.C.La., 37 F. Supp. 819, 820.*

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[51] *Cf.* 37 CFR §§ 2.120(c) and 2.123(a).

[52] *See*, *in general*, Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). *Cf. DBMS Consultants Ltd. v. Computer Associates International, Inc.*, 18 FR Serv 3d 33, 131 FRD 367 (D. Mass. 1990) (court granted application for issuance of a letter rogatory finding that it would be unjust and inappropriate to require oral examination and that opposing party has shown no good reason to deny the application).

> *A formal communication in writing, sent by a court in which an action is pending to a court or judge of a foreign country, requesting that the testimony of a witness resident within the jurisdiction of the latter court may be there formally taken under its direction and transmitted to the first court for use in the pending action. Fed. R. Civ. P. 28.*
>
> *This process was also in use, at an early period, between the several states of the Union. The request rests entirely upon the comity of courts towards each other.*

While the letter rogatory procedure is usually conducted through the judicial system, because the proceeding is before an administrative body, the Board in this instance would function as the initiating "court" contemplated by the rule.

A party that wishes to have the Board issue a letter rogatory should file a written request therefor with the Board.[53] The party must also submit an original and two copies of the proposed letter rogatory, and an original and two copies of the questions to be propounded to the nonparty witness. If the official language of the foreign country is not English, the propounding party must submit an original and two copies of the letter rogatory and questions in English, and an original and two copies thereof translated into the official language. In addition, the propounding party must serve on each adverse party a copy of every paper submitted to the Board.[54]

If the request is granted, each adverse party will be given an opportunity to submit cross-questions, a copy of which must also be served on the propounding party. If an adverse party does submit cross questions, the propounding party, in turn, will be given an opportunity to submit redirect questions, a copy of which must be served on each adverse party.[55] As in the case of the initial questions, an original and two copies of any cross questions and redirect questions must be submitted to the Board; if the official language of the foreign country is not English, an original and two copies of the questions in English, and an original and two copies thereof translated into the official language, must be submitted.

After the original and copies of the letter rogatory, and of all of the questions, have been submitted to the Board, and the letter rogatory has been approved as to

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[53] *See* Fed. R. Civ. P. 28(b).

[54] *See* 37 CFR § 2.119(a). *Cf.* 37 CFR § 2.124(b)(2).

[55] *Cf.* 37 CFR § 2.124(d)(1).

form, the letter rogatory will be issued by the Board. The letter rogatory will be signed by the Chief Administrative Trademark Judge; the signature will be authenticated in such a manner at to meet the requirements of the foreign country; and the original and one copy of the letter rogatory and accompanying questions will be forwarded to the United States Department of State with a transmittal letter from the Board (the remaining copy of these papers will be retained in the Board proceeding file). In its transmittal letter, the Board will request, pursuant to 28 U.S.C. § 1781 (which authorizes the Department of State to, *inter alia*, "receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution"), that the Department of State transmit the letter rogatory to the appropriate judicial authority in the foreign country, and, after execution, receive it back and return it to the Board. Thereafter, the Department of State will transmit the letter rogatory, through diplomatic channels, to the appropriate judicial authority in the foreign country.

The party seeking discovery must pay all fees, including authentication, consular, and foreign government fees, charged in connection with the letter rogatory procedure. The Department of State will require the propounding party to make a deposit to cover the consular and foreign government fees. Payment may be made by certified check or money order made payable to the American Embassy/Consulate [insert the name of the appropriate city, i.e., Paris, Bonn, Tokyo, etc.]. Any unused portion of the deposit will be returned to the depositor after completion of the letter rogatory process.

Further information concerning the letter rogatory process may be obtained from the Office of Citizens Consular Services, Department of State, 2201 C Street N.W., Washington, D.C. 20520.

Once the appropriate foreign judicial authority has received the letter rogatory, it may or may not be executed. As indicated above, the letter rogatory "rests entirely upon the comity of courts towards each other." Some countries refuse or are reluctant to lend assistance in the taking of a discovery deposition in their country through the letter rogatory procedure, and compliance with the procedural requirements for a letter rogatory does not ensure that the requested deposition will be completed.[56] Before a request for issuance of a letter rogatory is filed with the Board, the requesting party should examine the law and policy of the involved foreign country, and consult with the Office of Citizens Consular Services,

[56] *See NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to Fed. R. Civ. P. 28(b*), and Wright, Miller & Marcus, *Federal Practice and Procedure*: Civil 2d § 2083 (1994).

Department of State, in order to determine whether the country in question is likely to honor a letter rogatory, particularly a letter rogatory issued by the Board.

Even in those foreign countries that are not reluctant to execute a letter rogatory, the foreign judicial authority may refuse to honor a letter rogatory issued by the Board (an administrative tribunal) rather than by a United States district court. Further, if the foreign country has a "blocking statute" prohibiting its residents from disclosing certain types of information in judicial or administrative proceedings outside of the foreign country, a letter rogatory may not be honored if the foreign judicial authority believes that disclosure of the information requested therein would violate the blocking statute.[57]

If a letter rogatory is honored, its probative value may be limited. In executing the letter rogatory, the foreign judicial tribunal will follow its customary procedures for taking testimony. The fact that these procedures may differ from those normally followed in proceedings before the Board does not mean that the deposition must necessarily be excluded. Rather, any such differences are matters to be considered by the Board in determining the probative value of the deposition.[58]

A party considering the filing of a request for issuance of a letter rogatory should bear in mind not only the complexity and uncertain outcome of the procedure, but also its time-consuming nature. The entire process, from the filing of the initial request for issuance of a letter rogatory, to receipt by the Board either of the completed deposition, or of notification that the letter rogatory will not be honored; will consume months, if not years. During the interim, proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory.[59]

The Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (commonly known as the "Hague Convention"), opened for signature March 18, 1970, 23 U.S.T. 2555, T.I.A.S. No. 7444, prescribes procedures under which a judicial authority in one member country may request evidence located in another. The Convention offers another possible method by which a party to an inter partes proceeding before the Board may attempt to obtain the discovery

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[57] *See* Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

[58] *See* Fed. R. Civ. P. 28; *NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to Fed. R. Civ. P. 28(b);* and Wright, Miller & Marcus, *Federal Practice and Procedure*: Civil 2d § 2083 (1994).

[59] *Cf.* 37 CFR § 2.124(d)(2).

deposition of an unwilling nonparty witness residing in a foreign country, if the foreign country is a member of the Convention.[60]

The Hague Convention provides for the compulsion of evidence (including the deposition of an unwilling witness) in a member country pursuant to a "letter of request," which is very similar in nature to a letter rogatory.[61] However, the Board has been advised by the Department of State that foreign countries are more likely to lend assistance in the taking of a discovery deposition if the request therefor is made under the more formal letter rogatory procedure. Before filing a motion for issuance of a letter of request, the moving party should consult with the Office of Citizens Consular Services, Department of State, in order to determine whether the foreign country in question is likely to honor a letter of request, particularly a letter of request issued by the Board.

404.03(d) Foreign Person Present Within the United States – Party

37 CFR § 2.120(c)(2) *Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if*

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[60] *See*, *for example*, *Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522 (1987) (although Hague not exclusive discovery procedure, it may apply even if Federal Rules of Civil Procedure are available); *In re Anschuetz & Co., GmbH*, 838 F.2d 1362 (5th Cir. 1988) (U.S. district courts have discretion to resolve discovery conflicts between Federal Rules of Civil Procedure and Hague Convention); Wright, Miller and Marcus, *Federal Practice and Procedure*: *Civil 2d* § 2005 (1994)**;** and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board,* 75 Trademark Rep. 296 (1985*). For general information concerning the Hague Convention, see Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) (applicant failed to establish necessity of using Hague procedures). [NOTE: This case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

[61] *For information concerning the letter of request procedure under the Hague Convention*, *see Chapter 1 of the Convention. See also Double J of Broward Inc. v. Skalony Sportswear GmbH,*21 USPQ2d 1609 (TTAB 1991).

the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

Whenever a natural person who is a foreign party, or an officer, director, or managing agent, of a foreign party, or some other person who consents to testify on a foreign party's behalf, is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination on notice pursuant to 37 CFR § 2.120(c)(2).[62] Indeed, this option was available even before the adoption of 37 CFR § 2.120(c)(2).[63]

When the discovery deposition of a foreign party, or an officer, director, managing agent, or other person who consents to testify on behalf of a foreign party, is taken in the United States by oral examination pursuant to 37 CFR § 2.120(c)(2), the deposition must be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition.[64]

404.03(e) Foreign Person Present Within the United States – Nonparty

If the proposed deponent is a foreign person who is present within the United States but the person is not a party to the proceeding and is not willing to appear voluntarily, it may be necessary to secure the deponent's attendance, if at all, by the procedures set forth in TBMP § 404.03(c).

404.04 Persons Before Whom Depositions May be Taken

Fed. R. Civ. P. 28. Persons Before Whom Depositions May Be Taken
(a) *Within the United States. Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the*

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[62] *See also* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984).

[63] *See Rhone-Poulenc Industries v. Gulf Oil Corp.,* 198 USPQ 372 (TTAB 1978). and *Jonergin Co. v. Jonergin Vermont Inc.,*222 USPQ 337 (Comm'r 1983).

[64] *See* 37 CFR § 2.120(c)(2).

examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.

(b) *In Foreign Countries. Depositions may be taken in a foreign country (1) pursuant to any applicable treaty or convention, or (2) pursuant to a letter of request (whether or not captioned a letter rogatory), or (3) on notice before a person authorized to administer oaths in the place where the examination is held, either by the law thereof or by the law of the United States, or (4) before a person commissioned by the court, and a person so commissioned shall have the power by virtue of the commission to administer any necessary oath and take testimony. A commission or a letter of request shall be issued on application and notice and on terms that are just and appropriate. It is not requisite to the issuance of a commission or a letter of request that the taking of the deposition in any other manner is impracticable or inconvenient; and both a commission and a letter of request may be issued in proper cases. A notice of commission may designate the person before whom the deposition is to be taken either by name or descriptive title. A letter of request may be addressed "To the Appropriate Authority in [here name the country]." When a letter of request or any other device is used pursuant to any applicable treaty or convention, it shall be captioned in the form prescribed by that treaty or convention. Evidence obtained in response to a letter of request need not be excluded merely because it is not a verbatim transcript, because the testimony was not taken under oath, or because of any similar departure from the requirements for depositions taken within the United States under these rules.*
(c) *Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.*

Discovery depositions in Board inter partes proceedings may be taken before the persons designated by Rule 28 of the Federal Rules of Civil Procedure.

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a Board proceeding discovery deposition "shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending."[65] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter that is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a Board proceeding discovery deposition may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a Board proceeding discovery deposition taken of a willing witness in a foreign country usually may be taken on notice before a United States

[65] *See* Fed. R. Civ. P. 28(a).

consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed.[66] A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

404.05 Notice of Deposition

Fed. R. Civ. P. 30(b) Notice of Examination: General Requirements*; ...*
(1) A party desiring to take the deposition of any person upon oral examination shall give reasonable notice in writing to every other party to the action. The notice shall state the time and place for taking the deposition and the name and address of each person to be examined, if known, and, if the name is not known, a general description sufficient to identify the person or the particular class or group to which the person belongs. ...

37 CFR § 2.124(b)(2) [Depositions upon written questions] *A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.*

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party may be taken on notice alone.

Prior to the taking of a discovery deposition on notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party.[67]

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[66] *See* Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2083 (1994).

[67] *See* Fed. R. Civ. P. 30(b)(1), and 37 CFR §§ 2.120(c), 2.124(b)(2), and 2.124(c). *Cf.* 37 CFR § 2.123(c); Fed. R. Civ. P. 31(a)(3); and TBMP § 703.01(e) (Notice of Testimony Deposition).

The elements to be included in the notice are specified in Fed. R. Civ. P. 30(b)(1), for a deposition on oral examination, and in 37 CFR §§ 2.124(b)(2) and 2.124(c), for a deposition on written questions.[68] It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition. The deposition must be taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period).[69]

In noticing the deposition of a corporation, partnership, association, governmental agency, or other juristic person, the deposing party may, in lieu of naming a person to be deposed, simply name as the deponent the corporation, partnership, association, governmental agency, or other juristic person, and describe with reasonable particularity the matters on which examination is requested. The named organization must, in turn, designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may state, for each person designated, the matters on which he or she will testify. Each designated person must testify not only as to those matters within his or her knowledge, but also as to matters known or reasonably available to the organization.[70]

For information concerning the procedure for combining a notice of taking a discovery deposition with a request for production of documents, see TBMP § 406.01.

404.06 Taking a Discovery Deposition

The manner of taking a discovery deposition in an inter partes proceeding before the Board is very similar to taking a testimony deposition.[71]

For information concerning the procedure for taking a testimony deposition (including the examination of witnesses, the form of a deposition, and the protection of confidential information or trade secret material forming part of a deposition transcript or exhibits thereto) see TBMP §§ 703.01 and 703.02. *For a discussion of significant differences between discovery depositions and testimony depositions, see* TBMP § 404.09. *For information concerning the procedure for taking a discovery deposition on written questions, see* TBMP § 404.07.

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[68] *See also, e.g., Red Wing Co. v. J.M. Smucker Co.,* 59 USPQ2d 1861, 1864 (TTAB 2001) (subject matter of deposition to be described with reasonable particularity in the notice).

[69] *See* TBMP § 403.02 (Time for Service of Discovery Requests).

[70] *See* Fed. R. Civ. P. 30(b)(6) and 31(a)(3), and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383 (1985).

[71] *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991).

On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone.[72] A deposition taken by telephone is regarded as taken in the Federal judicial district and at the place where the witness is to answer the questions propounded to him or her.

404.07 Discovery Depositions on Written Questions

Discovery depositions on written questions are taken in the manner prescribed by 37 CFR § 2.124.

404.07(a) Depositions on Written Questions: Before Whom Taken

37 CFR § 2.124(a) *A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.*

A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28.[73]

404.07(b) Depositions on Written Questions: When Taken

37 CFR § 2.120(a) *... Discovery depositions must be taken, ...on or before the closing date of the discovery period as originally set or as reset.*

Discovery depositions must be both noticed and taken during the discovery period.[74] Thus, it is recommended that a party, which desires to take a discovery deposition on written questions, initiate the procedure early in its discovery period.

404.07(c) Depositions on Written Questions: Place of Deposition

For information concerning the place where a discovery deposition on written questions is taken, see TBMP § 404.03.

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[72] *See* Fed. R. Civ. P. 30(b)(7), and *Hewlett-Packard Co. v. Healthcare Personnel Inc., supra at* 1553 (leave to take telephonic depositions should be liberally granted in appropriate cases current federal practice favors use of technological benefits).

[73] *See* 37 CFR § 2.124(a) and TBMP § 404.04 (Persons Before Whom Depositions May be Taken).

[74] *See* 37 CFR § 2.120(a). *See also* TBMP § 404.01 (When and by Whom Taken).

404.07(d) Depositions on Written Questions: Notice of Deposition

37 CFR § 2.124(b)(2) *A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery disposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.*

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

(d)(1) *Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. ...*

A party that desires to take a discovery deposition on written questions must serve notice thereof on each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board.[75]

The notice must state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the person is to be provided so the responding party can designate one or more persons to be deposed. The notice must also be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken, and by the written questions to be propounded on behalf of the deposing party.[76]

For further information concerning notices of deposition in general, *see* TBMP § 404.05.

404.07(e) Depositions on Written Questions: Examination of Witness

37 CFR § 2.124(d)(1) *Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions*

[75] *See* 37 CFR § 2.124(b)(2).

[76] *See* 37 CFR §§ 2.124(b)(2), 2.124(c), and 2.124(d)(1).

upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(d)(2) *Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. ...*

(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.*

Within 20 days from the date of service of the notice (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight courier,[77] any adverse party may serve cross questions on the deposing party. A party that serves cross-questions on the deposing party must also serve copies thereof on every other adverse party. Within 10 days from the date of service of the cross questions (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), any party that served cross-questions may serve recross questions on the deposing party. A party which serves recross questions on the deposing party must also serve copies thereof on every other adverse party.[78]

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[77] *See* 37 CFR § 2.119(c).

[78] *See* 37 CFR § 2.124(d)(1). *See also Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

Written objections to questions may be served on the party that propounded the questions. A party that serves objections on a propounding party must also serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). The substitute questions must also be served on every other adverse party.[79]

As all discovery depositions must be completed within the discovery period, including depositions on written questions, on motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 CFR § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions to allow for the orderly completion of the depositions on written questions.[80]

Within 10 days after the last date when questions, objections, or substitute questions may be served, the deposing party must mail a copy of the notice and copies of all the questions to the officer designated in the notice. A copy of the notice and of all the questions mailed to the officer must also be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question.[81]

404.07(f) Depositions on Written Questions: Objections

37 CFR § 2.124(d)(1) *... Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.*

* * * *

(g) *Objections to questions and answers in depositions upon written questions may be considered at final hearing.*

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[79] *See* 37 CFR § 2.124(d)(1). *See also Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990).

[80] *See* 37 CFR § 2.124(d)(2). *Cf.* 37 CFR § 2.124(d)(2) *regarding suspension of proceedings for testimonial depositions on written questions.*

[81] *See* 37 CFR § 2.124(e).

Written objections to questions propounded for a deposition on written questions may be served on the party that propounded the questions. Any party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party.[82]

Objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board (unless waived) at final hearing.[83]

For further information concerning the raising of objections to discovery depositions, see TBMP § 404.08. *For information concerning the raising of objections to a notice of reliance on a discovery deposition, see* TBMP §§ 707.02 and 532.

404.07(g) Depositions on Written Questions: Form of Deposition; Signature

37 CFR § 2.124(e) *... The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question.*

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question.[84]

For further information concerning the form of a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(g), and TBMP § 703.01(i). *For information concerning signature of a deposition taken in an inter partes proceeding before the Board, see* 37 CFR § 2.123(e)(5), and TBMP § 703.01(j).

404.07(h) Depositions on Written Questions: Certification of Deposition

37 CFR § 2.124(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after*

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[82] *See* 37 CFR § 2.124(d)(1). *See also* TBMP § 703.02(k) (Objections to Testimony Depositions on Written Questions).

[83] *See* 37 CFR § 2.124(g), and *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy deferred until final hearing).

[84] *See* 37 CFR § 2.124(e).

the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. When the transcript has been certified, the officer should mail the transcript and exhibits to the party that took the deposition.[85]

404.07(i) Depositions on Written Questions: Service, Correction, and Making the Deposition of Record

37 CFR § 2.124(f) *The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see §2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by §2.120(j). ...*

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party.[86] The party that took the deposition must also assure that the transcript is correct.[87]

If the discovery deposition is to be made of record, the same procedures provided by 37 CFR § 2.120(j) are to be followed.[88]

404.07(j) Deposition on Written Questions: Utility

A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered.

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[85] *See* 37 CFR § 2.124(e). *For further information concerning certification of a deposition taken in an inter partes proceeding before the Board, see, for example*, 37 CFR § 2.123(f), and TBMP § 703.01(k).

[86] *See* 37 CFR § 2.124(f). *See also* TBMP § 703.01(m) *regarding service of testimony deposition transcript.*

[87] *See* 37 CFR §§ 2.124(f) and 2.125(b). *For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, see* TBMP § 703.01(n).

[88] *See* 37 CFR § 2.124(f). *See also*, *with respect to making a discovery deposition of record*, TBMP § 704.09 and *Fischer Gesellschaft M.b.H. v. Molnar and Co., Inc.*, 203 USPQ 861 (TTAB 1979).

Moreover, it deprives an adverse party of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions.[89]

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country. Moreover, the deposition on written questions is generally less expensive than the deposition on oral examination, and is usually more convenient for the witness.

404.08 Discovery Deposition Objections

404.08(a) Objections to Notice

Objections to errors and irregularities in a notice of the taking of a discovery deposition must be promptly served, in writing, on the party giving the notice; any such objections that are not promptly served are waived.[90] *For information concerning the raising of objections to a notice of reliance on a discovery deposition, see* TBMP §§ 707.02 and 532.

404.08(b) Objections as to Disqualification of Officer

An objection to the taking of a discovery deposition because of a disqualification of the officer before whom the deposition is to be taken, is waived unless it is made before the

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[89] *See* 37 CFR 2.124(d)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989); and Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253, 253 (1980). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985); and TBMP § 703.02(m) (Utility of Testimony Depositions on Written Questions).

[90] *See* Fed. R. Civ. P. 32(d)(1). *Compare S. Industries Inc. v. Lamb-Weston Inc.,* 45 USPQ2d 1293 (TTAB 1997) (Board will not rule in advance of deposition as to whether information sought is confidential or otherwise objectionable) *and Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (objections to subject matter of deposition may only be raised during, not prior to, the deposition) *with Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (objections to subject matter of 30(b)(6) deposition raised prior to deposition).

Cf., generally, with regard to notice of testimony depositions, 37 CFR § 2.123(j); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (premature taking of testimony deposition could have been corrected upon seasonable objection); *Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony deposition excluded where notice did not name witness and objection was timely made and consistently maintained), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982). *For additional case cites, see Appendix of Cases.*

deposition begins, or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence.[91]

404.08(c) Objections During Deposition

Fed. R. Civ. P. 32(d)(3)(A) *Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.*

(B) *Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.*

Objections to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony "are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time."[92]

In the case of a discovery deposition taken on oral examination, objections to errors and irregularities occurring at the deposition in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and objections to errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonably made at the deposition.[93]

For information concerning objections to the form of questions in the case of a discovery deposition on written questions, see TBMP § 404.07(f).

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential.[94] If a witness, having

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[91] *See* Fed. R. Civ. P. 32(d)(2). *Cf.* 37 CFR § 2.123(j).

[92] *See* Fed. R. Civ. P. 32(d)(3)(A). *Cf.* 37 CFR § 2.123(k).

[93] *See* Fed. R. Civ. P. 32(d)(3)(B). *Cf.* 37 CFR § 2.123(j).

[94] *See* 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b), 30(c), and 37(a); Fed. R. Evid. 501; and Wright, Miller & Marcus, *Federal Practice and Procedure*: *Civil 2d* § 2113 (1994). *See also Johnston Pump/General Valve Inc. v.*

stated an objection to a discovery deposition question, answers the question subject to the objection, and the deposition is subsequently made of record in the proceeding pursuant to the provisions of 37 CFR §§ 2.120(j)(1), (2), (3)(i), and (4), the propriety of the objection will be considered by the Board at final hearing when the objections are preserved and raised in the final briefs; that is, the Board will evaluate the testimony in light of the stated objection.[95]

For information concerning the propounding party's options if a witness not only objects to, but also refuses to answer, a particular question during a discovery deposition, see TBMP § 411.03.[96]

404.09 Discovery Depositions Compared to Testimony Depositions

A discovery deposition, like a testimony deposition, may be taken either on oral examination or on written questions.[97] In fact, the actual taking of a discovery deposition is very similar to the taking of a testimony deposition. Nevertheless, there are substantial differences between the two, stemming from the differences between the discovery and trial stages of a proceeding. Some of the most significant differences are discussed below. A discovery deposition is a broad discovery device used by a party to obtain from an adversary information about the adversary's case, or to obtain from a nonparty information that may be helpful to the deposing party's case. The discovery deposition is taken of the adversary or a nonparty, or an official or employee of the adversary or a nonparty. A testimony deposition, on the other hand, is a narrower device used by a party to present evidence in support of its own case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party.[98]

Chromalloy American Corp., 10 USPQ2d 1671, 1676 (TTAB 1988) (Board, upon motion to compel, allowed parties time to work out protective order under which confidential information would be provided).

[95] *See* 37 CFR § 2.120(j)(3)(i); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979) (objections to discovery deposition questions should be preserved and argued in the briefs at final hearing); and *Neville Chemical Co. v. Lubrizol Corp.,* 183 USPQ 184, 189 (TTAB 1974).

[96] *See also Neville Chemical Co. v. Lubrizol Corp., supra* (if opposer objects to and refuses to answer certain deposition questions, applicant may seek subpoena for immediate resolution or file motion to compel answers).

[97] *See* Fed. R. Civ. P. 26(a).

[98] *See Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978) and *Bison Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987). *See also* Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time.[99] A party may only take a testimony deposition during the party's assigned testimony period; each party has an assigned testimony period, and only the party to which a particular testimony period is assigned may take testimony therein.[100]

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence.[101] In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection.[102]

In both types of depositions, questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged or confidential.[103] Both types of depositions are taken out of the presence of the Board, and if a witness not only objects to, but also refuses to answer a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by adjourning the deposition and applying, under 35 U.S.C. § 24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer.[104]

In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the Board to compel the witness to answer the unanswered question.[105] A motion to compel is not available, however, in the case of a testimony deposition taken in a proceeding before the Board,

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[99] *See Smith International, Inc. v. Olin Corp., supra*; *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978); and TBMP § 403.02 (Time for Service of Discovery Requests).

[100] *See* 37 CFR § 2.121(a)(1).

[101] *See* Fed. R. Civ. P. 26(b)(1).

[102] *See* 37 CFR §§ 2.122(a) and 2.123(k), and TBMP § 533 (motions to strike trial testimony depositions).

[103] *See* 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b)(5), 30(c), and 37(a)(2)(B); Fed. R. Evid. 501; and Wright, Miller & Marcus, *Federal Practice and Procedure*: Civil 2d § 2113 (1994).

[104] *See Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974). *See also S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953).

[105] *See* 37 CFR § 2.120(e) and *Neville Chemical Co. v. Lubrizol Corp., supra*.

nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition.[106]

Accordingly, in those cases where the witness in a *testimony* deposition refuses to answer a particular question, no court action is sought, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony.[107]

A discovery deposition does not form part of the evidentiary record in a case unless a party entitled to offer it into evidence files, during the party's testimony period, the deposition together with a notice of reliance thereon.[108] That is, the offering of a discovery deposition in evidence is voluntary, not mandatory.[109] Every testimony deposition taken *must* be filed, and, when filed, becomes part of the record; a notice of reliance thereon is not necessary.[110]

The discovery deposition of an adverse party may be taken on notice alone.[111] However, the testimony deposition of an adverse party, unless obtained voluntarily, may only be taken pursuant to a subpoena issued by a United States district court.[112]

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[106] *See Jain v. Ramparts Inc.,* 49 USPQ2d 1429 (TTAB 1998) (motion to compel not available) and *Ferro Corp. v. SCM Corp., supra.* (should have applied to district court for order compelling answers).

[107] *See Health-Tex Inc. v. Okabashi (U.S.) Corp.,* 18 USPQ2d 1409, 1411 (TTAB 1990) (a refusal to answer, if found to be unjustified, may be construed against the objecting party). *See also* TBMP § 707.03(d) (refusal to answer testimony deposition question), and authorities cited therein.

[108] *See* TBMP § 704.09 (introducing discovery depositions into evidence).

[109] *See, for example, Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); 37 CFR §§ 2.120(j)(1), (j)(2), and (j)(3)(i); TBMP § 704.09 (introducing discovery depositions); and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Reporter 353 (1980).

[110] *See generally* 37 CFR § 2.123, and TBMP § 703.01(l) (Testimony Deposition Must be Filed).

[111] *See* TBMP § 404.03 (Securing Attendance of Deponent).

[112] *See* 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976); and TBMP § 703.01(f) (Securing Attendance of Adverse Party or Nonparty). *For further information concerning differences between discovery and testimony depositions, see Fischer Gesellschaft m.b.H. v. Molnar & Co., supra* (discovery deposition of nonparty is not admissible as evidence under a notice of reliance absent compelling circumstances or consent of the adverse party given the functional and historical differences between discovery and trial); *Smith International, Inc. v. Olin Corp., supra*; and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

405 Interrogatories

405.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written interrogatories on any other party.[113] Interrogatories may be served on an adversary from the day discovery opens through the last day of the discovery period, even though the answers thereto will not be served until after the discovery period has closed.[114]

405.02 Scope

Interrogatories may seek any information that is discoverable under Fed. R. Civ. P. 26(b)(1).[115] An interrogatory that is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact.[116]

405.03 Limit on Number

405.03(a) Description of Limit

37 CFR § 2.120(d)(1) *The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties. A motion for leave to serve additional interrogatories must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. ...*

The total number of interrogatories which a party may serve on another party, in a proceeding, may not exceed 75, counting subparts, except that the Board, may allow

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[113] *See* TBMP § 403.01 (Timing of Discovery in General).

[114] *See* TBMP § 403.02 (Time for Service of Discovery Requests).

[115] *See* Fed. R. Civ. P. 33(c).

[116] *See* Fed. R. Civ. P. 33(b); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (query whether opposer believes marks in question to be confusingly similar must be answered even though it requires opposer to draw legal conclusion). *See also Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973).

additional interrogatories on motion therefor showing good cause, or on stipulation of the parties.[117]

405.03(b) Application of Limit: Sets of Interrogatories

The numerical limit of 37 CFR § 2.120(d)(1) pertains to the total number of interrogatories that one party may serve on another party over the course of an entire proceeding, not just per set of interrogatories. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of interrogatories directed to the same party, the interrogatories in the separate sets would be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded.[118]

Accordingly, a party which is preparing a first set of interrogatories should reserve a portion of its allotted 75 interrogatories (counting subparts) to use for follow-up discovery, unless it is sure that it will not be serving follow-up interrogatories.

405.03(c) Application of Limit: Multiple Marks, Etc.

Trademark Rule 2.120(d)(1) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional interrogatories. However, a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex

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[117] *For information on motions for leave to serve additional interrogatories, see* TBMP § 519.

[118] *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

issues, and these are factors that will be considered in determining a motion for leave to serve additional interrogatories.[119]

405.03(d) Application of Limit: Counting Interrogatories

In determining whether the number of interrogatories served by one party on another exceeds the limit of 37 CFR § 2.120(d)(1), the Board will count each subpart within an interrogatory as a separate interrogatory, regardless of whether the subpart is separately designated (i.e., separately numbered or lettered).[120]

If an interrogatory includes questions set forth as numbered or lettered subparts, each separately designated subpart will be counted by the Board as a separate interrogatory. The propounding party will, to that extent, be bound by its own numbering system, and will not be heard to complain that an interrogatory, although propounded with separately designated subparts, should nevertheless be counted as a single interrogatory because the interrogatory concerns a single transaction, state of facts, etc., or because the division was made for clarification or convenience.[121]

On the other hand, if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory.[122] For example, if two or more questions are combined in a single compound interrogatory, and are not set out as

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[119] *See* Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra.*

[120] *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

[121] *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., supra*; *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra.*

[122] *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra.*

separate subparts, the Board will look to the substance of the interrogatory, and count each question as a separate interrogatory.[123]

If an interrogatory contains both an initial question, and follow-up questions to be answered if the first is answered in the affirmative, the initial question and each follow-up question will be counted as separate interrogatories.[124]

Similarly, if an interrogatory begins with a broad introductory clause ("Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:") followed by several subparts ("Applicant's date of first use of the mark on the goods listed in the application," "Applicant's date of first use of the mark on such goods in commerce," etc.), the Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated.[125]

If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests "all relevant facts and circumstances" concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory.[126]

The introductory instructions or preamble to a set of interrogatories will not be counted by the Board as interrogatories or subparts for purposes of determining whether the limit specified in 37 CFR § 2.120(d)(1) has been exceeded. On the other hand, the Board's determination, on a motion to compel, of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble; the Board is not bound by

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[123] *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

[124] *See Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*..

[125] *Cf. Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*..

[126] *See* Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra;* and Notice of Final Rulemaking, published in the *Federal Register* on August 22, 1989 at 54 FR 34886 and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26.

the instructions or preamble, and will make its own independent determination of the adequacy of the answer, without regard to the instructions or preamble.[127]

405.03(e) Remedy for Excessive Interrogatories

37 CFR § 2.120(d)(1) *... If a party upon which interrogatories have been served believes that the number of interrogatories served exceed the limitation specified in this paragraph, 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. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.*

If a party on which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, 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.[128] A party should not answer what it considers to be the first seventy-five interrogatories and object to the rest as excessive.[129]

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of Rule 2.120(e), including the requirement that a motion to compel be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable

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[127] *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992) and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra.*

[128] *See* 37 CFR § 2.120(d)(1) and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

[129] *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

to reach agreement.[130] It is further recommended that the moving party set out its counting method showing that the number of interrogatories does not exceed seventy-five.[131]

If, on determining a motion to compel filed in response to a general objection to interrogatories on the ground of excessive number, the Board finds that the interrogatories are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not exceeding the numerical limit. The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely.[132]

However, if the revised set is not served until after the close of the discovery period, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information not sought in the excessive set.[133]

Although there are no limitations on the number of document requests that may be served, a party may properly refuse to respond to a document request seeking all documents identified or referred to in response to interrogatories if the number of interrogatories is believed to be excessive.[134]

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[130] *See* 37 CFR §§ 2.120(d)(1) and 2.120(e); and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

[131] *For further information concerning motions to compel discovery, see* TBMP § 523.

[132] *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.,* 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc*., 16 USPQ2d 1468, 1469 (TTAB 1990). *See also Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.,* 16 USPQ2d 1398 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd*., 15 USPQ2d 1572 (TTAB 1990); and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1),* 82 Trademark Rep. 89 (1992).

Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 USPQ2d 1466, 1468 n.6 (TTAB 1990) (opposer may seek answers by taking discovery deposition of applicant).

[133] *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*..

[134] *See Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1399 (TTAB 1990) (refusal to respond to document requests was proper; petitioner could not respond to document requests without first having to answer excessive interrogatories).

In those cases where a party which has propounded interrogatories realizes, on receipt of a general objection thereto on the ground of excessive number, that the interrogatories are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of interrogatories, in the manner normally allowed by the Board, instead of bringing their dispute to the Board by motion to compel.[135]

[NOTE: Although some of the cases cited in this TBMP section were decided under an earlier version of 37 CFR § 2.120(d)(1) governing the procedure for objecting to interrogatories on the basis of their excessive number, the decisions are otherwise applicable to the issues which may arise under Rule 2.120(d)(1).[136]

405.04 Responses to Interrogatories

405.04(a) Time for Service of Responses

Responses to interrogatories must be served within 30 days after the date of service of the interrogatories.[137] If service of the interrogatories is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the interrogatories.[138]

A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits.[139] Objections going to the merits of an interrogatory or

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[135] *See* Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), supra*.

[136] *See* Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

[137] *See* TBMP § 403.03 (Time for Service of Discovery Responses).

[138] *See* 37 CFR § 2.119(c), and TBMP §§ 113.05 (Additional Time for Service by Mail) and 403.03 (Time for Service of Discovery Responses).

[139] *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding time to respond); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (although party failed to timely respond to

other discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.[140] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.[141]

405.04(b) Nature of Responses

Ordinarily, a party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer.[142] If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, 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.[143]

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto.[144]

In some cases, the information sought in an interrogatory may be derived or ascertained from the business records of the responding party, or from an examination, audit, or inspection of those business records (including a compilation, abstract, or summary thereof) and the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party. In those cases, the responding party may answer the interrogatory by itself providing, in its written answer to the interrogatory, the information sought. Alternatively, the responding party may answer the interrogatory by specifying the records from which the information may be

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discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel).

[140] *See No Fear Inc. v. Rule*, *supra* at 1554.

[141] *See No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

[142] *See* Fed. R. Civ. P. 33(b)

[143] *See* 37 CFR § 2.120(d)(1), and TBMP § 405.03(e) (Remedy for Excessive Interrogatories).

[144] *See* G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts, or summaries. If the responding party elects to answer an interrogatory by specifying and producing business records, the specification must be in sufficient detail to permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained.[145]

A responding party cannot simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents.[146]

It is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those interrogatories that it believes to be proper and stating its objections to those that it believes to be improper.[147]

405.04(c) Signature of Responses

Interrogatories must be answered by the party served. If the party served is a corporation, partnership, association, or governmental agency, the interrogatories must be answered by an officer or agent, who must furnish whatever information is available to the party served.[148]

The term "agent" includes an attorney, who may answer even though he has no personal knowledge of the facts stated in the answers; the attorney's answers, like an officer's answers, must contain the information available to the party served.[149] However, an attorney who answers interrogatories on behalf of a corporation, partnership, association, or governmental agency may thereafter be exposed to additional discovery and possibly even disqualification.[150]

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[145] *See* Fed. R. Civ. P. 33(c); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (responding party may not merely agree to provide access to voluminous records which may contain responsive information); and *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1435 (TTAB 1998) (identifying prerequisites for exercising the option to produce business records in lieu of answering interrogatories).

[146] *See* Wright, Miller & Marcus, *Federal Practice and Procedure:* Civil 2d § 2178 (1994) and *No fear Inc. v. Rule*, *supra*.

[147] *See* TBMP § 410 (Asserting Objections to Discovery).

[148] *See* Fed. R. Civ. P. 33(a) and (b).

[149] *See Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1665 (TTAB 1988).

[150] *See* 37 CFR § 10.63, and *Allstate Insurance Co. v. Healthy America Inc., supra..*

Answers to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them.[151]

406 Requests for Production of Documents and Things

406.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve requests for production of documents and things on any other party.[152] Requests for production may be served from the day discovery opens through the last day of the discovery period, even though the answers thereto may not be served until after the discovery period has closed.[153]
If requests for production are combined with a notice of taking a discovery deposition (i.e., if it is requested that the deponent bring designated documents to the deposition), the requests for production must be served at least 35 days prior to the scheduled date of the deposition if service of the requests for production is made by first-class mail, "Express Mail," or overnight courier, and at least 30 days prior to the deposition if service of the requests for production is made by one of the other methods specified in 37 CFR § 2.119(b).[154]

If a discovery deposition deponent is a nonparty witness residing in the United States[155] production of designated documents by the witness at the deposition may be obtained by means of a subpoena duces tecum.[156] A subpoena is unnecessary, however, if the nonparty witness is willing to produce the documents voluntarily.

406.02 Scope

Fed. R. Civ. P. 34(a) Scope. *Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on the requestor's behalf, to inspect and copy, any designated documents (including writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations from which information can be obtained, translated,*

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[151] *See* Fed. R. Civ. P. 33(b)(2).

[152] *See* Fed. R. Civ. P. 34(a); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); and TBMP § 403.01 (Timing of Discovery In General).

[153] *See* TBMP § 403.02 (Time for Discovery Responses).

[154] *See* Fed. R. Civ. P. 34(b); 37 CFR § 2.119(c); and TBMP §§ 113.04 (Manner of Service), 113.05 (Additional Time for Service by Mail), and 403.03 (Time for Service of Discovery Responses).

[155] *See* TBMP § 404.03(a)(2) (Nonparty Residing in U.S.).

[156] *See* Fed. R. Civ. P. 45 and 35 U.S.C. § 24.

if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served; or (2) to permit entry upon designated land or other property in the possession or control of the party upon whom the request is served for the purpose of inspection and measuring, surveying, photographing, testing, or sampling the property or any designated object or operation thereon, within the scope of Rule 26(b).

The scope of a request for production, in an inter partes proceeding before the Board, is governed by Fed. R. Civ. P. 34(a), which in turn refers to Fed. R. Civ. P. 26(b).[157]

Generally, a party does not have an obligation to locate documents that are not in its possession, custody or control and produce them during discovery.[158]

Because proceedings before the Board involve only the right to register trademarks, the request for entry upon land for inspection and other purposes is rarely, if ever, used in Board proceedings.

406.03 Elements of Request for Production; Place of Production

Fed. R. Civ. P. 34(b) Procedure*. The request shall set forth, either by individual item or by category, the items to be inspected and describe each with reasonable particularity. The request shall specify a reasonable time, place, and manner of making the inspection and performing the related acts. ...*

37 CFR § 2.120(d)(2) *The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.*

A request for production must include the elements specified in Fed. R. Civ. P. 34(b), as set forth above.

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[157] *For a discussion of the scope of discovery permitted under Fed. R. Civ. P. 26(b), see* TBMP § 402 (Scope of Discovery).

[158] *See* Fed. R. Civ. P. 34(c) for discovery of documents in possession of a third party. *See also Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999), *appeal filed, Pro-Football, Inc. v. Harjo, mot. to dismiss denied*, *(not reported in F.Supp.2d)*, 57 USPQ2d 1140 (D.D.C. 2000).

The place of production is governed by 37 CFR § 2.120(d)(2).[159] However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party.[160]

On motion pursuant to 37 CFR § 2.120(d)(2), the Board may order the place and the manner in which the documents are to be produced. The Board may, for example, order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party when the responding party has unreasonably refused to produce documents.[161]

406.04 Responses to Requests for Production

406.04(a) Time for Service of Responses

Responses to requests for production must be served within 30 days after the date of service of the requests.[162] If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests.[163]

A party which fails to respond to requests for production during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the requests on their merits.[164]

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[159] *See also Electronic Industries Assn. v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1015 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976) (documents requested to be produced as part of a discovery deposition would be produced where they are located); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449, 451 (1984).

[160] *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) and *Electronic Industries Assn. v. Potega*, *supra*.

[161] *See No Fear Inc. v. Rule, supra* at 1555 (at the responding party's expense as a discovery sanction); *Unicut Corp. v. Unicut, Inc., supra* (at the requesting party's expense); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, supra*. *Cf. Electronic Industries Assn. v. Potega, supra.*

[162] *See* Fed. R. Civ. P. 34(b), 37 CFR § 2.120(a) and TBMP § 403.03 (Time for Service of Responses).

[163] *See* 37 CFR § 2.119(c) and TBMP §§ 113.05 (Additional Time for Mail) and 403.03 (Time for Responses).

[164] *See* TBMP §§ 403.03 (Time for Responses) and 405.04(a) (Time for Responses to Interrogatories) and cases cited therein. *See also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (applicant, having waived its right to object to discovery requests on their merits was not entitled to raise objection regarding place of production of documents).

406.04(b) Nature of Responses

A response to a request for production of documents and things must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated.[165] If objection is made to only part of an item or category, the part must be specified. A party that produces documents for inspection must produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request.[166]

It is generally inappropriate for a party to respond to requests for production by filing a motion attacking them, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by indicating, with respect to those requests that it believes to be proper, that inspection and related activities will be permitted, and by stating reasons for objection with respect to those requests that it believes to be improper.[167]

407 Requests for Admissions

407.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written requests for admissions on any other party.[168] Like interrogatories and requests for production of documents, requests for admission may be served on an adversary from the day the discovery period opens through the last day of the discovery period, even though the answers thereto will not be due until after the discovery period has closed.[169]

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[165] *See* Fed. R. Civ. P. 34(b) and *No Fear Inc. v. Rule*, *supra* at 1555 (a proper response requires stating as to each request either that there are responsive documents and they will be produced (or withheld on a claim of privilege) or stating party has no responsive documents).

[166] *See* Fed. R. Civ. P. 34(b) and *No Fear Inc. v. Rule*, *supra* at 1556, *citing* 8A Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2213 (2d ed. 1994) (party may not simply dump large quantities of documents containing responsive as well as unresponsive documents).

[167] *See* TBMP § 410 (Asserting Objections).

[168] *See* Fed. R. Civ. P. 36(a) and TBMP § 403.01 (Time of Discovery In General).

[169] *See* TBMP § 403.02 (Time for Requests).

407.02 Scope and Nature of Requests for Admission

Fed. R. Civ. P. 36(a) Request for Admission. *A party may serve upon any other party a written request for the admission, for purposes of the pending action only, of the truth of any matters within the scope of Rule 26(b)(1) set forth in the request that relate to statements or opinions of fact or of the application of law to fact, including the genuineness of any documents described in the request. Copies of documents shall be served with the request unless they have been or are otherwise furnished or made available for inspection and copying. ...*

Each matter of which an admission is requested shall be separately set forth. ...
The scope and nature of requests for admission, in inter partes proceedings before the Board, are governed by Fed. R. Civ. P. 36(a), which in turn refers to Fed. R. Civ. P. 26(b)(1).[170]

Requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters that must be tried.[171] These requests are also useful as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents.[172]

407.03 Responses to Requests for Admission

407.03(a) Time for Service of Responses

Responses to requests for admission must be served within 30 days after the date of service of the requests.[173] If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests.[174]

If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect or unless a motion to withdraw or

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[170] *For a discussion of the scope of discovery permitted under Fed. R. Civ. P. 26(b)(1), see* TBMP § 402.01. *See also* TBMP § 402.02 (Limitations).

[171] Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985).

[172] *See* TBMP § 403.05(b) (Facilitates Introduction).

[173] *See* TBMP § 403.03 (Time for Service of Responses).

[174] *See* 37 CFR § 2.119(c), and TBMP §§ 113.05 (Additional Time) and 403.03 (Time for Discovery Responses).

amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board.[175]

For information concerning motions pursuant to Fed. R. Civ. P. 36(b) to withdraw or amend admissions, see TBMP § 525.

407.03(b) Nature of Responses

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested.[176]

The Board prefers that the responding party reproduce each request immediately preceding the answer or objection thereto.[177]

An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. "*A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny*."[178]

If the responding party objects to a request for admission, the reasons for objection must be stated. If a responding party believes that a matter of which an admission has been

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[175] *See* Fed. R. Civ. P. 6(b) and 36(a); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) ("...where failure to timely respond to a request for admission has harsh result, Rule 36(b) provides method for obtaining relief."); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989); and *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979). *See also Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd, Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).
Cf. Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

[176] *See* Fed. R. Civ. P. 36(a).

[177] *See* G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

[178] Fed. R. Civ. P. 36(a).

requested presents a genuine issue for trial, the party may not object to the request on that ground alone. Rather, the party may deny the matter; alternatively, the party may set forth reasons why it cannot admit or deny the matter.[179]

It is generally inappropriate for a party to respond to requests for admission by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those requests that it believes to be proper and stating its reasons for objection to those that it believes to be improper.[180]

407.03(c) Signature of Responses

Answers and objections to requests for admission may be signed either by the responding party, or by its attorney.[181]

407.04 Effect of Admission

Any matter admitted (either expressly, or for failure to timely respond) under Fed. R. Civ. P. 36 is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission.[182]

For further information concerning motions to withdraw or amend an admission, see TBMP § 525.

An admission made by a party under Fed. R. Civ. P. 36 is only for the purpose of the pending proceeding. It is not an admission for any other purpose, nor may it be used against that party in any other proceeding.[183]

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[179] *See* Fed. R. Civ. P. 36(a).

[180] *See* TBMP § 410 (Asserting Objections).

[181] *See* Fed. R. Civ. P. 36(a).

[182] *See* Fed. R. Civ. P. 36(b). *See also American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (an admission not withdrawn or amended cannot be rebutted by contrary testimony at trial).

[183] *See* Fed. R. Civ. P. 36(b).

408 Duties to Cooperate, Search Records, Supplement

408.01 Duty to Cooperate

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case.[184]

It should be noted, in this regard, that under the provisions of Fed. R. Civ. P. 26(g)(2), the signature of an attorney or party to a discovery request, response, or objection:[185]

> *. . . constitutes a certification that to the best of the signer's knowledge, information, and belief, formed after a reasonable inquiry, the request, response, or objection is:*
>
> > *(A) consistent with [the Federal Rules of Civil Procedure] and warranted by existing law or a good faith argument for the extension, modification, or reversal of existing law;*
> > *(B) not interposed for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation; and*
> > *(C) not unreasonable or unduly burdensome or expensive, given the needs of the case, the discovery already had in the case, the amount in controversy, and the importance of the issues at stake in the litigation.*

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[184] *See, for example*, Fed. R. Civ. P. 26(g); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 13 USPQ2d 1719,1721 n.4 (TTAB 1989); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 10 USPQ2d 1671, 1675 (TTAB 1988) (in view of parties' impasse, Board was burdened with resolving numerous requests for discovery); *Luehrmann v. Kwik Kopy Corp.,* 2 USPQ2d 1303, 1305 (TTAB 1987) (both parties failed to cooperate, thus saddling Board with needless motions); *Sentrol, Inc. v. Sentex Systems, Inc*., 231 USPQ 666, 667 (TTAB 1986) (parties must narrow amount of disputed requests to reasonable number); *Unicut Corp. v. Unicut, Inc*., 222 USPQ 341, 344 (TTAB 1984) (failure to cooperate in discovery resulted in entry of sanctions); *Medtronic, Inc. v. Pacesetter Systems, Inc*., 222 USPQ 80, 83 (TTAB 1984) (it was clear from number and nature of opposer's discovery requests and applicant's blanket objections thereto that neither party was cooperating*). See also C. H. Stuart Inc. v. Carolina Closet, Inc.,* 213 USPQ 506 (TTAB 1980); *C. H. Stuart Inc. v. S. S. Sarna, Inc.,* 212 USPQ 386 (TTAB 1980); *Varian Associates v. Fairfield-Noble Corp*., 188 USPQ 581 (TTAB 1975); *Tektronix, Inc. v. Tek Associates, Inc.,* 183 USPQ 623 (TTAB 1974); and *Gastown Inc. of Delaware v. Gas City, Ltd.,* 180 USPQ 477 (TTAB 1974).

Cf. Micro Motion Inc. v. Kane Steel Co., 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990).

[185] *See also Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) *Cf.* 37 CFR § 10.18(a); Fed. R. Civ. P. 11; and TBMP § 106.02 (Signatures).

Provision is made, in Fed. R. Civ. P. 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule.

Because the signature of a party or its attorney to a request for discovery constitutes a certification by the party or its attorney that, *inter alia*, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another.[186]

408.02 Duty to Search Records

A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. A responding party which, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question) unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e).[187]

408.03 Duty to Supplement Discovery Response

Fed. R. Civ. P. 26(e) Supplementation of ... Responses. *A party who has ... responded to a request for discovery with a ... response is under a duty to supplement or correct the ... response to include information thereafter acquired if ordered by the court or in the following circumstances:*

* * * *

(2) *A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.*

The duty to supplement discovery responses in proceedings before the Board is governed by Fed. R. Civ. P. 26(e)(2).[188] Under that rule, a party that has responded to a request for discovery with

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[186] *See, for example, Miss America Pageant v. Petite Productions, Inc., supra at* 1069 (Board was persuaded that certain interrogatories would be unduly burdensome).

[187] *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987).

[188] *See* 37 CFR § 2.116(a).

a response is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2).[189] In addition, a duty to supplement responses may be imposed by order of the Board.[190]

409 Filing Discovery Requests and Responses With Board

37 CFR § 2.120(j) Use of discovery deposition, answer to interrogatory, or admission.

* * * *

(6) *Paragraph (j) of this section will not be interpreted to preclude the reading or the use of a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party*.

* * * *

(8) *Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.*

Discovery requests, discovery responses, and materials or depositions obtained through the discovery process, should not be filed with the Board except when submitted:

(1) With a motion relating to discovery [e.g., motion to compel, motion to determine the sufficiency of an answer or objection to a request for admission, motion for leave to serve additional interrogatories];

(2) In support of or in response to a motion for summary judgment;

(3) Under a notice of reliance during a party's testimony period; or

(4) As exhibits to a testimony deposition.

Authorities and cases regarding the filing of discovery materials with the Board are cited in the note below.[191]

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[189] *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998).

[190] *Cf. P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield Int'l, Inc*., 226 USPQ 431 (TTAB 1985); and *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60 (TTAB 1982).

In addition, when a party objects to proffered evidence on the ground that it should have been, but was not, provided in response to a request for discovery, a copy of the pertinent discovery request(s) and response(s) should be submitted in support of the objection.

Discovery papers or materials filed with the Board under circumstances other than those specified above may be returned to the party that filed them.[192]

410 Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery

The rules governing discovery in proceedings before the Board provide both for the assertion of objections to discovery requests believed to be improper, and a means (namely, the motion to compel, in the case of discovery depositions, interrogatories, and requests for production; and the motion to test the sufficiency of answers or objections, in the case of requests for admission) for testing the sufficiency of those objections. It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those that it believes to be improper.[193]

Further, if a party on which interrogatories have been served in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the responding party must,

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[191] *See* 37 CFR §§ 2.120(j)(6) and (j)(8). *See also The Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479, 1480 (TTAB 1990) (regarding combined sets of interrogatories which are subject to a motion relating to discovery); *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (regarding a motion for summary judgment); *Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc.*, 5 USPQ2d 1067, 1070 (TTAB 1987) (respondent again reminded that discovery materials are not to be filed with the Board except under specified circumstances); and *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979) (filing of a discovery deposition not required or desired in the absence of a notice of reliance); and G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163, 166-167 (1981) (but note that this article was written prior to the rule changes noted above).

[192] *See* 37 CFR § 2.120(j)(8).

[193] *See Red Wing Co. v. J.M. Smucker Co.,* 59 USPQ2d 1861, 1863 (TTAB 2001) (burden is on the party seeking the information to establish why it is relevant); *Luemme Inc. V. D.B. Plus Inc.,* 53 USPQ2d 1758, 1761 (TTAB 1999) and *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections with particularity). *See also Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974); and *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974).

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; a motion for a protective order is not the proper method for raising the objection of excessive number.[194]

Nevertheless, there are some situations in which a party may properly respond to a request for discovery by filing a motion attacking it. In cases where, for example, a request for discovery constitutes clear harassment, or where a defendant on which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest, the party on which the request was served may properly respond to it by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions.[195]

If the discovery sought is a discovery deposition, and the request therefor constitutes harassment, there is insufficient notice, etc., the party on which the request was served may file either a motion to quash the notice of deposition or a motion for a protective order.[196]

411 Remedy for Failure to Provide Discovery

411.01 Interrogatories or Requests for Production

If any party fails to answer any interrogatory, the party seeking discovery may file a motion with the Board for an order to compel an answer. Similarly, if any party fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion for an order to compel production and an opportunity to inspect and copy.[197]

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[194] *See* 37 CFR § 2.120(d)(1); TBMP § 405.03(e) (Remedy for Excessive Interrogatories); and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

[195] *See, for example,* 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c); *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high-level official granted); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted since obligation to respond to discovery requests rests with assignee)*;* and *Kellogg Co. v. New Generation Foods Inc.,* 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash one notice to depose person who was no longer an employee and another notice to depose person with authority to negotiate settlement, granted).

[196] *See, for example, FMR Corp. v. Alliant Partners, supra* at 1763 (motion for protective order) *and Kellogg Co. v. New Generation Foods Inc.,* 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash). *See also* TBMP § 521 (motion to quash) and TBMP § 526 (motion for a protective order).

[197] *See* 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a)(2)(B). *For information concerning motions to compel, see* TBMP § 523.

411.02 Requests for Admission

If a party on which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board.[198]

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the answer or objection.[199] If the Board determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served.[200]

411.03 Discovery Depositions

If a party fails to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(3), or if a party or such designated person, or an officer, director or managing agent of a party, fails to attend a discovery deposition, or fails to answer any question propounded in a discovery deposition, the party seeking discovery may file a motion with the Board for an order to compel a designation, or attendance at a deposition, or an answer.[201]

A discovery deposition is taken out of the presence of the Board, and if a witness objects to, and refuses to answer, a particular question, and the propounding party wishes to obtain an immediate ruling on the propriety of the objection, it may do so only by adjourning the deposition and applying, under 35 U.S.C. § 24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer.[202] In the absence of a court order compelling an answer, the propounding party's only alternative, if it

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[198] *See* TBMP § 407.03(a) (Time for Responses). *For information on motions to withdraw or amend admissions, see* TBMP § 525.

[199] *See* 37 CFR § 2.120(h), and Fed. R. Civ. P. 36(a).

[200] *See* Fed. R. Civ. P. 36(a). *For information on motions to determine the sufficiency of answers or objections to requests for admission, see* TBMP § 524.

[201] *See* 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a). *For information concerning motions to compel, see* TBMP § 523.

[202] *See Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974). *Cf. Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983) (where a witness refuses to answer a question in a testimony deposition). *See also S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953).

wishes to compel an answer, is to complete the deposition and then file a motion to compel with the Board.[203]

411.04 Discovery Sanctions

In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide discovery. The sanctions which may be entered by the Board include, *inter alia*, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; drawing adverse inferences against uncooperative party; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party.[204]

412 Protective Orders

37 CFR § 2.120(f) *Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party provide or permit discovery.*

412.01 In General

On motion, showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (1) through (8) of Fed. R. Civ. P. 26(c).[205]

For further information on motions for protective orders, see TBMP § 410 (Motions Attacking Requests for Discovery), TBMP § 412.02 (Protective Order Regarding Confidential and Trade Secret Information) and TBMP § 526 (Motion for Protective Order).

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[203] *See* 37 CFR § 2.120(e), and *Neville Chemical Co. v. Lubrizol Corp., supra.*

[204] *See* 37 CFR §§ 2.120(g)(1) and (2), and 2.127(f), and TBMP § 502.05 (Attorneys' Fees). *For further information concerning discovery sanctions and when they are available, see* TBMP § 527.01.

[205] *See* 37 CFR § 2.120(f). *See also* TBMP §§ 527.01(a) (sanctions), and 703.01(p) (confidential materials).

412.02 Protective Order Regarding Confidential and Trade Secret Information

412.02(a) Upon Motion

When the Board grants a motion for a protective order with respect to confidential or trade secret information, it may direct either the disclosing party, or the parties together, to prepare an order with terms that are mutually agreeable to them.[206] Other alternatives involve accepting a protective order proffered by a party, or ordering parties to adhere to Board's standard protective order.[207] If the Board orders that the parties abide by the terms of this order, the parties may subsequently agree to modifications or additions, subject to Board approval.

412.02(b) Upon Stipulation

Parties to proceedings before the Board may, and often do, enter into stipulated protective orders, that is, agreements as to specified procedures and restrictions that shall govern the disclosure of any confidential or trade secret information.[208] The Board has a standardized protective order which parties are free to use or modify as appropriate. The standardized protective order can be found in the Appendix of Forms in this manual and on the USPTO web site at: www.uspto.gov.

If the parties enter into a stipulated protective order, a copy of the executed agreement should be filed with the Board so that the Board is on notice that confidential material may be filed in connection with the proceeding. The Board will acknowledge receipt of the agreement, but the parties should not wait for the Board's acknowledgement to conduct themselves in accordance with the terms of their agreement. The terms of the agreement are binding as of the date the agreement is signed.[209]

Only confidential or trade secret information should be filed pursuant to a stipulated protective order. Such an order may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that except for matter filed under seal pursuant to a protective order issued by a court or by the Board, the file of a

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[206] *See, for example, Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*,13 USPQ2d 1719 (TTAB 1989); and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

[207] The standard protective order can be found in the Appendix of Forms in this manual and on the USPTO web site at: www.uspto.gov.

[208] *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

[209] *See* TBMP § 412.05 (Signature of Protective Agreement).

published application or issued registration, and all proceedings relating thereto, are available for public inspection.[210]

412.02(c) In Camera Inspection

In situations where there is a dispute between the parties to a proceeding as to the relevance and/or confidentiality of a document, or portions thereof, sought to be discovered, and the Board cannot determine from the arguments of the parties, on motion to compel production, whether the document is relevant and/or confidential, the Board may request that a copy of the document be submitted to the Board for an in camera inspection, after which the document will be returned to the party which submitted it.[211]

412.02(d) Contents of Protective Order

Typically, a protective order dealing with confidential or trade secret information contains provisions such as the following:

(1) A definition of the type of material to be considered confidential or trade secret information.

(2) A description of the manner in which confidential or trade secret information is to be handled.

(3) A requirement that a party claiming confidentiality or trade secret designate the information covered by the claim prior to disclosure of the information to the discovering party.

(4) A provision that a party may not designate information as confidential or trade secret unless the party has a reasonable basis for believing that the information is, in fact, confidential or trade secret in nature.

(5) A provision that information designated by the disclosing party as confidential or trade secret may not include information which, at or prior to disclosure thereof to the discovering party, is known to or independently developed by the discovering party; or is public knowledge or becomes available to the public without violation of the agreement.

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[210] *See Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1445 (TTAB 2000) and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements, supra.*

[211] *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, *supra.*

(6) A provision that information designated by the disclosing party as confidential or trade secret may not include information that, after the disclosure thereof, is revealed to the public by a person having the unrestricted right to do so.

(7) A provision that information designated by the disclosing party as confidential or trade secret may not include information which is acquired by the discovering party from a third party, which lawfully possesses the information and/or owes no duty of nondisclosure to the party providing discovery.

(8) A specification of the persons to whom confidential or trade secret information may be disclosed (e.g., outside counsel; house counsel; counsel's necessary legal and clerical personnel).

(9) A provision that all persons to whom confidential or trade secret information is disclosed shall be advised of the existence and terms of the protective order.

(10) A provision that the discovering party will not disclose or make use of confidential or trade secret information provided to it under the order except for purposes of the proceeding in which the information is provided.

(11) A means for resolving disputes over whether particular matter constitutes confidential or trade secret information.

(12) A provision that if material designated as confidential or trade secret is made of record in the proceeding, it shall be submitted to the Board in a separate sealed envelope or other sealed container bearing the proceeding number and name, an indication of the general nature of the contents of the container, and, in large letters, the designation "CONFIDENTIAL."

(13) A statement that at the end of the proceeding, each party shall return to the disclosing party all confidential information and materials, including all copies, summaries, and abstracts thereof.

The Board's standardized protective order can be found in the Appendix of Forms in this manual and on the USPTO web site at: www.uspto.gov.

For additional information concerning the contents of a protective order, see the cases and authorities cited in the note below.[212]

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[212] *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981). *See also Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000) (stipulated protective agreement should include provision that it may be amended without leave of Board); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (in addition to

412.03 Signature of Protective Order

Stipulated protective orders may be signed either by the parties thereto, or by their attorneys, or by both. However, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding.[213]

Imposition of the terms of a protective order by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order.

The terms of the protective order are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

412.04 Filing Confidential Materials With Board

37 CFR § 2.27 Pending trademark application index; access to applications.
(d) *Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection ...*

(e) *Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the board shall be filed under seal.*

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provisions mandated by Board, protective order may contain other provisions as are agreeable to parties); and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (Board required provision that information furnished by opposer would be confined to applicant's attorneys).

[213] *See Duke University v. Haggar Clothing Co.,* 54 USPQ2d 1443, 1445, n.3 TTAB 2000) (Board's jurisdiction would not extend to third-party signatory); and *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987). *See also*, *with respect to violation of a Board protective order after the conclusion of the Board proceeding, Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991) (bringing confidential business documents into the public record in violation of the Board's protective order established a cause of action in district court).

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying.[214] Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. If a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.[215]

Confidential materials filed in the absence of a protective order are not regarded as confidential and are not kept confidential by the Board.[216] The mere stamping of "confidential" on documents does not operate in lieu of a protective order or agreement.

In the event that material designated as confidential (including trade secret material) is made of record in the proceeding, it should be submitted to the Board in a separate sealed envelope or other sealed container prominently marked with the word "CONFIDENTIAL." Many attorneys also like to attach to the sealed envelope or other sealed container a statement, such as the following:

> FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER.
> The materials contained in this envelope have been designated confidential, pursuant to a protective order, and are not to be
>
> disclosed or revealed except to the Trademark Trial and Appeal Board and counsel for the parties, or by order of a court.

The envelope or other container should also bear information identifying the proceeding in connection with which it is filed (i.e., the proceeding number and name), and an indication of the nature of the contents of the container (i.e., "Applicant's Answers to Opposer's Interrogatories 8 and 19," "Pages 22-26 From the Discovery Deposition of John Doe," "Opposer's Exhibits 3-5 to the Discovery Deposition of John Smith," etc.).

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[214] *See, e.g., Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file).

[215] *See* 37 CFR § 2.27(d) and (e); *Duke University v. Haggar Clothing Inc.,* 54 USPQ2d 1443, 1445 (TTAB 2000); and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements,* 71 Trademark Rep. 653 (1981).

[216] *See Harjo v. Pro-Football, Inc.*, *supra* (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file).

412.05 Handling of Confidential Materials By Board

Confidential materials (including trade secret information) filed under seal subject to a protective order are stored by the Board in a secure location, and are disclosed only to the Board and to those people specified in the protective order as having the right to access.[217] After the proceeding before the Board has been finally determined, all confidential materials are returned to the party that submitted them.[218]

413 Telephone and Pre-Trial Conferences

When appropriate and necessary, a motion relating to discovery may be resolved by telephone conference, or by pre-trial conference at the offices of the Board. In either case, the conference will involve the parties or their attorneys and an Attorney-Advisor, or a Member, or the Board.[219]

414 Discovery Guidelines

Listed below are guidelines, with case citations, relating to the discoverability of a variety of matters:

(1) The identification of discovery documents (as opposed to their substance) is not privileged or confidential.[220]

(2) In those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.[221]

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[217] *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, *supra*, and TBMP § 120.02.

[218] *For information concerning access to protective order materials during an appeal from the decision of the Board, see* TBMP § 904.

[219] *See* 37 CFR § 2.120(i). *For further information concerning the resolution of motions by telephone and pre-trial conference, see* TBMP § 502.06.

[220] *See Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that client received legal opinions and identity of documents related thereto, not privileged); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (objection to interrogatories on ground of privilege or under Rule 26(b)(3), *i.e.*, material prepared in anticipation of trial, not well taken).

[221] *See, for example, Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987) (production of representative sample not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985) (allowed to

(3) The classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers constitute confidential information, and generally are not discoverable, even under protective order.[222] However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order.[223]

(4) Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant).[224]

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provide representative samples of invoices from each calendar quarter); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579-80 (TTAB 1975) (opposer need not identify dollar value and number of units of product held in inventory but may indicate only whether it does in fact carry such products in stock); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 689-90 (TTAB 1975) (sales and advertising figures for six different categories of goods since 1936 limited to five-year period and a statement that there have been sales for the other years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (production limited to ten representative samples of documents pertaining to selection of each type of copy machine); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (representative samples of advertisements permitted).

Compare British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197, 1201 (TTAB 1993) (if opposers believed the limited information provided by applicant in response to interrogatories was insufficient and that applicant's objections on grounds that the interrogatories were unduly broad, burdensome, etc., were unfounded, opposers could have moved to compel more complete responses), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) and *The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.* , 191 USPQ 468, 471 (TTAB 1976) (if applicant believed documents produced by opposer were not truly representative, applicant could have filed motion to compel).

[222] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not reveal names of customers including dealers).

[223] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra* at 1675 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985) (need for customer names does not outweigh possible harm, such as harassment of customers); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 169 (TTAB 1980) (possible harm outweighed where issue is abandonment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (name and address of first customer may be revealed to verify date of first use); and *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (must identify class of customers who purchase products under mark, but not names of customers). *For additional case cites, see Appendix of Cases.*

[224] *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (must identify knowledgeable employees); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (whether applicant received opinions concerning adoption of mark is not privileged and applicant must identify person, date and documents relating thereto); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (identification of persons who suggested use of involved mark on involved goods is not improper).

Cf. *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1974) (applicant's request for writings relating to selection of mark to show what third parties' marks may have been considered and extent to which opposer believed its mark conflicted therewith not permitted).

(5) Information concerning a party's first use of its involved mark is discoverable.[225]

(6) Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived).[226]

(7) A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable.[227]

(8) A party's plans for expansion may be discoverable under protective order.[228]

(9) Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence.[229]

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[225] *See, for example, Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195-96 (TTAB 1976) (dates petitioner's plants first began production of goods bearing mark are pertinent to claim of priority), and *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 496 (TTAB 1975) (must provide name, address and affiliation of persons to whom service was first rendered). *See also Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (use or intended use of applicant's mark in commerce with U.S. is relevant).

[226] *See Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that an opinion concerning trademark validity or possible conflicts regarding applicant's adoption and use of mark was given to applicant is not privileged); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975); and *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974) (attorney comments on search report or prosecution of application are privileged).

[227] *See Time Warner Entertainment Co. v. Jones,* 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document and witness in support of its pleaded allegations" was equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper); *Milliken & Co. v. Image Industries, Inc.*, 39 USPQ2d 1192, 1197 (TTAB 1996) (need only identify expert witnesses); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (need not disclose entirety of proposed evidence), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (motion to exclude testimony of witness for failure to identify witness during discovery denied); *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542, 543 (TTAB 1974) (opposer need not describe evidence it will rely on to support allegations in opposition); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 124 (TTAB 1974).

[228] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (opposer's intent to expand business to include manufactured products similar to applicant's is relevant).

[229] *See Sports Authority Michigan Inc. v. PC Authority Inc.,* 63 USPQ2d 1782, 1788 (TTAB 2001) (no obligation to search for third-party uses); *Red Wing Co. v. J.M. Smucker Co.,* 59 USPQ2d 1861, 1864 (TTAB 2001)

(10) Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable.[230] However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published).[231]

(11) A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion.[232]

(investigation not necessary); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not investigate); and *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show mark is weak). *See also Domino's Pizza Inc. v. Little Caesar Enterprises Inc.,* 7 USPQ2d 1359, 1363 n.9 (TTAB 1988) (relevant to show purchaser perception of the marks).

[230] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show admissions against interest, limitations on rights in mark, course of conduct leading to abandonment, that the mark has been carefully policed, etc.); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976) (settlement agreements that have avoided litigation may show limitations on party's rights in mark or reveal inconsistent statements); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580-81 (TTAB 1975) (identity of all civil and USPTO proceedings involving mark is not objectionable); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (contacts with third parties, such as through litigation or agreements, based on pleaded mark for involved goods, are relevant).

[231] *See Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975) (need not reveal reasons for dismissal of prior opposition against third party) and *Johnson & Johnson v. Rexall Drug Co.*, *supra* at 172 (need not identify all documents pertaining to such litigation).

[232] *See TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (where goods of parties differ, determining whether parties market goods of same type is relevant to establishing relationship between goods); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (questions concerning specific goods on which opposer uses mark are proper to extent scope of inquiry is limited to those goods identified in application, or involve goods of type marketed by applicant, or mentioned by opposer during discovery); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 n.2 (TTAB 1985) (information regarding goods other than those in involved application and registration is irrelevant); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 584 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1979) (applicant's use of mark on goods other than those in application irrelevant); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (interrogatory too broad, requiring identity of products having no relevance to opposition); *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.,* 176 USPQ 493, 493 (TTAB 1973) (applicant need not provide information as to its other marks or its other products, or as to whether involved mark is used on other products). *See also Wella Corp. v. California Concept Corp.,* 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (although the goods are not the same, they are of the type often made by the same manufacturer), and *Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649, 652

(12) The names and addresses of a party's officers are discoverable. However, if a party has a large number of officers, it need only provide the names and addresses of those officers most knowledgeable of its involved activities.[233]

(13) Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purpose of forestalling a foreign user's expansion into the United States, or where the foreign mark is "famous," albeit not used, in the United States.[234]

(CCPA 1975) (in the absence of any showing that manufacturers never use same mark on the two involved classes of goods, the fact that the goods are often made by the same manufacturer, even if under different marks, may be relevant)

[233] *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (may identify reasonable number of those most knowledgeable of adoption, selection or day-to-day uses of mark); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (identification of vice-president as most familiar with use held sufficient).

[234] *See, for general rule*, *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) and *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.). *See also Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481, 489 n.7 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff'd, Miller Brewing Co. v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976).

See, re possible exceptions, Article 6 bis of the Paris Convention; *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (knowledge of foreign use, in itself, does not preclude good faith adoption and use in U.S.); *Double J of Broward Inc. v. Skalony Sportswear GmbH, supra*; *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 702 (TTAB 1986) (in view of applicant's knowledge of opposer's claim to mark in foreign countries and of opposer's intention to enter U.S. market, it appears that applicant intended to preclude opposer from entering U.S. market); *Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A.*, 228 USPQ 589, 595 (TTAB 1985) (presale publicity including providing clothing with mark to competitive skiers insufficient to popularize mark as identifying source to U.S. purchasers and to create priority rights in the U.S.); *Davidoff Extension S.A. v. Davidoff International, Inc.*, 221 USPQ 465, 468 (S.D. Fla. 1983) (foreign corporation with U.S. registration based on foreign registration had rights in mark superior to individual who attempted to use the name in the U.S.); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 77-78 (TTAB 1983) (prior use and advertising in connection with goods marketed in foreign country, whether advertising occurs inside or outside U.S., creates no prior rights in U.S. against one who adopts similar mark prior to foreigner's first use on goods sold in U.S., unless foreign party's mark was famous); *All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc.*, 220 USPQ 1069, 1072 (TTAB 1983) (opposer acquired rights to famous mark in U.S. for competitions held in England prior to adoption of mark by applicant for any goods/services); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 662 (TTAB 1983) (claim of fame in France and existence of pending U.S. application based on foreign registration insufficient to establish that fame extended to U.S.). *See also Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046 (TTAB 1983) and *Johnson & Johnson v. Diaz*, 339 F. Supp. 60, 172 USPQ 35 (C.D. Cal. 1971).

(14) Generally, the names and addresses of the stockholders of a corporate party or other entities owned or controlled by the party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related companies" within the meaning of Section 5 of the Act, 15 U.S.C. § 1055.[235]

(15) The locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its involved mark, are discoverable.[236]

(16) Information relating to the areas of distribution for a party's involved goods or services sold under its involved mark is discoverable.[237]

(17) The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion.[238]

(18) Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order.[239]

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[235] *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (irrelevant unless the other company has used the mark); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 472 (TTAB 1974) (no bearing on right to register); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974).

[236] *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (locations of "all places of business" overly broad); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974).

[237] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (relevant areas of inquiry include number of salesmen, locations of sales representatives who market goods bearing the mark, and geographic location of dealers who market and distribute the products under the mark); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 196 (TTAB 1976) (petitioner was required to list all states to which its goods were shipped prior to respondent's claimed first use date and to identify persons who would be knowledgeable about such matters); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (information regarding geographic areas of distribution of goods is relevant to questions of likelihood of confusion and abandonment); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 495 (TTAB 1975) (year by year, state by state break down of numbers of magazines distributed is proper); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974).

[238] *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (may lead to relevant information concerning circumstances surrounding selection of mark, distinctiveness of mark, etc.).

[239] *See Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of likelihood of confusion and abandonment; response that these figures have been "substantial" is insufficient); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (sales and advertising expenditures have bearing on registrability); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (relevant to issue of abandonment); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to

(19) Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable.[240]

(20) Information concerning the technical expertise of the purchasers of a party's products, is relevant to the issue of likelihood of confusion and is discoverable.[241]

(21) A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact.[242]

(22) The mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, is not objectionable on the basis that it constitutes a collateral attack on the registration.[243]

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provide figures for each of last five years and a statement that there have been sales for the other years); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (money expended in advertising to be confined to goods in application); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (required to furnish round figures concerning sales under mark for period of five years as well as advertising expenditures relating thereto).

[240] *See Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (applicant's knowledge of use by opposer or by the public or the trade, is relevant); and *American Optical Corp. v. Exomet, Inc.,* 181 USPQ 120, 123 (TTAB 1974) (applicant required to go through its files to determine when it acquired actual knowledge of opposer's marks).

[241] *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (the sophistication of purchasers a factor in assessing the likelihood of confusion).

[242] *See* Fed. R. Civ. P. 33(c) and 36(a); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988)*;* and *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) (question of whether opposer believes marks to be confusingly similar is relevant).

[243] *See Johnson & Johnson v. Rexall Drug Co*., 186 USPQ 167, 171 (TTAB 1975) (party is entitled to take discovery to determine whether grounds exist for any affirmative defenses or counterclaims) and *Neville Chemical Co. v. Lubrizol Corp.,* 183 USPQ 184, 187 (TTAB 1974).

Chapter 400
DISCOVERY

Chapter 500
STIPULATIONS AND MOTIONS

501 Stipulations

501.01 In General

Subject to the approval of the Board, parties may stipulate to a wide variety of matters. For example, parties may stipulate to extend or reopen times; that the total number of interrogatories which one party may serve upon another party in a proceeding may exceed the limitation specified in 37 CFR § 2.120(d)(1); that the production of documents and things under the provisions of Fed. R. Civ. P. 34 may be made in a specified place and/or manner;[1] to protective agreements;[2] to the facts in the case of any party;[3] that the testimony of witnesses may be submitted in affidavit form;[4] that a deposition may be taken at a particular place, or in a certain manner;[5] that the proceeding shall be ended in a specified way.[6]

501.02 Filing Stipulations

Stipulations which require action or consideration by the Board, such as stipulations to extend a defendant's time to file an answer to the complaint, stipulations to extend trial dates, stipulations relating to the form of testimony, stipulations to end a proceeding in a specified way, must be filed with the Board. Some other types of stipulations, such as stipulations to extend a party's time for responding to a request for discovery, do not necessarily have to be filed with the Board. However, even in the case of a stipulation which does not have to be filed, the better practice is to reduce the stipulation to writing, in order to avoid any misunderstanding between the parties as to the existence and terms thereof.

501.03 Form of Stipulations

A stipulation may be signed either by the parties, or by their attorneys, or other authorized representatives.

If parties stipulate to extend or reopen a time or times, the stipulation should specify the closing date for each rescheduled time. For example, if parties stipulate to extend or reopen a

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[1] *See* 37 CFR § 2.120(d)(2).

[2] S*ee* TBMP § 412.02 (Protective Orders – Upon Stipulation).

[3] *See* 37 CFR § 2.123(b).

[4] *See* 37 CFR § 2.123(b).

[5] *See* 37 CFR § 2.123(b).

[6] *See* TBMP § 605.03 (Settlement Agreements).

defendant's time to file an answer to the complaint, the stipulation should specify the new due date for the answer. Due dates for answers to complaints may not be extended beyond the close of discovery. Stipulations to extend the time to answer beyond the close of discovery will be denied. If parties stipulate to extend or reopen testimony periods, or the discovery period and testimony periods, the stipulation should be submitted in the form used in a trial order, specifying the closing date for each period to be reset.[7] Further, any stipulation to extend or reopen a time or times should be filed in multiple form, i.e., one copy of the stipulation for the Board proceeding file, plus as many additional copies as there are parties, so that if the stipulation is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party.[8]

The resetting, whether by stipulation or otherwise, of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods--such dates will be rescheduled only upon stipulation of the parties being approved by the Board, or upon motion granted by the Board, or by order of the Board.[9]

502 Motions--In General

502.01 Available Motions

There is a wide range of motions which may be filed in inter partes proceedings before the Board. Trademark Rule 2.116(a), 37 CFR § 2.116(a), provides that "[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure." Thus, many of the motions available under the Federal Rules of Civil Procedure are also available in proceedings before the Board.

However, because the Board is an administrative tribunal, its rules and procedures, and hence the motions available in proceedings before it, necessarily differ in some respects from those prevailing in the Federal district courts.[10]

For example, the Board does not preside at the taking of testimony. Instead, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any

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[7] *See* 37 CFR § 2.121(d), and *Jan Bell Marketing Inc. v. Centennial Jewelers Inc.*, 19 USPQ2d 1636 (TTAB 1990).

[8] *See* 37 CFR §§ 2.102(d) and 2.121(d), and *Jan Bell Marketing Inc. v. Centennial Jewelers Inc., supra*.

[9] *See* 37 CFR §§ 2.120(a) and 2.121(a), and TBMP § 403.04 (Extensions of Discovery Period and/or Time to Respond to Discovery).

[10] *See* TBMP §§ 102.03 (General Description of Board Proceedings) and 702 (Manner of Trial and Introduction of Evidence).

exhibits thereto, are then filed with the Board.[11] Further, for reasons of administrative economy, it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision.[12] For this reason, the Board will defer consideration of substantive objections to trial evidence (e.g., on the grounds of hearsay, relevance, or that the evidence constitutes improper rebuttal) until final decision.[13] Therefore, except for the motions for involuntary dismissal under Trademark Rules 2.132(a) and (b) for failure of the plaintiff to take testimony, the Board will not entertain any motion challenging or otherwise relating to the probative value or sufficiency of a party's trial evidence.[14] Motions that require examination of trial evidence prior to final decision, such as those under Fed. R. Civ. P. 41(b) for involuntary dismissal and under Fed. R. Civ. P. 50(a) for judgment as a matter of law (formerly known as a motion for directed verdict), are not available in Board proceedings.[15]

Given the broad range of possible motions which might be filed in an inter partes proceeding before the Board, this chapter discusses only the motions which most commonly arise in Board proceedings.

502.02 Form of Motions and Briefs on Motions

37 CFR § 2.127(a) *Every motion shall be made in writing, shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board or the time is extended by stipulation of the parties approved by the Board, or upon*

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[11] *See* 37 CFR § 2.125(c) and TBMP § 702 (Manner of Trial and Introduction of Evidence).

[12] *See, e.g., M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (Board will not rule on objections pertaining to admissibility prior to final decision).

[13] *See, e.g., Hilson Research Inc. v. Society for Human Resource Management,* 27 USPQ2d 1423, 1426 (TTAB 1993) (contested motions to introduce discovery depositions filed with a notice of reliance deferred); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (objection to notice of reliance that the evidence is improper rebuttal evidence will be deferred) and *M-Tek Inc. v. CVP Systems, Inc., supra* (motion to strike documents submitted under a notice of reliance as hearsay and not properly authenticated deferred). *See also* TBMP § 707 (Objections to Evidence).

[14] *For information concerning these motions see* TBMP § 534.

[15] *See Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993) (directed verdicts not available); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718, 718 (TTAB 1985) (to extent motion for summary judgment was intended as one for directed verdict, it is inappropriate); *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 61 (TTAB 1985), *aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (motion for involuntary dismissal under Rule 41(b) unavailable); and Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983).

motion granted by the Board, or upon order of the Board. ... The Board may, in its discretion, consider a reply brief. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion will be considered by the Board. Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. The brief in support of the motion and the brief in response to the motion shall not exceed 25 pages in length; and a reply brief shall not exceed 10 pages in length. Exhibits submitted in support of or in opposition to the motion shall not be deemed to be part of the brief for purposes of determining the length of the brief....

(e)(1)... If no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within 30 days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. ... The Board may, in its discretion, consider a reply brief A reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.

502.02(a) Form of Motions

Every motion must conform to the requirements of 37 CFR § 2.127(a). In addition, a motion should bear the name and number of the inter partes proceeding in connection with which it is being filed, and a title describing the nature of the motion.[16] A party who files a motion, which does not bear the correct proceeding number, runs the risk that the paper will not be associated with the file of the proceeding for which it is intended (and hence may never be considered by the Board).

A motion must be signed by the party filing it, or by the party's attorney or other authorized representative. If a motion is unsigned, it will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board.[17]

The certificate of mailing by first-class mail procedure provided under 37 CFR § 1.8, and the "Express Mail" procedure provided under 37 CFR § 1.10, are both available for the filing of motions.[18]

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[16] *See* TBMP § 106.01 (Identification of Paperes).

[17] *See* 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

[18] *See* 37 CFR §§ 1.8 and 1.10, and TBMP §§ 110 (Certificate of Mailing or Transmission Procedure) and 111 ("Express Mail" Procedure).

Except as noted below, only one copy of a motion need be filed with the Board. Every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service ordinarily must be made before the motion will be considered by the Board.[19]

Any consented motion to extend, or reopen, a time or times should be filed in multiple form, i.e., one copy of the motion for the Board proceeding file, plus as many additional copies as there are parties, so that if the motion is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party.[20] Further, in the case of a consented motion to extend, or reopen, a time or times, the motion should specify the closing date for each rescheduled time. A consented motion to extend, or reopen, testimony periods, or the discovery period and testimony periods, should be submitted in the form used in a trial order, specifying the closing date for each period to be reset.

An unconsented motion to extend, or reopen, should be filed in single (not multiple) form. If the motion seeks an extension, or a reopening, of a testimony period or periods, or of the discovery period and testimony periods, it is preferable that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion.

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion.

When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

502.02(b) Briefs on Motions

Every motion must embody or be accompanied by a brief.[21]

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[19] *See* 37 CFR §§ 2.119(a) and 2.119(b), and TBMP § 113 (Service of Papers).

[20] *See* 37 CFR § 2.121(d), and TBMP §§ 501.03 (Form of Stipulations) and 509.02 (Form and Determination of Motions to Extend or Reopen). *Cf.* TBMP § 403.03 (Time for Service of Discovery Responses).

[21] *See* 37 CFR § 2.127(a).

Briefs on motions should not be filed in bound form.[22] Briefs must be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Briefs in support of and in response to a motion may not exceed 25 pages in length and a reply brief may not exceed 10 pages.[23] Exhibits submitted with the brief are not counted in determining the length of the brief.

A brief in response to a motion, except for a motion for summary judgment, must be filed within 15 days from the date of service of the motion (20 days if service of the motion was made by first class mail, "Express Mail," or overnight courier).[24] A brief in response to a motion for summary judgment (or, if appropriate, a motion under Fed. R. Civ. P. 56(f)), must be filed within 30 days from the date of service of the summary judgment motion (35 days if 37 CFR. § 2.119(c) applies).[25] These time periods for responding to motions shall apply unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause; or the time is reopened by stipulation of the parties approved by the Board or by order of the Board on motion showing excusable neglect.[26]

The Board may, in its discretion, consider a reply brief in support of a motion.[27] A reply brief, if filed, including a reply brief for a summary judgment motion, shall be filed within 15 days from the date of service of the brief in response to the motion (20 days if 37 CFR § 2.119(c) applies). The time for filing a reply brief will not be extended.[28] No further papers (including surreply briefs) will be considered by the Board, and any such papers filed in violation of this rule may be returned to the filing party.[29] The filing of

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[22] *See* TBMP § 106.03 (Form of Papers).

[23] *See* 37 CFR § 2.127(a). *See also Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002) (reply brief was untimely and exceeded page limit) and *Estate of Shakur v. Thug Life Clothing Co*., 57 USPQ2d 1095, 1096 (TTAB 2000) (filing of two briefs in an attempt to circumvent page limitation improper).

[24] *See* 37 CFR § 2.119(c)).

[25] *See* Trademark Rule 2.127(e)**.** *See also* TBMP § 528.02 *for further information regarding the time for filing a motion for summary judgment.*

[26] *See* Fed. R. Civ. P. 6(b) and TBMP § 509 (Motion to Extend Time; Motion to Reopen Time).

[27] *See* 37 CFR § 2.127(a). *See also, e.g., Seculus da Amazonia S/S v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, n.4 (TTAB 2003) (reply brief considered because it clarified the issues under consideration); *Harjo v. Pro-Football, Inc.,* 45 USPQ2d 1789, 1791 (TTAB 1998) (motion to strike reply brief denied); and *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 n.4 (TTAB 1995).

[28] *See* 37 CFR § 2.127(a). *See also Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc., supra* (approval of consented motion to extend time to file reply brief vacated).

[29] *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000).

reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief.[30] Thus, it remains within the Board's discretion whether to consider a reply brief.[31]

502.03 Oral Hearings on Motions

An oral hearing is not held on a motion except by order of the Board.[32] It is the practice of the Board to deny a request for an oral hearing on a motion unless, in the opinion of the Board, an oral hearing is necessary to clarify the issue or issues to be decided. Ordinarily, arguments on a motion are, and should be, adequately presented in the briefs thereon, and therefore the Board rarely grants a request for an oral hearing on a motion.[33]

502.04 Determination of Motions

37 CFR § 2.127(a) ... *When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded.*

37 CFR § 2.127(c) *Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Member of the Trademark Trial and Appeal Board or by an Attorney-Examiner of the Board to whom authority so to act has been delegated.*

Motions fall into three categories: consented, uncontested, and contested. If the nonmoving party has consented to a motion, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto (unless written consent is required under the provisions of 37 CFR §§ 2.106(c), 2.114(c), 2.134(a), or 2.135). Ordinarily, a consented motion will be granted by the Board.

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[30] *See No Fear Inc. v. Rule*, *supra* at 1553 and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto").

[31] *See No Fear Inc. v. Rule*, *supra* at 1553 (TTAB 2000) (reply brief reviewed, but given no consideration).

[32] *See* 37 CFR § 2.127(a).

[33] *See The Scotch Whiskey Association v. United States Distilled Products Co.*, 13 USPQ2d 1711 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991) (issues on motion to dismiss not so extraordinary to warrant an oral hearing), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); and *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989) (exception to usual practice is not warranted). *Compare Federal Trade Commission v. Formica Corp.*, 200 USPQ 182 (TTAB 1978) (oral hearing on motion allowed in view of importance and novelty of issue).

If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the Board, in its discretion, may grant the motion as conceded.[34] However, the Board, in its discretion, may also decline to treat an uncontested motion as conceded, and may grant or deny the motion on its merits.[35]

If a motion is contested by the nonmoving party, the Board will decide the motion on its merits.

Interlocutory motions which are not actually or potentially dispositive of a proceeding may be acted upon by a single Board administrative trademark judge, or by a single interlocutory attorney to whom such authority has been delegated.[36] Contested motions that are actually or potentially dispositive of a proceeding are determined by a panel of at least three Board judges.[37] Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be determined under the authority of the Board.

For information concerning the remedies available to a party that is dissatisfied with a decision on a motion, see TBMP § 518. *See also* TBMP § 905.

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party that wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

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[34] *See* 37 CFR § 2.127(a). *See also Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (treating motion for summary judgment as conceded was proper); *Central Manufacturing Inc. v. Third Millennium Technology, Inc*., 61 USPQ2d 1210, 1211 (TTAB 2001) (motion to dismiss treated as conceded); and *Boston Chicken Inc. v. Boston Pizza International Inc*., 53 USPQ2d 1053, 1054 (TTAB 1999).

[35] *See, e.g., Boyds Collection Ltd. v. Herrington & Co.,* 65 USPQ2d 2017, 2018 (TTAB 2003) (motion to suspend for civil action not treated as conceded where potentially dispositive motion was pending when motion to suspend was filed); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.,* 55 USPQ2d 1848, 1854 (TTAB 2000) (cross-motion for judgment not treated as conceded in view of its potentially dispositive nature); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990) (uncontested motion to dismiss decided on merits) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990).

[36] *See* 37 CFR § 2.127(c), and TBMP § 102.03 (General Description of Board Proceedings).

[37] *See* TBMP § 102.03.

502.05 Attorneys' Fees, etc., on Motions

The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party.[38]

502.06 Telephone and Pre-Trial Conferences

502.06(a) Telephone Conferences

37 CFR § 2.120(i)(1) *Whenever it appears to the Trademark Trial and Appeal Board that a motion filed in an inter partes proceeding is of such nature that its resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, resolve the motion by telephone conference.*

When it appears to the Board that a motion filed in an inter partes proceeding may be resolved by a telephone conference call involving the parties or their attorneys and an interlocutory attorney, or an administrative trademark judge, of the Board, the Board may, upon its own initiative or upon request made by a party, resolve the motion by telephone conference.[39] Immediately after the resolution of a motion by telephone conference, the Board will issue a written order confirming its decision on the motion.

Board attorneys retain discretion to decide whether a particular matter can be heard or disposed of by telephone. There is no formal limit as to the type of matters that can be handled through telephone conferences,[40] but the Board will not decide by telephone

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[38] 37 CFR § 2.127(f). *See, for example, Central Manufacturing Inc. v. Third Millennium Technology Inc.,* 61 USPQ2d 1210, 1213 (TTAB 2001) and *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 n.3 (TTAB 2000). *See also* 37 CFR §§ 2.120(f) and 2.120(g)(1). Note, however, that conduct in violation of the Canons and Disciplinary Rules set forth in 37 CFR part 10 may be referred to the Office of Enrollment and Discipline for appropriate action. *See* 37 CFR §§ 10.18(d) and 10.20, *et.seq.*

[39] *See* 37 CFR § 2.120(i)(1). *See also Duke University v. Haggar Clothing Co.,* 54 USPQ2d 1443, 1446 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.,* 53 USPQ2d 1758, 1761 (TTAB 1999); *Electronic Industries Association v. Potega,* 50 USPQ2d 1775 (TTAB 1999); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); and the *Official Gazette* notice entitled *Teleconferencing on Cases Before the TTAB* (June 20, 2000). The notice is posted on the USPTO home page, and is accessible via www.uspto.gov. under the *Official Gazette* Notices (item #9 of the June 20, 2000 notice).

[40] *See, for example, Duke University v. Haggar Clothing Co., supra* at 1446 (consented request to stay opposer's rebuttal testimony period pending ruling on opposer's motion to quash); *Electronic Industries Association v. Potega,* 50 USPQ2d 1775 (TTAB 1999) (motion to quash and motion for discovery sanctions); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991) (motion to attend testimony deposition by telephone); and *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990) (uncontested motion to extend testimony period and motion for a protective order).

conference any motion which is potentially dispositive, that is, a motion which, if granted, would dispose of a Board proceeding. The telephone conference procedure is particularly useful for resolving motions where time is of the essence, such as a motion to quash a notice of deposition.[41]

Telephone conferences are not a substitute for stipulated written motions. Parties are encouraged to file stipulated motions rather than call the Board for an order that can be agreed upon without the Board's involvement.[42] Moreover, telephone conferences may not be used as a means to supplement a motion or a related brief, and are not an opportunity to present oral arguments in support of fully briefed written motions.[43]

Requesting a telephone conference:[44] A party may request a telephone conference from the responsible Board attorney before it files the underlying motion. The initial contact will be limited to a simple statement of the nature of the issues proposed to be decided by telephone conference, with no discussion of the merits. A party served with a written motion may request a telephone conference by contacting the responsible Board attorney soon after it receives the service copy of the motion. A party may not request a telephone conference at or near the end of its time to respond to the motion, so as to avoid or delay its response to the motion.

During the initial contact, the Board attorney will decide whether any party must file a motion or brief or written agenda to frame the issues for the conference and will issue instructions.

When the Board grants a party's request for a telephone conference, the requesting party is responsible for scheduling the conference at a time agreeable to all parties and the Board attorney. The party must arrange the conference call. When a telephone conference is initiated by the Board, the Board attorney will schedule the conference. If a response to a pending motion has not yet been filed, the non-moving party should be prepared to make an oral response to the motion during the telephone conference. Any other instructions regarding filing of briefs or serving copies will be provided. To expedite matters, the moving party may hand deliver its motion, at the offices of the

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[41] *See, for example, Electronic Industries Association v. Potega, supra; Luemme Inc. v. D.B. Plus Inc.,* 53 USPQ2d 1758, 1761 (TTAB 1999) (to the extent time was of the essence, party could have contacted the Board and requested that the motion to extend discovery be resolved on an expedited basis or by telephone conference);.and cases cited in previous note. *See also* TBMP § 521 *regarding motions to quash a notice of deposition..*

[42] *See, generally, Official Gazette notice entitled Teleconferencing on Cases Before the TTAB, supra.*

[43] *Id.*

[44] *Id.*

Board, to the Board attorney to whom the case is assigned. Alternatively, the moving party may call the Board attorney and request permission to fax a copy of the motion to the Board.[45]

Denial of a request for a telephone conference is without prejudice on the merits of the motion or other matter sought to be heard by telephone. If the request is denied, the Board attorney will provide instructions to the party or parties regarding requirements for filing the motion or briefs required to have the matter decided on the papers.

Conduct of conference.[46] The telephone conference will be limited to the issues defined by the Board prior to, or at the commencement of, the conference. The Board will not record the conference nor may the parties record the contents of the telephone conference. The Board attorney may make rulings at the conclusion of the conference or may take the parties' arguments under advisement. If the Board attorney determines during the telephone conference that the motion or matter should be decided on the written record, the Board attorney may halt the telephone conference and direct the filing of a motion or response to a motion, or both.

Parties must conduct themselves with appropriate decorum. Interruptions are to be avoided. The Board attorney conducting the conference generally will signal that a party may make an argument or presentation by inviting the party to do so or by inviting a response to an argument or presentation made by another.

Participation.[47] Failure to participate in a scheduled telephone conference may result in the motion being denied with prejudice or the motion being treated as conceded.

Issuance of Rulings.[48] The Board attorney may make rulings at the conclusion of a telephone conference or may take the parties' arguments under advisement. In every instance, after the resolution of a motion or matter by telephone conference, the Board attorney will issue a written order containing all rulings. In most instances, the Board's written order will consist of only a brief summary of the issues and the resulting decision; generally, the order will not include a recitation of the parties' arguments. The decision will be forwarded to the parties by fax or mail.

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[45] *See* TBMP § 107 (How and Where to File Papers).

[46] *See, generally, Official Gazette Notice entitled Teleconferencing on Cases Before the TTAB, supra*.

[47] *Id.*

[48] *Id.*

The filing of a request for reconsideration under 37 CFR § 2.127(b) or the filing of a petition under 37 CFR § 2.146(e)(2) will not, in the usual case, result in a stay of proceedings. Any discovery, trial dates, or other deadlines set by the Board will ordinarily remain as set, notwithstanding the request for reconsideration or petition. The Board may, however, reset dates, as appropriate, if either a request for reconsideration or a petition is granted.

502.06(b) Pre-trial Conferences

37 CFR § 2.120(i)(2) *Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would be likely to be facilitated by a conference in person of the parties or their attorneys with a Member or Attorney-Examiner of the Board, the Board may, upon its own initiative or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a pre-trial conference.*

Because the pre-trial conference procedure necessarily involves expense for the parties, it is rarely used by the Board. However, it may be advantageous in cases where numerous complex motions are pending or where attorneys or parties are unable to work out a resolution of any of their differences.[49]

502.07 Fed. R. Civ. P. 11 Applicable

For information concerning the applicability of the provisions of Fed. R. Civ. P. 11 to motions filed in proceedings before the Board, see TBMP § 527.02.

503 Motion to Dismiss for Failure to State a Claim

503.01 Time for Filing

When the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer.[50] When the motion is directed to an amended pleading, it must be filed before, or concurrently with, the movant's answer to the amended pleading.[51]

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[49] *See* Abraham Bogorad, *The Impact of the Amended Rules Upon Discovery Practice Before the Trademark Trial and Appeal Board,* 66 Trademark Rep. 28, 37 (1976).

[50] *See* Fed. R. Civ. P. 12(b) and *Hollowform Inc. v. Delma Aeh*, 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). *Compare Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478 n.1 (TTAB

The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer.[52] If the motion is filed before the movant's answer, and is denied, the Board will reset the time for filing an answer.

The defense of failure to state a claim upon which relief can be granted may be raised after an answer is filed, provided that it is raised by some means other than a motion to dismiss. For example, the defense may be raised, after an answer is filed, by a motion for judgment on the pleadings, or by a motion for summary judgment.[53]

503.02 Nature of Motion

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint.[54] In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for cancelling the subject registration (in the case of a cancellation proceeding).[55]

1998) (untimeliness waived where 12(b)(6) motion filed three weeks after answer, but plaintiff responded to motion on the merits).

[51] *See William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1871 (TTAB 1994).

[52] *See Hollowform, Inc. v. Delma Aeh, supra* (motion for default judgment for failure to answer denied).

[53] *See* Fed. R. Civ. P. 12(h)(2), and Wright & Miller, *Federal Practice and Procedure*: Civil 2d §1357 (1990). *See also DAK Industries Inc. v. Daiichi Kosho Co.,* 35 USPQ2d 1434 (TTAB 1995) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (construed as motion for judgment on the pleadings). *Compare, Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995) (Rule 12(b)(6) permits defendant to assert in answer "defense" of failure to state a claim thereby allowing plaintiff to test sufficiency of defense by moving under 12(f) to strike the defense).

[54] *See, for example, Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) (Rule 12(b)(6) challenges the legal theory of the complaint not the sufficiency of the evidence that might be adduced); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985).

[55] *See Young v. AGB Corp.,* 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)*; Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538 (TTAB 2000); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990)*; Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.,* 228 USPQ 752 (TTAB 1985); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985); and *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512 (TTAB 1984).

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not respond by submitting proofs in support of its pleading. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions.[56]

For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff.[57] Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.[58]

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought.[59]

503.03 Leave to Amend Defective Pleading

A plaintiff may amend its complaint once as a matter of course at any time before an answer thereto is served, and may amend its complaint thereafter with the written consent of every adverse party or by leave of the Board, which is freely given when justice so requires.[60] Thus, plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, inter alia, an amended complaint. If the amended complaint corrects the

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[56] *Cf. Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (leave to amend pleading granted over objection that there was no evidence to prove the ground to be added). *See also Caron Corp. v. Helena Rubinstein, Inc.*, 193 USPQ 113 (TTAB 1976); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); and *Syndicat de la Parfumerie Francaise v. Scaglia*, 173 USPQ 383 (TTAB 1972).

[57] *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); *Young v. AGB Corp., supra; Intellimedia Sports Inc. v. Intellimedia Corp.* 43 USPQ2d 1203 (TTAB 1997). *See also Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra*; and *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

[58] *See Young v. AGB Corp., supra; Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra*; and *Kelly Services Inc. v. Greene's Temporaries Inc., supra.*

[59] *See Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters, supra; Intellimedia Sports Inc. v. Intellimedia Corp., supra*; *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993); and *Kelly Services Inc. v. Greene's Temporaries Inc., supra. See also Delta Tire Corp. v. Sports Car Club of America, Inc.,* 186 USPQ 431 (TTAB 1975*) and National Semiconductor Corp. v. Varian Associates,* 184 USPQ 62 (TTAB 1974).

[60] *See* TBMP § 507.02 (Amendments – General Rule – Fed. R. Civ. P. 15(a)).

defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot.

If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading.[61]

However, in appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment.[62]

503.04 Matters Outside the Pleading Submitted on Motion to Dismiss

If, on a motion to dismiss for failure to state a claim upon which relief can be granted, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed. R. Civ. P. 56.[63] Ordinarily, the parties to the proceeding will be notified that the motion to dismiss is being treated as a motion for summary judgment, and the responding party will be given reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56.[64]

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[61] *See, for example, Intellimedia Sports Inc. v. Intellimedia Corp.,* 43 USPQ2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993) (particularly where challenged pleading is the initial pleading); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985). *See also Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

[62] *See, for example,* Fed. R. Civ. P. 15(a); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (amendment would be futile because opposers cannot prevail on claim as a matter of law); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985) (plaintiff had already been allowed two opportunities to perfect its pleading). and *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984) (amendment would serve no useful purpose).

Cf. Trek Bicycle Corp. v. StyleTrek Ltd., 64 USPQ2d 1540 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987) (motion to amend to add claim or defense which is legally insufficient will be denied); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986) (would serve no useful purpose); and TBMP § 507.02 (regarding motions to amend pleading).

[63] *See Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ 1478, 1479 n.2 (TTAB 1998) (matters excluded) and *Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, 1436 (TTAB 1996) (matters excluded).

[64] *See, for example,* Fed. R. Civ. P. 12(b); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as a motion for summary judgment

Such notice may be dispensed with as unnecessary, however, where the parties themselves clearly have treated a motion to dismiss as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis.[65]

504 Motion for Judgment on the Pleadings

504.01 Time for Filing

After the pleadings are closed, but within such time as not to delay the trial, any party to an inter partes proceeding before the Board may file a motion for judgment on the pleadings.[66] In Board inter partes proceedings, the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period.[67] Thus, to be timely, a motion for judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period, as originally set or as reset.[68]

When a motion to dismiss for failure to state a claim upon which relief can be granted is filed after the answer, but prior to trial, the motion may be construed by the Board as a motion for judgment on the pleadings.[69]

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without notifying adverse party); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992); and *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991) (not an appropriate case to treat as summary judgment; extrinsic matters excluded). *See also Pegasus Petroleum Corp. v. Mobil Oil Corp*., 227 USPQ 1040 (TTAB 1985); and *Exxon Corp. v. National Foodline Corp*., 196 USPQ 444 (TTAB 1977), *aff'd,* 579 F.2d 1244, 198 USPQ 407 (CCPA 1978).

Cf. Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988) (motion for judgment on the pleadings properly treated as motion for summary judgment).

[65] *See Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (both parties submitted evidentiary materials outside the pleadings). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc., supra* (nonmoving party expected only that sufficiency, not merits of case would be decided).

[66] *See* Fed. R. Civ. P. 12(c).

[67] *See* 37 CFR § 2.116(e); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH,* 5 USPQ2d 1376 (TTAB 1986); and *La Maur, Inc. v. Bagwells Enterprises, Inc*., 193 USPQ 234 (Comm'r 1976).

[68] *Cf.* 37 CFR § 2.127(e)(1); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, supra; Lukens Inc. v. Vesper Corp*., 1 USPQ2d 1299 (TTAB 1986), *aff'd, Vesper Corp. v. Lukens Inc.,* 831 F.2d 306 (Fed. Cir. 1987); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co*., 226 USPQ 718 (TTAB 1985); *Buffett v. Chi Chi's, Inc.,* 226 USPQ 428 (TTAB 1985); *La Maur, Inc. v. Bagwells Enterprises, Inc., supra; Peterson's Ltd. v. Consolidated Cigar Corp.,* 183 USPQ 559 (TTAB 1974); and *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.,* 182 USPQ 572 (Comm'r 1974).

[69] *See Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, 1438 (TTAB 1996); *DAK Industries Inc. v. Daiichi Kosho Co.,* 35 USPQ2d 1434 (TTAB 1995); and *Western Worldwide Enterprises Group*

504.02 Nature of Motion

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice.[70]

For purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(d), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted.[71] All reasonable inferences from the pleadings are drawn in favor of the nonmoving party.[72]

A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law.[73]

A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment.[74]

504.03 Matters Outside the Pleadings Submitted on Motion for Judgment on Pleadings

If, on a motion for judgment on the pleadings, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed.

Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990) (since motion based on defense that petition fails to state claim, standard for adjudicating motion for judgment on pleading is same as Rule 12(b)(6)). *Cf.* TBMP § 503.01 (Time for Filing Motion to Dismiss).

[70] *See The Scotch Whisky Association v. United States Distilled Products Co*., 13 USPQ2d 1711, 1714 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991)), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

[71] *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); and Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 1367 *et seq*. (1990).

[72] *See Baroid Drilling Fluids Inc. v. Sun Drilling Products, supra*; *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992); and Wright & Miller, *supra* § 1367 *et seq*.

[73] *See Baroid Drilling fluids Inc. v. Sun Drilling Products*, *supra*; *CBS Inc. v. Mercandante, supra; International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); and Wright & Miller, *supra* § 1367 et seq.

[74] *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, *supra* and Wright & Miller, *supra* § 1368 (1990).

R. Civ. P. 56.[75] Ordinarily, the parties to the proceeding will be notified that the motion for judgment on the pleadings is being treated as a motion for summary judgment, and they will be given a reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56.[76]

Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion for judgment on the pleadings as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis.[77]

505 Motion for a More Definite Statement

505.01 Nature of Motion

If, in an inter partes proceeding before the Board, a pleading to which a responsive pleading must be made is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement.[78] The motion must point out the defects complained of, specify the details which the movant desires to have pleaded, and indicate that the movant is unable to frame a responsive pleading without the desired information.[79]

A motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant

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[75] *See Wellcome Foundation Ltd. v. Merck & Co*., 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (matters outside the pleading excluded); and *DAK Industries Inc. v. Daiichi Kiosho Co*., 35 USPQ2d 1434, 1436 (TTAB 1995) (exhibits excluded).

[76] *See* Fed. R. Civ. P. 12(c). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as motion for summary judgment without notifying nonmoving party); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, supra; Pegasus Petroleum Corp. v. Mobil Oil Corp*., 227 USPQ 1040 (TTAB 1985); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp., supra;* and *Exxon Corp. v. National Foodline Corp*., 196 USPQ 444 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978);

[77] *Compare Selva & Sons, Inc. v. Nina Footwear, Inc.*, *supra* at 646 (nonmoving party did not expect Rule 12(b)(6) motion to be treated as one for summary judgment).

[78] *See* Fed. R. Civ. P. 12(e), and Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 1376 (1990). *Cf. CBS Inc. v. Mercandante*, 23 USPQ2d 1784, n.8 (TTAB 1992) (answer to a counterclaim is not a pleading to which a responsive pleading is permitted).

[79] *See* Fed. R. Civ. P. 12(e) and Wright & Miller, *supra* § 1378.

cannot make a responsive pleading in good faith or without prejudice to itself.[80] If the movant believes that the pleading does not state a claim upon which relief can be granted, its proper remedy is a motion under Fed. R. Civ. P. 12(b)(6) to dismiss for failure to state a claim upon which relief can be granted, not a motion for a more definite statement.[81]

A motion for a more definite statement may not be used to obtain discovery. The only information that a movant may obtain by this motion is that which it needs to make its responsive pleading.[82]

505.02 Time for Filing

A motion for a more definite statement, if filed, must be filed within the time for, and before, the moving party's responsive pleading.[83] An extension of time to file a responsive pleading automatically extends the time to file a motion for a more definite statement, unless the Board orders otherwise.

505.03 Failure to Obey Order for More Definite Statement

If the Board, upon motion, issues an order for a more definite statement, and the order is not obeyed within the time specified by the Board, the Board may strike the pleading to which the motion was directed, or make such order as it deems just.[84]

506 Motion to Strike Matter From Pleading

506.01 Nature of Motion

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.[85] The

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[80] *See* Wright & Miller, *supra* § 1376-1377.

[81] *See* Wright & Miller, *supra* § 1376.

[82] *See* Wright & Miller, *supra* § 1376-1377.

[83] *See* Fed. R. Civ. P. 12(e).

[84] *See* Fed. R. Civ. P. 12(e).

[85] *See* Fed. R. Civ. P. 12(f).

Board also has the authority to strike an impermissible or insufficient claim (or portion of a claim) from a pleading.[86]

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case.[87] The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted.[88] Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense.[89] A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits.[90]

Nevertheless, the Board grants motions to strike in appropriate cases.[91]

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[86] *See Ohio State University v. Ohio Universi*ty, 51 USPQ2d 1289, 1293 (TTAB 1999) (motion to strike certain allegations in the counterclaim) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery,* 17 USPQ2d 1137 (TTAB 1990) (motion to strike allegations of geographic descriptiveness asserted against registration over five years old granted).

[87] *See Ohio State University v. Ohio University, supra; Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973); and Wright & Miller, *supra* § 1380 (1990).

[88] *See* TBMP §§ 309.03 (Substance of Complaint) and 311.02 (Substance of Answer); *Harsco Corp. v. Electrical Sciences Inc., supra*; and *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985). *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[89] *See Ohio State University v. Ohio University, supra* at 1294-95; *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims);. *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (applicant's affirmative defense amplifies denial of likelihood of confusion); and *Harsco Corp. v. Electrical Sciences Inc., supra* at 1571 (reasonable latitude permitted in statement of claims).

[90] *See* Wright & Miller, *supra* § 1381.

[91] *See, for example, Ohio State University v. Ohio University, supra at* 1292 and 1295 n.16 (estoppel may not be asserted as a defense against claims of mere descriptiveness or geographic descriptiveness; laches may not be maintained against fraud); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial)*; American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (insufficient affirmative defenses stricken); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (ground for cancellation not available for registration over five years old); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988) (immaterial allegation stricken); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822 (TTAB 1984) (affirmative defense stricken because identical to counterclaim); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977) (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794 (TTAB 1974) (complaint stricken for failure to comply with requirement of Rule 10(b) that each numbered paragraph be limited to a single set of circumstances); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973) (allegations in answer which merely reiterated denial of likelihood

506.02 Time for Filing

A motion to strike matter from a pleading should be filed within the time for, and before, the moving party's responsive pleading.[92] If a motion to strike matter from a complaint is filed with an answer to the complaint, the motion to strike is construed by the Board as having been filed first.

If no responsive pleading is required, the motion should be filed within 20 days after service upon the moving party of the pleading which is the subject of the motion (25 days, if service of the pleading was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)).[93]

However, the Board, upon its own initiative, and at any time, may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.[94] Thus, the Board, in its discretion, may entertain an untimely motion to strike matter from a pleading.[95]

506.03 Exhibits Attached to Pleadings

Exhibits submitted with pleadings will not be stricken by the Board since they are clearly contemplated by 37 CFR §§ 2.104(a), 2.105, 2.112(a), 2.113, and 2.122(c). However, except for status and title copies of a plaintiff's pleaded registrations filed by the plaintiff with its complaint pursuant to 37 CFR § 2.122(d)(1), exhibits attached to pleadings are not evidence on behalf of

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of confusion without adding anything of substance thereto stricken as redundant); *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973) (affirmative defense attacking validity of plaintiff's pleaded registration stricken); *S. C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973) (affirmative defense of failure to state a claim upon which relief can be granted stricken since complaint did state such a claim); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959) (recital of evidentiary material, namely, list in defendant's pleading of asserted third-party registrants and users, stricken).

Cf. Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., 177 USPQ 401 (TTAB 1973) (allegations pertinent to the issues in the case not stricken).

[92] *See* Fed. R. Civ. P. 12(f) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, supra*.

[93] *See* Fed. R. Civ. P. 12(f). *See also American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1316 (TTAB 1992).

[94] *See* Fed. R. Civ. P. 12(f).

[95] *See* Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 1380 (1990); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995); *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1316 (TTAB 1992); and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, supra.*

the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period.[96]

507 Motion to Amend Pleading

507.01 In General

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted.[97] Claims or defenses which are not asserted in the pleadings as originally filed, or as amended or deemed amended, will not be entertained by the Board.[98]

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15.[99] Amendments in general are governed by Fed. R. Civ. P. 15(a). Amendments to conform the pleadings to trial evidence are governed by Fed. R. Civ. P. 15(b).

A motion for leave to amend a pleading should be accompanied by a signed copy of the proposed amended pleading.[100]

507.02 Amendments--General Rule—Fed. R. Civ. P. 15(a)

A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course at any time before a responsive pleading is served. If the pleading is one to which no responsive pleading is permitted, it may be amended once as a matter of course at any time within 20 days after it is served.[101] An amendment filed as a matter of course need not be accompanied by a motion for leave to amend.[102]

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[96] *See* 37 CFR § 2.122(c), and TBMP § 317 (Exhibits to Pleadings).

[97] *See* TBMP §§ 309.03(a) (General Substance of Complaint), 311.02 (Substance of Answer), 506.01 (Nature of Motion to Strike Matter from Pleading), and cases cited in the foregoing sections. *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[98] *See* TBMP § 314 (Unpleaded Matters) and cases cited therein.

[99] *See* 37 CFR §§ 2.107, 2.115, and 2.116(a).

[100] *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[101] *See* Fed. R. Civ. P. 15(a).

[102] *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; leave must be freely given when justice so requires.[103] In view thereof, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.[104]

This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint,[105] including a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint.[106]

A proposed amendment need not of itself set forth a claim or defense; a proposed amendment may serve simply to amplify allegations already included in the moving party's pleading.[107] However, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally

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[103] *See* Fed. R. Civ. P. 15(a).

[104] *See, for example, Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ 1701 (TTAB 2000); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843 (TTAB 1989); *See's Candy Shops Inc. v. Campbell Soup Co*., 12 USPQ2d 1395 (TTAB 1989); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302 (1991). *For additional case cites see the Appendix of Cases.*

[105] *See, for example, Boral Ltd. v. FMC Corp., supra* at 1702. S*ee also Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Gemini Engine Co. v. Solar Turbines Inc.*, 225 USPQ 620 (TTAB 1985); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974); and *Johnson & Johnson v. Cenco Medical Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973).

[106] *See, for example, Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1867 (Fed. Cir. 1991) (amendment to add later-acquired registration to tack on prior owner's use); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (notice of opposition amended during testimony period to add claim of ownership of newly issued registration); *Marmark Ltd. v. Nutrexpa S.A.*, *supra*; and *Cudahy Co. v. August Packing Co*., 206 USPQ 759 (TTAB 1979); and *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240 (Comm'r 1990) (opposer's motion to amend to join party and claim ownership of registration granted)).

[107] *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973) (allegations amplified). *See also*, *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1734 (TTAB 1990) (petitioner permitted to add allegation concerning respondent's assertion of infringement to support standing). [NOTE: This case was overruled by *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG* , 34 USPQ2d 1266 (TTAB 1995), to the extent it held that Section 18 of the trademark Act may be invoked only when tied to a properly pleaded ground for opposition or cancellation.]

will deny the motion for leave to amend.[108] On the other hand, whether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment.[109]

Generally, an amended pleading, if allowed, will supercede any prior pleadings, particularly an amended pleading which is complete in itself and does not adopt or make any reference to the earlier pleadings.[110]

507.02(a) Timing of Motion to Amend Pleading – In General

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by

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[108] *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (motion to amend to restrict goods would serve no purpose); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.,* 62 USPQ2d 1857, 1858 (TTAB 2002) (amendment denied because Board has no jurisdiction to decide issues arising under state dilution laws), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003); *Leatherwood Scopes International Inc. v. Leatherwood,* 63 USPQ2d 1699 (TTAB 2002) (proposed amended pleading of abandonment insufficient and leave to amend denied as futile where opposer asserted applicant's lack of exclusive rights in the mark but failed to include allegation that mark had lost all capacity to act as a source indicator for applicant's goods); *Polaris Industries v. DC Comics, supra at* 1799 (where proposed pleading of dilution was legally insufficient, leave to re-plead allowed); *Trek Bicycle Corp. v. StyleTrek Ltd*., 64 USPQ2d 1540 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2D 1057 (TTAB 2000) (motion to add counterclaim denied where mere allegation that opposer did not submit copy of foreign registration at time of examination is insufficient to state claim); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (opposers could not prevail on res judicata claim as a matter of law); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993) (claim of lack of bona fide intent to use found legally sufficient); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992) (opposer's attempt to amend answer to add counterclaim denied as inconsistent with notice of opposition); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (defense of unclean hands insufficient because allegations were either unclear, non-specific, irrelevant to the defense or merely conclusory; defense of laches not available where ground is failure to control use of a certification mark); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (proposed amendment to add 2(d) claim denied as legally insufficient); and *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977). *Cf.* TBMP § 503.03 (Leave to Amend Defective Pleading).

[109] *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha***,** 22 USPQ2d 1316, 1318 (TTAB 1992), and *Flatley v. Trump, supra* at 1286

[110] *See Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1858 (Fed. Cir. 2000) (citing, *inter alia, Kelley v. Crosfield Catalysts*, 135 F.3d 1202 (7th Cir. 1998)) and, *e.g.*, *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136, n.10 (TTAB 2000). *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81, *supra.*

allowance of the proposed amendment.[111] A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely.[112]

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[111] *See International Finance Corporation v. Bravo Company*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (motion to amend opposition denied where it was filed eight months after filing of notice of opposition, with no explanation for the delay, and appeared to be based on facts within opposer's knowledge at the time opposition was filed); *Boral Ltd. v. FMC Corp.*, *supra* at 1703-04 (no undue delay because motion to add claim of dilution was promptly filed after such claim became available, albeit over two years after commencement of proceeding); *Penguin Books Ltd. v. Eberhard,* 48 USPQ2d 1280, 1286-87 (TTAB 1998) (request raised for the first time in reply brief on counterclaim to further restrict pleaded registration denied since opposer had no notice of this issue)**;** *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.***,** 41 USPQ2d 1030, 1033 (TTAB 1996) (motion to add claim of fraud denied where petitioner was fully aware of all the facts it needed to add such claim over three years before filing motion to amend)*; Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205 (TTAB 1993) (motion filed after close of discovery to assert claim of res judicata based on a judgment entered in another case after the filing of opposition permitted since applicant was afforded adequate notice and no further discovery would be necessary); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (no undue delay in view of pending motion for summary judgment and discovery was still open when motion was filed); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993) (proceeding still in pre-trial stage and discovery had been extended); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (opposer's motion to amend its pleading during its testimony period granted in the interests of justice and judicial economy and since any prejudice could be mitigated by reopening discovery solely for applicant); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990) ("concept of 'undue delay' is inextricably linked with the concept of prejudice to the non-moving party"); *.Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990) (proceeding still in the discovery stage and no undue prejudice shown); *Flatley v. Trump*, *supra* (proceedings still in the discovery stage); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (no substantial prejudice to applicant by allowance of amendment where proceeding remained in a fairly early stage); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had as yet taken testimony); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975) (proceeding was still in the pre-trial stage); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) (trial period had not yet commenced and no prejudice to applicant); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974) (no testimony had as yet been taken); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971) (applicant's motion to amend its pleading after the close of opposer's testimony period, but before the opening of applicant's testimony period, permitted); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), *aff'd,* 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (where plaintiff moved to amend after close of its testimony period, motion denied as untimely to extent it sought amendment under Rule 15(a)); and *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982) (opposer's motion to amend to rely on eight additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed, and the discovery period had already been extended several times at opposer's request).

[112] *See M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984) (plaintiff should plead any registrations it wishes to introduce as soon as possible after the omission, or newly issued registration, comes to plaintiff's attention). *See also International Finance Corporation v. Bravo Company*, *supra* at 1604 (motion denied

In order to avoid any prejudice to the adverse party when a motion for leave to amend under Fed. R. Civ. P. 15(a) is granted, the Board may, in its discretion, reopen the discovery period to allow the adverse party to take discovery on the matters raised in the amended pleading.[113]

507.02(b) Timing of Motion to Amend to Add Counterclaim

The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations. Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).[114] As provided therein, if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned.[115]

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where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim).

[113] *See Boral Ltd. v. FMC Corp.*, *supra* (reopened for limited purpose of conducting discovery on new claim); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (reopened solely for applicant's benefit); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (applicant to advise whether it would need additional discovery); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[114] *See* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by 2.106(b)(2)(i)). *But see See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989) (applied 13(f) "when justice requires" standard where grounds for counterclaim were known at time of answer).

[115] *See* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i); TBMP § 313.04 (Compulsory Counterclaims) and cases cited therein; and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). *See also Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (asserting claim as separate petition to cancel rather than counterclaim does not obviate timeliness requirements of 2.114(b)(2)(i)); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1033 (TTAB 1996); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992) (filing of an answer is not a condition precedent to operation of Trademark Rule 2.106(b)(2)(i) where grounds are learned during course of proceeding) and *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990) (counterclaim was pleaded promptly after defendant obtained information through discovery concerning possible fraud).

507.03 Amendments to Conform to the Evidence -- Fed. R. Civ. P. 15(b)

507.03(a) During Trial After Objection to Trial Evidence

If evidence is objected to at trial on the ground that it is not within the issues raised by the pleadings, the Board, upon motion, may allow the pleadings to be amended, and will do so freely when the presentation of the merits of the case will be subserved thereby and the objecting party fails to satisfy the Board that the admission of such evidence would prejudice it in maintaining its action or defense upon the merits.[116]

The motion for leave to amend should be filed promptly after the objection is made.[117] If the motion is granted, the Board may extend the objecting party's testimony period, or reopen discovery for that party, if necessary, to enable the objecting party to meet the evidence which was the subject of the objection.[118]

507.03(b) To Add Issues Tried by Express or Implied Consent

When issues not raised by the pleadings are tried by the express or implied consent of the parties, the Board will treat them in all respects as if they had been raised in the pleadings. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the result of the trial of these issues.[119]

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[116] *See* Fed. R. Civ. P. 15(b), and *Ercona Corp. v. JENAer Glaswerk Schott & Gen.*, 182 USPQ 573 (TTAB 1974).

[117] *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[118] *See* Fed. R. Civ. P. 15(b). *Cf. Buffett v. Chi Chi's, Inc.,* 226 USPQ 428 (TTAB 1985); *Anheuser –Busch, Inc. v. Martinez,* 185 USPQ 434 (TTAB 1975); and *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

[119] *See, for example,* Fed. R. Civ. P. 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984) (motion to amend to add abandonment submitted after filing of trial briefs denied because the issue had not been tried);*Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (opposition deemed amended to include opposer's claim of ownership of previously unpleaded registrations where opposer filed notice of reliance on those registrations at trial and applicant did not object thereto); *Linville v. Rivard,* 41 USPQ2d 1731, 1735 n.9 (TTAB 1996) (certain abandonment issues while not pleaded were clearly tried by the parties and argued in their trial briefs), *aff'd,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 (TTAB 1993) (functionality was tried by implied consent, such consent having been given by defendant prior to trial); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (no express or implied consent to try certain issues); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990) (permitted to amend answer after trial to add an affirmative defense that was in fact tried); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600 (TTAB 1987) (motion to amend at time of final briefing granted); and Beth A. Chapman, *TIPS*

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.[120]

Inasmuch as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a Fed. R. Civ. P. 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing.[121]

508 Motion for Default Judgment for Failure to Answer

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board, on its own initiative, may issue a notice of default allowing the defendant 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response which does not show good cause, default judgment may be entered against it.[122]

FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). *For additional cases relating to this issue see the Appendix of Cases.*

[120] *See, for example, Time Warner Entertainment Co. v. Jones*, *supra* at 1653 n.2 (where opposer, during trial, filed notice of reliance on seven unpleaded registrations and where applicant did not object thereto, Board found parties had tried by implied consent, any issues arising from those registrations); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony but was not fairly apprised that evidence, which also related to existing claim, was being offered in support of unpleaded claim); *Levi Strauss & Co. v. R. Josephs Sportswear, Inc*., 36 USPQ2d 1328 (TTAB 1994) (party was not fairly apprised that evidence used for a pleaded claim of descriptiveness was also being offered in support of unpleaded 2(d) claim); *Kasco Corp. v. Southern Saw Service Inc.*, *supra* at 1504 (defendant raised no objection to evidence on unpleaded issue but was fairly apprised of its purpose); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.., supra* (applicant sufficiently apprised that issue was being litigated where applicant's answers to discovery requests on unpleaded issue were made of record by opposer, and where applicant did not object to the cross-examination on this issue and moreover attempted to clarify a matter related to the issue); *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985) (stipulation of evidence relating to chain of title of mark and registration was insufficient to put respondent on notice of additional claims of lack of ownership); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). *For additional case cites, see Appendix of Cases.*

[121] *See Micro Motion Inc. v. Danfoss A/S, supra; Devries v. NCC Corp*., 227 USPQ 705 (TTAB 1985). *See also Marcal Paper Mills, Inc. v. American Can Co*., 212 USPQ 852 (TTAB 1981); *New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co.*, 207 USPQ 954 (TTAB 1980); *Plus Products v. Redken Laboratories, Inc*., 199 USPQ 111 (TTAB 1978); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). Cf. TBMP § 502.01 (Available Motions).

[122] *See* 37 CFR §§ 2.106(a) and 2.114(a); Fed. R. Civ. P. 55(a) and 55(b) and TBMP § 312 (Default). *See also, for example, DeLorme Publishing Co., Inc. v. Eartha's, Inc.* 60 USPQ2d 1222, 1223-24 (TTAB 2000) (good cause not shown where failure to answer was based on belief that notice of opposition was "incomplete").

The issue of whether default judgment should be entered against a defendant when it fails to file a timely answer to the complaint may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its late-filed answer be accepted.. However the issue is raised, the standard for determining whether default judgment should be entered against the defendant, for its failure to file a timely answer to the complaint, is the Fed. R. Civ. P. 55(c) standard, which requires that the defendant show good cause why default judgment should not be entered against it. [123]

If a plaintiff files a motion for default judgment for failure of the defendant to file a timely answer to the complaint, and the defendant fails to file a brief in opposition to the plaintiff's motion, default judgment may be entered against defendant.[124]

If a defendant files an answer after the due date therefor, but before the issuance by the Board of a notice of default, and also files a motion asking that the late-filed answer be accepted, and the plaintiff fails to file a brief in opposition to the defendant's motion, the motion may be granted as conceded.[125]

For further information concerning default judgment for failure of the defendant to file a timely answer to the complaint, see TBMP § 312.

509 Motion to Extend Time; Motion to Reopen Time

Fed. R. Civ. P. 6(b) Enlargement. *When by these rules or by a notice given thereunder or by order of court an act is required or allowed to be done at or within a specified time, the court for cause shown may at any time in its discretion (1) with or without motion or notice order the period enlarged if request therefor is made before the expiration of the period originally prescribed or as extended by a previous order, or (2) upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect; but it may not extend the time for taking any action under Rules ... 60(b) ... except to the extent and under the conditions stated in them.*

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[123] *See* TBMP § 312 (Default) and authorities cited therein.

[124] *See* Fed. R. Civ. P. 55(b) and 55(c), and 37 CFR § 2.127(a).

[125] *See* 37 CFR § 2.127(a), and TBMP § 502.02(b) (Briefs on Motions).

509.01 Nature of Motions

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 CFR § 2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done.[126] If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend, and the moving party need only show good cause for the requested extension. If, however, the motion is not filed until after the expiration of the period as originally set or previously extended, the motion is a motion to reopen, and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect.[127]

509.01(a) Motions to Extend Time

A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient.[128]

Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor.[129] The Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown.[130]

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[126] *Compare, however*, 37 CFR § 2.127(e)(1) ("The time for filing a motion under [Fed. R. Civ. P.] 56(f) will not be extended").

[127] *See* Fed. R. Civ. P. 6(b).

[128] *See, e.g., Fairline Boats plc v. New Howmar Boats Corp.,* 59 USPQ2d 1479, 1480 (TTAB 2000) (motion denied where party failed to provide detailed information regarding apparent difficulty in identifying and scheduling its witnesses for testimony and where sparse motion, containing vague reference to possibility of settlement, demonstrated no expectation that proceedings would not move forward during any such negotiations); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause); *Luemme, Inc. v. D. B. Plus Inc.,* 53 USPQ2d 1758 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.").

[129] *See Luemme, Inc. v. D. B. Plus Inc.***,** *supra* 1760-61 (diligence not shown; discovery requests not served until last day of the discovery period); and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant's motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time).

[130] *See Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 63 Fed. Reg. at 48086 (1998), 1214 TMOG at 149 (September 29, 1998). *See also Luemme, Inc. v. D. B. Plus Inc.***,** *supra.*

For further information concerning good cause for a motion to extend, see the cases cited in the note below.[131]

If a motion to extend the time for taking action is denied, the time for taking such action may remain as previously set.[132]

509.01(b) Motions to Reopen Time

In general. Where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action. The movant must show that its failure to act during the

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[131] *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383-84 (TTAB 2001) (the press of other litigation may constitute good cause to extend but alleged deficiencies in discovery responses not good cause to extend discovery where timely motion to compel was not filed); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.,* 61 USPQ2d 1542, 1543-44 (TTAB 2001) (insufficiently explained rearrangement of petitioner's laboratory facilities; no detailed information regarding petitioner's apparent difficulty in preparing and submitting its evidence or why petitioner waited until the last day of its testimony period to request the extension); *SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited,* 60 USPQ2d 1372 (TTAB 2001) (attorney's unwarranted and untimely request for permission to withdraw from representation of party viewed as bad faith attempt to obtain an extension of time); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra* (while maternity leave may constitute good cause, in this case defendant's counsel knew that defendant would not be able to comply with deadline, yet waited until penultimate day of response period to file unconsented motion to extend time); *Fairline Boats plc v. New Howmar Boats Corp., supra* (mere existence of settlement negotiations or proposals, without more, would not justify delay in proceeding with testimony); *Instruments SA Inc. V. ASI Instruments, Inc.*, *supra* (plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown); *Luemme, Inc. v. D.B. Plus Inc., supra* (plaintiff failed to set forth detailed facts concerning the circumstances -- plaintiff's allegedly busy travel schedule -- which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously-set discovery period)*; Luehrmann v. Kwik Kopy Corp*., 2 USPQ2d 1303 (TTAB 1987) (desire to conduct follow-up discovery is not good cause for extension of discovery period where party seeking extension did not serve initial discovery requests until late in discovery period) and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985) (opposer's motion to compel having been granted, it was reasonable to allow additional time, albeit less than requested, for opposer to complete discovery before proceeding with testimony). *For additional cases relating to this issue, see Appendix of Cases.*

[132] *See, e.g.,* Trademark Rules 2.120(a) (discovery period); 2.121(a)(1) (testimony period); 2.127(a) (time for responding to a motion); and 2.127(e)(1) (time for responding to a summary judgment motion). S*ee also Fairline Boats plc v. New Howmar Boats Corp., supra* at 1479**;** *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra*; *Luemme Inc. v. D.B. Plus Inc., supra;* and *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (petitioner's testimony period consequently expired where motion to extend testimony period was denied and dates were left as originally set).

Compare C.H. Stuart Inc. v. Carolina Closet, Inc., 213 USPQ 506, 507(TTAB 1980) (three-day testimony period for opposer reset "putting opposer in the same position it would have been in had no motion to compel been filed."). *In addition, see Notice of Final Rulemaking*, published in the Federal Register on September 9, 1998 at 63 FR 48081, specifically, comments and responses published in the notice at 48091.

time previously allotted therefor was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b).

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps,* 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith.[133]

The "prejudice to the nonmovant" contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant.[134].

It has been held that the third *Pioneer* factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case.[135]

Additionally, although many excusable neglect decisions which were issued prior to the Board's 1997 *Pumpkin* decision may no longer be controlling under the somewhat more

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[133] *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, supra* at 395 and *Pumpkin Ltd. v. The Seed Corps, supra* at 1586. *See also* cases cited throughout this section and in TBMP §§ 534.02 regarding motions to dismiss under 37 CFR § 2.132, and 544 regarding motions for relief from final judgment.

[134] *See Pumpkin Ltd. v. The Seed Corps, supra* at 1587, citing *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997) and *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

[135] *See Pumpkin Ltd. v. The Seed Corps, supra* at n.7 and cases cited therein. *See also Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.,* 59 USPQ2d 1369 (TTAB 2000) (failed to provide specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (failed to provide evidence linking the reason for the delay with the expiration of movant's testimony period); and *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay).

flexible excusable neglect standard set out in *Pioneer* and *Pumpkin* (e.g., decisions holding that a failure to act due to counsel's docketing errors is, *per se,* not the result of excusable neglect), they nonetheless may be directly relevant to the Board's analysis under the third *Pioneer* excusable neglect factor.[136]

A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient.[137]

In addition, for purposes of making the excusable neglect determination, it is irrelevant that the failure to timely take the required action was the result of the party's counsel's neglect and not the neglect of the party itself. Under our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel.[138]

To introduce newly discovered evidence. If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not

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[136] *See Pumpkin Ltd. v. The Seed Corps., supra* at 1586-87 and at n.8. Such pre-*Pioneer* cases include, e.g., *Hewlett-Packard Co. v. Olympus Corp.,* 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (no excusable neglect where plaintiff's counsel unreasonably relied on defendant's counsel to sign and file plaintiff's proposed stipulated motion to extend trial dates); *American Vitamin Products Inc. v. DowBrands Inc.,* 22 USPQ2d 1313 (TTAB 1992) (defendant's desire to take follow-up discovery and its uncertainty regarding status of plaintiff's pending motion to strike affirmative defenses did not excuse respondent's neglect in failing to file timely motion to extend discovery); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2065 (TTAB 1990) (no excusable neglect where defendant's failure to timely respond to certain discovery requests was due to defendant's oversight or lack of care in reading discovery requests); *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.,* 229 USPQ 619 (TTAB 1986) (no excusable neglect where defendant's failure to timely respond to summary judgment motion was due to counsel's press of other litigation); and *Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc*., 223 USPQ 176 (TTAB 1984) (same). *For additional cases involving the excusable neglect standard, see Appendix of Cases and TBMP §§ 534 (Motion for Judgment for Plaintiff's Failure to Prove Case) and 544 (Motion for Relief from Final Judgment).*

[137] *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., supra* (no specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, *supra* (no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case).

[138] *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, supra*, at 396 (citing *Link v. Wabash R. Co.,* 370 U.S. 626 (1962) and *United States v. Boyle*, 469 U.S. 241 (1985)); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., supra*; *CTRL Systems Inc. v. Ultraphonics of North America Inc*., 52 USPQ2d 1300 (TTAB 1999); and *Pumpkin Ltd. v. The Seed Corps., supra* at 1586.

Cf. Netcore Technologies, Inc. v. Firstwave Technologies, Inc., ___ USPQ2d ___ (TTAB 2001) (attorney's unwarranted and untimely request to withdraw from representation of party may not be used as subterfuge to obtain a reopening of time to which the party is not otherwise entitled).

have been discovered earlier through the exercise of reasonable diligence.[139] However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of the new evidence. The Board must also consider such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party.[140]

509.02 Form and Determination of Motions to Extend or Reopen

If a motion to extend or a motion to reopen is made with the consent of the nonmoving party, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto. Ordinarily, a consented motion to extend or reopen will be granted by the Board.

Any consented motion to extend or reopen a time or times should be filed in multiple form, i.e., one copy of the stipulation for the Board proceeding file, plus as many additional copies as there are parties, so that if the stipulation is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party.[141]

Further, a consented motion to extend or reopen a time or times should specify the closing date for each rescheduled time. A consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, should be submitted in the form used in a trial order, specifying the closing date for each period to be reset.[142] If a consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, specifies only the closing date for the first period to be reset, and the motion is approved, the Board will

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[139] *See, for example, Rowell Laboratories, Inc. v. Canada Packers Inc.*, 215 USPQ 523, 529 n.2 (TTAB 1982) (improper to attempt to introduce newly discovered evidence by way of rebuttal testimony rather than moving to reopen testimony period*). See also Oxford Pendaflex Corp. v. Roladex Corp.*, 204 USPQ 249 (TTAB 1979); *Wilson Sporting Goods Co. v. Northwestern Golf Co*., 169 USPQ 510 (TTAB 1971); *United States Plywood Corp. v. Modiglass Fibers, Inc*., 125 USPQ 144 (TTAB 1960); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc*., 221 USPQ 354 (TTAB 1984); *Tektronix, Inc. v. Daktronix, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and *Chemetron Corp. v. Self-Organizing Systems, Inc.,* 166 USPQ 495 (TTAB 1970).

[140] *See Harjo v. Pro-Football, Inc*., 45 USPQ2d 1789, 1790 (TTAB 1998) (newly discovered evidence was cumulative and redundant and did not have significant probative value to justify further delay of case) *citing Canadian Tire Corp. Ltd. v. Cooper Tire & Rubber Co*., 40 USPQ2d 1537, 1539 (Comm'r 1996) (newly discovered evidence was hearsay in nature and pertained to unpleaded defense).

[141] *See* 37 CFR §§ 2.102(d) and 2.121(d), and TBMP §§ 501.03 (Form of Stipulations) and 502.02(a) (Form of Motions). *Cf.* TBMP § 403.03 (Time for Service of Discovery Responses).

[142] *See* 37 CFR § 2.121(d).

automatically reschedule the subsequent periods as well.[143] However, receipt by the parties of the Board's action on the motion will be delayed, because the Board will not be able to simply stamp the motion "Approved" and return the copies to the parties, but rather will have to prepare a letter indicating that the motion has been approved and specifying the closing date for each period being rescheduled.

A stipulation to extend time to file an answer, but not the other trial dates, will be approved only if the proposed new due date for the answer is prior to the close of the discovery period. The time to answer will not be extended beyond the close of the discovery period. Thus, any extension request which would reset the time to answer beyond the date presently set for the close of discovery must also include a request for an extension of the discovery period.

When the Board notes that a consented or stipulated motion to extend time is based on the asserted existence of the parties' settlement negotiations, the Board may suspend proceedings, sua sponte, for six months, to enable the parties to concentrate on settlement and to obviate the filing of numerous extension requests. Such suspension shall be made subject to either party's right to request resumption of proceedings at any time.[144]

When a motion to extend, or a motion to reopen, is filed without the consent of the nonmoving party, it should be filed in single (not multiple) form. The Board normally will defer action on the motion until after the expiration of the nonmoving party's time to file a brief in opposition to the motion.[145] If the nonmoving party fails to file a brief in opposition thereto, the motion normally will be granted by the Board as conceded. [146] If the motion is contested by the nonmoving party, the Board will decide the motion on its merits.[147]

A party has no right to assume that its motion to extend (much less a motion to reopen) made without the consent of the adverse party will always be granted automatically.[148] Moreover, while the Board attempts, where possible, to notify the parties of its decision on an unconsented motion to extend, or a motion to reopen, prior to expiration of the enlargement sought, the Board

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[143] *See* 37 CFR § 2.121(a).

[144] *See* TBMP § 510.03(a) (Suspension).

[145] *Cf.* 37 CFR § 2.127(a).

[146] *See* 37 CFR § 2.127(a), and TBMP § 502.02(b) (Briefs on Motions).

[147] *See* TBMP § 509.01 regarding the standards to be applied in deciding contested motions to extend or reopen time.

[148] *See Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (CCPA 1980) (after granting numerous extensions of time to respond to motion for summary judgment, last request denied and motion for summary judgment granted as conceded).

is under no obligation to do so, and in many cases cannot.[149] Therefore, it is preferable, at least where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion. However, in the event that the motion to extend or reopen time is denied, the time for taking required action may remain as previously set.[150]

The resetting of the closing date for discovery will result in the automatic rescheduling of the testimony periods by the Board. However, the resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods--such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.[151]

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

Extensions of time to seek judicial review of a final decision of the Board (whether by way of appeal to the Court of Appeals for the Federal Circuit or by way of a civil action) may be granted by the Director upon written request, which should be directed to the Office of the Solicitor, not the Board.[152]

510 Motion to Suspend; Motion to Resume

37 CFR § 2.117 Suspension of proceedings.
(a) *Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding*

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[149] *See Chesebrough-Pond's Inc. v. Faberge, Inc., supra* and *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999) (waiting for Board approval of previous extension request insufficient to justify resetting of dates). *Cf.* TBMP § 202.01 (Time for Filing Request – In General); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); and *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r 1992).

[150] *See* 37 CFR §§ 2.120(a), 2.121(a)(1), 2.121(c), 2.12(a) and 2.127(e)(1). *See also Luemme, Inc. v. D. B. Plus Inc., supra.*

[151] *See* 37 CFR § 2.121(a).

[152] *See* 37 CFR § 2.145(e); *Appeals to the Federal Circuit from PTO*, 1120 TMOG 22 (November 13, 1990); and TBMP §§ 902.02 (Time for Filing Notice of Appeal) and 903.04 (Time for Filing Civil Action).

which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

(b) *Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.*

(c) *Proceedings may also be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board.*

37 CFR § 2.120(e)(2) *When a party files a motion for an order to compel discovery, the case will be suspended by the [Board] with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.*

37 CFR § 2.127(d) *When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the [Board] with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

37 CFR § 2.146(g) *The mere filing of a petition to the Director will not act as a stay in any ... inter partes proceeding that is pending before the [Board] ... except when a stay is specifically requested and is granted ... .*

37 CFR §2.124 (2) [Depositions upon written questions] ...*Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.*

510.01 In General

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon

motion, or upon stipulation of the parties approved by the Board.[153] Some of the most common reasons for suspension are discussed below.

510.02 Suspension Pending Outcome of Another Proceeding; Resumption

510.02(a) Suspension

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action.[154]

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a Federal district court. To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court .[155]

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[153] *See* 37 CFR § 2.117, and *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), *rev'd on other grounds,* 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

[154] *See* 37 CFR § 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.,* 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co*., 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.,* 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp*., 171 USPQ 805 (TTAB 1971); and David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

[155] *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the PTO); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986) (primary jurisdiction should not be invoked where, inter alia, a stay of the district court action is more likely to prolong the dispute than lead to its economical disposition and where the district court action includes claims which cannot be raised before the Board); and *Toro Co. v. Hardigg Industries, Inc.,* 187 USPQ 689, 692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977);

Cf. Larami Corp. v. Talk To Me Programs Inc., 36 USPQ2d 1840, 1844-1845 (TTAB 1995) (district court finding concerning priority of use not binding in view of differences in interpretation of Section 7(c) by Board and court, and finding regarding priority of secondary meaning not binding because said issue was not involved in the Board proceeding); Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings*, 80 Trademark Rep. 540 (1990); and David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

Further, pursuant to 37 CFR § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved,[156] or a civil action pending between the parties in a state court,[157] or a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the other party's subject application is based,[158] or even another proceeding in which only one of the parties is involved.[159]

Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.[160]

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board,[161] nor do parties or their

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[156] *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending outcome of ex parte prosecution of opposer's application).

[157] *See Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983) (state court infringement action); *Professional Economics Incorporated v. Professional Economic Services, Inc.*, 205 USPQ 368, 376 (TTAB 1979) (decision of state court, although not binding on the Board, was considered persuasive on the question of likelihood of confusion); and *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975) (state court action to determine ownership of applicant's mark and authority of applicant to file application).

[158] *See Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (TTAB 1993) (opposition suspended pending decision of German court on validity of foreign registration which is the basis of the U.S. application involved in the opposition).

[159] *See Argo & Co. v. Carpetsheen Manufacturing, Inc., supra* (state court action between applicant and third party to determine ownership of applicant's mark).

[160] *See* 37 CFR § 2.117(a) and, *for example, General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ 1933 (TTAB 1992) (relief sought in Federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Section 2(d) claim before Board), *petition denied,* 181 USPQ 779 (Comm'r 1974). *See also Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); and *Martin Beverage Co. v. Colita Beverage Corp.,* 169 USPQ 568 (TTAB 1971).

But see Boyds Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017 (TTAB 2003) (petitioner's motion to suspend filed after trial denied as untimely, and in any event, petition was dismissed since petitioner's only proffered evidence had been stricken); *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 USPQ 807, 808 n.3 (TTAB 1978) and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973) (in each case, a motion to suspend filed after the conclusion of testimony and briefing periods, when the Board proceeding was ready for decision, was denied).

[161] *See Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990) (district court has no control over Board docket and no power to stay Board proceedings), *rev'd on other grounds,* 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

attorneys.[162] However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding.[163]

When a motion to suspend pending the outcome of a civil action is filed, the Board normally will require that a copy of the pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action will have a bearing on the issues before the Board.[164] This requirement ordinarily is waived if the parties stipulate to the suspension.

The Board does not usually require that an issue be joined (that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding.[165] Such a requirement is made only in those cases where there is no stipulation to suspend and it is not possible for the Board to ascertain, prior to the filing of an answer in one or both proceedings, whether the final determination of the other proceeding will have a bearing on the issues before the Board.

If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered.[166] The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion.[167] However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.

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[162] *See Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971)).

[163] *See* David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act,* 74 Trademark Rep. 180 (1984).

[164] *See Forest Laboratories Inc. v. G.D. Searle & Co.* 52 USPQ2d 1058 (TTAB 1999) and *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975).

[165] *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied,* 181 USPQ 779 (Comm'r 1974).

[166] *See* 37 CFR § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co., supra* (motion to strike petitioner's notice of reliance, its only evidence in the case, decided before motion to suspend, and granted).

[167] *See* David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse Gaston Act*, *supra*.

510.02(b) Resumption

When a proceeding before the Board has been suspended pending the outcome of another proceeding, and that other proceeding has been finally determined, the interested party should file a paper notifying the Board of the disposition of the other proceeding, and requesting that further appropriate action be taken in the Board proceeding. Usually, the interested party requests, as a result of the decision in the other proceeding, that judgment be entered in its behalf on one or more issues in the Board proceeding. The paper should be accompanied by a copy of the decision in the other proceeding. Absent any such notification as to the final determination of the civil action, cases which have been suspended pending civil action will remain in a suspended status for two years before the Board will issue an order requiring the parties to provide the status of the civil action.

A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e., a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided.

510.03 Suspension for Other Reasons; Resumption

510.03(a) Suspension

The Board suspends proceedings in cases before it for a wide variety of reasons including those discussed below.

Upon motion or upon stipulation. Proceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board.[168] For example, proceedings may be suspended, upon motion or stipulation under 37 CFR § 2.117(c), for purposes of settlement negotiations, subject to the right of either party to request resumption at any time.[169] In addition, if a motion to extend time indicates that the parties are negotiating for settlement, the Board may, in lieu of granting the requested extension, suspend proceedings for a specified time, usually six months, subject to resumption by either party at any time.[170] The parties may also agree to suspend

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[168] *See* 37 CFR § 2.117(c).

[169] *See Instruments SA Inc. v. ASI Instruments Inc.,* 53 USPQ2d 1925, 1927 (TTAB 1999) (it may be the safest course of action for parties engaged in settlement to file a consented motion or stipulation to suspend proceedings) and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979) (order suspending proceedings for settlement vacated once it came to Board's attention that adverse party objected to suspension on such basis). *See also Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc*., 65 USPQ2d 1701 (TTAB 2002) (proceedings are not suspended automatically when parties are discussing settlement and a party which fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk).

[170] *See* TBMP § 509.02 (Form and Determination of Motions to Extend or Reopen).

proceedings for consideration of a matter by the Examining Attorney, including the disposition of a party's application before the Examining Attorney.[171]

Bankruptcy. The Board will issue an order suspending proceedings if it comes to the attention of the Board that the defendant has filed a petition for bankruptcy.[172] Under the automatic stay provisions of Section 362 of the United States Bankruptcy Code, 11 U.S.C. § 362, a petition for bankruptcy (filed under Section 301, 302, or 303 of the Code, 11 U.S.C. § 301, 302, or 303) operates as a stay, inter alia, of the commencement or continuation of a judicial, administrative, or other process against the debtor that was or could have been commenced before the commencement of the bankruptcy case. However, if it is the plaintiff in the Board proceeding, rather than the defendant, which has filed a petition for bankruptcy, the automatic stay provisions do not mandate the suspension of the Board proceeding unless there is a counterclaim in the Board proceeding for cancellation of the plaintiff's registration(s).

Withdrawal of counsel. If, in a Board proceeding, a party's attorney or other authorized representative files a request to withdraw as counsel for the party, and the request is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it desires to represent itself, failing which the Board may issue an order to show cause why default judgment should not be entered against the party.[173] A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance on the party's behalf in the proceeding.[174]

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[171] *See, for example, The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending consideration of consent agreement by Examining Attorney).

[172] *See, for example, In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992) (suspended where petitioner's pleaded registration was the subject of a counterclaim) *aff'd sub nom., Checkers Drive-In Restaurants, Inc. v. Commissioners or Patents and Trademarks,* 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995), *cert. denied,* 516 US 866 (1995).

[173] *See, with respect to withdrawal of counsel*, TBMP §§ 116.02-116.05 and 513.01. *For information concerning action by the Board after expiration of the time allowed in the suspension order, see* TBMP § 510.03(b) (Resumption).

[174] *See* TBMP § 114.03 (Representation by Attorney). *See also* TBMP §§ 114.04 (Representation by Non-Lawyer) and 114.05 (Representation by Foreign Attorney).

Potentially dispositive motion. When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss,[175] a motion for judgment on the pleadings, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion.[176]

The filing of such a potentially dispositive motion does not, in and of itself, operate to suspend a case; until the Board issues its suspension order, all times continue to run.[177] However, when issuing its suspension order, the Board ordinarily treats the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion.[178] On a case-by-case basis, the Board may find that the filing of a potentially dispositive motion provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests.[179]

Once the Board has suspended proceedings in a case, pending determination of a potentially dispositive motion, no party should file any paper that is not germane to the motion.[180]

Motion to compel. Pursuant to 37 CFR § 2.127(d) (effective October 9, 1998) when a party files a motion to compel discovery, the Board will issue an order suspending the

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[175] The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. *See* Fed. R.. Civ. P. 12(b) and *Hollowform Inc. v. Delma Aeh*, 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

[176] *See* 37 CFR § 2.127(d); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (suspended pending disposition of motion for discovery sanctions which included request for entry of judgment); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434 (TTAB 1995) (suspended pending disposition of motion for judgment on the pleadings); *Pegasus Petroleum Corp. v. Mobil Oil Corp.,* 227 USPQ 1040, 1044 n.7 (TTAB 1985) (suspended pending motion for summary judgment, and subsequent motion to suspend for civil action deferred until after decision on summary judgment); and *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross motion for summary judgment is germane to a pending motion for summary judgment).
Cf. SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994) (motion for leave to amend a notice of opposition is not a potentially dispositive motion which would warrant suspension under 2.127(d)).

[177] *See Electronic Industries Association. V. Potega, supra; SDT Inc. v. Patterson Dental Co., supra;* and *Giant Good, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986).

[178] *See Leeds Technologies Limited v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002) and *Electronic Industries Association. v. Potega, supra.*

[179] *See Leeds Technologies Limited v. Topaz Communications Ltd., supra* (time for opposer to serve discovery responses reset following decision on opposer's motion for judgment on pleadings).

[180] *See* 37 CFR § 2.127(d); *Pegasus Petroleum Corp. v. Mobil Oil Corp., supra* (motion to suspend for civil action not considered); and *Nestle Co. v. Joyva Corp., supra* (cross-motion for summary judgment germane to pending summary judgment motion).

proceeding with respect to all matters not germane to the motion,[181] and no party should file any paper which is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel.[182]

Petition to the Director. The mere filing of a petition to the Director seeking review of an interlocutory decision or order of the Board[183] will not act as a stay of the Board proceeding pending disposition of the petition. Such a stay must be specifically requested of the Board and granted by the Board.[184] The decision as to whether to grant such a stay is within the Board's discretion. Until and unless the Board issues a suspension order, all times continue to run as previously set or reset by the Board.

Testimony Depositions on Written Questions. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions pursuant to 37 CFR § 2.124, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions upon written questions.[185]

510.03(b) Resumption

Settlement negotiations. When proceedings are suspended for purposes of settlement negotiations, the Board normally sets a specific period of suspension (up to six months). Each party has the right to request resumption at any time during the suspension period.[186] If no word is heard from either party prior to the expiration of the suspension period, the Board resumes proceedings. When resuming proceedings, if the consented motion or stipulation to suspend does not specify otherwise, the Board will generally issue a new trial order beginning with whatever period was running when the consented

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[181] *See also, e.g., Jain v. Ramparts Inc*., 49 USPQ2d 1429 (TTAB 1998) (proceedings deemed suspended as of the filing of the motion).

[182] *See* 37 CFR § 2.120(e)(2). *See also* TBMP § 523 regarding motions to compel.

[183] *See generally* TBMP § 905 (Petition to the Director).

[184] *See* 37 CFR § 2.146(g).

[185] *See* 37 CFR § 2.124(d)(2), and TBMP § 703.02(c) (Depositions on Written Questions – When Taken).

[186] *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

motion or stipulation to suspend was filed.[187] In addition to, or instead of, resetting trial dates, the Board may reset the time for the parties to take other appropriate action in the case. Until the Board issues an order resuming proceedings and setting new response and/or trial dates, proceedings remain suspended, despite the fact that the suspension period set by the Board has run.

Matter Before the Examining Attorney. If proceedings have been suspended for consideration of a matter by the Examining Attorney, including the disposition of a party's application before the Examining Attorney, and the matter does not resolve the case, the Board will issue an order resuming proceedings, and taking further appropriate action.[188]

Bankruptcy. When proceedings have been suspended by the Board because a defendant in a Board proceeding (or plaintiff whose registration is the subject of a counterclaim) has filed a petition for bankruptcy, the Board periodically (normally, every two years) inquires as to the status of the bankruptcy case. In order to expedite matters, however, when the bankruptcy case has been concluded, or the involved application or registration of the bankrupt party has been transferred to some other person, the interested party should immediately file a paper notifying the Board thereof. Once the Board has been notified of the outcome of the bankruptcy case, and/or of the disposition of the bankrupt's involved application or registration, the Board will resume proceedings and take further appropriate action.

Withdrawal of counsel. If proceedings have been suspended in order to allow a party, whose attorney or other authorized representative has withdrawn, a period of time in which to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself[189] and new counsel is appointed (and the Board is informed thereof) during the time allowed, the Board will resume proceedings, and go forward with that person representing the party. If, instead, the party files a paper stating that it desires to represent itself, the Board will resume proceedings and go forward with the party representing itself, but the party may employ a new attorney or other authorized representative at any time thereafter. If the party fails, during the time allowed, to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself, the Board may issue an order noting that the party appears to have lost interest in the case, and allowing the party time in which to show cause why default

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[187] *See Instruments SA Inc. v. ASI Instruments Inc.,* 53 USPQ2d 1925, 1927 n.3 (TTAB 1999).

[188] *See, for example, The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings to be resumed if consent agreement did not overcome Examining Attorney's 2(d) refusal).

[189] *See* TBMP § 510.03(a) (Suspension).

judgment should not be entered against it.[190] If the party, in turn, files a response indicating that it has not lost interest in the case, default judgment will not be entered against it. If the party fails to file a response to the show cause order, default judgment may be entered against it.

Potentially dispositive motion. When proceedings have been suspended pending determination of a potentially dispositive motion, and the determination of the motion does not dispose of the case, the Board, in its decision on the motion, will issue an order resuming proceedings, and taking further appropriate action.[191]

511 Motion to Consolidate

Fed. R. Civ. P. 42 (a) Consolidation. *When actions involving a common question of law or fact are pending before the court, it may order a joint hearing or trial of any or all the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.*

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases.[192] In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.[193] Although identity of the parties is another factor considered by the Board in determining whether

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[190] *See, for example, Pro-Cuts v. Schilz-Price Enterprises Inc*., 27 USPQ2d 1224 (TTAB 1993).

[191] *See* 37 CFR § 2.127(d) and, *for example, Electronic Industries Association v. Potega* , 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (dates reset beginning with the period that was running when the potentially dispositive motion was filed).

[192] *See* Fed. R. Civ. P. 42(a). *See also S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); *Ritchie v. Simpson,* 41 USPQ2d 1859 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993) (opposition and cancellation consolidated); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). *For additional cases relating to this issue, see Appendix of Cases*.

[193] *See, for example*, Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 2383 (1999); *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982) (consolidation denied where one case was just in pleading stage, and testimony periods had expired in other); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same); *World Hockey Ass'n v. Tudor Metal Products Corp.,* 185 USPQ 246 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); and *Izod, Ltd. v. La Chemise Lacoste,* 178 USPQ 440 (TTAB 1973) (consolidation denied where issues differed).

consolidation should be ordered,[194] it is not always necessary.[195] Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative.[196]

Generally, the Board will not consider a motion to consolidate until an answer has been filed (i.e., until issue has been joined) in each case sought to be consolidated. However, the Board may, in its discretion, order cases consolidated prior to joinder of issue.[197]

When cases have been ordered consolidated, they may be presented on the same record and briefs.[198] Papers should only be filed in the "parent" case of the consolidated proceedings unless otherwise advised by the Board, but the caption of each paper filed with the Board should reference the individual proceeding numbers with the parent case listed first.[199] The oldest (i.e., first-filed) of the consolidated cases is treated as the "parent" case.

When actions by different plaintiffs are consolidated, and the plaintiffs are represented by different counsel, the plaintiffs may be required to appoint one lead counsel to supervise and coordinate the conduct of the plaintiffs' cases.[200]

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment.[201] Upon consolidation,

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[194] *See Bigfoot 4x4 Inc. v. Bear Foot Inc.,* 5 USPQ2d 1444 (TTAB 1987)

[195] *See* Wright & Miller, *supra* at § 2384.

[196] *See, for example*, Wright & Miller, *supra* at § 2383; *8440 LLC v. Midnight Oil Co.* , 59 USPQ2d 1541 (TTAB 2001) (opposition and cancellation proceedings consolidated on Board's own initiative*); S. Industries Inc. v. Lamb-Weston Inc., supra* at 1297 (motion); *Hilson Research Inc. v. Society for Human Resource Management*, *supra* (stipulation); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (Board's initiative); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) (stipulation); *Bigfoot 4x4 Inc. v. Bear Foot Inc., supra* (joint motion); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, *supra* (motion); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered,* 217 USPQ 464 (TTAB 1983) (motion).

[197] *Cf.* 37 CFR §§ 2.104(b) and 2.114(b), and TBMP § 305 (Consolidated and Combined Complaints).

[198] *See Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, n.2 (TTAB 1996) and *Hilson Research Inc. v. Society for Human Resource Management*, *supra.*

[199] *See, e.g., S. Industries Inc. v. Lamb-Weston Inc., supra* at n.4 and *Nabisco Brands Inc. v. Keebler Co.,* 28 USPQ2d 1237, 1238 n.2 (TTAB 1993).

[200] *See* TBMP § 117.02 (More than One Attorney).

[201] *See* Wright & Miller, *supra* at § 2382 (1999).

the Board will reset trial dates for the consolidated proceeding, usually by adopting the trial dates as set in the most recently instituted of the cases being consolidated.

512 Motion to Join or Substitute

512.01 Assignment of Mark

When there has been an assignment of a mark which is the subject of, or relied upon in, an inter partes proceeding before the Board the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative.[202]

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted.[203] If the mark in an application or registration which is the subject matter of an inter partes proceeding before the Board is assigned, together with the application or registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding; or as a junior or senior party, as the case may be, in an interference or concurrent use proceeding) upon the filing with the Board of a copy of the assignment. When the assignment is recorded in the Assignment Division of the Patent and Trademark Office, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objection to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery.[204]

If a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted for the originally named party if the assignment

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[202] *See, e.g., Interstate Brands Corp. v. McKee Foods Corp*., 53 USPQ2d 1910, 1910 n.1 (TTAB 2000) (assignee joined at final decision).

[203] *See* 37 CFR §§ 3.71 and 3.73(b).

[204] *See, for example*, 37 CFR §§ 2.113, 3.71 and 3.73(b); Fed. R. Civ. P. 17 and 25; *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1138 n.4 (TTAB 1990) (assignee joined after filing copy of an assignment which occurred subsequent to commencement of proceeding); and *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 857 n.1 (TTAB 1986) (assignee joined where papers filed by parties indicated registration had been assigned). *For additional cases relating to this issue, see Appendix of Cases.*

occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or if the defendant raises no objection to substitution. Otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence.[205] The assignment does not have to be recorded with respect to a plaintiff's pleaded application or registration before substitution or joinder (whichever is appropriate) is made. However, recordation in the Assignment Division of the Patent and Trademark Office is advisable because it will aid the assignee in its effort to prove ownership of the application or registration at trial.

If the mark of an excepted common law user (which is not the owner of an involved application or registration) in a concurrent use proceeding, is assigned, the assignee will be joined or substituted as party defendant upon notification to the Board of the assignment.[206]

Alternatively, if there has been an assignment of a mark which is the subject of, or is relied upon in, a proceeding before the Board, and the Board does not order that the assignee be joined or substituted in the proceeding, the proceeding may be continued in the name of the assignor.[207]

Further, the fact that a third party related to the plaintiff, such as a parent or licensor of the plaintiff, may also have an interest in a mark relied on by the plaintiff does not mean that the third party must be joined as a party plaintiff.[208]

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[205] *See, for example*, 37 CFR §§ 2.113, 3.71 and 3.73(b); Fed. R. Civ. P. 17 and 25; 37 CFR § 2.102(b); TBMP § 303.05(b) (Opposition Filed by Privy); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870 (TTAB 1994) (substitution of opposer appropriate where assignment occurred prior to commencement); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993) (motion to substitute filed during testimony period granted to the extent that successor was joined); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992) (opposer's motion to substitute granted where copy of assignment was filed and applicant did not object); and *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988) (survivor of merger substituted at final decision). *For additional cases relating to this issue, see Appendix of Cases.*

Compare SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994) (motion to join licensee as "co-opposer" denied since right to oppose may be transferred but not shared unless timely opposition is filed) and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993) (substitution of proper party in interest not permitted in view of misidentification of original party).

[206] *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993) and *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133 (TTAB 1982).

[207] *See* Fed. R. Civ. P. 25(c), and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, n.1 (TTAB 1982) (decision will be binding upon the assignee).

[208] *See Avia Group International Inc. v. Faraut,* 25 USPQ2d 1625 (TTAB 1992) (respondent's motion to join petitioner's licensor as party plaintiff denied).

512.02 Change of Name

If the name of a party to an inter partes proceeding before the Board is changed, the title of the Board proceeding may be changed, upon motion or upon the Board's own initiative, to reflect the change of name, provided that appropriate evidence thereof is made of record in the proceeding. Such evidence may consist, for example, of a copy of the name change document, or the reel and frame numbers at which such document is recorded in the Assignment Services Division of the USPTO.[209] If no such evidence is made of record in the proceeding, the proceeding may be continued in the party's old name.[210]

A name change document does not have to be recorded with respect to a defendant's involved application or registration, or a plaintiff's pleaded application or registration, in order for the Board proceeding title to be changed to reflect the new name. However, recordation is advisable because it facilitates proof of ownership of the application or registration, and because filing for recordation is one of the 37 CFR § 3.85 requirements for an applicant which desires, if it prevails in the proceeding, to have its registration issue in its new name.[211]

512.03 Issuance of Registration to Assignee, or in New Name

37 CFR § 3.85 Issue of registration to assignee.
The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

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[209] *See, for example, WMA Group Inc. v. Western International Media Corp.*, 29 USPQ2d 1478 (TTAB 1993); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.1 (TTAB 1992) (caption to be changed if document evidencing of change of name is submitted); *NutraSweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964 n.2 (TTAB 1987) (although no request to substitute was filed, where the change of name was recorded and there was no dispute as to facts and circumstances surrounding name change, opposer under new name was substituted as plaintiff); and *Binney & Smith Inc. v. Magic Market Industries, Inc*., 222 USPQ 1003 (TTAB 1984). *Cf. In re Brittains Tullis Russell Inc.*, 23 USPQ2d 1457 n.1 (Comm'r 1991) (in petition to Commissioner to accept § 8 & 15 affidavit, registration file evidenced change of registrant's name and claim of ownership accepted).

[210] *See, for example, Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736 (TTAB 1983) (caption was not changed to reflect name change where no supporting documents submitted) and *National Blank Book Co. v. Leather Crafted Products*, 218 USPQ 827 (TTAB 1983). *Cf.* Fed. R. Civ. P. 25(c).

[211] *See* TBMP § 512.03 (Issuance of Registration to Assignee, or in New Name) and, *for example*, *Maine Savings Bank v. First Banc Group of Ohio, Inc., supra*.

Even where the assignee of an application which is the subject matter of a Board inter partes proceeding has been joined or substituted as a party to the proceeding,[212] any registration issued from the application may issue in the name of the assignor unless the assignee complies with the requirements of 37 CFR § 3.85. Specifically, to ensure that the registration will issue in its name, the assignee must file a written request in the application (or in the Board proceeding, if that proceeding has not yet ended), by the time the application is being prepared for issuance of the certificate of registration, that the registration be issued in its name. In addition, an appropriate document must be of record in the Assignment Division of the USPTO, or the written request must state that the document has been filed for recordation. Finally, the address of the assignee must be made of record in the application file.

Similarly, even though the title of an inter partes proceeding before the Board may have been changed to reflect a name change of an applicant whose application is the subject of the proceeding, any registration issued from the application may issue in the applicant's original name unless the applicant complies with the requirements of 37 CFR § 3.85.[213]

If an assignment or change of name document is recorded in the Assignment Division well prior to the time the subject application is prepared for issuance of a registration, the registration may issue in the name of the assignee, or in the new name, even if no 37 CFR § 3.85 request is filed. However, the registration may issue in the name of the assignor, or in the old name. The purpose of the written request is to call the attention of the PTO to the assignment, or change of name, and thus to ensure that the registration issues in the name of the assignee, or in the new name. Accordingly, it is sufficient for the purpose if applicant files a paper referring to the assignment or change of name, and the assignment or change of name document has either been recorded, or applicant states that the document has been submitted for recording.

512.04 Misidentification

When it is shown to the satisfaction of the Board that a party in whose name a Board proceeding complaint was filed was misidentified therein by mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest.[214]

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[212] *See* TBMP § 512.01 (Assignment of Mark).

[213] *See Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 n.1 (TTAB 1992).

[214] *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.3 (TTAB 1985); *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505 (TTAB 1974); *Lone Star Manufacturing Co. v. Bill Beasley, Inc.*, 176 USPQ 426 (TTAB 1972), *rev'd on other grounds*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Davidson v. Instantype, Inc.*, 165 USPQ 269 (TTAB 1970); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221 (TTAB 1969); *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407 (TTAB 1964); and *Textron, Inc. v. Gillette Co.*, 177 USPQ 530 (Comm'r 1973). *Cf.* 37 CFR § 2.102(b); TBMP § 303.05(c)

When an application or registration is the subject of an inter partes proceeding before the Board, and it is shown to the satisfaction of the Board that the applicant was misidentified in the application by mistake, the Board may allow amendment of the application or registration (and of the Board proceeding title) to correct the misidentification.[215]

513 Motion to Withdraw as Representative; Petition to Disqualify

513.01 Motion to Withdraw as Representative

37 CFR § 2.19(b) *An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Director.*

37 CFR § 10.40 Withdrawal from employment.
(a) *A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.*

(b) Mandatory withdrawal*. A practitioner representing a client before the Office shall withdraw from employment if:*

> *(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*

(Misidentification of Opposer); and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993) (amendment to correct misidentification and substitute proper party in interest not permitted).

[215] *See Accu Personnel Inc. v. Accustaff Inc.,* 38 USPQ 1443, 1445-46 (TTAB 1996) (applicant's misidentification of itself as a corporation was harmless mistake): *Argo & Co. v. Springer*, 198 USPQ 626 (TTAB 1978) (Board allowed substitution of three individuals for a legally defective corporate applicant finding no mistake as to the true owner of the mark but rather only a mistake as to legal form or identity of that owner); *Argo & Company, Inc. v. Springer, et al.,* 189 USPQ 581 (TTAB 1976); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r 1974) (deletion of "company" was correctable mistake).

Cf. TMEP §§ 802.06 and 802.07; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r 1990)*; In re Techsonic Industries, Inc.,* 216 USPQ 619 (TTAB 1982); and *In re Eucryl Ltd.,* 193 USPQ 377 (TTAB 1976).

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;
(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or
(4) The practitioner is discharged by the client.

***(c) Permissive withdrawal**. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:*

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;
(ii) Personally seeks to pursue an illegal course of conduct;
(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;
(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;
(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or
(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;
(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;
(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
(5) The practitioner's client knowingly and freely assents to termination of the employment; or
(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§ 10.40(b) and 10.40(c).

Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a).[216] In accordance with that rule, a request for permission to withdraw should include (1) a specification of the basis for the request; (2) a statement that the practitioner has notified the client of his or her desire to withdraw from employment, and has allowed time for employment of another practitioner; (3) a statement that all papers and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (4) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded; and (5) proof of service of the request upon the client and upon every other party to the proceeding.[217] The facts establishing these elements should be set out in detail.[218] Moreover, a request to withdraw from representation may not be used as a subterfuge to obtain an extension or reopening of time that a party would not otherwise be entitled to.[219]

If the request to withdraw is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it desires to represent itself. If the party fails to take such action, the Board may issue an order to show cause why default judgment should not be entered against the party based on the party's apparent loss of interest in the case.[220]

A request for permission to withdraw as counsel in an application that is the subject of a potential opposition (*i.e.*, an application as to which a request for extension of time to file an opposition is pending) is determined by the Board, not the examining operation, and it should be filed with the Board to insure prompt processing.[221] .

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[216] *See* 37 CFR §§ 2.19(b) and 10.40; *SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372 (TTAB 2001) (request to withdraw denied as prejudicial to client where it was filed on last day of client's testimony period, although grounds for withdrawal were known months earlier); *Netcore Technologies, Inc. v. Firstwave Technologies, Inc.*, ___ USPQ2d ___ (TTAB 2001) (attorney's withdrawal request filed in response to Board's show cause order under Rule § 2.128(a)(3) denied as untimely where attorney assertedly had ceased to represent client months earlier).

Cf. In re Slack, 54 USPQ2d 1504, 1507 (Comm'r 2000) (request to withdraw during ex parte prosecution granted where requirements of 37 CFR § 10.40(a) were satisfied and attorney filed the request within a reasonable time after notifying applicant of his intent to withdraw).

[217] *See* 37 CFR § 10.40.

[218] *See SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited,, supra* and *Netcore Technologies Inc, v. Firstwave Technologies, Inc.*, *supra*.

[219] *See SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited,, supra* and *Netcore Technologies Inc, v. Firstwave Technologies, Inc.*, *supra*.

[220] *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

[221] *See* TBMP § 212.01 (Jurisdiction to Consider Amendment).

A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance in the party's behalf in the proceeding.[222]

For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP § 510.03(b). *For further information concerning withdrawal of counsel, see* TBMP §§ 116.02-116.05. *Cf.* TMEP § 602.03(a).

513.02 Petition to Disqualify

37 CFR § 10.130(b) *Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner [Director of the United States Patent and Trademark Office] deems appropriate.*

If a party to an inter partes proceeding before the Board believes that a practitioner representing another party to the proceeding should be disqualified (due, for example, to a conflict of interest, or because the practitioner may testify in the proceeding as a witness on behalf of his client), the party may file a petition to disqualify the practitioner.

Petitions to disqualify are not disciplinary proceedings and hence are not governed by 37 CFR §§ 10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR § 10.130(b), and are determined in the manner specified in that rule.

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition. After the petition has been determined or dismissed, the Board issues an action resuming proceedings in the case, and taking further appropriate action therein. Petitions to disqualify in matters before the Board are currently determined by the Chief Administrative Trademark Judge under authority delegated by the Director.[223]

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[222] *See* TBMP § 114.03 (Representation by Attorney). *See also* TBMP §§ 114.04 (Representation by Non-Lawyer) and 114.05 (Representation by Foreign Attorney).

[223] *With respect to disqualification due to an asserted conflict of interest, see* TBMP § 114.08, and authorities cited therein. *With respect to disqualification where the attorney is a witness in the case, such as giving testimony on behalf of the client, see* 37 CFR § 10.63; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ 2d 1663 (TTAB 1988); and *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989). *Cf. In re Gray*, 3 USPQ2d 1558 (TTAB 1987).

For examples of cases involving petitions to disqualify, see the decisions cited in TBMP § 114.08.

514 Motion to Amend Application or Registration

37 CFR § 2.133(a) *An application involved in a proceeding may not be amended in substance nor may a registration be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or except upon motion.*

(b) *If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party.*

(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

514.01 In General

The amendment of any application or registration which is the subject of an inter partes proceeding before the Board is governed by 37 CFR § 2.133. Thus, an application which is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board.[224] Similarly, a registration which is the subject of a Board inter partes proceeding may not be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion.[225]

For information regarding amendments to applications which are subject to a pending request for an extension of time to oppose see TBMP § 212. *For information concerning amendments to delete one or more classes from a multiple-class application or registration involved in an inter partes proceeding, see* TBMP § 602.01.

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[224] *See, e.g., Gallagher's Restaurants, Inc. v. Gallagher's Farms, Inc.*, 3 USPQ2d 1864 (TTAB 1986) (amendment to named excepted users in a concurrent use application); *Giant Food Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (amendment to identification of goods); and *Greyhound Corporation and Armour and Company v. Armour Life Insurance Company*, 214 USPQ 473 (TTAB 1982) (amendment to dates of use).

[225] *See* 15 U.S.C. § 1057(e) and 37 CFR § 2.173.

A proposed amendment to any application or registration which is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions. These include 37 CFR §§ 2.71-2.75, in the case of a proposed amendment to an application; and 37 CFR § 2.173 and Section 7(e) of the Act, 15 U.S.C. § 1057(e), in the case of a proposed amendment to a registration. Thus, for example, a proposed amendment which involves an addition to the identification of goods or services, or which materially alters the character of the subject mark, will not be approved by the Board.[226] However, an otherwise appropriate amendment to an application will ordinarily not be rejected by the Board solely on the basis that the amendment would require republication of the mark.

A request to amend an application or registration which is the subject of a Board inter partes proceeding should bear at its top both the number of the subject application or registration, and the Board proceeding number and title. In addition, the request should include proof of service of a copy thereof upon every other party to the proceeding.[227] A request to amend an application involved in a Board proceeding must be filed with the Board, not with the Trademark Examining Operation. Similarly, a request to amend a registration involved in a Board proceeding must be filed with the Board, not with the Post Registration Branch. Failure to file such a request with the Board will result in unnecessary delay and may result in the loss or misplacement of the amendment request.

When the Board grants a request to amend a registration which is the subject of a Board inter partes proceeding, the file is forwarded to the Post Registration branch of the Office of Trademark Services for entry of the amendment of the registration. The action by the Post Registration branch is limited to the ministerial duty of ensuring that the authorized change to the registration is made.[228]

514.02 Amendment With Consent

When a request to amend an application or registration which is the subject of a Board inter partes proceeding is made with the consent of the other party or parties, and the proposed amendment is in accordance with the applicable rules and statutory provisions, the request

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[226] *See* Section 7(e) of the Act, 15 U.S.C. § 1057; 37 CFR §§ 2.71(b), 2.72, 2.173(a) and 2.173(b); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (material alteration); *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993) (expansion of scope of goods); *Mason Engineering and Designing Corporation v. Mateson Chemical Corporation*, 225 USPQ 956 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration); and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).

[227] *See* 37 CFR § 2.119(a) and TBMP § 113 (Service of Papers).

[228] *See In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r 1980) (examining operation acted beyond its authority in denying amendment to registration which Board had already approved).

ordinarily will be approved by the Board. However, if the application or registration is the subject of other inter partes proceedings, the consent of the other parties in each of those other proceedings must be of record before the amendment may be approved.[229]

514.03 Amendment Without Consent

The Board, in its discretion, may grant a motion to amend an application or registration which is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto.[230]

When a motion to amend an application or registration in substance is made without the consent of the other party or parties, it ordinarily should be made prior to trial, in order to give the other party or parties fair notice thereof; an unconsented motion to amend which is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b).[231]

The Board generally will defer determination of a timely filed (i.e., pre-trial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment.[232]

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[229] *See Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (no consent from opposers in two other oppositions against the application).

[230] *See* 37 CFR § 2.133(a). *See also, for example, International Harvester Company v. International Telephone and Telegraph Corporation,* 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods) and *Pro-Cuts v. Schilz-Price Enterprises Inc.,* 27 USPQ2d 1224 (TTAB 1993) (where applicant consented to entry of judgment against itself with respect to a geographically unrestricted registration).

[231] *See, for example, Personnel Data Systems, Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863 (TTAB 1991) (defendant's motion to restrict identification of goods in involved registration, filed with brief on case, denied) *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (same); and *International Harvester Company v. International Telephone and Telegraph Corporation,* 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods). *See also* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).

Cf. Reflange Inc. v. R Con International, 17 USPQ2d 1125 (TTAB 1990) and TBMP §§ 311 (Form and Content of Oppositions and Petitions to Cancel), 314 (Unpleaded Matters), and 507 (Motion to Amend Pleading).

[232] *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same). *See also* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra*.

If a defendant, whose application or registration is the subject of a Board inter partes proceeding, wishes to defend by asserting that it is at least entitled to a registration with a particular restriction, the defense should be raised either in the defendant's answer to the complaint, or by way of a timely motion to amend the application or registration to include the restriction.[233] The proposed restriction should be described in defendant's pleading, or in its motion to amend, in sufficient detail to give the plaintiff fair notice thereof.[234]

If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction which was timely proposed by the defendant, the proposed restriction will be approved and entered. If a further refinement thereof is found necessary by the Board, and is within the scope of the notice given to plaintiff by defendant, or was tried with the express or implied consent of plaintiff, defendant will be allowed time in which to file a request that its application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party.[235] If, on the other hand, the Board ultimately finds that defendant is entitled to registration even without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered.[236]

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding.[237] Moreover, Section 7(e) of the Act, 15 U.S.C. § 1057(e), and 37 CFR § 2.173 cannot be used to impose concurrent use restrictions on registrations.[238] However, an applicant whose geographically unrestricted application is the subject of an opposition proceeding may file a motion to amend its application to one for a concurrent use registration, with the opposer being recited as the exception to the applicant's right to exclusive use. If the proposed amendment is otherwise appropriate, and is made with the consent of the opposer, the opposition will be dismissed without prejudice in favor of a concurrent use proceeding. If the

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[233] *See* 37 CFR §§ 2.133(a) and 2.133(b); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, *supra*; *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); *Space Base Inc. v. Stadis Corp.*, *supra*; TBMP § 311.02(b) (Affirmative Defenses); and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra.*

[234] *See Space Base inc. v. Stadis Corp., supra* and TBMP § 311.02(b) (Affirmative Defenses). *See also Flow Technology Inc. v. Picciano, supra*.

[235] *See* 37 CFR § 2.133(b), and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra*. *See also* Section 18 of the Act, 15 U.S.C. § 1068.

[236] *See* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today, supra.*

[237] *See* 37 CFR § 2.133(c); *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990) (allegations of abandonment in a particular geographic location is an insufficient pleading); and TBMP § 1101.02 (Context for USPTO Determination of Concurrent Rights).

[238] *See In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984) (petition to Commissioner to territorially restrict a registration denied) and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987).

opposer does not consent to the amendment, the amendment may nevertheless be approved and entered, and a concurrent use proceeding instituted, provided that applicant agrees to accept entry of judgment against itself in the opposition with respect to its request for a geographically unrestricted registration.[239]

514.04 Amendment to Allege Use; Statement of Use

For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application which is the subject of the opposition, see TBMP § 219.

515 Motion to Remand Application to Examining Attorney

37 CFR § 2.130 New matter suggested by Examiner of Trademarks.
If, during the pendency of an inter partes case, facts appear which, in the opinion of the Examiner of Trademarks, render the mark of any applicant involved unregistrable, the attention of the Trademark Trial and Appeal Board shall be called thereto. The Board may suspend the proceeding and refer the application to the Examiner of Trademarks for his determination of the question of registrability, following the final determination of which the application shall be returned to the Board for such further inter partes action as may be appropriate. The consideration of such facts by the Examiner of Trademarks shall be ex parte, but a copy of the action of the examiner will be furnished to the parties to the inter partes proceeding.

37 CFR § 2.131 Remand after decision in inter partes proceeding.
If, during an inter partes proceeding, facts are disclosed which appear to render the mark of an applicant unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may refer the application to the examiner for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon receiving the application, the examiner shall withhold registration pending reexamination of the application in the light of the reference by the Board. If, upon reexamination, the examiner finally refuses registration to the applicant, an appeal may be taken as provided by §§2.141 and 2.142.

If, during the pendency of an opposition, concurrent use, or interference proceeding, the Examining Attorney learns of facts which, in his or her opinion, render the subject mark of an involved applicant unregistrable, *the Examining Attorney* may file a request that the Board

[239] *See* TBMP § 1113 ("Conversion" of Opposition or Cancellation Proceeding to Concurrent Use Proceeding); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983); Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today,* 81 Trademark Rep. 408 (1991); and Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings*, 76 Trademark Rep. 252 (1986).

suspend the inter partes proceeding, and remand the application to the Examining Attorney for further ex parte examination.[240]

There is no provision under which such a remand may be made upon motion by a *party* to the proceeding. Moreover, a request to amend an application which is the subject of an inter partes proceeding before the Board is not remanded to the Examining Attorney for consideration, but rather is considered and determined by the Board.[241]

However, if, during the course of an opposition, concurrent use, or interference proceeding, facts are disclosed which appear to render the subject mark of an involved applicant unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to Fed. R. Civ. P. 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, include a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the Examining Attorney reexamine the application in light of the disclosed facts.[242] A 37 CFR § 2.131 remand may be made by the Board upon its own initiative, or upon request granted by the Board. Thus, if a party to the proceeding believes that the facts disclosed therein appear to render the subject mark of an involved application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR § 2.131 remand to the Examining Attorney. The request may be made in the party's brief on the case, at oral hearing, or by separate motion.

516 Motion to Divide Application

An application which is the subject of an inter partes proceeding before the Board may be physically divided into two or more separate applications upon motion granted by the Board, and payment of the required fee.[243]

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[240] *See* 37 CFR § 2.130.

[241] *See generally* 37 CFR § 2.133(a), and TBMP § 514 (Motion to Amendment Application or Registration).

[242] *See, for example*, 37 CFR § 2.131; *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1636 n.6 (TTAB 1988) (remand for consideration of evidence regarding applicant's date of first use); *West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.,* 2 USPQ2d 1306, 1309 n.5 (TTAB 1987) (remand for determination of status of underlying foreign registration); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984) (remand for consideration of evidence regarding applicant's use of mark prior to application filing date); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.,* 222 USPQ 1012 (TTAB 1984); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936 (TTAB 1983); and *Antillian Cigar Corp. v. Benedit Cigar Corp*., 218 USPQ 187 (TTAB 1983).

[243] *See* 37 CFR § 2.87. *Cf. In re Little Ceasar Enterprises Inc.*, 48 USPQ2d 1222 (Comm'r 1998) (regarding request to divide filed during pendency of request to extend time to oppose but prior to commencement of opposition).

For example, if an application which is the subject of an opposition includes multiple classes, not all of which have been opposed, the applicant may file a motion to divide out the unopposed classes. If applicant seeks to divide out an entire class or classes, a fee for dividing the application must be submitted for each new application to be created by the division.[244]

Similarly, if an application which is the subject of an opposition includes more than one item of goods, or more than one service, in a single class, and the opposition is not directed to all of the goods or services, the applicant may file a motion to divide out the unopposed goods or services. Applicant must submit both a fee for dividing the application, and an application filing fee, for each new application to be created by the division.[245]

In both cases, if the motion to divide is granted, the application file is forwarded to the ITU/Divisional Unit for processing of the division. After the applications have been divided, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Section 1(b) of the Act, 15 U.S.C. § 1051(b), for issuance of a notice of allowance. The original application will be returned to the Board.

Any request to divide an application which is the subject of a Board inter partes proceeding will be construed by the Board as a motion to divide, and every other party to the proceeding will be allowed an opportunity to file a brief in opposition thereto.
A registration may not be divided.[246]

For further information concerning division of an application, see TMEP §§ 1105.06 and 1105.06(a).

517 Motion to Strike Brief on Motion

Specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion, a brief in opposition to a motion, and a reply brief in further support of the motion. No further papers will be considered regarding the motion and any such papers may be returned to the filing party as being filed in violation of the rules.[247]

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief any argument it feels will be to its advantage. Accordingly, when a moving brief, an opposition

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[244] *See* 37 CFR §§ 2.87(a) and 2.87(b).

[245] *See* 37 CFR §§ 2.87(a) and 2.87(b).

[246] *See* TMEP § 1105.06(b).

[247] *See* 37 CFR § 2.127(a). *See also* TBMP § 502.02(b) (Briefs on Motions).

brief, or a reply brief on a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party which simply objects to the contents thereof. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the original motion, and any portions of the brief which are found by the Board to be improper will be disregarded.

However, if a brief in opposition to a motion, or a reply brief in support of the motion, is not timely filed, it may be stricken, or given no consideration, by the Board.

518 Motion for Reconsideration of Decision on Motion

37 CFR § 2.127(b) *Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within 15 days from the date of the service of the request.*

A request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date of the order or decision.[248] Unless the Director, upon petition, waives the time requirement of 37 CFR § 2.127(b), the Board need not consider a request for reconsideration or modification filed more than one month from the date of the order or decision complained of.[249] Nor does the rule contemplate a second request for reconsideration of the same basic issue.[250] However, the Board may, on its own initiative, reconsider and modify one of its orders or decisions if it finds error therein, and the Board may also, in its discretion, consider an untimely request for reconsideration or modification.[251]

Any brief in response to a request for reconsideration or modification of an order or decision issued on a motion must be filed within 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.120(c)).[252]

When a party upon which a motion has been served fails to file a brief in response, and the Board grants the motion as conceded pursuant to 37 CFR § 2.127(a), the nonresponding party cannot

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[248] *See* 37 CFR § 2.127(b) and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

[249] *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736 (Comm'r 1974).

[250] *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) and *Avedis Zildjian Co. v. D.G. Baldwin Co., supra.*

[251] *See Avedis Zildjian Co. v. D. H. Baldwin Co., supra.*

[252] *See* 37 CFR § 2.127(b).

use a request for reconsideration as a second opportunity to file a brief in opposition to the motion.[253]

Generally, the premise underlying a motion for reconsideration, modification or clarification under 37 CFR § 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. Rather, the motion should be limited to a demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change.[254]

An interlocutory motion, request, or other matter which is not actually or potentially dispositive of a proceeding, may be acted upon by a single Board administrative trademark judge, or by a Board interlocutory attorney to whom authority so to act has been delegated.[255] When a single Board administrative trademark judge, or a single duly authorized interlocutory attorney, has acted upon an interlocutory motion, request, or other matter not actually or potentially dispositive of the proceeding, and one or more of the parties is dissatisfied with the action, the dissatisfied party or parties may seek review thereof by requesting, under 37 CFR § 2.127(b), the same single Board judge, or the same single interlocutory attorney, to reconsider the action, and/or by filing a petition to the Director for review of the decision under 37 CFR § 2.146(e)(2) (*see* TBMP § 905). A request that the action of the single Board judge, or single interlocutory attorney, be reviewed by one or more (other) administrative trademark judges of the Board is improper and will be denied. However, at final hearing, the Board panel to which the case is assigned for decision may review an interlocutory ruling and reverse it, if appropriate.[256]

519 Motion for Leave to Serve Additional Interrogatories

37 CFR § 2.120(d)(1) *The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories; and must be*

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[253] *See Joy Manufacturing Co. v. Robbins Co.*, 181 USPQ 408 (TTAB 1974). *Cf. General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc.*, 189 USPQ 425 (TTAB 1975).

[254] *Cf.* TBMP § 543 (Motion for Reconsideration of Final Decision).

[255] *See* 37 CFR § 2.127(c). *See also* TBMP § 502.04 (Determination of Motions).

[256] *See, for example, Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986).

accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. ...

A motion under 37 CFR § 2.120(d)(1) for leave to serve additional interrogatories must be filed and granted *prior* to service of the proposed additional interrogatories; and must be accompanied both by a copy of any interrogatories which have already been served by the moving party, and by a copy of the interrogatories proposed to be served.[257]

Good cause for the service of additional interrogatories will generally be found only where it is shown that there is a legitimate need for further discovery by interrogatories.[258] The mere fact that the additional interrogatories may be relevant and narrowly drawn to a single issue, or that they may be easy to answer, is insufficient, in and of itself, to show good cause for the service of additional interrogatories.[259]

For further information concerning good cause for a motion to serve additional interrogatories, see TBMP § 405.03(C). *For information concerning the interrogatory limit specified in 37 CFR § 2.120(d)(1), see* TBMP § 405.03.

520 Motion to Take Foreign Deposition Orally

37 CFR § 2.120(c)(1) *The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.*

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[257] *See* 37 CFR § 2.120(d)(1); *Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.,* 16 USPQ2d 1466 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.,* 16 USPQ2d 1398 (TTAB 1990); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990); *Notice of Final Rulemaking,* published in the Federal Register on September 12, 1991 at 56 FR 46376 and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

[258] *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., supra*.

[259] *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., supra; Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc., supra; and Brawn of California Inc. v. Bonnie Sportswear Ltd., supra*.

37 CFR § 2.123(a)(2) *A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by §2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.*

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in 37 CFR § 2.124.[260] Moreover, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition.[261]

However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the discovery deposition, when taken in a foreign country, be taken by oral examination.[262]

Similarly, a testimony deposition taken in a foreign country must be taken by deposition upon written questions in the manner described in 37 CFR § 2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination.[263] In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country.[264]

521 Motion to Quash Notice of Deposition

A party to an inter partes proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimony deposition, to quash the notice of deposition. Alternatively, in

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[260] *See* 37 CFR § 2.120(c)(1). *See also* TBMP § 404.03(b) (Person Residing in a Foreign Country – Party), and authorities cited therein.

[261] *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998); and TBMP § 404.03(b) and authorities cited therein.

[262] *See* 37 CFR § 2.120(c)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989) (good cause to take oral deposition of witness in England); *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983) (stipulation to take oral deposition in Canada); and TBMP § 404.03(b).

[263] *See* 37 CFR § 2.123(a)(2). *See Jain v. Ramparts, supra* at 1431.

[264] *See Orion Group Inc. v. Orion Insurance Co. P.L.C.*, *supra* at 1925-26 (good cause found in view of circumstances and since fares to England were not that much greater than fares within the U.S. and no translation was required). *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990) (applicant would be prejudiced by rebuttal testimony deposition on written questions of opposer's survey expert who was present in U.S.), *corrected,* 19 USPQ2d 1479 (TTAB 1990); and TBMP §§ 521 (Motion to Quash) and 531 (Motion that Deposition upon Written Questions be taken Orally).

the case of a notice of discovery deposition and under appropriate circumstances, the party may file a motion for a protective order.[265]

A motion to quash may be filed on a variety of grounds. For example, a party may move to quash a notice of deposition on the ground that **(1)** the proposed deposition is untimely;[266] or **(2)** constitutes harassment or is without proper basis;[267] or **(3)** in the case of a discovery deposition to be taken in the United States, the deposition is not scheduled to be taken in the Federal judicial district where the proposed deponent resides or is regularly employed;[268] or **(4)** in the case of a deposition to be taken in a foreign country, the deposition is scheduled to be taken orally in violation of 37 CFR § 2.120(c) or 2.123(a)(2);[269] or **(5)** that the deposing party has noticed depositions for more than one place at the same time, or so nearly at the same time that reasonable opportunity for travel from one place of examination to another is not available;[270] or **(6)** that there was not due (i.e., reasonable) notice of the proposed deposition;[271] or **(7)** that the

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[265] *See* TBMP § 410 (Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery).

[266] *See S. Industries Inc. v. Lamb-Weston Inc.,* 45 USPQ2d 1293, 1298 (TTAB 1997) (notice was reasonable and timely; no scheduling conflict with depositions in civil action)**;** *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990) (notices of 13 depositions on written questions served eight months after original opening of testimony period, but within 10 days of latest extension, were timely); and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978) (deposition noticed during discovery but scheduled for date after discovery closed was untimely).

[267] *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988) (notice to take deposition of CEO merely to discuss settlement was baseless as a party is not required to discuss settlement). *Compare Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976) (written discovery requests directed to assignor need not be answered where assignment occurred prior to institution of proceeding).

[268] *See* 37 CFR § 2.120(b).

[269] *See Rhone-Poulenc Industries v. Gulf Oil Corp., supra.*

[270] *See* 37 CFR § 2.123(c).

[271] *See* 37 CFR §§ 2.123(c); Fed. R. Civ. P. 30(b) and 31(a); and *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (whether notice is reasonable depends upon the circumstances of each case; one and two-day notices were not reasonable without compelling need for such haste, but three-day notice was reasonable).

See also, where objection to notice was raised by other means, Electronic Industries Association v. Potega , 50 USPQ2d 1775 (TTAB 1999) (two-day notice unreasonable and failure of opposing counsel to attend was excused); *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown); and TBMP §§ 404.05 (Notice of [Discovery] Deposition) and 703.01(e) (Notice of [Testimony] Deposition) .

taking of the deposition should be deferred until after determination of a certain motion pending before the Board, such as a motion for summary judgment; or **(8)** that the deposing party improperly seeks to force a foreign natural person to come to the United States for the taking of his or her deposition;[272] or **(9)** that a testimony deposition scheduled to be taken upon written questions should be taken orally (usually, this motion is titled as a motion that a deposition be taken orally).[273]

However, the Board has no jurisdiction over nonparty depositions, or adverse witness depositions, taken by subpoena, and thus has no authority to quash such subpoenas.[274]

A motion to quash a notice of deposition should be filed promptly after the grounds therefor become known to the moving party. When time is of the essence, the moving party may telephone the Board attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call.[275] Telephone conference procedures are fully discussed in TBMP § 502.06(a).

522 Motion for Order re Manner or Place of Document Production

37 CFR § 2.120(d)(2) *The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.*

In an inter partes proceeding before the Board, the place where documents and things are to be produced is governed by 37 CFR § 2.120(d)(2).[276]

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[272] *See* TBMP § 404.03(b) (Person Residing in a Foreign Country – Party) and authorities cited therein. *Cf. Jain v. Ramparts Inc.*, 49 USPQ 1429 (TTAB 1998) (issue raised by motion to compel).

[273] *See* 37 CFR § 2.123(a)(1); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990) (good cause shown for oral deposition), *corrected*, 19 USPQ2d 1479 (TTAB 1990); and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980) (good cause shown for oral deposition).

[274] *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (Board has no jurisdiction over third-party subpoenas), and TBMP §§ 404.03(a)(2) (Person Residing in United States – Nonparty) and 703.01(f) (Securing Attendance of Unwilling Adverse Party or Nonparty).

[275] *See* 37 CFR § 2.120(i)(1) and TBMP § 502.06(a) (Telephone Conferences).

[276] *See also Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976) (documents to be produced as part of a discovery deposition would be produced where they are located); and TBMP § 406.03 (Elements of Request for Production; Place of Production).

Accordingly, upon motion, the Board, in its discretion, may make any appropriate order concerning the place and/or manner of production of documents and things. For example, the Board may order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party, all at the requesting party's expense.[277]

523 Motion to Compel Discovery

523.01 In General

37 CFR § 2.120(e) Motion for an order to compel discovery. *(1) If a party fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. ...*

(2) When a party files a motion for an order to compel discovery, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

In inter partes proceedings before the Board, a motion to compel discovery procedure is available in the event of a failure to provide discovery requested by means of discovery depositions, interrogatories, and requests for production of documents and things.[278]

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[277] *See Unicut Corp. v. Unicut, Inc., supra;* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449, 451 (1984). *See also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (applicant ordered to copy responsive documents and forward them to opposer at applicant's expense as discovery sanction) and *Jain v. Ramparts Inc*., 49 USPQ2d 1429, 1432 (TTAB 1998).

[278] *See* 37 CFR § 2.120(e). *See also* TBMP § 411 (Remedy for Failure to Provide Discovery) and, *for example*, *Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998) (interrogatories and document requests); *S. Industries Inc. v. Lamb-Weston Inc.,* 45 USPQ2d 1293, 1298 (TTAB 1997) (discovery deposition)*; MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979) (interrogatories); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976) (motion for sanctions treated as motion to compel); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976) (party may file motion to compel if it believes objections to discovery requests to be improper). *In addition, see Spa International, Inc. v. European Health Spa, Inc.*, 184 USPQ 747 (TTAB 1975); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974); *Neville*

Alternatively, if a witness objects to, and refuses to answer (or answer adequately), a question propounded during a discovery deposition, the propounding party may obtain an immediate ruling on the propriety of the objection by applying, under 35 U.S.C. § 24, to the Federal district court in the jurisdiction where the deposition is being taken, for an order compelling answer.[279]

In accordance with 37 CFR § 2.120(e)(2), when a party files a motion to compel discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel.[280]

This rule, in conjunction with 37 CFR §§ 2.120(e)(1) and 2.120(h)(1) which provide, respectively, that a motion to compel must be filed prior to the commencement of the first testimony period as originally set or as reset and that the period between the end of the discovery period and the opening of the first testimony period is increased from thirty to sixty days, is designed to ensure that all discovery disputes are resolved prior to the commencement of trial.[281] The motion to compel procedure is not applicable to requests for admission. The procedure to be followed in the case of requests for admission is as set forth in 37 CFR § 2.120(h) and Fed. R. Civ. P. 36(a).[282]

For information concerning the effect of a party's failure to timely respond to interrogatories and document requests, see TBMP §§ 403.03 (regarding time for service of discovery responses), 405.04(a) (regarding time for service of interrogatory responses), and 406.04(a) (regarding time for service of responses to document requests), 523 (regarding motion to compel discovery) and 524 (regarding motion to test sufficiency of responses to admission requests).

Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); and *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974). *Cf.* Fed. R. Civ. P. 37(a)(2)(B).

[279] *See* TBMP §§ 404.09 (Discovery Depositions Compared to Testimony Depositions) and 411.03 (Discovery Depositions), and authorities cited therein.

[280] *See* 37 CFR § 2.120(e)(2).

[281] *See Luemme Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758 (TTAB 1999) (motions to compel and motions to test the sufficiency of responses to requests for admission must be filed prior to the opening of the first testimony period).

[282] *See* TBMP §§ 411.02 (Requests for Admissions) and 524 (Motion to Test Sufficiency of Response to Admission Request).

523.02 Special Requirements for Motion

37 CFR § 2.120(e) Motion for an order to compel discovery. *... The motion shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.*

A motion to compel must include a copy of the request for discovery and the response thereto, as specified in 37 CFR § 2.120(e).[283]

In addition, the motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement.[284]

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[283] *See also Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976) (Board must be able to render a meaningful decision on a motion to compel); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Helene Curtis Industries, Inc. v. John H. Breck, Inc.*, 183 USPQ 126 (TTAB 1974).

[284] *See* 37 CFR § 2.120(e); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (failed to submit documentary evidence of good faith effort); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties must narrow disputed requests for discovery to a reasonable number); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80, 83 (TTAB 1984) (it was clear from the nature and the number of discovery requests that no good faith effort had been made); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979) (good faith effort is required where there has been a complete failure to respond to discovery; telephone call to counsel sufficient); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (same; a statement that discovery has not been responded to is insufficient). *See also Ford Motor Co. v. Shelby International, Inc.*, 193 USPQ 236 (TTAB 1976); *Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc.*, 189 USPQ 479 (TTAB 1976); *Varian Associates v. Fairfield Nobel Corp.*, 188 USPQ 581 (TTAB 1975); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 581 (TTAB 1975); *Penthouse International Ltd. v. Dyn Electronics, Inc.*, 184 USPQ 117 (TTAB 1974); and *Angelica Corp. v. Collins & Aikman Corp.*, 183 USPQ 378 (TTAB 1974).

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require determination.[285]

For information concerning the special requirements for a motion to compel answers to interrogatories that are the subject of a general objection on the ground of excessive number, see TBMP § 405.03(e).

523.03 Time for Filing Motion

37 CFR§ 2.120(e) Motion for an order to compel discovery. *...The motion must be filed prior to the commencement of the first testimony period as originally set or as reset. ...*

A motion to compel does not necessarily have to be filed during the discovery period.[286] However, the motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate and must, in any event, be filed before the first testimony period opens.[287] Trial schedules include a 60-day period between the close of discovery and the opening of the first testimony period to allow time for the filing of any necessary discovery motions.

523.04 Failure to File Motion to Compel

If a party that served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof.[288]

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[285] *See* 37 CFR § 2.120(e) and, *e.g.*, *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (late responses rendered motion to compel, based on complete non-responsiveness, moot).

[286] *See Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974).

[287] *See* 37 CFR § 2.120(e); and, *for example*, *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL,* 59 USPQ2d 1383 (TTAB 2001).

[288] *See Time Warner Entertainment Co. v. Jones,* 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (objections that discovery requests are, for example, ambiguous or burdensome, are not of a nature which would lead propounding party to believe that the requested information does not exist and party should have filed motion to compel), *aff'd,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery

524 Motion to Test Sufficiency of Response to Admission Request

524.01 In General

Fed. R. Civ. P. 36(a) Request for Admission. *... The party who has requested the admissions may move to determine the sufficiency of the answers or objections. Unless the court determines that an objection is justified, it shall order that an answer be served. If the court determines that an answer does not comply with the requirements of this rule, it may order either that the matter is admitted or that an amended answer be served. ...*

37 CFR § 2.120(h) Request for admissions. *... (2) When a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.*

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response.[289]

If the Board, upon motion to test the sufficiency of a response to a request for admission, determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served.[290]

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deposition without motion to compel complete responses and violation of an order compelling answers). *See also Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL,* 59 USPQ2d 1383 (TTAB 2001) (any motion to compel to test alleged deficiencies in responses would be time-barred). *In addition, see Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976); and *Comserv Corp. v. Comserv*, 179 USPQ 124 (TTAB 1973). *Accord* TBMP § 524.04 (regarding failure to file motion regarding sufficiency of admission responses). *Cf.* TBMP § 527.01(e) (Estoppel Sanction).

[289] *See* 37 CFR § 2.120(h); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697 n.7 (TTAB 1971). *Cf.* 37 CFR § 2.120(e), and TBMP § 523.01 (Motion to Compel Discovery – In General).

[290] *See* Fed. R. Civ. P. 36(a).

524.02 Special Requirements for Motion

37 CFR § 2.120(h) Request for admissions. *(1) ... The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.*

A motion to determine the sufficiency of a response to a request for admission must include a copy of the request for admission (and any exhibits thereto) and of the answer or objection.[291]

In addition, the motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement.[292]

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require determination.[293]

524.03 Time for Filing Motion

37 CFR § 2.120(h) Request for admissions.
(1) Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed prior to the commencement of the first testimony period, as originally set or as reset.

(2) When a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to determine the sufficiency of an answer or objection to

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[291] *See* 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e).

[292] *See* 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e) and TBMP § 523.02 (Special Requirements for Motion), and cases cited therein.

[293] *See* 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e).

a request for admission shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

A motion to test the sufficiency of a response to a request for admission does not necessarily have to be filed during the discovery period, but it should be filed within a reasonable time after service of the response believed to be inadequate and, in any event, must be filed prior to the commencement of the first testimony period, as originally set or as reset.[294]

524.04 Failure to File Motion

If a party which served a request for admission receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof.[295]

525 Motion to Withdraw or Amend Admission

Fed. R. Civ. P. 36(b) Effect of Admission. *Any matter admitted under this rule is conclusively established unless the court on motion permits withdrawal or amendment of the admission. ...the court may permit withdrawal or amendment when the presentation of the merits of the action will be subserved thereby and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits. Any admission made by a party under this rule is for the purpose of the pending action only and is not an admission for any other purpose nor may it be used against the party in any other proceeding.*

Any matter admitted under Fed. R. Civ. P. 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission.[296] This applies both to matters expressly admitted; and to those deemed admitted for failure to timely respond to a request for admission, where there is no persuasive showing that the failure to timely respond was the result of excusable neglect.[297]

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[294] 37 CFR § 2.120(h)(1). *Cf. Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974) (motion to compel timely even if filed after close of discovery) and TBMP § 523.03 (Time for Filing Motion).

[295] *See Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971). *Cf.* TBMP § 523.04 (failure to file motion to compel), and cases cited therein. *Cf. also* TBMP § 527.04 (regarding effect of failure to timely respond to requests for admission).

[296] *See* Fed. R. Civ. P. 36(b), and TBMP § 407.04 (Effect of Admission).

[297] *See* Fed. R. Civ. P. 6(b) and 36, and TBMP §§ 407.03(a) (Time for Service of Responses) and 407.04 (Effect of Admission).

The Board, upon motion, may permit withdrawal or amendment of an admission when the presentation of the merits of the proceeding will be subserved thereby, and the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits.[298] The timing of a motion to withdraw or amend an admission plays a significant role in the Board's determination of whether the propounding party will be prejudiced by withdrawal or amendment.[299]

526 Motion for a Protective Order

37 CFR § 2.120(f) Motion for a protective order. *Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party provide or permit discovery.*

In inter partes proceedings before the Board, motions for a protective order are governed by 37 CFR § 2.120(f).

It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request which it believes to be proper, and stating its objections to those which it believes to be improper.[300]

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[298] *See* Fed. R. Civ. P. 36(b); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (amendment permitted where the requested admissions were ambiguous and conclusory and possible prejudice avoided by extending discovery period); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by relieving opposer of admission on relevant issue and prejudice avoided by allowing applicant limited discovery as to the amended answer); and *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979) (motion to withdraw admissions by default denied, but to extent admissions are contradicted by evidence, they will not be relied on for purposes of deciding whether entry of summary judgment is appropriate). *See also American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend).

[299] *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc., supra* (propounding party's testimony period had not yet opened) and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp., supra* (case was still in pre-trial stage). *Cf.* TBMP § 507.02 (Amendments under Fed. R. Civ. P. 15(a)).

[300] *See* TBMP § 410 (Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery) and cases cited therein. *See also Luemme Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999).

Moreover, if a party upon which interrogatories have been served believes that the number of interrogatories served exceeds the limitation specified in 37 CFR § 2.120(d)(1), and is not willing to waive this basis for objection, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, or a motion for a protective order, serve a general objection on the ground of their excessive number, leaving the inquiring party with the burden of filing a motion to compel if it believes that the objection is not well taken.[301]

Nevertheless, there are certain situations (such as, for example, when a request for discovery constitutes clear harassment, or when a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest) in which a party may properly respond to a request for discovery by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions.[302]

Except in those situations, a motion for a protective order ordinarily should be filed in a Board proceeding only in response to a motion to compel where, for example, matter sought to be discovered assertedly constitutes trade secret or confidential information, or cannot be provided without undue burden or expense.[303]

When the Board grants a request for a protective order with respect to confidential or trade secret information, it may direct either the disclosing party, or the parties together, to prepare an order with terms which are mutually agreeable to them.[304] Other alternatives involve accepting a protective agreement proffered by a party or ordering parties to adhere to Board's standard agreement.[305] Parties are encouraged, however, to stipulate to a protective agreement governing

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[301] *See* 37 CFR § 2.120(d)(1), and TBMP § 405.03(e) (Remedy for Excessive Interrogatories).

[302] *See, for example,* 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c); *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high level executive granted); and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where obligation to respond to discovery requests rested with assignee). *See also* TBMP § 412 (Protective Orders).

[303] *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 387-388 (1985).

[304] *See, for example, Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra*; and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

[305] *For other examples of cases involving a motion for a protective order relating to discovery, see Double J of Broward Inc. v. Skalony Sportswear GmbH,* 21 USPQ2d 1609 (TTAB 1991) (request for protective order that discovery be governed by the Hague Evidence Convention); and *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.,* 188 USPQ 141 (TTAB 1975) (motion for protective order that discovery not be taken pending Board's determination of motion to dismiss).

the handling of confidential or trade secret information rather than filing a motion for a protective order.

For further information concerning protective orders, see TBMP § 412.

527 Motion for Sanctions

527.01 Motion for Discovery Sanctions

527.01(a) For Failure to Comply With Board Discovery Order

37 CFR § 2.120(g) Sanctions.
(1) If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award any expenses to any party. The Board may impose against a party any of the sanctions provided by this subsection in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure.

If a party fails to comply with an order of the Board relating to discovery, including a protective order or an order compelling discovery, the Board may enter appropriate sanctions, as defined in 37 CFR § 2.120(g)(1).[306] In the case of a protective order, these sanctions may be entered by the Board against a party if the party or any attorney, agent, or designated witness of the party fails to comply with the protective order.[307]

The sanctions which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party.[308] Default judgment is a harsh remedy, but may be justified where no

[306] *See* 37 CFR § 2.120(g)(1) and *Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 11 Fed. R. Serv.3d 1342 (Fed. Cir. 1988) (question of proper sanction committed to sound discretion of the court).

[307] *See* 37 CFR § 2.120(g)(1).

[308] *See Ingalls Shipbuilding, Inc. v. United States*, *supra* (Fed. Cir. 1988); *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment); *Baron Philippe de Rothchild S.A. v. Styl-Rite Optical Mfg. Co.,* 55 USPQ2d 1848, 1854 (TTAB 2000) (pattern of dilatory conduct indicated willful disregard of

less drastic remedy would be effective and there is a strong showing of willful evasion.[309] However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party.[310]

The motion for sanctions for failure to comply with an order of the Board lies only when the Board has entered an order relating to discovery (i.e., an order compelling discovery or a protective order) and the order has been violated.[311]

The motion for sanctions for failure to comply with an order of the Board relating to discovery does not apply in situations involving requests for admissions. Sanctions in those situations are governed by Fed. R. Civ. P. 36, except that the Board will not award any expenses to any party.[312]

For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, see TBMP § 527.01(d).

Board order and resulted in entry of judgment); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (applicant ordered to copy and forward documents to opposer at applicant's expense); and *Electronic Industries Assn. v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (where applicant, in violation of order, served objections to discovery requests, judgment was denied as too harsh but applicant was ordered to provide new and complete responses without objection, to copy documents and forward to opposer, and to study sections of TBMP and certify completion to the Board). *See also Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984) and *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983) (in 1983 decision respondent sanctioned by order to produce documents by mailing them to petitioner's attorney at petitioner's expense; in 1984 decision respondent's continued refusal to obey Board orders sanctioned by entry of judgment); and *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976) (judgment entered where applicant provided no reason for not complying with Board order compelling discovery).

Cf. Ingalls Shipbuilding, Inc. v. United States, supra at 1348 (failure to comply based on confusion or sincere misunderstanding of court's order does not warrant dismissal) and *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984) (sanction of drawing adverse inference best left to situations where witness fails or refuses to answer during testimony as opposed to discovery deposition).

[309] *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra* at 1854, *and other cases cited in previous note.*

[310] *See* 37 CFR §§ 2.120(g)(1) and 2.127(f), and TBMP § 502.05 (Attorneys' Fees, etc., on Motions).

[311] *See, for example, MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979) (Board did not issue order compelling discovery but had only resumed proceedings after apparent failure of settlement negotiations and reset time to respond to discovery); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976) (motion for summary judgment on basis of petitioner's failure to answer interrogatories denied); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974) (motion for judgment denied).

[312] *See* 37 CFR § 2.120(h), and TBMP § 502.05.

[312] *See* 37 CFR §§ 2.120(g)(1), (2), 2.127(f), and TBMP § 502.05.

527.01(b) If Party Says It Will Not Respond to Discovery Request

37 CFR § 2.120(g)(2) *If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.*

The motion for sanctions under 37 CFR § 2.120(g)(2) is available only for discovery depositions, interrogatories, and requests for production of documents and things, and lies only where the responding party **(1)** has failed to respond, *and* **(2)** has informed the party seeking discovery that no response will be made.

The sanctions which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party.[313]

The motion for sanctions under 37 CFR § 2.120(g)(2) does not apply in situations involving requests for admissions. *For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, see* TBMP § 527.01(d).

527.01(c) Untimely Response to Discovery Requests

A party which fails to respond to a request for discovery (except for a request for admission) during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits.[314] Objections going to the merits of a discovery request include claims that the

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[314] *See No Fear Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found)*; Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (circumstances do not justify waiver of right to object in view of confusion regarding time to respond); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (even where there is complete failure to respond to discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel); *and Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975)

information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.[315] Objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.[316]

527.01(d) In the Case of Requests for Admission

The entry of sanctions for failure to respond, or respond properly, to requests for admission is governed by 37 CFR § 2.120(h) and Fed. R. Civ. P. 36, except that the Board will not award expenses to any party.[317]

If a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 CFR § 2.120(j)(3)(i), unless the party upon which the requests were served is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board. *See* Fed. R. Civ. P. 6(b) and 36(a), and TBMP § 407.03(a). *For information concerning motions to withdraw or amend admissions, see* TBMP § 525.

If a party upon which requests for admission have been served responds by serving answers and/or objections thereto, and the propounding party believes that one or more of the answers and/or objections is insufficient, the propounding party may file a motion with the Board to determine the sufficiency of the answers and/or objections believed to be insufficient.[318] If the Board determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served.[319] *For information concerning*

(waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also* TBMP § 403.03 (Time for Service of Discovery Responses)

[315] *See No Fear Inc. v. Rule*, *supra* at 1554.

[316] *See No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

[317] *See* 37 CFR § 2.120(h), and TBMP § 502.05 (Attorneys' Fees etc., on Motions)

[318] *See* 37 CFR § 2.120(h); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971).

[319] *See* Fed. R. Civ. P. 36(a).

motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.

527.01(e) Estoppel Sanction

A party which responds to a request for discovery by indicating that it does not have the information sought, or by stating objections thereto, may be barred by its own action from later introducing the information sought in the request as part of its evidence on the case, providing that the propounding party raises the matter by objecting to the evidence in question on that ground, and preserves the objection in its brief on the case (it is not necessary that the objecting party file a motion asking for application of this sanction).[320]

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[320] *See, for example, Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 11 Fed. R. Serv. 3d 1342, 1351 (Fed. Cir. 1988); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 828-29 (CCPA 1980) (applicant's representations in objecting to interrogatories that facts other than those already litigated in prior proceedings were irrelevant and not discoverable gave rise to equitable estoppel preventing applicant from introducing testimony about those other facts); *Super Valu Stores Inc. v. Exxon Corp.*, 11 USPQ2d 1539, 1543 (TTAB 1989) (party may not refuse to answer interrogatories by claiming confidentiality and then introduce responsive information during its trial period); *Presto Products Inc. v. Nice-Pak Products Inc.,* 9 USPQ2d 1895, 1896 n.5 (TTAB 1988) (trademark search report not produced under attorney-client privilege, albeit rightfully withheld, still cannot be relied upon to support motion for summary judgment); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987) (exhibits demonstrating pronunciation not produced during discovery, though encompassed by discovery requests, excluded from consideration); and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration). *See also* TBMP § 523.04 (Failure to File Motion to Compel).

Cf. Linville v. Rivard, 41 USPQ2d 1731, 1733 (TTAB 1996) (no estoppel; where objections that discovery requests are, for example, ambiguous or burdensome, or are otherwise not of a nature which would lead propounding party to believe that the requested information does not exist, party should have filed motion to compel), *aff'd,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (no estoppel; where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery deposition without motion to compel complete responses and violation of an order compelling answers); and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989) (in that party need not specify evidence it intends to present, failure to identify witness in response to interrogatory seeking identification of all witnesses who would testify at trial, did not preclude testimony of such witness).

For additional cases relating to this issue, see Appendix of Cases.

527.02 Motion for Fed. R. Civ. P. 11 Sanctions

Fed. R. Civ. P. 11…
(b) Representations to Court. *By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, --*

(1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;
(2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
(3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.

(c) Sanctions. *If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the attorneys, law firms, or parties that have violated subdivision (b) or are responsible for the violation.*

(1) How Initiated.

(A) By Motion. A motion for sanctions under this rule shall be made separately from other motions or requests and shall describe the specific conduct alleged to violate subdivision (b). It shall be served..., but shall not be filed with or presented to the court unless, within 21 days after service of the motion (or such other period as the court may prescribe), the challenged paper, claim, defense, contention, allegation, or denial is not withdrawn or appropriately corrected. ...
(B) On Court's Initiative. On its own initiative, the court may enter an order describing the specific conduct that appears to violate subdivision (b) and directing an attorney, law firm, or party to show cause why it has not violated subdivision (b) with respect thereto.

(2) Nature of Sanction; Limitations. *A sanction imposed for violation of this rule shall be limited to what is sufficient to deter repetition of such conduct or comparable conduct by others similarly situated. Subject to the limitations in subparagraphs (A) and (B), the sanction may consist of, or include, directives of a nonmonetary nature,...*
(3) Order. *When imposing sanctions, the court shall describe the conduct determined to constitute a violation of this rule and explain the basis for the sanction imposed.*

(d) Inapplicability to Discovery. *Subdivisions (a) through (c) of this rule do not apply to ... discovery requests, responses, objections, and motions that are subject to the provisions of Rules 26 through 37.*

37 CFR § 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.*

(b) *By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

> *(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and*
> *(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-*
>
> > *(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;*
> > *(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*
> > *(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*
> > *(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

(c) *Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of*

paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner [Director of the United States Patent and Trademark Office], or the Commissioner's [Director's] designee, which may include, but are not limited to, any combination of-

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action. See §10.23(c)(15).*

The quoted provisions of Fed. R. Civ. P. 11 are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board.[321] Thus, if a paper filed in an inter partes proceeding before the Board violates the provisions of Fed. R. Civ. P. 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction. The Board may find a Fed. R. Civ. P. 11 violation, and impose an appropriate sanction, not only upon motion, but also upon its own initiative, following issuance of an order to show cause and an opportunity for the party to be heard.[322]

Moreover, Rule 11 certification standards apply to parties as well as attorneys.[323]

While Fed. R. Civ. P. 11 provides, inter alia, for the imposition of monetary sanctions, the Board will not impose monetary sanctions, or award attorneys' fees or other expenses to any party.[324]

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[321] *See* 37 CFR § 2.116(a); *The Clorox co. v. Chemical Bank,* 40 USPQ2d 1098, n.9 (TTAB 1996) (accuracy in factual representations is expected); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (filing of notice of reliance on third-party discovery deposition constitutes certificate that circumstances exist which justify acceptance of the evidence). *See also*, Alan S. Cooper, *The Application of Rule 11 Sanctions in Trademark Cases*, 78 Trademark Rep. 427 (1988).

[322] *See* Fed. R. Civ. P. 11(c)(1)(B); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.,* 45 USPQ2d 2021 (TTAB 1998) (order to show cause issued where, although 56(f) motion was granted, party responded to summary judgment without taking the requested discovery); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 633 n.19 (TTAB 1986) (Rule 11 permits court to enter sanctions sua sponte).

[323] *See Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.,* 498 U.S. 533, 547, 111 S.Ct. 922, 112 L.Ed.2d 1140 (1991) and *Central Manufacturing Inc. v. Third Millennium Technology Inc*., 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). *See also* Patent and Trademark Rule 10.18(b).

[324] *See* 37 CFR § 2.127(f) and TBMP § 502.05 (Attorneys' Fees etc., on Motion). *Compare* 37 CFR § 2.120(f) and 2.120(g)(1).

However, the Board may enter other appropriate sanctions, up to and including the entry of judgment, against a party which violates Fed. R. Civ. P. 11.[325]

A motion for sanctions under Fed. R. Civ. P. 11(c) is governed by, and should not be filed in violation of, Fed. R. Civ. P. 11(b). If the Board finds that a motion for Fed. R. Civ. P. 11(c) sanctions itself violates the provisions of Fed. R. Civ. P. 11(b), an appropriate Fed. R. Civ. P. 11(c) sanction may be entered against the party that filed the motion.

The provisions of 37 CFR § 10.18 largely pattern Federal Rule 11 and are also applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. Any practitioner who knowingly violates the provisions of that rule is subject to disciplinary action.[326]

527.03 Inherent Authority to Sanction

Flowing from the Board's inherent authority to manage the cases on its docket is the inherent authority to enter sanctions against a party.[327] The Board's exercise of this authority is clearly permitted in a variety of situations where the conduct in question does not fall within the reach of other sanctioning provisions of the rules.[328]

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[325] *See* 37 CFR § 2.116(a); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, *supra* at 2023 (sanctions included requirement that law firm include express provision in all subsequent filings acknowledging Rule 11(b) and Trademark Rule 10.18(a) and stating that motion was read, has a sound legal basis and is not interposed for delay, harassment or other improper purpose); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1221 (TTAB 1990) (Rule 11 not designed to punish semantic errors; applicant had reasonable basis for allegations in its pleading); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (filing of discovery motions without reasonable basis in law or in fact resulted in Rule 11 sanctions precluding applicant from filing further discovery motions and from filing any motion without prior leave of Board); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (applicant's frivolous request for reconsideration of order imposing Rule 11 sanctions resulted in entry of judgment); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986) (applicant warned that any other filing deemed frivolous would result in judgment). *See also*, Alan S. Cooper, *The Application of Rule 11 Sanctions in Trademark Cases*, 78 Trademark Rep. 427 (1988).

[326] *See* 37 CFR § 10.18 and, for example, *ITC Entertainment Group Ltd. v. Nintendo of America Inc., supra. For information concerning disciplinary proceedings, see* 37 CFR §§ 10.130-10.170, and TBMP § 115.02 (Disciplinary Proceedings). In addition, conduct in violation of the Canons and Disciplinary Rules set forth in 37 CFR part 10 may be referred to the Office of Enrollment and Discipline for appropriate action. *See* 37 CFR §§ 10.18(d) and 10.20, *et.seq.*

[327] *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27*, rehearing denied*, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991) (stating that this inherent power "stems from the very nature of courts and their need to be able to manage their own affairs so as to achieve the orderly and expeditious disposition of the cases").

[328] *See Chambers v. NASCO, Inc.*, *supra* (stating that "[i]f in the informed discretion of the court, neither the statute nor the Rules are up to the task, the court may safely rely on its inherent power.") and *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's conduct did not "fall within reach" of Rule 11 but resulted in judgment under Board's inherent power to sanction).

For example, when a party to an inter partes proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and request entry of judgment in its favor. If, as is usually the case, the motion is uncontested, the Board normally will grant it.[329]

Similarly, if a registrant (having been served by the Board with a copy of a petition to cancel its registration) or any other party to an inter partes proceeding before the Board, relocates, and fails to inform its attorney (if it is represented by an attorney) or the Board or any adverse party of its new address, with the result that the party cannot be found, and papers relating to the proceeding cannot be served upon it, any adverse party may file a motion asserting such fact and requesting entry of judgment in its own favor. Again, if the motion is uncontested, it normally will be granted by the Board. Alternatively, under these or similar circumstances indicating that a party is no longer interested in the case, the Board may, either upon motion by the adverse party or upon its own initiative, issue an order that the party show cause why the Board should not enter judgment in view of the party's apparent loss of interest in the case. If the party files no response to the order, judgment will normally be entered.

Other circumstances involving the Board's inherent power to sanction are set forth in the cases cited in the note below. [330]

528 Motion for Summary Judgment

Fed. R. Civ. P. 56. Summary Judgment
(a) For Claimant. *A party seeking to recover upon a claim [or] counterclaim ... may ... move with or without supporting affidavits for a summary judgment in the party's favor upon all or any part thereof.*

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[329] *See* 37 CFR § 2.127(a).

[330] *International Finance Corp. v. Bravo Co.,* 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (following opposer's third motion to compel, Board prohibited opposer from filing any further motions to compel without prior Board permission); *Central Manufacturing Inc. v. Third Millennium Technology, Inc*., 61 USPQ2d 1210 (TTAB 2001) (extensions of time based on false allegations of continuing settlement negotiations resulted in imposition of continuing sanctions in future cases); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's "callous disregard for Board orders and ignorance of warnings" including violation of order prohibiting filing of any further papers without prior leave, resulted in order dismissing opposition without prejudice, and holding opposed application abandoned without prejudice); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp*., 13 USPQ2d 1719, n.4 (TTAB 1989) (opposer's counsel warned that Board would not tolerate any further "game playing" or evasiveness in discovery).

Cf. Thrifty Corporation v. Bomax Enterprises, 228 USPQ 62, 63 n.2 (TTAB 1985) (Board, while noting that it did not condone applicant's repeated failure to comply with the requirements of Trademark Rules 2.119(a) and (b) found that, in absence of any prejudice to opposer, such conduct did not justify the harsh result of entry of default judgment).

(b) For Defending Party. *A party against whom a claim [or] counterclaim ... is asserted ... may ... move with or without supporting affidavits for a summary judgment in the party's favor as to all or any part thereof.*

(c) Motion and Proceedings Thereon. *... The adverse party ... may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. ...*

(d) Case Not Fully Adjudicated on Motion. *If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court ..., by examining the pleadings and the evidence before it ..., shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, ... and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.*

(e) Form of Affidavits; Further Testimony; Defense Required. *Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party.*

(f) When Affidavits are Unavailable. *Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.*

* * * *

528.01 General Nature of Motion

The motion for summary judgment is a pretrial device to dispose of cases in which "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law."[331]

The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case.[332]

The summary judgment procedure is regarded as "a salutary method of disposition," and the Board does not hesitate to dispose of cases on summary judgment when appropriate.[333]
A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law.[334] This is a burden that is higher than the preponderance of the evidence burden needed to prevail at final

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[331] Fed. R. Civ. P. 56(c). *See, for example, Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); *Dana Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); and *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). *For additional cases relating to this issue, see Appendix of Cases.*

[332] *See, for example*, *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) (evidence which might be adduced at trial would not change result given the differences in the goods of the parties); *Larami Corp. v. Talk To Me Programs Inc*., 36 USPQ 1840, 1843 (TTAB 1995) (where issue involved collateral estoppel); and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1390-91 (TTAB 1994).

[333] *See, for example*, *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (no relevant evidence to raise genuine issue of material fact); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984) (response contained only unsupported arguments and conclusions): and *The Clorox Co. v. Chemical Bank,* 40 USPQ2d 1098, 1102 (TTAB 1996) (question of legal effect of assigning ITU application is one of law). *See also*, T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413, at 413-414 (1990); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, 77-78 (1986).
But see Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295, 1298-99 (Fed. Cir. 1991) (factual question of intent [regarding misuse of registration symbol] is particularly unsuited to disposition on summary judgment) and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (question of intent [regarding filing of ITU application] generally unsuitable for disposal by summary judgment).

[334] *See, for example*, *Copelands' Enterprises Inc. v. CNV Inc., supra* (moving party's conclusory statement as to intent insufficient) and *Corporate Document Services Inc. v. I.C.E.D. Management Inc*., 48 USPQ 1477 (TTAB 1998).

hearing. The burden of the moving party may be met by showing (that is, pointing out) "that there is an absence of evidence to support the nonmoving party's case."[335]

If the moving party meets its burden, that is, if the moving party has supported its motion with affidavits or other evidence which if unopposed would establish its right to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial.[336] A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party.[337]

In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine issues of material fact to be tried.[338] The non-moving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the non-moving party.[339]

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[335] *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) (no requirement that moving party support its motion with affidavits or other similar materials negating the opponent's claim but may be based on nonmovant's failure to make sufficient showing as to its own case on which it has burden of proof) and *Anderson v. Liberty Lobby, Inc*., 477 U.S. 242 (1986). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991); *Kellogg Co. v. Pack'Em Enterprises Inc.,* 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991); *Avia Group International Inc. v. L.A. Gear California Inc.,* 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); and *Sweats Fashions Inc. v. Pannill Knitting Co.,* 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

[336] Fed. R. Civ. P. 56(e); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (non-moving party's response was not supported by contradictory facts, but merely expressed disagreement with facts); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, *supra* at 1797 ("mere conclusory statements and denials do not take on dignity by placing them in affidavit form.").

[337] *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (not required to present entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute); *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.,* 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987) (dispute is genuine "only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant"); and *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc*., 60 USPQ2d 1733, 1735 (TTAB 2001).

[338] *See Dyneer Corp. v. Automotive Products plc,* 37 USPQ 1251, 1254 (TTAB 1995) and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

[339] *See Lloyd's Food Products Inc. v. Eli's Inc.,* 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (impermissible inferences against nonmovant); *Opryland USA Inc. v. The Great American Music Show Inc.*, *supra* at 1472; *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992) (impermissible inferences in favor of movant); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) (reasonable inferences as to intent could have been drawn in nonmovant's favor); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc*., 41 USPQ2d 1030, 1034 (TTAB 1996) (Board accepted nonmovant's

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings."[340] However, a dispute over a fact that would not alter the Board's decision on the legal issue will not prevent entry of summary judgment.[341] Further, even a genuine dispute over a fact relating only to an issue which is not the subject of the summary judgment motion will not preclude determination of the motion.[342]

Where both parties have moved for summary judgment, the mere fact that they have done so does not necessarily mean that there are no genuine issues of material fact, or authorize the resolution of such issues, or dictate that judgment should be entered in favor of one of them.[343] Summary judgment cannot be granted on an unpleaded issue or defended on an unpleaded claim or defense.[344]

A party moving for summary judgment should specify, in its brief in support of the motion, the material facts which are undisputed. The nonmoving party, in turn, should specify, in its brief in opposition to the motion, the material facts that are in dispute.[345]

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version of the facts for purposes of deciding motion); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (on opposer's motion for summary judgment applicant's evidence of statement of use filed in connection with another of its applications covering many of same goods as in opposed application created inference of bona fide intent to use present mark despite absence of any documents regarding its intent to use present mark).

[340] *Opryland USA Inc. v. The Great American Music Show Inc., supra* at 1472. *See also Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1879 (TTAB 1998) (fact is material when its resolution would affect the outcome of the case).

[341] *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result). *See also Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1879 (TTAB 1998) and *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

[342] *See United States Olympic Committee v. O-M Bread Inc.*, 29 USPQ2d 1555 (TTAB 1993) (genuine issues of fact as to grounds which were asserted in opposition but were not grounds for summary judgment were irrelevant).

[343] *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

[344] *See* TBMP § 528.07 (Unpleaded Issue).

[345] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

If the Board concludes that there is no genuine issue of material fact, but that the nonmoving party is the one entitled to judgment as a matter of law, the Board may enter summary judgment sua sponte in favor of the nonmoving party.[346]

Briefs in support of a motion for summary judgment and briefs in response are limited to 25 pages, and a reply brief shall not exceed 10 pages in length. Exhibits submitted in support of or in opposition to the motion are not deemed to be part of the brief for purposes of determining the length of the brief.[347] A motion for summary judgment should be filed in single (not multiple) form.

528.02 Time for Filing Motion

37 CFR § 2.127(e)(1) *A motion for summary judgment may not be filed until notification of the proceeding has been sent to the parties by the Trademark Trial and Appeal Board. A motion for summary judgment, if filed, should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter.*

A motion for summary judgment filed in an inter partes proceeding before the Board may not be filed until after the Board notifies the parties of the institution of the proceeding.[348]

Moreover, the motion for summary judgment should be filed before the opening of the first testimony period, as originally set or as reset. The motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law.[349] In inter partes proceedings before the Board, trial commences with the opening of the first testimony period.[350] Therefore, a motion for summary judgment should be filed prior to the opening of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any summary judgment motion filed thereafter.[351] If testimony

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[346] *See Clorox Co. v. Chemical Bank,* 40 USPQ2d 1098, 1104 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor).

[347] 37 CFR § 2.127(a).

[348] *See* 37 CFR 2.127(e)(1). *See also* TBMP § 310.01 (Notification of Proceeding).

[349] *See* TBMP § 528.01 (General Nature of Motion [for Summary Judgment]) and authorities cited therein.

[350] *See* TBMP §§ 504.01 (Time for Filing [Judgment on the Pleadings]) and 701 (Time of Trial).

[351] *See* 37 CFR § 2.127(e)(1); *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) (motion filed three days before testimony period opened was not untimely despite respondent's claim that it would have conducted additional discovery if it had known petitioner was planning to file motion rather than go to trial); *Stephanus Freiherr Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB

periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion for summary judgment filed before such testimony period commences is timely. Once the first testimony period commences, however, any summary judgment motion filed thereafter is untimely, even if technically filed prior to the opening of a rescheduled testimony period-in-chief for plaintiff, and/or even if no trial evidence has actually been adduced by the plaintiff.[352] The Board will generally not consider a motion for summary judgment filed after the first testimony period commences unless **(1)** it involves a matter of res judicata (claim preclusion) or collateral estoppel (issue preclusion), **(2)** was submitted by agreement of the parties (prior to the taking of any testimony), or **(3)** was not opposed by the nonmoving party (at least on the basis of its untimeliness).[353]

When a motion for summary judgment is filed a brief in response or a motion under 56(f) of the Federal Rules of Civil Procedure shall be filed within 30 days from the date of service of the motion. A reply brief, if any, shall be filed within 15 days from the service date of the brief in response.[354] The time for filing a responsive brief may be extend, but the time for filing, in lieu thereof, a motion under Rule 56(f) will not be extended.[355]

528.03 Suspension Pending Determination of Motion

37 CFR § 2.127(d) *When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension*

1986) (motion filed after trial period opens does not serve purpose of eliminating need for trial); and *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985) (motion filed after close of applicant's testimony period untimely).

[352] *See La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976) (motion filed before reset testimony period opened, but after previous testimony period opened was untimely; petition to Commissioner to reverse Board action denied); David J. Kera, *TIPS FROM THE TTAB: Summary Judgment*, 71 Trademark Rep. 59, 62 (1981); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, at 73-74 (1986).

[353] *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1498 n.2 (TTAB 1986) (untimely cross-motions decided where parties acknowledged that both were untimely but wanted a ruling thereon); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), *aff'd, Vesper Corp. v. Lukens Inc.,* 831 F.2d 306 (Fed. Cir. 1987) (untimely motion decided where non-moving party did not object to timeliness and responded on merits and moreover, motion was based on collateral estoppel); and *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (untimely motion decided where no objection to timeliness was raised and delay was relatively insignificant).

[354] 37 CFR § 2.127(e)(1).

[355] *See* TBMP § 528.06 (Request for Discovery to Respond to Summary Judgment).

order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

When a party files a timely motion for summary judgment, the Board will suspend proceedings in the case with respect to all matters not germane to the motion[356] (if the motion was untimely filed, the Board, in its discretion, may issue an immediate action denying the motion for that reason). The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case; rather, proceedings are suspended when the Board issues an order to that effect.[357] However, on a case-by-case basis, the Board may find that the filing of a motion for summary judgment provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests.[358]

Once the Board has suspended proceedings in a case pending the determination of a motion for summary judgment, no party should file any paper that is not germane to the motion.[359] Examples of papers which are or may be germane to a motion for summary judgment include a brief in opposition to the summary judgment motion, a motion for an extension of time in which to respond to the summary judgment motion, a motion under Fed. R. Civ. P. 56(f) for discovery needed to enable the nonmoving party to respond to the summary judgment motion, a cross-motion for summary judgment, and a motion for leave to amend a party's pleading.[360]

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[356] *See* 37 CFR §§ 2.127(d) and (e)(1) and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986) (motion to compel deferred pending ruling on summary judgment motion).

[357] *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, *supra* at 965 and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, at 74 (1986). *Cf. Consultants & Designers, Inc. v. Control Data Corp.*, 221 USPQ 635, 637 n.8 (TTAB 1984) (filing of motion for entry of default judgment for failure to answer does not automatically suspend proceedings).

[358] *Cf. Leeds Technologies Limited v. Topaz Communications Ltd.,* 65 USPQ2d 1303 (TTAB 2002) (regarding suspension in the case of a motion for judgment on the pleadings); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (regarding suspension in the case of a motion for sanctions in the nature of judgment); and *Giant Food, Inc. v. Standard Terry Mills, Inc., supra* at 965-66 (pendency of applicant's summary judgment motion did not under the circumstances constitute good cause for not responding to outstanding discovery requests).

[359] *See* 37 CFR § 2.127(d) and*, for example, Corporate Document Services Inc. v. I.C.E.D. Management Inc*., 48 USPQ2d 1477, 1479 (TTAB 1998) (motion for discovery sanctions not considered) and *Pegasus Petroleum Corp. v. Mobil Oil Corp., supra* (motion to suspend for civil action not considered).

[360] *See* TBMP § 528.07 (Unpleaded Issue), and cases cited therein (regarding amendment of pleadings*). See also International Finance Corp. v. Bravo Co.,* 64 USPQ2d 1597, 1603-04 (TTAB 2002) (motion to amend opposition germane inasmuch as it related to the issue of whether applicant's motion is one for complete or partial summary judgment); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.,* 41 USPQ 1030, 1032 (TTAB 1996) (motion to amend pleading to add new claim); *United States Olympic Committee v. O-M Bread Inc*., 26 USPQ2d 1221, 1222 (TTAB 1993) (motion to amend to amplify pleading); and *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment is a proper filing even after proceeding is suspended).

Extensions of time will not be granted for a motion under 56(f) for discovery or for the moving party to file a reply brief. The Board will consider no further papers beyond a reply brief in support of or in opposition to a motion for summary judgment.[361]

If the Board's determination of the summary judgment motion does not dispose of the case, the Board ordinarily will issue an order resuming proceedings.[362]

528.04 Miscaptioned Motion

If, on a motion captioned as a motion to dismiss (for failure to state a claim upon which relief can be granted), or a motion for judgment on the pleadings, matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed. R. Civ. P. 56.[363] Ordinarily, the parties to the proceeding will be notified that the motion to dismiss, or for judgment on the pleadings, is being treated as a motion for summary judgment, and they will be given a reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56.[364] Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion to dismiss, or a motion for judgment on the pleadings, as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis.[365]

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[361] 37 CFR § 2.127(e)(1).

[362] *See* 37 CFR § 2.127(d).

[363] *See, for example, Wellcome Foundation Ltd. v. Merck & Co.,* 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (third-party registrations submitted, but excluded). *See also* TBMP §§ 503.04 (regarding motions to dismiss for failure to state a claim) and 504.03 (regarding motions for judgment on the pleadings).

[364] *See, for example, Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc., supra at* 1031 (12(b)(6) motion treated in its entirety as one for summary judgment). *See also* TBMP §§ 503.04 (Matters Outside the Pleading for Motion to Dismiss) and 504.03 (Matters Outside the Pleadings for Judgment on Pleadings) and authorities cited therein.

[365] *See* TBMP §§ 503.04 and 504.03; *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (motion under 12(b)(6) and/or for summary judgment treated as a motion for summary judgment where both parties submitted evidentiary materials outside pleadings); and *Parker Brothers v. Tuxedo Monopoly, Inc.*, 225 USPQ 1222 (TTAB 1984) (motion to dismiss treated as one for summary judgment where matters outside the pleadings submitted and cross-motion for summary judgment filed in response).

Cf. Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) (Board improperly treated motion to dismiss as a motion for summary judgment by rendering a decision on the merits without giving plaintiff notice it would treat the motion as such).

Conversely, a motion for summary judgment without supporting evidence is the functional equivalent of a motion to dismiss for failure to state a claim upon which relief can be granted, or of a motion for judgment on the pleadings.[366]

528.05 Summary Judgment Evidence

528.05(a) In General

The types of evidence which may be submitted in support of, or in opposition to, a motion for summary judgment include "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any."[367]

The evidentiary record upon summary judgment in an inter partes proceeding before the Board also includes, without action by any party, the file of any application or registration which is the subject of the proceeding as provided in 37 CFR § 2.122(b) and a copy of any registration pleaded and made of record by the plaintiff with its complaint, in the manner prescribed in 37 CFR § 2.122(d)(1). In addition, a party may make of record, for purposes of summary judgment, copies of other registrations; documents or things produced in response to a request for production; official records, if competent evidence and relevant to an issue; printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue, if the publication is competent evidence and relevant to an issue; and testimony from other proceedings, so far as relevant and material.[368] A party need not submit these materials under a notice of reliance in order to make them of record for purposes of a summary judgment motion. Rather, the materials may be submitted as attachments or exhibits to a party's brief on the motion.[369]

In a Board proceeding, the only evidentiary materials likely to be already of record when a motion for summary judgment is filed are the pleadings; the file of any application or

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[366] *See S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987) (motion for summary judgment was unsupported and whether movant was entitled to judgment as a matter of law could not be determined on pleadings alone); and Wright, Miller & Kane, *Federal Practice and Procedure*: Civil 3d § 2722 (1998). *For information concerning the motion to dismiss for failure to state a claim, see* TBMP § 503. *For information concerning the motion for judgment on the pleadings, see* TBMP § 504.

[367] *See* Fed. R. Civ. P. 56(c). *See also* Fed. R. Civ. P. 56(e).

[368] *See* 37 CFR §§ 2.122(b), 2.122(d)(2), 2.122(e), 2.122(f), and 2.127(e)(2). *See also Raccioppi v. Apogee Inc.*, 47 USPQ 1368, 1369-70 (TTAB 1998) (may rely on documents admissible under 2.122(e)).

[369] *Cf.* TBMP § 700 (Trial Procedure and Introduction of Evidence).

registration which is the subject matter of the proceeding; and any registration pleaded and made of record by the plaintiff with its complaint. Any other evidence, which a party wishes to have considered upon summary judgment, must be submitted in connection with the summary judgment motion.[370]

Evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion**.** If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period.[371] However, the parties may stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision.[372] Moreover, the parties may, if they so desire, stipulate that the summary judgment motion and evidence be treated as the final record and briefs in the case.[373]

What follows, in TBMP §§ 528.05(b) through 528.05(f), is a more detailed discussion of some of the types of evidence that may be submitted in connection with a summary judgment motion.

528.05(b) Affidavits and Accompanying Exhibits

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they **(l)** are made on personal knowledge; **(2)** set forth such facts as would be admissible in evidence; and **(3)** show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits are

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[370] *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

[371] *See Hard Rock Café Licensing Corp. v. Elsea,* 48 USPQ2d 1400, 1404 (TTAB 1998)*; Levi Strauss & Co. v. R. Josephs Sportswear Inc*., 28 USPQ2d 1464 (TTAB 1993) (declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during applicant's testimony period); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983) (affidavit offered with response to motion for summary judgment became part of trial record when witness identified it during testimony deposition and adverse counsel cross-examined witness about statements in the affidavit); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981) (material in support of untimely summary judgment motion not trial evidence absent agreement of parties). *See also Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57 (TTAB 1975), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); and *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214 (TTAB 1970).

[372] *See, for example, Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1662 n.2 (TTAB 1998) (where parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial).

[373] *See*, *for example*, *Arleen Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002) and *Miller Brewing Company v. Coy International Corporation*, 230 USPQ 675, 676 (TTAB 1986).

self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. However, an adverse party may have an opportunity for direct examination of the affiant, if a Fed. R. Civ. P. 56(f) motion to take the discovery deposition of the affiant is made and granted - *see* TBMP § 528.06.[374]

The Board may permit affidavits submitted in connection with a summary judgment motion to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits.[375]

Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit.[376] An affidavit that is not supported by documentary evidence may nevertheless be given consideration if the statements contained in the affidavit are clear and convincing in character, and uncontradicted.[377]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20.[378]

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[374] *See* Fed. R. Civ. P. 56(e). *See also* Fed. R. Civ. P. 56(c); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (moving party's affidavit and other evidence were uncontradicted by nonmoving party); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477 (TTAB 1998) (use of standard language in declaration did not raise genuine issue as to personal knowledge); *C & G Corp. v. Baron Homes, Inc.*, 183 USPQ 60 (TTAB 1974) (affidavit is competent evidence); *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93, 94 (TTAB 1972) (affidavit was not made on personal knowledge and there was no foundation for statements made therein); and *4U Company of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251 (TTAB 1972) (issue of credibility raised as to one affiant but statements by another affiant were competent and uncontradicted and suspicion alone is insufficient to invalidate).

[375] *See* Fed. R. Civ. P. 56(e), and *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993) (additional affidavit submitted with reply brief considered).

[376] *See Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1030 n.9 (TTAB 1988) (documents were related to information given in affidavit, but were not specifically identified therein).

[377] *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001) (opposer's declaration, while not accompanied by any documentary evidence, was internally consistent, not characterized by uncertainty and unchallenged by applicant); *4U Company of America, Inc. v. Naas Foods, Inc., supra* at 253 (fact that allegations in affidavit not supported by invoice does not undermine the testimony when uncontradicted).

Cf., for example, with respect to testimony depositions, Liqwacon Corp. v. Browning-Ferris Industries, Inc., 203 USPQ 305, 307 n.1 (TTAB 1979); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976); *Clubman's Club Corp. v. Martin*, 188 USPQ 455, 458 (TTAB 1975); and *Rite Aid Corp. v. Rite-Way Discount Corp.*, 182 USPQ 698, 702 n.5 (TTAB 1974), *aff'd*, 508 F.2d 828, 184 USPQ 351 (CCPA 1975).

[378] *See* 37 CFR § 2.20, and *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

528.05(c) Discovery Responses

37 CFR § 2.127(e)(2) *For purposes of summary judgment only, a discovery deposition, or an answer to an interrogatory, or a document or thing produced in response to a request for production, or an admission to a request for admission, will be considered by the Trademark Trial and Appeal Board if any party files, with the party's brief on the summary judgment motion, the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for production and the documents or things produced in response thereto, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto).*

Cf. 37 CFR § 2.120(j), governing the use of discovery responses as trial evidence, and TBMP §§ 704.09-704.11.

528.05(d) Registrations

37 CFR § 2.122(d)(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...*

If a plaintiff's registration is pleaded and made of record pursuant to 37 CFR § 2.122(d)(1), the registration is of record for all purposes, including a summary judgment motion.

Alternatively, a plaintiff may make its pleaded registration of record, for purposes of summary judgment only, by filing such a status and title copy with its brief on the summary judgment motion.[379] A registration owned by a defendant may be made of record, for purposes of summary judgment only, in the same manner.

A party may make a third-party registration of record, for purposes of summary judgment only, by filing a copy thereof with its brief on the summary judgment motion; the copy need not be a certified copy, nor need it be a status and title copy.[380]

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[379] *See Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 n.3 (TTAB 1986). *Cf.* 37 CFR § 2.122(d)(2).

[380] *See Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977) (third-party registrations may be plain copies). *See also* 37 CFR § 2.122(e) and *Raccioppi v. Apogee Inc., supra* at 1370 (incomplete TRAM records of third-party registrations not sufficient).

For purposes of summary judgment only, a copy of a trademark search report, made of record as an exhibit to an affidavit, or as part of a discovery response, submitted in opposition to a summary judgment motion, may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation.[381]

528.05(e) Printed Publications and Official Records

Printed publications, as described in 37 CFR § 2.122(e), include such materials as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding.[382] The term "official records," as used in 37 CFR § 2.122(e), refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer.[383]

Materials which qualify as printed publications or official records under 37 CFR § 2.122(e) are considered essentially self-authenticating, that is, the nonoffering party is readily able to verify the authenticity of the proffered materials.[384] As such, these materials may be relied on for purposes of summary judgment without further evidence of authenticity.[385] A party may introduce evidence of this nature in connection with a summary judgment motion, if the evidence is competent and relevant, by: specifying the official record or printed publication (including, with respect to the printed publication, information sufficient to identify the source and date of the publication) and the pages to be read; indicating generally the relevance of the material being offered; and including a copy of the proffered material with the party's brief.[386]

The material need not be submitted under a notice of reliance or in connection with the affidavit or declaration of a witness, and may simply be submitted as an attachment or exhibit to a party's supporting brief.

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[381] *See, e.g., Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

[382] *See* 37 CFR § 2.122(e) and TBMP § 704.08 (Printed Publications).

[383] *See* TBMP § 704.07 (Official Records).

[384] *See Racciopp v. Apogee Inc*., 47 USPQ2d 1368, 1370 (TTAB 1998) and *Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

[385] *See* 37 CFR § 2.122(e) *and Racciopp v. Apogee Inc., supra* at 1369.

[386] *Cf. Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source).

Internet evidence and other materials that are not self-authenticating. The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet.[387] Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not "subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered."[388] For this reason, Internet printouts cannot be considered the equivalent of printouts from, for example, a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified.[389]

Materials which do not fall within 37 CFR § 2.122(e), that is, materials which are not self-authenticating in nature, may nonetheless be admissible as evidence in connection with a summary judgment motion, if competent and relevant, provided they are properly authenticated by an affidavit or declaration pursuant to Fed. R. Civ. P. 56(e).[390] Such materials, including printouts of articles or information obtained from the Internet may, on summary judgment, be introduced by the affidavit or declaration of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials.[391]

For further information concerning official records and printed publications, including the probative value of such evidence, see TBMP § 704.08.[392]

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[387] *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

[388] *Weyerhaeuser v. Katz*, *supra* at 1232 (TTAB 1992) *citing Glamorene Products Corporation v. Earl Grissmer Company, Inc.*, 203 USPQ 1091, 1092 n.5 (TTAB 1979). *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *Cf. Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1134 (TTAB 2000) (introduction of telephone listings retrieved from Internet was improper); and *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (printout of page of website is not proper subject matter for a notice of reliance).

[389] *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (examining attorney's request for judicial notice of on-line dictionary definitions denied because the definitions were not available in printed format).

[390] *See* TBMP § 528.05(b) (Affidavits and Accompanying Exhibits).

[391] *See, e.g., Raccioppi v. Apogee Inc.*, *supra* at 1369.

[392] *See also Raccioppi v. Apogee Inc., supra at* 1371 for a discussion of the probative weight given evidence obtained from the Internet.

528.05(f) Testimony from Another Proceeding

37 CFR § 2.122(f) Testimony from other proceedings. *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

Upon motion granted by the Board, testimony taken in another proceeding, or in a suit or action in a court, between the same parties or their privies, may be used in connection with a summary judgment motion in a pending Board proceeding, to the extent that the testimony is relevant and material. The use of such testimony, however, is subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony."[393] Any motion made to enter testimony from another proceeding should be accompanied by a copy of the testimony sought to be entered in the record together with clear arguments as to its relevance and materiality. Relevance and materiality frequently hinge upon the marks and goods or services involved in the two proceedings.[394]

When the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken upon recall of the same witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion for summary judgment; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, upon motion granted by the Board, during the appropriate trial period.[395]

528.06 Request for Discovery to Respond to Summary Judgment

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present by affidavit facts essential to justify its opposition to the motion.[396]

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[393] 37 CFR § 2.122(f).

[394] *See* TBMP § 530 (Motion to Use Testimony from Another Proceeding).

[395] *See* TBMP § 528.05(a) (Summary Judgment Evidence – In General).

[396] *See* Fed. R. Civ. P. 56(f); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992) (finding sufficient need for additional discovery); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (unfocused requests for discovery; 56(f) makes no

It is not sufficient that a nonmoving party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(f) that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present by affidavit facts sufficient to show the existence of a genuine issue of material fact for trial.[397] If a party has demonstrated a need for discovery which is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment.[398] The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable party to respond to the motion for summary judgment.[399]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20.[400]

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distinction between whether no discovery has been taken or whether additional discovery is needed); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988) (complaint that summary judgment was granted before it could take discovery unavailing where party failed to seek 56(f) protection); *Spectra Corp. v. Lutz*, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988) (discovery properly denied where plaintiff had conducted 11 months of discovery and was allowed to continue taking discovery pending decision on defendant's motion for summary judgment and failed to file 56(f) affidavit); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion in brief of need for discovery insufficient). *See also Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 n.13 (TTAB 1998) (assertion in response to summary judgment motion that opposers intend to conduct further discovery was not proper request for 56(f) discovery); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (56(f) denied where applicant also filed a response to the summary judgment motion on the merits); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989) (56(f) declaration sufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989) (mere unsupported assertion of desire to take deposition inadequate); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990). *See also Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) (failure to file 56(f) motion creates presumption party did not consider such discovery essential).

[397] *See Dyneer Corp. v. Automotive Products PLC, supra at* 1253 (56(f) denied where applicant failed to show need for discovery as to specific issues, not merely a showing that it deferred taking discovery it otherwise would have taken had it known a motion for summary judgment would be filed*). See also cases cited in previous note.*

[398] *See Orion Group Inc. v. Orion Insurance Co. P.L.C.,* 12 USPQ2d 1923 (TTAB 1989).

[399] *See Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (unfocused requests for discovery are insufficient); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (mere assertion that discovery is necessary is insufficient); *Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990) (affidavit stating that, during discovery party will seek to elicit information on likelihood of confusion insufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989) (56(f) motion, to the extent it could be construed as such, was not supported by required affidavit); and *J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697 (TTAB 1986) (statement by applicant of need to take discovery on validity of assignment was unsupported speculation).

[400] *See* 37 CFR § 2.20. *Cf. Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

When a request for discovery under Fed. R. Civ. P. 56(f) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, requests for discovery outstanding, and those requests remain unanswered.[401]

A request for Fed. R. Civ. P. 56(f) discovery, if filed, must be filed within 30 days of the date of service of the summary judgment motion.[402] No extensions of time will be granted to file a motion under Rule 56(f). The affidavit in support of the request may be signed either by the requesting party or by its counsel, as appropriate.[403]

A request for 56(f) discovery should be clearly made, and certainly not buried somewhere in a responsive brief or other paper, and should not be filed as a "throw away" alternative accompanying a response to the motion for summary judgment on the merits.[404] Moreover, if a party's request for discovery under Fed. R. Civ. P. 56(f) is granted by the Board, and the party thereafter files a response to the summary judgment without taking the requested discovery, the filing of the Rule 56(f) motion may be viewed as sanctionable conduct under Fed. R.. Civ. P. 11.[405]

For further information concerning requests for discovery under Fed. R. Civ. P. 56(f), see T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed,* 80 Trademark Rep. 413 (1990).

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[401] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

[402] 37 CFR § 2.127(e)(1).

[403] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, *supra*.

[404] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, supra* at 416. *See also Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002) (56(f) motion denied where opposer filed a response to the motion for summary judgment on the merits).

[405] *See ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021 (TTAB 1998) (order to show cause issued where, although 56(f) motion was granted, party responded to summary judgment without taking the requested discovery).

528.07 Unpleaded Issue

528.07(a) Not Basis for Entering or Avoiding Summary Judgment

A party may not obtain summary judgment on an issue that has not been pleaded.[406] Moreover, at the summary judgment stage of a proceeding before the Board, there has not yet been a trial of any issue, whether pleaded or unpleaded, and therefore the requirements of Fed. R. Civ. P. 15(b) for an amendment to conform the pleadings to the evidence cannot have been met.[407]

However, a party that seeks summary judgment on an unpleaded issue may move to amend its pleading to assert the matter.[408] Alternatively, if the parties, in briefing summary judgment motion, have treated an unpleaded issue on its merits, and the nonmoving party has not objected to the motion on the ground that it is based on an unpleaded issue, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter.[409]

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[406] *See* Fed. R. Civ. P. 56(a) and 56(b); *S. Industries Inc. v. Lamb-Weston Inc*., 45 USPQ2d 1293, 1297 (TTAB 1997); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 n.8 (TTAB 1991); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 628 (TTAB 1986); and *Consolidated Foods Corp. v. Berkshire Handkerchief Co. Inc.*, 229 USPQ 619, 621 (TTAB 1986).

[407] *See, e.g., Vaughn Russell Candy Co. v. Cookies in Bloom Inc.,* 47 USPQ2d 1635, 1635 (TTAB 1998) (attempt to amend pleadings under 15(b) denied since there had not yet been a trial, but allowed time to move to amend under 15(a))**.**

[408] *See Vaughn Russell Candy Co. v. Cookies in Bloom Inc., supra* at 1635 (allowed time to file motion to amend pleading to add new grounds and to renew summary judgment motion); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, *supra* (motion to amend, filed after summary judgment on unpleaded issue had been denied, was granted); and *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 n.4 (TTAB 1989) (motion to amend to add new ground, filed simultaneously with motion for summary judgment, granted and allegations in new ground deemed denied).

[409] *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 81 n.3 (TTAB 1984) (pleading deemed amended where nonmoving party did not object to motion on unpleaded claim and treated it on its merits). *Compare Greenhouse Systems Inc. v. Carson,* 37 USPQ2d 1748, 1750 n.5 (TTAB 1995) (not permitted where nonmoving party objected to inclusion of unpleaded grounds even though party responded to motion on unpleaded grounds on merits).
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528.07(b) Not Defense Against Summary Judgment

A party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense.[410]

However, a party which seeks to defend against a motion for summary judgment by asserting the existence of genuine issues of material fact regarding an unpleaded claim or defense, may move to amend its pleading to allege the matter.[411] Alternatively, if a party seeks to defend against a motion for summary judgment by asserting the existence of genuine issues of material fact regarding an unpleaded claim or defense, and the party moving for summary judgment treats the unpleaded matter on its merits, and does not object thereto on the ground that the matter is unpleaded, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter.[412]

528.08 Entry of Summary Judgment in Favor of Nonmoving Party

If the Board concludes, upon motion for summary judgment, that there is no genuine issue of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, in appropriate cases, enter summary judgment *sua sponte* in favor of the nonmoving party (that is, enter summary judgment in favor of the nonmoving party even though there is no cross-motion for summary judgment).[413]

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[410] *Cf. Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) (may not assert unpleaded Morehouse defense), and *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.2 (TTAB 1992) (no consideration given to three unpleaded grounds asserted by opposer in response to applicant's motion for summary judgment).

[411] *See United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993).

[412] *Cf.* TBMP § 528.07(a) (Unpleaded Issue – Not Basis for Entering or Avoiding Summary Judgment) and authorities cited therein.

[413] *See, for example, Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1446 (TTAB 1996) (nonmovant entitled to summary judgment where question was one of law); *The Clorox Company v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986) (granted to nonmovant as to its standing); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (granted to nonmovant applicant because application elements allegedly missing from application were not required by Paris Convention); and *Visa International Service Assn v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983) (nonmovant entitled to judgment as a matter of law on issues of abandonment, non-use and fraud).

529 Motion to Offer Discovery Deposition of Self or Nonparty

37 CFR § 2.120(j) Use of discovery deposition, ...
(1) The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.

(2) Except as provided in paragraph (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.

Ordinarily, the discovery deposition of a party (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated by a party pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(3)) may be offered in evidence only by an adverse party; a party may not, in the first instance, offer in evidence a discovery deposition taken of itself (or of its officer, director, managing agent, etc.) by an adverse party, except by stipulation of the parties approved by the Board, or by order of the Board on motion. Similarly, no party may offer into evidence the discovery deposition of a nonparty witness, except by stipulation of the parties approved by the Board, or by order of the Board on motion.[414]

A motion for leave to offer in evidence a discovery deposition taken by an adverse party of the moving party itself (or of an officer, director, managing agent, etc., of the moving party), or the discovery deposition of a nonparty witness, must show that:

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[414] *See* 37 CFR § 2.120(j)(2), and TBMP § 704.09 (Discovery Depositions) and authorities cited therein. *Cf.* 37 CFR § 2.120(j)(4) (fairness exception provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce any other part of the deposition which should be considered so as to make not misleading what was offered by the submitting party).

(1) The person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or

(2) Such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used.[415]

A motion based on one of the first grounds listed above must be filed at the time of the purported offer of the deposition in evidence. A motion based on the second ground must be filed promptly after the circumstances claimed to justify use of the deposition become known.[416]

530 Motion to Use Testimony From Another Proceeding

37 CFR § 2.122(f) Testimony from other proceedings. *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

The use, in an inter partes proceeding before the Board, of testimony taken in another Board proceeding, or testimony taken in a suit or action in a court, is governed by 37 CFR § 2.122(f).[417]

A party may seek, by motion, to use testimony from another proceeding, either as evidence in its behalf upon summary judgment or as part of its evidence on the case.[418] The Board prefers that a

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[415] *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (opposer established that one third-party witness was out of the country during its testimony period but failed to establish that another witness was either a "party" as contemplated by Trademark Rule 2.120(j)(1), at the time of deposition or the existence of exceptional circumstances).

Cf. Maytag Co. v. Luskin's, Inc., 228 USPQ 747 n.4 (TTAB 1986) (deposition of opposer's nonparty witness taken by opposer during discovery treated as testimony deposition taken by stipulation of the parties prior to trial); and *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (discovery deposition of nonparty treated as stipulated in the record where applicant had not objected to opposer's notice of reliance upon the deposition).

[416] *See* 37 CFR § 2.120(j)(2).

[417] *Cf.* TBMP § 704.11 (Produced Documents) and authorities cited therein.

[418] *See* TBMP §§ 528.05(f) (Testimony from Another Proceeding) and 704.11 (Produced Documents) and authorities cited therein.

motion for leave to use testimony from another proceeding as evidence on the case be filed during the testimony period of the moving party.[419] The better practice is to file the motion early in the testimony period, in order to minimize the resulting delay in the proceeding. If the motion is made without the consent of every adverse party, and the moving party believes that it will need additional time to present evidence if the motion is denied, the moving party should file with its motion under 37 CFR § 2.122(f) a motion to extend its testimony period.

However, 37 CFR § 2.122(f) does not require that a motion for leave to use testimony from another proceeding be filed during the testimony period of the moving party, and it is not unreasonable for a party to want to ascertain, prior to the opening of its testimony period, whether it will be allowed to rely on such testimony. Thus, a motion under 37 CFR § 2.122(f) filed prior to the opening of the moving party's testimony period will not be denied as untimely.[420]

A motion for leave to use testimony from another proceeding should be accompanied by a copy of the testimony, and accompanying exhibits, sought to be introduced. A copy of the motion, testimony, and accompanying exhibits should be served on every other party to the proceeding.[421]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony,[422] or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

531 Motion That Deposition Upon Written Questions Be Taken Orally

37 CFR § 2.123(a)(1) *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a*

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[419] *Cf.* 37 CFR § 2.120(j)(2).

[420] *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to admit testimony from prior opposition filed during discovery period).

[421] *See* 37 CFR § 2.119(a), and *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, supra.*

[422] *See Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172 (*cf.,* Allen, *dissenting,* 177, 182 n.15) (TTAB 1986) (wherein dissent contended that discovery deposition should have been admitted as admission against interest).

motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

A party served with notice of the taking, by an adverse party, of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, may, within 15 days from the date of service of the notice (20 days if service of the notice was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)), file a motion with the Board, showing good cause, for an order that the deposition be taken by oral examination.[423]

The determination of whether good cause exists for a motion that a testimonial deposition upon written questions instead is taken by oral examination, is made by the Board on a case-by-case basis, depending upon the particular facts and circumstances in each case.[424]

532 Motion to Strike Notice of Reliance

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. *For a discussion of the introduction of evidence see* TBMP § 700. Trademark Rule 2.120(j), 37 CFR § 2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR § 2.122(e). Trademark Rule 2.122(d)(2), 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Trademark Rule 2.122(e), 37 CFR § 2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records.[425]

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[423] *See* 37 CFR § 2.123(a)(1).

[424] *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990) (unjust to deprive applicant of oral cross-examination opposer's expert rebuttal witness present in U.S.), *corrected*, 19 USPQ2d 1479 (TTAB 1990) and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980) (proposed deposition on written questions of petitioner's employees during rebuttal period would deprive applicant of cross-examination and confronting witness). *See also* Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253, at 254 (1980). *Cf. Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989) (good cause to take oral discovery deposition of witness in England) and TBMP § 520 (Motion to Take Foreign Deposition Orally).

[425] *See also* TBMP §§ 704.03(b) (Not Subject of Proceeding – In General), and 704.07-704.11.

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted thereunder), in its entirety, as untimely.[426]

An adverse party may also move to strike a notice of reliance, in whole or in part, on the ground that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted. For example, a party may move to strike a Rule 2.122(e) notice of reliance on a printed publication, on the ground that it does not include a copy of the printed publication, or does not indicate the general relevance thereof,[427]or that the proffered materials are not appropriate for introduction by notice of reliance.[428] If, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party which filed the notice of reliance time within which to cure the defect, failing which the notice will stand stricken.[429]

Objections to a notice of reliance on substantive grounds, such as objections on the grounds that evidence offered under a notice of reliance constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, normally need not and should not be raised by motion to strike. Rather, such objections should be raised in the objecting party's brief on the case, unless the ground for objection is one which could have been cured if raised promptly by motion to strike.[430]

It is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. *See* TBMP § 502.01 and authorities cited therein. Thus, if a motion to strike cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), but instead would require a review of testimony or other evidence, determination of the motion will be deferred by the Board until final hearing.[431]

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[426] *See* TBMP § 707.02(c), and cases cited therein.

[427] *See* TBMP § 707.02(b)(2), and cases cited therein.

[428] *See* TBMP § 707.02(b)(2) (regarding objections to notices of reliance on procedural grounds) *and, for example, Boyds Collection Ltd. v. Herrington & Co*., 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance).

[429] *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990) (allowed 20 days to correct deficiencies) and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (where registrant was given leave to amend notice of reliance to correct deficiencies but failed to do so, documents remained stricken).

[430] *See* TBMP § 707.02(c) and authorities cited therein.

[431] *See M-Tek Inc. v. CVP Systems Inc.*, *supra* (questions of admissibility of documents based on hearsay and lack of authentication deferred).

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any objections thereto in its evaluation of the probative value of the evidence at final hearing.[432]

533 Motion to Strike Trial Testimony Deposition

533.01 On Ground of Untimeliness

37 CFR § 2.121(a)(1) *The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. ...*

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.[433]

When there is no such approved stipulation, granted motion, or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety, as untimely.[434] Alternatively, the adverse party may raise this ground for objection in its brief on the case.[435]

533.02 On Ground of Improper or Inadequate Notice

37 CFR § 2.123(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in §2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the*

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[432] *See* TBMP § 707.02(c) (Objections to Notice of Reliance on Substantive Grounds) and cases cited therein.

[433] *See* 37 CFR § 2.121(a) and TBMP § 701 (Time of Trial).

[434] *See* 37 CFR §§ 2.121(a) and 2.123(l); *Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998); and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990) (motion to strike testimony for insufficient notice construed as motion to strike testimony taken out of time).

[435] *See* TBMP § 707.03(b)(1) (Objections to Trial Testimony Depositions On Ground of Untimeliness) and authorities cited therein. *But see Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991) (where applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of testimony deposition two days prior to opening of testimony period could have been corrected upon seasonable objection).

witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. ...

37 CFR § 2.123(e)(3) *Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is to be taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record.[436]

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances.[437]

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[436] *See* 37 CFR § 2.123(e)(3); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1704 (TTAB 1990) (one day notice not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (substitute witness not identified but adverse party failed, after deposition, to move to strike); *Home Juice Co. v. Runglin Companies Inc.*, 231 USPQ 897, 898 n.4 (TTAB 1986) (motion to strike filed four months after testimony taken was untimely); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (where applicant attended deposition and objected to its consideration on ground that it was taken on two-days notice, Board found that notice, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

See also, for example, Duke University v. Haggar Clothing Co., 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Assn v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable and opposing counsel's failure to appear was excused); and *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date).

[437] *See* 37 CFR § 2.123(e)(3).

533.03 When Motion to Strike Should Not Be Filed

Objections to testimony depositions on grounds other than the ground of untimeliness, or the ground of improper or inadequate notice, generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the applicable rules, or orally "on the record" at the taking of the deposition, as appropriate.[438]

534 Motion for Judgment for Plaintiff's Failure to Prove Case

534.01 In General

37 CFR § 2.132 Involuntary dismissal for failure to take testimony.
(a) *If the time for taking testimony by any party in the position of plaintiff has expired and that party has not taken testimony or offered any other evidence, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.*

(b) *If no evidence other than a copy or copies of Patent and Trademark Office records is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all of the evidence is in the record. If judgment is not rendered, testimony periods will be reset for the party in the position of defendant and for rebuttal.*

(c) *A motion filed under paragraph (a) or (b) of this section must be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion grant a motion under paragraph (a) even if the motion was filed after the opening of the testimony period of the moving party.*

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[438] *See* TBMP § 707.03(c) (Objections to Trial Testimony Depositions on Other Grounds).

The Trademark Rules of Practice permit the filing of a motion for judgment directed to the sufficiency of a plaintiff's trial evidence in two particular situations, described in 37 CFR §§ 2.132(a) and 2.132(b). Only in these two situations will the Board entertain such a motion.[439]

534.02 Motion for Judgment under Rule 2.132(a)

The first situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence, is when the plaintiff's testimony period has passed, and the plaintiff has not taken testimony or offered any other evidence. In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal for failure of the plaintiff to prosecute.[440] A motion for judgment under 37 CFR § 2.132(a) should be filed before the opening of the moving party's testimony period, but the Board may, in its discretion, grant the motion even if it was filed thereafter.[441]

When a motion for judgment under 37 CFR § 2.132(a) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)) in which to respond and show cause why judgment should not be rendered against it. In the absence of a showing of good and sufficient cause, judgment may be rendered against the plaintiff.[442]

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[439] *See* TBMP § 534.04 (Motion Under Fed. R. Civ. P. 41(b) or 50(a) Not Available).

[440] *See* 37 CFR § 2.132(a). *See also, for example, Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.,* 61 USPQ2d 1542, 1544 (TTAB 2001) (motion to extend testimony period denied; motion to dismiss granted); *SFW Licensing Corp. v. Di Pardo Packing Ltd*., 60 USPQ2d 1372, 1374 (TTAB 2001) (same); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) (motion to extend testimony period granted, motion to dismiss denied); *Atlanta Fulton County Zoo Inc. v. De Palma,* 45 USPQ2d 1858 (TTAB 1998) (motion to reopen discovery and testimony periods denied, motion to dismiss granted); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 n.4 (TTAB 1990) (respondent advised that if petitioner continued to show no interest and failed to take testimony, applicant may avail itself of § 2.132(a)); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1845-46 (TTAB 1987) (where opposer failed to offer evidence during its testimony period, applicant could have filed motion to dismiss instead of offering its own evidence); *Loren Cook Co. v. Acme Engineering and Manufacturing Corp.*, 216 USPQ 517 (TTAB 1982) (where evidence was presented by plaintiff, motion for judgment under rule 2.132 was not entertained); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275-276 (1984).

[441] *See* 37 CFR § 2.132(c), and *Hewlett-Packard Co. v. Olympus Corp., supra* and *Atlanta-Fulton County Zoo, supra*.

[442] *See* 37 CFR § 2.132(a). *See also Hewlett-Packard Co. v. Olympus Corp.*, *supra* at 1713 ("While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines") and *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.,* 61 USPQ2d 1860, 1862 (TTAB 2002) (Board is justified in enforcing procedural deadlines).

Cf. Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509, 512 (TTAB 1976) (although no testimony or other evidence was introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing).

The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard that would have to be met by any motion under Fed. R. Civ. P. 6(b) to reopen the plaintiff's testimony period.[443]

For examples of cases involving the question of whether good and sufficient cause has been shown for a plaintiff's failure to offer any evidence, see note below.[444] *For a complete discussion of excusable neglect and the standard to be applied, see* TBMP § 509.01(b) regarding motions to reopen, and cases cited therein.

If a timely motion under 37 CFR § 2.132(a) is denied, testimony periods will be reset for the defendant and for rebuttal.[445]

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[443] *See PolyJohn Enterprises Corp. v. 1-800-Toilets Inc., supra* at 1860-61*; HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998); and *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989) (showing of good and sufficient cause is equivalent of excusable neglect because it requires the reopening of the testimony period to introduce the evidence).

[444] *Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc.*, 65 USPQ2d 1701 (TTAB 2002) (excusable neglect not found where opposer waited four months after close of testimony period to file motion to reopen and where reason for delay was based on, *inter alia*, opposer's asserted failure to receive answer to opposition); *HKG Industries Inc. v. Perma-Pipe Inc., supra* (plaintiff provided no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc., supra* (excusable neglect not found where motion to reopen was filed nearly one month after close of testimony period and was based on mistaken belief that extension of time to respond to discovery extended testimony period and on fact that petitioner was gathering information to respond to discovery); *Jain v. Ramparts*, 49 USPQ2d, 1429, 1431 (TTAB 1998) (pendency of plaintiff's motion to compel and to extend trial dates after ruling on such motion sufficient cause for failure to try case); and *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations insufficient).

See also the following cases [NOTE: These cases were decided prior to *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership,* 507 U.S. 380 (1993) which changed the excusable neglect standard. For a discussion of the effect of this change on the Board's analysis, see TBMP § 509.01(b) regarding motions to reopen.] *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (mere request from adversary for extension of time is not sufficient and plaintiff cannot rely on inaction of defendant to establish that its own neglect was excusable); *Grobet File Co. of America Inc. v. Associated Distributors Inc.,* 12 USPQ2d 1649 (TTAB 1989) (no excusable neglect where plaintiff mistakenly assumed extension of time to respond to discovery would result in extension of discovery period); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982) (opposer's good faith interpretation of parties' long-standing agreement to cooperate in extending or resetting dates constituted excusable neglect).

Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067 (TTAB 1987) (plaintiff entitled to know disposition of defendant's pending motion to amend its answer before proceeding to trial); and *Proctor & Gamble Co. v. Johnson & Johnson Inc.*, 485 F. Supp. 1185, 205 USPQ 697 (S.D.N.Y. 1979), aff'd without opinion, 636 F.2d 1203 (2d Cir. 1980).

For additional cases, with summaries, see Appendix of Cases.

[445] *See* 37 CFR § 2.132(a).

The purpose of the motion under 37 CFR § 2.132(a) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff has failed to offer any evidence during its testimony period.[446] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory.[447] If no motion under 37 CFR § 2.132(a) is filed, trial dates will continue to run, and the case will be determined at final hearing; in those cases where plaintiff did, in fact, fail to offer any evidence during its testimony period, plaintiff cannot prevail and, thus, defendant need not offer evidence either.[448]

The fact that a defendant may have previously sought judgment under 37 CFR § 2.132(b) does not preclude it from thereafter seeking judgment under 37 CFR § 2.132(a).[449]

534.03 Motion for Judgment Under Rule 2.132(b)

The second situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence is when the plaintiff's testimony period has passed, and the plaintiff has offered no evidence other than a copy or copies of PTO records. In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the plaintiff has shown no right to relief.[450] A motion for judgment under 37 CFR § 2.132(b) must be filed before the opening of the moving party's testimony period. [451]

When a motion for judgment under 37 CFR § 2.132(b) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)) to file a brief in response.[452]

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[446] *See Litton Business Systems, Inc. v. J. G. Furniture Co. Inc.*, 190 USPQ 431 (TTAB 1976).

[447] *See Pfaltzgraf v. William Davies Co. Inc.*, 175 USPQ 620 (TTAB 1972), and Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983).

[448] *See, for example*, *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1645-46 (TTAB 1987) (opposition dismissed where applicant filed evidence instead of a motion to dismiss and opposer filed improper rebuttal) and *Pfaltzgraf v. William Davies Co.*, *supra*.

[449] *See W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118 (TTAB 1973).

[450] *See* 37 CFR § 2.132(b).

[451] *See* 37 CFR § 2.132(c).

[452] *See* 37 CFR § 2.132(b).

In determining a motion under 37 CFR § 2.132(b), the Board may either render judgment against the plaintiff, or decline to render judgment until all of the evidence is in the record.[453]

If a timely motion under 37 CFR § 2.132(b) is denied, testimony periods will be reset for the defendant and for rebuttal.[454]

The purpose of the motion under 37 CFR § 2.132(b) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff, during its testimony period, has offered no evidence other than copies of USPTO records, and those records do not make out a prima facie case.[455] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory.[456]

The fact that a defendant may have previously sought judgment under 37 CFR § 2.132(a) does not preclude it from thereafter seeking judgment under 37 CFR § 2.132(b).[457]

534.04 Motion Under Fed. R. Civ. P. 41(b) or Fed. R. Civ. P. 50(a) Not Available

Trial testimony, in Board inter partes proceedings, is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence, prior to its final deliberations in the proceeding.[458]

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[453] *See* 37 CFR § 2.132(b). *See also Merker Counter Co., Inc. v. Central Counter Co.*, 310 F.2d 746, 135 USPQ 433 (CCPA 1962) (declined to render judgment); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (judgment entered where marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); and *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313 (TTAB 1976) (motion granted as conceded but even if denied, petition to cancel would have been dismissed on the merits).

Cf. Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509, 512 (TTAB 1976) (where 2.132(a) motion was filed, although no testimony or other evidence had been introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing).

[454] *See* 37 CFR § 2.132(b).

[455] *See, for example*, *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., supra* (2.132(b) requires decision on merits of the case); and *Litton Business Systems, Inc. v. J. G. Furniture Co., Inc.*, 190 USPQ 431, 434 (TTAB 1976) (Board will not use judicial notice to remedy plaintiff's failure to present adequate evidence).

[456] *See* Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983). *Cf. Pfaltzgraf v. William Davies Co.*, 175 USPQ 620 (TTAB 1972).

[457] *See Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., supra.*

[458] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

Accordingly, the only means available for testing the sufficiency of trial evidence in an inter partes proceeding before the Board are the motions described in 37 CFR §§ 2.132(a) and 2.132(b).[459] The motion under Fed. R. Civ. P. 41(b) for involuntary dismissal, and the motion under Fed. R. Civ. P. 50(a) for a directed verdict, are not available in Board proceedings.[460]

535 Motion for Order to Show Cause Under Rule 2.134(b)

37 CFR § 2.134(b) *After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted his involved registration to be cancelled under § 8 of the Act of 1946 or has failed to renew his involved registration under § 9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.*

It is generally the responsibility of a petitioner for cancellation to keep track of the status of the respondent's subject registration, and to file a motion for an order to show cause under 37 CFR § 2.134(b) if such registration is cancelled under Section 8 or 9 of the Act, 15 U.S.C. § 1058 or 1059, after the commencement of the proceeding. However, if the cancellation of the registration under Section 8 or 9 of the Act comes to the attention of the Board in another manner, the Board may issue an order to show cause upon its own initiative.

The purpose of 37 CFR § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding and avoid judgment by deliberately failing to file a required affidavit of use under § 8 or renewal application under § 9.[461]

In those cases where the Board finds that respondent has not acted deliberately to avoid judgment and thereby has shown good and sufficient cause why judgment should not be entered against it under 37 CFR § 2.134(b), petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. In those cases where the Board enters judgment against the

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[459] *See* TBMP §§ 534.02 (Motion for Judgment Under Rule 2.132(a)) and 534.03 (Motion for Judgment under Rule 2.132(b)).

[460] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

[461] *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (failure to file Section 8 occurred prior to commencement of proceeding and therefore not to avoid judgment).

respondent only and specifically on the ground of abandonment, petitioner will be given time in which to elect whether it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. [462]

For further information concerning orders to show cause under 37 CFR § 2.134(b), see TBMP § 602.02(b).

536 Motion for Order to Show Cause Under Rule 2.128(a)(3)

37 CFR § 2.128(a)(3) *When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.*

The principal purpose of 37 CFR § 2.128(a)(3) is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is not the policy of the Board to enter judgment against a plaintiff for failure to file a main brief on the case if the plaintiff still wishes to obtain an adjudication of the case on the merits.[463] If a show cause order is issued under 37 CFR § 2.128(a)(3), and the plaintiff files a response indicating that it has not lost interest in the case, the show cause order will be considered discharged, and judgment will not be entered against

plaintiff for failure to file a main brief. If the plaintiff files no response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff.[464]

When a plaintiff fails to file a main brief on the case, it is the normal practice of the Board to issue, sua sponte, an order to show cause why the failure to file a brief should not be treated as a concession of the case. If such an order is not issued by the Board sua sponte, or if an adverse party fears that the Board may inadvertently overlook a plaintiff's failure to file a main brief, the adverse party may file a motion for an order to show cause.

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[462] *See* TBMP § 602.02(b) (Cancellation Under Section 8; Expiration Under Section 9) and cases cited therein.

[463] *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23132, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 22; and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

[464] *See, for example, CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2D 1300, 1302 (TTAB 1999) (no response filed).

When it finds that a 37 CFR § 2.128(a)(3) order to show cause has been discharged, the Board may reset the times for filing remaining briefs on the case. If the plaintiff includes with its response to the show cause order a motion under Fed. R. Civ. P. 6(b) to reopen its time to file a main brief (*see* TBMP § 509), and the motion is granted, all times for filing briefs on the case will be reset.

If a 37 CFR § 2.128(a)(3) order to show cause has been discharged, but the record shows that plaintiff failed, during its testimony period, to take any testimony or offer any other evidence in its behalf, the Board, in lieu of resetting the times for filing remaining briefs on the case, may enter judgment against plaintiff for failure to prove its case.[465]

537 Motion for Leave to Exceed Page Limit for Brief on Case

37 CFR § 2.128(b) *... Each brief shall contain an alphabetical index of cases cited therein. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. ...*

Motions for leave to file a brief on the case in excess of the page limit are disfavored by the Board and rarely granted. Because the Board is an administrative tribunal of limited jurisdiction, empowered to determine only the right to register, very few of the cases before it are of such a nature as to require a brief on the case which exceeds the 37 CFR § 2.128(b) page limit. Further, one of the primary purposes of the rule is to assist the Board in managing its workload, and to encourage litigants to focus their arguments and eliminate needless verbiage.[466] Thus, a party seeking leave to file a brief on the case with more than the allowed number of pages must obtain "prior leave" from the Board to do so.[467] The motion must be submitted on or before the date that the brief is due.[468] This is so even in those cases where the motion is filed with the consent of the adverse party or parties. Trademark Rule 2.128(b) is for the benefit of the Board, and it is only with the Board's permission, timely sought, that a brief exceeding the page limit be entertained.

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[465] *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (show cause order discharged but plaintiff failed to show excusable neglect to reopen case).

[466] *Cf. Fleming v. County of Kane*, 855 F.2d 496 (7th Cir. 1988).

[467] *See* 37 CFR § 2.128(b) and, *for example, Boswell v. Mavety Media Group Ltd.,* 52 USPQ2d 1600**,** 1604 n.4 (TTAB 1999)**.**

[468] *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994).

The preferred practice, when a timely motion for leave to exceed the page limit is filed, is that the proposed overlength brief not be filed with the motion. If the moving party refrains from filing its brief with the motion, and the motion is granted, the Board in its decision on the motion will allow time for the filing of the brief and specify the number of additional pages granted. Alternatively, if the motion is denied, the Board, in its decision, will allow time for the filing of a brief that does not exceed the page limit specified in 37 CFR § 2.128(b). On the other hand, if the proposed overlength brief is filed with the motion, and the motion is granted, the Board will accept the brief. If the motion is denied, the overlength brief will be given no consideration, and the Board will allow time for the filing of a brief which meets the limit. denied, the overlength brief will be given no consideration as not in compliance with the rules, but the Board will allow time for the filing of a brief which conforms to the relevant page limit of 37 CFR § 2.128(b).[469]

A timely motion to exceed the specified page limit need not be accompanied by a motion to extend the time for filing the subject brief. As noted in the preceding paragraph, when the Board rules upon the motion to exceed the page limit, it will reset the due date for the brief which is the subject of the motion, along with the due dates for any remaining briefs on the case, whether or not the motion is granted.

If a party files a brief which exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute brief which meets the limit.[470]

A motion for leave to file a brief exceeding the page limit is evaluated on the basis of the reasonableness of the request in light of such factors as the number of additional pages sought, the novelty and/or complexity of the issues in the case, the extent of the trial record, and any other relevant facts or circumstances which may serve to demonstrate why additional pages are necessary.[471]

For information concerning the parts of a brief which fall within the page limit, see TBMP § 801.03 and authorities cited therein.

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[469] *See United Foods Inc. v. United AirLines Inc.*, *supra* (filing brief with motion is potentially disadvantageous as movant may end up having to redo brief if motion is denied).

[470] *See United Foods Inc. v. United AirLines Inc., supra.*

[471] *See United Foods Inc. v. United Air Lines Inc.*, *supra*, (30-page reply brief unnecessary where main brief was 18 pages and responsive brief was 37 pages); and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987) (due to size of record, parties allowed to file overlength briefs). *Cf.* 37 CFR § 2.129(a), and TBMP § 541.02 regarding motions for additional time for oral argument.

538 Motion for Leave to File Amicus Brief

Amicus briefs are neither provided for nor prohibited in the rules governing practice in Board proceedings. Thus, the Board may, in its discretion, entertain an amicus brief if the Board finds that such a brief is warranted under the circumstances of a particular case.[472]

An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. The motion may be accompanied by the proposed brief. An amicus brief should be filed within the time allowed the party whose position the brief serves to support, unless all parties consent otherwise, or the Board, upon motion for good cause shown, permits a later filing.[473]

A motion for leave to file an amicus brief may not be used as a substitute for a timely notice of opposition or petition for cancellation.

Motions for leave to file an amicus brief are rarely filed in Board proceedings, and the granting thereof by the Board is even rarer. The Board will determine whether the proposed brief will aid the Board in resolving issues of law, whether the moving party is effectively seeking a role in the proceeding beyond arguing questions of law, and is effectively arguing factual matters, and whether any partisan arguments would prejudice defendant.[474]

539 Motion to Strike Brief on Case

The Trademark Rules of Practice specifically provide for the filing of briefs on the case, namely, the main brief of the party in the position of plaintiff, the answering brief of the party in the position of defendant, and the reply brief of the party in the position of plaintiff.[475]

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it believes will be to its advantage. Accordingly, when a brief on the case has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party which simply objects to the contents thereof. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its

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[472] *See, for example*, *Harjo v. Pro-Football Inc*., 45 USPQ2d 1789, 1791 (TTAB 1998) (leave to file amicus brief denied as unnecessary to resolve issues which have been adequately addressed by parties), and Federal Circuit Rule 29 (governing the filing of amicus briefs in appeals to the Court of Appeals for the Federal Circuit).

[473] *Cf.* Federal Circuit Rule 29.

[474] *See Harjo v. Pro-Football Inc., supra* at 1791 (motion denied where Board, noting "intimate" relationship between movants and petitioners, found that movants were seeking to introduce new evidence and advance partisan arguments).

[475] *See* 37 CFR § 2.128(a). *See also* TBMP § 801.02 (Time for Filing Brief on the Case).

determination of the case, and any portions of the brief which are found by the Board to be improper will be disregarded.

However, if a brief on the case is not timely filed, or violates the length limit or other format requirements specified in 37 CFR § 2.128(b),[476] it may be stricken, or given no consideration, by the Board.[477] If a brief is stricken because of a format violation, the Board may, in its discretion, allow the offending party time to submit a substitute brief complying with the requirements of 37 CFR § 2.128(b).[478]

Because the rules do not provide for the filing of a reply or rejoinder brief by a party in the position of defendant, any such brief may be stricken, or given no consideration, by the Board.[479] Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party. If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike or otherwise.[480]

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[476] *See* TBMP §§ 537 (motions regarding page limitations for final briefs) and 801.03 (regarding form and contents of brief).

[477] *See*, *Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250 (TTAB 1972) (brief filed three weeks late stricken); and *American Optical Corp. v. Atwood Oceanics, Inc.*, 177 USPQ 585 (Comm'r 1973) (brief which was too long and not in proper form was not considered).

[478] *But see* TBMP § 537 (if a party files a brief which exceeds the page limit without also filing a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute brief that meets the limit).

[479] *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.3 (TTAB 1993) (motion to strike portions of opposer's reply brief on the case given no consideration since motion was essentially attempt by applicant to file a reply brief); and *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 863 n.3 (TTAB 1985). *See also Hydrotechnic Corp. v. Hydrotech International, Inc.*, 196 USPQ 387 (TTAB 1977); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); and *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469 (TTAB 1973).

[480] *See, for example, Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to brief given no consideration); and *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978) (applicant's exhibits attached to its brief cannot be considered). *See also Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

540 Motion for Augmented Panel Hearing

Each case before the Board is heard by a panel of at least three members of the Board (i.e., its statutory members, including administrative trademark judges).[481] However, the Board may use an augmented panel to hear a case.[482] An augmented panel may include any number of Board members exceeding three, that is, from four to the entire body of members. *For information concerning the constitution of Patent and Trademark Office Board panels, see In re Alappat,* 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Director has authority to constitute a new panel for purposes of reconsideration).

A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding. A motion requesting that a case be heard by an augmented panel should be filed no later than the time for requesting an oral hearing on the case (i.e., no later than 10 days after the due date for the filing of the last reply brief in the proceeding--*see* 37 CFR § 2.129(a)).

An augmented panel is used by the Board only in extraordinary cases, involving precedent-setting issues of exceptional importance, or when consideration by an augmented panel is necessary to secure or maintain uniformity of Board decisions.[483]

541 Motion to Change Oral Hearing Date; For Additional Time

541.01 Motion to Change Oral Hearing Date

If a party to a proceeding before the Board desires to present oral argument (i.e., oral hearing), at final hearing, the party must file a request therefor, by separate paper, not later than 10 days after the due date for the filing of the last reply brief in the proceeding.[484] When a request for an oral

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[481] *See, for example,* 37 CFR §§ 2.129(a) and 2.142(e)(1). *See also* 15 U.S.C. § 1067.

[482] *See, for example, In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992) (augmented panel used to overrule previous decision barring examining attorneys from requesting reconsideration), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (in view of issues presented, oral hearing held before augmented panel of eight Board members); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986) (augmented five-member panel); and *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services).

[483] *See, for example, In re Johanna Farms Inc., supra; In re McDonald's Corp., supra;* and *In re WSM, Inc., supra*. *See also Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (augmented panel of eight-member because of the importance of the issues). *Cf.* Federal Circuit Rule 35 and *In re Alappat*, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Section 7 grants Director authority to designate the members of a panel and expanded panel). *Cf. also Fioravanti v. Fioravanti Corrado S.R.L,* 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

[484] *See* TBMP § 802 regarding oral hearings.

hearing is filed, the Board sets the date and time for the hearing, and sends each party written notice thereof.[485] Ordinarily, oral hearings are scheduled on Tuesdays, Wednesdays and Thursdays. It is the normal practice of the Board, in setting an oral hearing, to phone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing, following which the written notice formally scheduling the hearing is mailed.

The date or time of an oral hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives.[486] When parties agree to the resetting of an oral hearing, they should determine a new date and time convenient to every party and then contact the Chief Administrative Trademark Judge's secretary by phone, well prior to the scheduled hearing date, to request that the hearing be reset for the new date and time. The parties should also file a written stipulation or consented motion confirming their agreement. If parties agree to the resetting of an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations.

When one or more of the parties does not consent to the resetting of an oral hearing, the party that wishes to have the hearing reset must file a motion therefor, showing good cause.[487] The motion should be filed well in advance of the scheduled hearing date. Further, to ensure that the motion is determined (by telephone conference call, if necessary) prior to the scheduled hearing date, the moving party should either hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned, or, if the motion has been filed with the Board by some other method, telephone the interlocutory attorney handling the case and notify the attorney of the filing of the motion.[488] An unconsented motion to reset an oral hearing should not be filed merely because another date would be more convenient. The process of scheduling an oral hearing is a time-consuming task for the Board. Because of the inherent difficulties in arranging a date for an oral hearing, an unconsented motion to reset the hearing should be filed only for the most compelling reasons. Examples thereof include the onset of serious illness, nonelective surgery, death of a family member and similar unanticipated or unavoidable events.[489]

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[485] *See* 37 CFR § 2.129(a).

[486] *See* 37 CFR § 2.129(b).

[487] *See* Fed. R. Civ. P. 6(b) and TBMP § 509 (Motion to Extend Time; Motion to Reopen Time).

[488] *See* TBMP § 502.06(a) (Telephone Conferences).

[489] *See, e.g., In re Taylor & Francis [Publishers] Inc.,* 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule oral hearing three hours before hearing due to "a sudden conflict of time" denied).

Repeated stipulations or consented requests to reset an oral hearing should not be filed.

For further information concerning oral hearings, see TBMP § 802.

541.02 Motion for Additional Time for Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. [490] If, because of the novelty or complexity of the issues, the extent of the record, the presence of a counterclaim involving different issues than those involved in the original proceeding, etc., a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time.[491] If the request is granted, each party will be allowed the same amount of time for oral argument.

When a party decides to request additional time for oral argument, the party should immediately call the Board and notify the Board that it intends to file a request for additional time. Alternatively (and ideally), the request for additional time may be included in the request for oral hearing. This early notification is necessary to ensure that there will be time in the Board's hearing schedule for an extended oral hearing, and also to ensure that the request will be considered and determined prior to the date of the oral hearing.[492]

542 Motion for Leave to Audiotape Oral Hearing

Upon prior arrangement, the Board will usually permit a party to make an audiotape recording of an oral hearing. However, such a recording is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board).

Leave to audiotape an oral hearing is secured by filing a motion therefor showing good cause (such as, that the audiotape is desired by the requesting attorney, or the requesting attorney's firm, for personal use in evaluating the performance of the attorney as an advocate). The motion should be filed well in advance of the date set for the oral hearing, so that if an adverse party raises any objections, the Board will have time to rule upon the motion prior to the oral hearing.

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[490] *See* 37 CFR § 2.129(a), and TBMP § 802.05 (Length of Oral Argument).

[491] *See* 37 CFR § 2.129(a), and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987) (additional time for arguments allowed in view of voluminous record). *Cf.* 37 CFR § 2.128(b) and TBMP § 537 (Motion for Leave to Exceed Page Limit for Brief on Case).

[492] *Cf.* TBMP § 541.01 (Motion to Change Oral Hearing Date).

Where permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audiotaping equipment in an unobtrusive manner. A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, *an oral hearing before the Board may not be videotaped*. Any motion for leave to videotape an oral hearing will be denied.

543 Motion for Reconsideration of Final Decision

37 CFR § 2.129(c) *Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within fifteen days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.*

The filing of a request for rehearing, reconsideration, or modification of a decision issued after final hearing is governed by 37 CFR § 2.129(c).[493]

There is no requirement that an adverse party file a brief in response to a request for rehearing, reconsideration, or modification of a decision issued after final hearing. However, it is the better practice to do so.[494] If a responsive brief is filed, it must be filed within 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)).

Although 37 CFR § 2.129(c) makes no provision for the filing of a reply brief on a request for rehearing, reconsideration, or modification of a decision issued after final hearing, the Board may, in its discretion, consider such a brief.[495]

Generally, the premise underlying a request for rehearing, reconsideration, or modification under 37 CFR § 2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence,[496] nor should it be devoted simply to a reargument of the points presented in

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[493] *Cf.* 37 CFR § 2.127(b), and TBMP § 518 (Motion for Reconsideration of Decision on Motion).

[494] *See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 410 (TTAB 1979) (serious questions raised by applicant's request for reconsideration ought to have generated response by opposer).

[495] *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 176, 177 n.2 (TTAB 1975) (reply brief considered only to the extent it addressed arguments in responsive brief). *See also* 37 CFR § 2.127(a) and TBMP § 502.02(b) (Briefs on Motions).

[496] *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978) (survey did not qualify as newly discovered evidence).

the requesting party's brief on the case. Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change.[497]

If a request for rehearing, reconsideration, or modification of a decision after final hearing is timely filed, the time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire two months after action on the request.[498]

544 Motion for Relief From Final Judgment

Fed. R. Civ. P. 60(b) Mistakes; Inadvertence; Excusable Neglect; Newly Discovered Evidence; Fraud, etc. *On motion and upon such terms as are just, the court may relieve a party or a party's legal representative from a final judgment, order, or proceeding for the following reasons: (1) mistake, inadvertence, surprise, or excusable neglect; (2) newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b); (3) fraud (whether heretofore denominated intrinsic or extrinsic), misrepresentation, or other misconduct of an adverse party; (4) the judgment is void; (5) ... a prior judgment upon which [the judgment] is based has been reversed or otherwise vacated ...; or (6) any other reason justifying relief from the operation of the judgment. The motion shall be made within a reasonable time, and for reasons (1), (2), and (3) not more than one year after the judgment, order, or proceeding was entered or taken. A motion under this subdivision (b) does not affect the finality of a judgment or suspend its operation. This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or proceeding ... or to set aside a judgment for fraud upon the court. ...*

Motions to set aside or vacate a final judgment rendered by the Board are governed by Fed. R. Civ. P. 60(b).[499] Thus, upon such terms as are just, the Board, on motion, may relieve a party from a final judgment for one of the reasons specified in Fed. R. Civ. P. 60(b).

Fed. R. Civ. P. 60(b), as made applicable by 37 CFR § 2.116(a), applies to all final judgments issued by the Board, including default and consent judgments, summary judgments, and judgments entered after trial on the merits. As a practical matter, motions to vacate or set aside a final Board judgment are usually based upon the reasons set forth in subsections (1), (2) and/or (6) of Fed. R. Civ. P. 60(b).

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[497] *For examples of cases in which a request for reconsideration of a decision after final hearing has been granted, see Steiger Tractor Inc. v. Steiner Corp.*, 3 USPQ2d 1708 (TTAB 1984). *Cf. In re Kroger Co.*, 177 USPQ 715, 717 (TTAB 1973).

[498] *See* 37 CFR § 2.145(d)(1), and TBMP §§ 902.02 (Time for Filing Notice of Appeal) and 903.04 (Time for Filing Civil Action).

[499] *See* 37 CFR § 2.116(a).

For examples of cases involving a motion for a relief from a final judgment of the Board, see cases cited in the note below.[500]

A motion for relief from judgment must be made within a reasonable time; and if the motion is based on reasons (1), (2), and/or (3), it must be filed not more than one year after the judgment was entered.[501] The filing of the motion will not affect the finality of the judgment or suspend its operation.[502]

Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances.[503] The determination of whether a motion under Fed. R. Civ. P. 60(b) should be granted is a matter which lies within the sound discretion of the Board.[504]

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[500] S*ee CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300 (TTAB 1999) (reason (1) denied; counsel and client share duty [suggesting *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992), where relief was granted due to negligent conduct of counsel who concealed critical facts from petitioner, is no longer good law]); *S. Industries Inc. v. Lamb-Weston Inc*., 45 USPQ2d 1293 (TTAB 1997) (reason (1) granted; petitioner contributed to respondent's delay and confusion); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.,* 44 USPQ2d 1950 (TTAB 1997) (reasons (4) and (6), based on alleged failure to receive correspondence from Board, denied, given presumption of receipt of correspondence, passage of 12 years, and resulting hardship to third parties); *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 (TTAB 1992) (reason (6) granted; petition withdrawn based on apparent acceptance by Examining Attorney of settlement agreement obviating basis for refusal of petitioner's applications); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991) (reason (1) granted; respondent's failure to answer resulted from mistake due to involvement in numerous Board proceedings); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (reason (1) granted; respondent's employees had limited knowledge of English and were unaware cancellation and opposition were separate proceedings).

See also Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976) (reasons (1) and (6) denied; opposer's failure to maintain communication between its staff counsel due to inattention and carelessness is not excusable neglect and does not constitute "inadvertence") and *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (reason (1) denied; petitioner's arguments that its neglect resulted from docketing errors and the absence of petitioner's counsel from its office do not constitute excusable neglect). *In addition see Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330 (TTAB 1982) (reasons (1), (3), and (6)); *Lee Byron Corp. v. H.D. Lee Co.* 203 USPQ 1097 (TTAB 1979) (reason (2)); *Amoco Oil Co. v. Amerco, Inc.,* 201 USPQ 126 (TTAB 1978) (reason (2)); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819 (TTAB 1978) (reason (1)); and *Columbia Broadcasting System, Inc. v. De Costa*, 165 USPQ 95 (TTAB 1970) (reason (6)).

Cf. In re Sotheby's Inc., 18 USPQ2d 1969 (Comm'r 1989).

[501] *See* Fed. R. Civ. P. 60(b); *Djeredjian v. Kashi Co.*, *supra* (filed 15 days after entry of default judgment); and *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819 (TTAB 1978) (motion denied where judgment was entered under § 2.135 and applicant was mistaken as to consent to abandonment by opposer but delayed over a year to file motion).

[502] *See* Fed. R. Civ. P. 60(b).

[503] *See Djeredjian v. Kashi Co., supra* at 1615.

[504] *See Djeredjian v. Kashi Co., supra* at 1615.

Where a motion for relief from judgment is made without the consent of the adverse party or parties, it must persuasively show (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in Fed. R. Civ. P. 60(b).

Because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments.[505] Among the factors to be considered in determining a motion to vacate a default judgment for failure to answer the complaint are (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action.[506]

If, in a cancellation proceeding, a petition to the Director is filed concurrently with a Fed. R. Civ. P. 60(b) motion to the Board for relief from judgment, and the petition and motion seek the same relief and require review of the same set of facts, the Board will rule first upon the motion for relief from judgment.[507] If the Board grants the motion, the Director, as a ministerial act, will reinstate the subject registration.[508]

Where the parties are agreed that the circumstances warrant the vacating or setting aside of a final judgment, a stipulation or consented motion for relief from the judgment should be filed. The Board ordinarily will grant a consented request for relief from judgment.

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[505] *See* TBMP § 312.03 (Setting Aside Default Judgment) and authorities cited therein.

[506] *See* TBMP § 312.03; *Djeredjian v. Kashi Co.*, *supra* at 1615 (granted pending showing of meritorious where other two elements were established) and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings). *Compare Jack Lenor Larsen Inc. v. Chas. O. Larson Co., supra* (motion denied).

[507] *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61 (Comm'r 1985).

[508] *See National Telefilm Associates, Inc. v. Craig Denney Productions*, *supra.*

601 Withdrawal by Opposition or Cancellation Plaintiff

601.01 Withdrawal by Opposer

37 CFR § 2.106(c) *The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.*

An opposer may withdraw its opposition without prejudice at any time before the applicant's answer is filed. After the answer is filed, however, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.[1]

For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see note below.[2]

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[1] 37 CFR § 2.106(c). *See Estee Lauder Inc. v. Aloe Creme Laboratories, Inc.*, 178 USPQ 254, 256 (TTAB 1973) (opposition dismissed with prejudice where applicant's statement that favorable decision in civil action renders issues in opposition moot cannot be construed as consent to opposer's withdrawal).

Cf. 37 CFR § 2.114(c), and *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (although there was no indication that the dismissal of the counterclaims in a previous opposition was "with prejudice," because the record showed that the counterclaims were withdrawn after answer and without consent, it was clear that dismissal was with prejudice and that therefore plaintiff was estopped from attempting to assert same counterclaim in subsequent petition to cancel).

[2] *See Johnson & Johnson v. Bio-Medical Sciences, Inc., supra* (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding).

Cf. Miller Brewing Co. v. Coy International Corp., 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); *and In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as a estoppel in subsequent application for a distinctly different mark).

An opposer may withdraw its opposition by filing in the USPTO a written withdrawal signed by the opposer or the opposer's attorney or other authorized representative. The withdrawal should include proof of service upon every other party to the proceeding.[3]

601.02 Withdrawal by Petitioner

37 CFR § 2.114(c) *The petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, the petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.*

A petitioner may withdraw its petition for cancellation without prejudice at any time before the registrant's answer is filed. After the answer is filed, however, the petition for cancellation may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.[4]

For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see note below.[5]

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[3] *See* 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

[4] 37 CFR § 2.114(c). *See Johnson & Johnson v. Bio-Medical Sciences, Inc.*, *supra*. *Cf.* 37 CFR § 2.106(c), and *Estee Lauder Inc. v. Aloe Creme Laboratories, Inc.*, *supra*..

[5] *See Johnson & Johnson v. Bio-Medical Sciences, Inc., supra* (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding).

Cf. Miller Brewing Co. v. Coy International Corp., 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); *and In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as a estoppel in subsequent application for a distinctly different mark).

A petitioner may withdraw its petition for cancellation by filing in the USPTO a written withdrawal signed by the petitioner or the petitioner's attorney or other authorized representative. The withdrawal should include proof of service upon every other party to the proceeding.[6]

601.03 Effect of Motion for Judgment

A plaintiff in an opposition or cancellation proceeding may unilaterally withdraw its complaint without prejudice, even in the face of a defendant's adverse motion such as a motion to dismiss, motion for summary judgment, motion for judgment on the pleadings, provided that the withdrawal is filed prior to defendant's answer to the complaint. When a plaintiff unilaterally withdraws its complaint prior to answer, in the face of a defendant's pending motion for judgment, the proceeding will be dismissed without prejudice (unless plaintiff specifies that it is withdrawing with prejudice), and the pending motion will be declared moot.

602 Withdrawal by Opposition or Cancellation Defendant

602.01 Withdrawal by Applicant

37 CFR § 2.68 Express abandonment (withdrawal) of application.
An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

37 CFR § 2.135 Abandonment of application or mark.
After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

An applicant may expressly abandon its application by filing in the USPTO a written statement of abandonment or withdrawal of the application, signed by the applicant or the applicant's attorney or other authorized representative.[7]

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[6] *See* 37 CFR § 2.119(a), TBMP § 113 (Service of Papers) and *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 50 USPQ2d 1532, 1536 (Fed. Cir. 1999) (filing of withdrawal of petition sufficient to consider that no proceeding is" pending" and that proceeding was "disposed of" for purposes of filing Section 15 declaration of incontestability).

[7] 37 CFR § 2.68.

However, after the commencement of an opposition proceeding, if the applicant files a written abandonment of its subject application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant.[8] The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative.[9]

For information concerning the effect of a 37 CFR § 2.135 judgment against applicant, see cases cited in the note below.[10]

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR § 2.135.

An abandonment of an opposed application should be filed with the Board, and should bear at the top of its first page both the application serial number, and the opposition number and title.

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[8] 37 CFR § 2.135. *See Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992) (where excepted user abandoned application in concurrent use proceeding, judgment precluded applicant from obtaining any registration at all, although it may remain in proceeding as defaulting user); *Goodway Corp. v. International Marketing Group Inc.*, 15 USPQ2d 1749, 1749 (TTAB 1990); *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.,* 14 USPQ2d 2065, 2067 (TTAB 1990) (consent required for abandonment without prejudice regardless of motivation for abandonment, i.e.. a concession by applicant that it is not owner of mark and that judgment would be unfair to real owner, a nonparty to the case); and *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where abandonment of application and notice of opposition were filed on same day, consent was not required because there was no application to oppose).

[9] *See* 37 CFR § 2.135.

[10] *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in the prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); *and In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as a estoppel in subsequent application for a distinctly different mark).

Cf. Aromatique Inc. v. Lang, 25 USPQ2d 1359, 1361 (TTAB 1992) (applicant, by abandoning application with prejudice in prior opposition is estopped in subsequent opposition from attempting to register virtually identical mark for identical goods), and *Johnson & Johnson v. Bio-Medical Sciences, Inc., supra*. (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding).

The abandonment should include proof of service upon every other party to the proceeding.[11]

If an applicant files an unconsented abandonment after the commencement of an opposition, but before applicant has been notified of the opposition by the Board, applicant will be allowed an opportunity to obtain and submit the written consent of every adverse party, or to withdraw the abandonment and defend against the opposition, failing which judgment will be entered against applicant.[12]

If an opposition and an unconsented abandonment of the opposed application are filed on the same day, the abandonment (unless specifically made with prejudice) is without prejudice to applicant; the opposition will be returned to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded.[13] .

Abandonment prior to publication. If after an opposition is filed, it comes to the attention of the Board that the opposed application was abandoned prior to its publication for opposition for failure of the applicant to respond to an Office action, the Board will advise the parties that the application is not subject to opposition unless applicant files a petition to revive under 37 CFR § 2.66, and the petition is granted. If a prior abandonment for failure to timely respond comes to the attention of the Board at a time reasonably contemporaneous with the filing of the opposition, and the application is not revived, the opposition will not be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded. If the prior abandonment comes to the attention of the Board at a later stage in the opposition, and the application is not revived, the opposition will be dismissed without prejudice.[14]

Abandonment for failure to respond to office action after remand. If, during the pendency of an opposition, the Board grants a request by the Trademark Examining Attorney for remand under 37 CFR § 2.130,[15] and the application thereafter becomes abandoned by operation of law for failure of the applicant to respond to an Office action issued by the Examining Attorney, or because a final refusal to register is affirmed on appeal, judgment under 37 CFR § 2.135 will not be entered against applicant in the opposition. Trademark Rule 2.135 comes into play only when there is a *written* abandonment by the applicant. However, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits, or to

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[11] *See* 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

[12] *See In re First National Bank of Boston*, *supra*. (where opposition and abandonment were filed on same day) *Cf.* TBMP § 218 (Abandonment of Application).

[13] *See In re First National Bank of Boston*, *supra*. *Cf.* TBMP § 218 (Abandonment of Application).

[14] *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1080 (TTAB 1992).

[15] *See* TBMP § 515 (Motion to Remand Application to Examining Attorney).

have the opposition dismissed without prejudice as moot.[16] If, after remand under 37 CFR § 2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 CFR § 2.135.

If an applicant whose application is the subject of an opposition files an abandonment of the application with the written consent of the opposer, the opposition will be dismissed without prejudice, and the application will stand abandoned.

If the applicant files an abandonment of the application with the written consent of the opposer, and the opposer files a withdrawal of the opposition, the opposition will be dismissed without prejudice, and the application will stand abandoned.

If the applicant files an abandonment of the application *with prejudice* with the written consent of the opposer, the opposition will be dismissed without prejudice (and the application will stand abandoned with prejudice to applicant's right to reregister the same mark for the same goods or services), unless the parties specify otherwise in writing.[17]

If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, and the opposer files a withdrawal of the opposition with prejudice with the written consent of the applicant, the opposition will be dismissed with prejudice, and the application will stand abandoned with prejudice to applicant's right to reregister the same mark for the same goods or services.

602.02 Withdrawal by Respondent

602.02(a) Voluntary Surrender of Registration for Cancellation

37 CFR § 2.134(a) *After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(e) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be*

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[16] *Cf.* TBMP § 602.02(b) (Cancellation under Section 8; Expiration under Section 9) and cases cited therein. *Cf. also Bank of America National Trust & Savings Ass'n v. First National Bank of Allentown*, 220 USPQ 892, 8984 n.6 (TTAB 1984) (opposer elected to adjudicate pleaded issues where applicant had conceded that use was not made until after filing date, and its application was held void ab initio); and *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 119 USPQ 350, 350 (TTAB 1958), *rev'd on other grounds*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960) (applicant in prior opposition consented to judgment and therefore not entitled to registration but in subsequent opposition against same applicant, opposer pressed for determination on merits).

[17] *See Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992). *See also Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564 (CCPA 1979) (applicant's successor in interest is bound by act of withdrawal of application with prejudice and is barred from again seeking to register same mark for same goods).

entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

37 CFR § 2.172 Surrender for cancellation.
Upon application by the registrant, the Director may permit any registration to be surrendered for cancellation. Application for such action must be signed by the registrant and must be accompanied by the original certificate of registration, if not lost or destroyed. When there is more than one class in a registration, one or more entire class but less than the total number of classes may be surrendered as to the specified class or classes. Deletion of less than all of the goods or services in a single class constitutes amendment of registration as to that class (see § 2.173).

A registrant that wishes to voluntarily surrender its registration for cancellation may file in the USPTO a written application, signed by the registrant and accompanied by the original certificate of registration, or, if the original certificate of registration has been lost or destroyed, by a statement to that effect.[18] There is no fee for a voluntary surrender for cancellation.[19]

However, after the commencement of a cancellation proceeding, if the respondent applies for surrender of its subject registration under Section 7(e) of the Act, 15 U.S.C. § 1057(e), without the written consent of every adverse party to the proceeding, judgment will be entered against the respondent.[20] The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative.[21]

For information concerning the effect of a judgment of this type, see TBMP §602.01, and cases cited therein.

In a cancellation proceeding against a registration having multiple classes, if the respondent files a request to amend the registration to delete a class sought to be cancelled, the request

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[18] *See* Section 7(e) of the Act, 15 U.S.C. § 1057(e); 37 CFR § 2.172; and TMEP §§ 1403.05(b) (for multiple class registrations) and 1608 (Surrender of Registration).

[19] *See* TMEP § 1608

[20] *See* 37 CFR § 2.134(a). *Cf.* 37 CFR § 2.135; *Goodway Corp. v. International Marketing Group Inc.*, 15 USPQ2d 1749, 1750 (TTAB 1990)**;** *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.,* 14 USPQ2d 2065, 2067 (TTAB 1990) (consent required for abandonment without prejudice regardless of motivation for abandonment, i.e., a concession by applicant that it is not owner of mark and that judgment would be unfair to real owner, a nonparty to the case); and *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where abandonment of application and notice of opposition were filed on same day, consent was not required because there was no application to oppose).

[21] *See* 37 CFR § 2.134(a).

for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 CFR § 2.134(a).

An application for voluntary surrender of a registration that is the subject of a Board inter partes proceeding should be filed with the Board, and should bear at the top of its first page both the registration number and the inter partes proceeding number and title. The application for voluntary surrender should include proof of service upon every other party to the proceeding.[22]

If a registrant whose registration is the subject of a petition for cancellation files a voluntary surrender of the registration with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled.

If the registrant files a voluntary surrender of the registration with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled.

If the registrant files a voluntary surrender of the registration *with prejudice* with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice (the registration will be cancelled with prejudice to registrant's right to reregister the same mark for the same goods or services), unless the parties specify otherwise in writing.

If the registrant files a voluntary surrender of the registration with prejudice with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation with prejudice with the written consent of the registrant, the petition for cancellation will be dismissed with prejudice, and the registration will be cancelled with prejudice to registrant's right to reregister the same mark for the same goods or services.

602.02(b) Cancellation Under Section 8; Expiration Under Section 9

37 CFR § 2.134(b) *After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted his involved registration to be cancelled under § 8 of the Act of 1946 or has failed to renew his involved registration under § 9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the*

[22] *See* 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

If it comes to the attention of the Board, during the course of a proceeding, that respondent has permitted its involved registration to be cancelled under Section 8 of the Trademark Act, 15 U.S.C. § 1058, or has failed to renew its involved registration under Section 9 of the Act, 15 U.S.C. § 1059, the Board may issue an order allowing respondent time to show cause why the cancellation, or the failure to renew, should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of petitioner and should not result in entry of judgment against respondent.[23]

In a cancellation proceeding against a registration having multiple classes, if the respondent permits a class which is the subject of the cancellation proceeding to be cancelled under Section 8 of the Act, or fails to renew the registration under Section 9 of the Act with respect to that class, the cancellation or failure to renew with respect to that class is governed by 37 CFR § 2.134(b).

An order to show cause under 37 CFR § 2.134(b) may be issued by the Board upon motion by the petitioner, or (if the failure to file a Section 8 or Section 9 affidavit comes to the attention of the Board in another manner) upon the Board's own initiative.[24]

For information concerning motions for an order to show cause under 37 CFR § 2.134(b), see TBMP § 535.

The purpose of 37 CFR § 2.134(b) is to prevent a cancellation proceeding respondent whose subject registration comes due, during the course of the proceeding, for a Section 8 or Section 9 affidavit, from being able to moot the proceeding, and avoid judgment, by deliberately failing to file the required affidavit of use under Section 8, or renewal application under Section 9.[25] The Board's policy governing application of 37 CFR § 2.134(b) is as follows:

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[23] *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988); and *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230 (TTAB 1986). *Cf. In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992), *aff'd sub nom., Checkers Drive-In Restaurants, Inc. v. Commissioners or Patents and Trademarks, 51* F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995), *cert. denied,* 516 US 866 (1995); *and Global Maschinen GmbH v. Global Banking Systems, Inc.*, 227 USPQ 862 (TTAB 1985).

[24] *See C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, *supra* at 1452 (motion for order to show cause); and *Abraham's Seed v. John One Ten*, *supra* at 1232 (show cause order issued where respondent's failure to file Section 8 affidavit came to Board's attention following receipt of petitioner's final brief but before final decision).

[25] *See In re Checkers, supra* (petitioner should not be deprived of a judgment in its favor by a respondent who lets its registration lapse during a cancellation proceeding); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (although judgment entered on ground of abandonment in view of concession that failure

> *The paragraph has been modified to provide an opportunity for the respondent in such situation to "show cause" why judgment should not be entered against it. If respondent submits a showing that the cancellation or expiration was the result of an inadvertence or mistake, judgment will not be entered against it. If respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding but rather was the result, for example, of a two-year period of nonuse which commenced well before respondent learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment.*[26]

If, in response to an order to show cause issued under 37 CFR § 2.134(b), a respondent submits a showing that the cancellation of its registration under Section 8 of the Act, or failure to renew the registration under Section 9 of the Act, was the result of inadvertence or mistake, judgment will not be entered against it.[27]

If respondent submits a showing that it permitted its registration to be cancelled under Section 8 of the Act, or failed to renew the registration under Section 9 of the Act, because its registered mark had been abandoned, and that the abandonment was not made for purposes of avoiding the proceeding, judgment will be entered against it only and specifically on the

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to file Section 8 affidavit was due to discontinued use of mark, judgment was not entered on ground of likelihood of confusion where respondent showed that failure to file Section 8 affidavit with respect to that ground was result of deliberate business decision made prior to commencement of proceeding and not for purposes of avoiding proceeding); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 277 (1984).

[26] Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23133, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 23. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989) (where registrant stated that failure to file Section 8, with respect to ground of likelihood of confusion, was result of deliberate business decision made prior to commencement of proceeding and not to avoid judgment, judgment was not entered as to that ground); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230 (TTAB 1986) (respondent's belief that it was improper to file a Section 8 affidavit since "the cancellation action had priority," while erroneous, was treated as sufficient showing of cause to avoid entry of judgment); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, *supra*.

[27] *See C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, *supra* (failure to renew was unintentional and not due to abandonment) and *Abraham's Seed v. John One Ten*, *supra* (respondent's belief that it was improper to file a Section 8 affidavit since "the cancellation action had priority," while erroneous, was treated as sufficient showing of cause to avoid entry of judgment).

ground of abandonment (if abandonment has not been pleaded as a ground for cancellation, plaintiff will be allowed to amend its pleading appropriately).[28]

In those cases where the Board finds that respondent has shown good and sufficient cause why judgment should not be entered against it under 37 CFR § 2.134(b), petitioner may be given time to decide whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot.[29] In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner may be given time to decide if it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues.[30]

As noted above, the purpose of 37 CFR § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding, and avoid judgment, by deliberately failing to file a required affidavit of use under Section 8, or renewal application under Section 9. The rule provides not that an order to show cause "shall" be issued, but rather that an order "may" be issued. Normally, the Board, in the exercise of its discretion under the rule, does not issue a show cause order in those cases where the failure to file a required affidavit under Section 8, or renewal application under Section 9, occurs after the filing of a petition for cancellation, but before respondent has been notified by the Board.[31] Rather, the Board issues an action notifying respondent of the filing of the proceeding, advising both parties that the registration has been cancelled under Section 8, or has expired, and allowing petitioner time to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot.[32] However, a petitioner which believes that the respondent had knowledge of the filing of the petition to cancel

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[28] *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (where registrant stated that failure to file Section 8, with respect to ground of likelihood of confusion, was result of deliberate business decision made prior to commencement of proceeding and not to avoid judgment, judgment was not entered as to that ground and petitioner was allowed time to advise whether it wished to go forward on that ground).

[29] *See Abraham's Seed v. John One Ten*, *supra* (opted for decision on merits). *Cf. C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, *supra* (where petitioner moved for show cause order and respondent filed response showing good cause along with uncontested motion to dismiss petition as moot, petition was dismissed as moot).

[30] *See Marshall Field & Co. v. Mrs. Fields Cookies*, *supra*. *Cf. with respect to the Board's election practice, United Rum Merchants Ltd. v. Distillers Corp. (S.A.),* 9 USPQ2d 1481, 1484 n.3 (TTAB 1988); *Bank of America National Trust & Savings Ass'n v. First National Bank of Allentown*, 220 USPQ 892, 894 n.6 (TTAB 1984) (where application was held void ab initio, opposer elected to adjudicate pleaded issues); and *Daggett & Ramsdell, Inc. v. Procter & Gamble Co*., 119 USPQ 350, 350 (TTAB 1958), *rev'd on other grounds*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960).

[31] *See Global Maschinen GmbH v. Global Banking Systems Inc.*, 227 USPQ 862, 862 n.1 (TTAB 1985).

[32] *Cf.* TBMP § 602.01 (Withdrawal by Applicant).

(notwithstanding the fact that respondent had not been notified thereof by the Board), and that respondent deliberately failed to file a required affidavit of use under Section 8, or renewal application under Section 9, in an effort to moot the proceeding, and avoid judgment, may file a motion for an order to show cause under 37 CFR § 2.134(b)[33] stating the reasons for its belief.

603 Withdrawal by Interference or Concurrent Use Applicant

37 CFR § 2.68 Express abandonment (withdrawal) of application.
An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

37 CFR § 2.135 Abandonment of application or mark.
After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

After the commencement of an interference or concurrent use proceeding, if an applicant whose application is a subject of the proceeding files a written abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant.[34] Any concurrent use proceeding will be dissolved, and registration to applicant will be refused.

If, after the commencement of a concurrent use proceeding involving two or more applicants, one of the applicants files an unconsented abandonment of its application, but not of its use of its mark, judgment will be entered against that applicant with respect to the registration sought by it. However, if the abandoning applicant is specified as an excepted concurrent user in any other application involved in the proceeding, the abandoning applicant will remain a party to the proceeding as a concurrent user, and every other applicant to the proceeding who, in its own application, has listed that party as an excepted user will retain the burden of proving its

[33] *See* TBMP § 535 (Motion for Order to Show Cause under Rule 2.134(b)).

[34] 37 CFR § 2.135.

entitlement to registration in view of the acknowledged rights of the abandoning applicant.[35] On the other hand, if a party to a concurrent use proceeding abandons all rights in its mark and in its application (if any), any remaining party that seeks concurrent registration may move to amend its application to delete the abandoning party as an excepted user. If the abandoning party is the only excepted user specified in a remaining party's application, the remaining party may move to amend its application to seek a geographically unrestricted registration.[36] If the motion is granted, the concurrent use proceeding will be dissolved without prejudice, and the application will be republished, for purposes of opposition, as an application for a geographically unrestricted registration.

If an application which is the subject of an interference or concurrent use proceeding has multiple classes, and the applicant files a request to amend the application to delete a class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR § 2.135.

An abandonment of an application, which is the subject of an interference or concurrent use proceeding, should be filed with the Board. The top of its first page should list both the application serial number, and the interference or concurrent use proceeding number and title. The abandonment should include proof of service thereof upon every other party to the proceeding.[37]

If, during the pendency of an interference or concurrent use proceeding, the Board grants a request by the Trademark Examining Attorney for remand under 37 CFR § 2.130[38] and the application thereafter becomes abandoned by operation of law, for failure of the applicant to respond to an Office action, or because a final refusal to register is affirmed on appeal, judgment under 37 CFR § 2.135 will not be entered against applicant in the interference, or in the concurrent use proceeding. Trademark Rule 2.135 comes into play only when there is a *written*

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[35] *See Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992) (although judgment was entered against excepted user in view of abandonment of its application without consent and therefore user was not entitled to a registration, because said party was listed as exception to plaintiff's right to use, plaintiff was required to show entitlement to concurrent registration), and *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1308 (TTAB 1984) (once concurrent user is acknowledged, even if application owned by user is expressly abandoned, plaintiff is not entitled to unrestricted registration and still must show entitlement to concurrent use registration).

Cf. 37 CFR § 2.99(d)(3), and *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987) (settlement agreement sufficient to show entitlement as to non defaulting user but still must show entitlement as to defaulting users and may do so through an ex parte type of showing).

[36] *See Newsday, Inc. v. Paddock Publications, Inc., supra*.

[37] *See* 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

[38] *See* TBMP § 515 (Motion to Remand Application to Examining Attorney).

abandonment by the applicant. If, after remand under 37 CFR § 2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 CFR § 2.135.

604 Consent to Judgment

If a party to an inter partes proceeding before the Board does not wish to litigate the case, and is willing to accept entry of judgment against itself, the party may file a statement with the Board indicating that it consents to entry of judgment against itself. Upon receipt of such a statement, the Board will enter judgment against the filing party.

605 Settlement

605.01 In General

A substantial percentage of the inter partes cases filed with the Board are eventually settled. The Board encourages settlement, and several aspects of Board practice and procedure, including its liberal discovery practice (*see* TBMP chapter 400) and its usual willingness to suspend proceedings in pending cases while parties negotiate for settlement[39] serve to facilitate the resolution of cases by agreement.

605.02 Suspension for Settlement Negotiations

Parties which are negotiating for settlement, and wish to defer further litigation of the case pending conclusion of their negotiations, should remember to file stipulations to extend or suspend the running of the time periods set in the case.

When the Board is notified that parties are negotiating for settlement, the Board may suspend proceedings for a period of up to six months, subject to the right of either party to request resumption at any time prior to the expiration of the suspension period.[40] The suspension period may be further extended upon request, or upon notification to the Board that the parties are still engaged in their settlement negotiations. However, once proceedings have been suspended for over a year, the Board may require that the parties submit a report as to the status of their negotiations in order to show good cause for continued suspension. This report should include a summary of the progress of the parties' negotiations and a firm timetable for resolution. Absent

[39] *See* TBMP §§ 510.03 (Suspension for Other Reasons) and 605.02 (Suspension for Settlement Negotiations).

[40] *See* TBMP § 510.03.

such a report, any subsequent motion to extend or suspend for settlement negotiations may be denied, even though agreed to by the parties.[41]

605.03 Settlement Agreements

605.03(a) In General

When an inter partes proceeding before the Board is settled, the parties should promptly notify the Board of the settlement. It is not necessary that the parties file a copy of their settlement agreement with the Board. Rather, they may simply file a stipulation stating the desired disposition of the proceeding (i.e., "It is hereby stipulated that the opposition be sustained," "It is hereby stipulated that the petition for cancellation be dismissed with prejudice," or the like). If there is a counterclaim, the stipulation should also state the desired disposition of the counterclaim. If, in a proceeding with a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, but there is no stipulation to dispose of the counterclaim, and there is no withdrawal of the counterclaim, consent by one party to entry of judgment against itself on the counterclaim, etc., the counterclaim will go forward, notwithstanding the fact that judgment has been entered on the original claim.[42]

If the proceeding is to be dismissed, the stipulation should specify whether the dismissal is to be with prejudice or without prejudice. If no specification is made, the Board, in its action dismissing the proceeding, will simply state that the proceeding is being dismissed "in accordance with the agreement of the parties." However, if the agreement itself also fails to indicate whether the dismissal is to be with or without prejudice, at some later time a dispute may arise between the parties as to whether they intended the dismissal to be with or without prejudice. A clear specification in the stipulation may avoid future trouble.

A settlement agreement may simply call for a party to withdraw with, or without, prejudice, or with, or without, consent. In such a case, the parties need not file a settlement stipulation, because the withdrawal, when filed, will result in a final disposition of the proceeding.

A settlement stipulation, which is not in accordance with the applicable rules and the statute, will be given no effect by the Board.

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[41] *Cf. Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 121 (TTAB 2001) (where opposer's statements that the parties were engaged in settlement negotiations were found to be false and filed in bad faith, opposer was sanctioned with dismissal). *For a discussion of motions to suspend see* TBMP § 510.

[42] *See* TBMP § 606 (Effect on Counterclaim).

605.03(b) With Amendment of Subject Application or Registration

If a settlement agreement is contingent upon amendment of a defendant's subject application or registration, the request for amendment is governed by 37 CFR § 2.133(a)[43] and should be filed with the Board. The request should list at the top of the page both the number of the subject application or registration, and the Board proceeding number and title. The request also should include proof of service thereof upon every other party to the proceeding.[44]

A proposed amendment to a defendant's application or registration must comply with all applicable rules and statutory provisions.[45] Thus, for example, a proposed amendment, which materially alters the character of the defendant's subject mark, cannot be approved.[46] If a settlement agreement calls for an amendment which may amount to a material change in the defendant's mark, the parties may wish to also agree that if a request for amendment of the defendant's subject application or registration is denied by the Board, the defendant will abandon that application, or voluntarily surrender that registration, and file a new application for registration of the altered mark; and that the plaintiff will not oppose the new application or seek to cancel any registration that matures there from. Any abandonment or voluntary surrender is governed by 37 CFR § 2.135 or 37 CFR § 2.134(a), respectively.[47]

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR § 2.135. Similarly, in a cancellation proceeding against a registration having multiple classes, if the respondent files a request to amend the registration to delete a class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 CFR § 2.134(a).

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[43] *See* TBMP § 514 (Motion to Amend Application or Registration).

[44] *See* 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

[45] *See* TBMP § 514.01 (Motion to Amend Application or Registration – In General).

[46] *See* Section 7(e) of the Act, 15 U.S.C. § 1057(e), and 37 CFR §§ 2.72 and 2.173.

[47] *See* TBMP § 602 (Withdrawal by Opposition or Cancellation Defendant).

605.03(c) With Amendment of Plaintiff's Pending Application

The plaintiff in an inter partes proceeding before the Board may own a pending application for registration which has been rejected by the Trademark Examining Attorney in view of the defendant's subject registration, or which is going to be rejected by the Examining Attorney when and if defendant's subject application matures to registration. In such a case, a settlement agreement may be contingent upon the approval of an amendment to be filed in the plaintiff's application, or acceptance of a consent agreement to be filed therein, and the consequent approval of the application for publication.

The Board has no jurisdiction over a plaintiff's application which is still pending

before the Trademark Examining Attorney.[48] Thus, when the plaintiff in an inter partes proceeding before the Board owns an application which is still pending before the Trademark Examining Attorney, and an amendment or consent agreement is filed in the application pursuant to a settlement agreement between the parties, the amendment should be filed with the Examining Attorney, not with the Board. The Examining Attorney should consider the amendment or agreement and take appropriate action (including, if the amendment or consent agreement puts the application in condition for publication, approving the application for publication), notwithstanding the fact that action on the application may previously have been suspended pending the final determination of the inter partes proceeding before the Board. Indeed, if settlement of the inter partes proceeding is contingent upon approval of the amendment, or acceptance of the consent agreement, by the Examining Attorney, proceedings before the Board may be suspended pending action by the Examining Attorney on the amendment or consent agreement.

605.03(d) Breach of Settlement Agreement

If an agreement settling an inter partes proceeding before the Board is breached by one of the parties, an adverse party's remedy is by way of civil action. The Board has no jurisdiction to enforce such an agreement. However, while the Board does not have jurisdiction to enforce the contract, agreements to cease use of a mark or not to use a mark in a certain format are routinely upheld and enforced to the extent a party may not obtain a registration for exclusive use that may be precluded by the terms of a settlement agreement.[49]

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[48] *See Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986) (cannot instruct Examining Attorney to pass application to registration).

[49] *See Vaughn Russell Candy Co. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1638 n.6 (TTAB 1998) (registration refused where settlement agreement precluded use of a portion of applicant's mark) and *In re Sun Refining and*

605.03(e) Effect of Judgment Based Upon Agreement

For information concerning the effect of agreements and judgments resulting there from, see cases cited in the note below.[50]

605.03(f) Consent Orders

The Board will dismiss, sustain, etc., a Board inter partes proceeding, if the parties so stipulate[51] and will also enter judgment against a party which submits its written consent to entry of judgment against itself, or which concedes that its case is not well taken. Further, the Board encourages the use of stipulated evidence in Board inter partes proceedings.[52] However, the Board does not issue advisory opinions. Nor does the Board issue consent orders. That is, the Board does not, based simply upon a joint request by the parties that it does so, enter, approve, or otherwise adopt as its own findings, as if on the merits, stipulated findings of fact and/or conclusions of law, without any consideration by the Board of evidence properly adduced during the course of the proceeding. Rather, the Board makes findings of fact, and conclusions of law, on the merits of the case only as warranted by the evidence of record upon motion for summary judgment or at final hearing.

Marketing Co., 23 USPQ2d 1072, 1074 (TTAB 1991) (refusal affirmed since settlement agreement containing geographic restrictions clearly showed that applicant was not entitled to unrestricted registration).

[50] *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 39 (Fed. Cir. 1985) (construction of 1924 agreement found that goods in current application not encompassed within agreement, registration permitted); *Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187, 191 n.4 (Fed. Cir. 1984) (unless principles of res judicata apply, consent given in a decree should be treated as any other contractual consent and as a factor to be taken into consideration in determining likelihood of confusion); *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564, 567 (CCPA 1979) (although agreement can be implied from applicant's withdrawal of application with consent and with prejudice in prior opposition, that agreement was not itself a settlement of the substantive rights of the parties and estoppel does not rest on that agreement but instead on the act of withdrawing the application with prejudice); *Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 372 (CCPA 1974) (equitable estoppel barring opposition rested on terms of the agreement between parties in settlement of prior proceeding); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in prior opposition does not operate as res judicata when different marks were involved in subsequent proceeding); and Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings*, 80 Trademark Rep. 540 (1990). *See also Epic Metals Corp. v. H.H. Robertson Co.*, 870 F.2d 1574, 10 USPQ2d 1296, 1299 (Fed. Cir. 1989) (district court erred in construction of consent judgment), and *Hartley v. Mentor Corp.*, 869 F.2d 1469, 10 USPQ2d 1138, 1142 (Fed. Cir. 1989) (intent of the parties is generally controlling with respect to preclusive effect of stipulated judgment).

[51] *See* TBMP § 605.03(a) (Settlement Agreements – In General).

[52] *See* 37 CFR § 2.123(b), and TBMP § 705 (Stipulated Evidence).

606 Effect on Counterclaim

If, prior to the determination of a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, or the original claim is withdrawn, dismissed for failure to prosecute, or otherwise disposed of, the counterclaim will nevertheless go forward, unless the parties stipulate to its disposition, or it is withdrawn by the counterclaimant, or one party consents to entry of judgment against itself on the counterclaim, etc.[53]

[53] *See, for example, Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (opposition dismissed with prejudice; applicant elected to go forward with counterclaim to cancel opposer's registration and had standing to do so). *Cf.* TBMP § 901.02(a).

701 Time of Trial

37 CFR § 2.116(b) *The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

(c) *The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

(d) *The assignment of testimony periods corresponds to setting a case for trial in court proceedings.*

(e) *The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.*

37 CFR § 2.121 Assignment of times for taking testimony.
(a)*(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule testimony periods is denied, the testimony periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party.*

* * * *

(b)*(1) The Trademark Trial and Appeal Board will schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.*

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Board will schedule testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.

(c) *A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods may remain as set.*

On receipt of a properly filed notice of opposition or petition to cancel (or at the time described in 37 CFR § 2.92 for an interference and 37 CFR § 2.99(c) for a concurrent use proceeding) the Board sends out a notice advising the parties of the institution of the proceeding. The notice includes a trial order assigning each party's time for taking testimony and introducing other evidence in the case.[1] Specifically, the Board schedules a 30-day testimony period for the plaintiff to present its case in chief, a 30-day testimony period for the defendant to present its case and to meet the case of the plaintiff, and a 15-day testimony period for the plaintiff to present rebuttal evidence.[2] The plaintiff's period for presenting its case in chief is scheduled to open 60 days after the close of the discovery period; the defendant's testimony period is scheduled to open 30 days after the close of the plaintiff's testimony period in chief; and the plaintiff's rebuttal testimony period is scheduled to open 30 days after the close of the defendant's testimony period.[3]

If there is a counterclaim, or if proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or if there is an interference or a concurrent use registration proceeding involving more than two parties, the Board schedules testimony periods as specified in 37 CFR § 2.121(b)(2), i.e., giving each plaintiff a period for presenting its case in chief as against each defendant, giving each defendant a period for presenting its case and meeting the case of each plaintiff, and giving each plaintiff a period for rebuttal. The testimony periods are separated from the discovery period by a 60-day interval, and from each other by 30-day intervals.[4] In an interference or concurrent use proceeding, a junior party is in the position of plaintiff and a senior party is in the position of defendant.[5]

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[1] *See* 37 CFR §§ 2.120(a), 2.121 and TBMP § 403.01 (Timing of Discovery in General).

[2] *See* 37 CFR §§ 2.121(b)(1) and 2.121(c).

[3] *See Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 356 (TTAB 1978) (thirty-day interval between each testimony period), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982).

[4] *See* 37 CFR §§ 2.121(b)(2) and 2.121(c). *Examples of trial schedules can be found in the Appendix of Forms for Chapter 300*.

[5] *See* 37 CFR §§ 2.96 and 2.99(e), and TBMP §§ 1005 and 1007.

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[6]

Testimony periods may be rescheduled, extended, or reopened by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.[7] It is preferable, where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion.[8]

The resetting of the closing date for discovery results in the automatic rescheduling of the testimony periods, without action by any party. However, the resetting of a party's time to respond to an outstanding request for discovery does not result in the automatic rescheduling of the discovery and/or testimony periods.[9] When a party's time to respond to an outstanding request for discovery is reset, the discovery and/or testimony periods will be rescheduled only on stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.[10]

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[6] *See* 37 CFR §2.121(a)(1). *See also M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1072 (TTAB 1990) (untimely deposition stricken); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (opposer's discovery deposition of nonparty witness treated as testimony deposition taken by stipulation prior to trial); and *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979) (discovery deposition of nonparty inadmissible as evidence under a notice of reliance filed by one party without express or implied consent of adverse party; should have taken deposition during trial period or at least moved to take trial testimony prior to assigned testimony period).

Cf. Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, but applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

[7] *See* 37 CFR §§ 2.121(a)(1) and 2.121(c); Fed. R. Civ. P. 6(b); and, *for example*, *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (motion to extend testimony filed on last day with vague references to settlement and no detailed information concerning apparent difficulty in identifying and scheduling its witnesses for testimony denied); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999) (motion to extend denied where sparse motion contained insufficient facts on which to find good cause); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (motion to reopen to submit new evidence denied); and *Pumpkin Ltd v. The Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997) (motion to reopen filed over three months after close of testimony period, due to a docketing error, denied). *See also* TBMP §§ 501 and 509 *regarding stipulations and motions to extend or reopen.*

[8] *See* TBMP § 509.02 (Form and Determination of Motions to Extend or Reopen).

[9] *See PolyJohn Enterprises Corp.* v. *1-800-TOILETS, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002) (mistaken belief that resetting time to respond to discovery also extended discovery and testimony periods did not constitute excusable neglect to reopen).

[10] *See* 37 CFR § 2.121(a)(1).

In Board inter partes proceedings, the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period.[11]

702 Manner of Trial and Introduction of Evidence – In General

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations).[12]

Within the parameters of these rules, there are a number of ways to introduce evidence into the record in a proceeding before the Board. Evidence may be introduced in the form of testimony depositions taken by a party during its testimony period, and documents and other exhibits may be made of record with appropriate identification and introduction by the witness during the course of the deposition.[13] Certain specified types of evidence, including official records and printed publications as described in 37 CFR § 2.122(e) and discovery responses under 37 CFR § 2.120(j), may, but need not be introduced in connection with the testimony of a witness. Such evidence may instead be made of record by filing the materials with the Board under cover of a notice of reliance during the testimony period of the offering party.[14] In addition, the parties may enter into a wide variety of stipulations concerning the timing and/or introduction of specified matter into evidence.[15] For example, the parties may stipulate that matter otherwise improper for a notice of reliance (such as documents obtained by production under Fed. R. Civ. P. 34) may be introduced in that manner, that testimony may be submitted in the form of an affidavit, that a party may rely on its own discovery responses or that notices of reliance can be filed after the testimony periods have closed. There may also be circumstances where improperly offered or

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[11] *See* TBMP § 504.01 (Time for Filing Judgment on Pleadings) and authorities cited therein. *See also Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (Board proceedings approximate the proceedings in a courtroom trial) and *Time Warner Entertainment Company v. Jones.* 65 USPQ2d 1650 (TTAB 2002) (trial in a Board proceeding takes place during the testimony periods). *Cf.* TBMP § 528.02 (Time for Filing Motion for Summary Judgment).

[12] 37 CFR § 2.122(a). *Cf.* TBMP §§ 101.01 and 101.02.

[13] *See generally,* TBMP § 703 regarding testimony depositions. *See also* TBMP § 704.13 regarding introducing testimony from another proceeding, and TBMP § 530 regarding motions to use testimony from another proceeding.

[14] *See generally,* TBMP § 704.02 regarding the types of evidence that may be submitted by notice of reliance and the requirements for the introduction of such evidence by notice of reliance. *See also Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1786 n.4 (TTAB 2001) (notices of reliance must be filed before closing date of party's testimony period).

[15] *See* TBMP § 705 regarding stipulated evidence.

otherwise noncomplying evidence may nevertheless be deemed stipulated into the record where, for example, no objection to the evidence is raised and/or the nonoffering party treats the evidence as being of record.[16]

A discussion of the time and manner of taking testimony depositions and introducing evidence is presented in the sections that follow.

Because the Board is an administrative tribunal, its rules and procedures differ in some respects from those prevailing in the Federal district courts.[17] For example, proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based on the written record therein.[18] The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board.[19]

Depositions may be noticed for any reasonable place in the United States.[20] As a result, parties do not have to travel to the offices of the Board, or to the geographical area surrounding the Board's offices, to take their testimony. A party to a proceeding before the Board need never come to the offices of the Board at all, unless the party wishes to argue its case at oral hearing (and an oral hearing is held only if requested by a party to the proceeding--*see* 37 CFR § 2.129(a)).

The papers and other materials filed with the Board during the course of an inter partes proceeding are kept, during the course of the proceeding, in the physical possession of the Board.[21] However, no paper, document, exhibit, etc. will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.[22]

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[16] *See generally* TBMP § 704 regarding the introduction of other evidence.

[17] *See Yamaha International Corp. v. Hoshino Gakki Co.*, *supra* and *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). *Cf.* TBMP §§ 102.03 (General Description of Board Proceedings) and 502.01 (Available Motions). *For a discussion concerning the general nature of trials in proceedings before the Board, see Fischer Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 867 (TTAB 1979); *La Maur, Inc. v. Bagwells Enterprises, Inc., supra; and Litton Business Systems, Inc. v. J. G. Furniture Co.,* 190 USPQ 431 (TTAB 1976).

[18] *See* 37 CFR § 1.2.

[19] *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991) and *La Maur, Inc. v. Bagwells Enterprises, Inc., supra*.

[20] *See* 37 CFR § 2.123(c).

[21] *See* TBMP § 120 (Access to Files).

[22] *See* 37 CFR § 2.123(l), and TBMP § 706 (Noncomplying Evidence).

703 Taking and Introducing Testimony

703.01 Oral Testimony Depositions

703.01(a) In General

A testimony deposition is a device used by a party to a Board inter partes proceeding to present evidence in support of its case. Testimony is taken out of the presence of the Board, on oral examination or written questions, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board.[23] During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) in behalf of the party.[24]

Testimony depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, but also those documents and other exhibits which may not be made of record by notice of reliance.[25] However, only evidence admissible under the applicable rules of evidence may properly be adduced during a testimony deposition; inadmissibility is a valid ground for objection.[26]

For a comparison of testimony depositions and discovery depositions, see TBMP § 404.09.

703.01(b) Form of Testimony

37 CFR § 2.123(a)*(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

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[23] *See* TBMP § 702 (Manner of Trial and Introduction of Evidence). *See also* TBMP § 502.01 (Available Motions).

[24] *See* TBMP § 404.02 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

[25] *See generally* TBMP § 704 describing types of evidence admissible by notice of reliance.

[26] *See* 37 CFR §§ 2.122(a) and 2.123(k), and TBMP § 707.03 (Objections to Trial Testimony Depositions).

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) Stipulations. *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken either on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124.[27]

However, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--see 37 CFR § 2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination.[28] What constitutes good cause to take an oral deposition is determined on a case-by-case basis.[29]

In addition, a testimony deposition taken in a foreign country must be taken by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.[30]

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[27] *See* 37 CFR § 2.123(a)(1). *For information concerning testimony depositions on written questions, see* TBMP § 703.02.

[28] 37 CFR § 2.123(a)(1). *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990) (good cause to take oral deposition of expert witness, during rebuttal testimony period); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (good cause shown where deponents were former employees of respondent and present employees of petitioner and were being deposed for first time during rebuttal period); and TBMP § 531 (Motion that Deposition on Written Questions be Taken Orally).

[29] *See Feed Flavors Inc. v. Kemin Industries, Inc., supra* at 591 and TBMP § 531.

[30] *See* 37 CFR § 2.123(a)(2). *See also* TBMP § 520 (Motion to take Foreign Deposition Orally) and*, with respect to discovery depositions*, *Jain v. Ramparts Inc.,* 49 USPQ2d 1429, 1431 (TTAB 1998); 37 CFR § 2.120(c)(1); TBMP § 404.03(b) (Person Residing in Foreign Country – Party); and *Orion Group Inc. v. Orion Insurance Co. P.L.C.,* 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause to take oral deposition of witness in England under the

By written agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit by such witness or witnesses.[31] The parties may also stipulate in writing the facts in the case of any party, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony.[32]

703.01(c) Time for Taking Testimony

A party may take testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[33]

For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see TBMP §§ 509 and 701.

703.01(d) Time and Place of Deposition

37 CFR § 2.123(a)*(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of*

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circumstances and since fares to England were not that much greater than fares within U.S. and no translation was required).

[31] 37 CFR § 2.123(b). *See Order Sons of Italy in America v. Memphis Mafia Inc*., 52 USPQ2d 1364, 1365 n.3 (TTAB 1999) ("statement" with exhibits by defendant's officer stricken where there was no agreement that defendant could file testimony in form of affidavit or declaration); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403-04 n.9 (TTAB 1998) (no agreement; officer's affidavit not considered); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.3-4 (TTAB 1989) (although parties had stipulated to submission of testimony by affidavit, opposer's objection was well taken because applicant's unsworn statement did not constitute testimony); *Chase Manhattan Bank, N.A. v. Life Care Services Corp*., 227 USPQ 389, 390 (TTAB 1985) (affidavits submitted by agreement of the parties); *Oxy Metal Industries Corp. v. Transene Co.,* 196 USPQ 845, 847 n.20 (TTAB 1977) (stipulation to presentation of evidence by affidavit evidence reduces cost of litigation); and *National Distillers and Chemical Corp. v. Industrial Condenser Corp*., 184 USPQ 757, 758-59 (TTAB 1974) (both parties submitted stipulated testimony and exhibits).

Cf. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993) (objection waived where although there was no such agreement, plaintiff did not object to declarations with exhibits submitted by defendant and moreover considered the evidence as if properly of record).

[32] 37 CFR § 2.123(b). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (stipulation for use of discovery deposition as testimony deposition) and *Oxy Metal Industries Corp. v. Transene Co.*, *supra*, at 847 n.20 (litigation expenses can be saved where parties agree to introduce all uncontroverted facts by affidavit or stipulated facts and provide balance through deposition testimony).

[33] *See* 37 CFR § 2.121(a)(1). *See also* TBMP § 701 (Time of Trial) and authorities cited therein.

the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

* * * *

(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.*

A testimony deposition may be noticed for any reasonable time during the deposing party's testimony period.[34] A testimony deposition may not be taken outside the deposing party's testimony period except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[35]

A testimony deposition to be taken in the United States may be noticed for any reasonable place.[36] A party may not take depositions in more than one place at the same

[34] *See* 37 CFR § 2.123(c).

[35] *See* 37 CFR § 2.121(a)(1) and *Fossil Inc. v. Fossil Group,* 49 USPQ2d 1451, 1454 n.1 (TTAB 1998) (stipulation that testimony deposition of applicant's witness could be taken prior to its testimony period on the same day as opposer's witness to achieve efficiencies in time and cost). *See also* TBMP § 701 (Time of Trial) and authorities cited therein. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n..2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

[36] *See* 37 CFR § 2.123(c).

time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.[37]

A deposition may not be noticed for a place in a foreign country, unless the deposition is to be taken on written questions as provided by 37 CFR § 2.124, or unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination.[38]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[39]

703.01(e) Notice of Deposition

37 CFR § 2.123(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.*

Before the oral depositions of witnesses may be taken by a party, the party must give due (i.e., reasonable) notice in writing to every adverse party.[40]

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[37] *See* 37 CFR § 2.123(c).

[38] *See* 37 CFR §§ 2.123(a)(2) and 2.123(c). *See also* TBMP § 703.01(b) (Form of Testimony).

[39] *See* 37 CFR § 2.123(b).

[40] 37 CFR § 2.123(c*). See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Assn v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable); *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time to prepare for deposition); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was

The notice must specify the time and place the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. If the name of a witness is not known, the notice must include a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation.[41]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[42]

Ordinarily, a notice of oral deposition need not be filed with the Board, except as part of the completed deposition.[43] However, if a certified copy of the notice of deposition is, for some reason, required for use before a Federal district court, the notice of deposition must be filed with the Board for purposes of certification.[44]

For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, see 37 CFR § 2.123(e)(3) and TBMP § 533.02.

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shown). *See also* TBMP § 533.02 (Motion to Strike on Ground of Improper or Inadequate Notice). *Cf.* TBMP § 404.05 (Notice of [Discovery] Deposition).

[41] *See* 37 CFR § 2.123(c). *See also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony not considered where notice failed to specify name of party being deposed), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352, 353 (TTAB 1976) (testimony stricken where notice identified one witness and indicated that "possibly others will testify"; and where opposer proceeded to take testimony of unidentified witness, applicant objected, did not cross-examine the witness, and moved to strike testimony); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313, 314 (TTAB 1971) (objections sustained where identification of possible witnesses as "such other persons as may be called" insufficient to identify witness or group to which witness belongs), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973). *Cf.* TBMP § 404.05 (Notice of [Discovery] Deposition).

[42] 37 CFR § 2.123(b).

[43] *See* Rany L. Simms, *TIPS FROM THE TTAB: Whether and When to File Papers During Trademark Proceedings*, 67 Trademark Rep. 175 (1977), and 37 CFR § 2.123(f).

[44] *See* TBMP §§ 122 (Certification) and 703.01(f)(2) (Securing Attendance of Unwilling Witness Residing in U.S.).

703.01(f) Securing Attendance of Unwilling Adverse Party or Nonparty

703.01(f)(1) In General

Normally, during a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness who is willing to appear voluntarily to testify on behalf of the party. These testimony depositions may be taken, at least in the United States, on notice alone.

However, where a party wishes to take the testimony of an adverse party or nonparty, or an official or employee of an adverse party or nonparty, and the proposed witness is not willing to appear voluntarily to testify, the deposition may not be taken on notice alone. Rather, the party that wishes to take the deposition must take steps, discussed below, to compel the attendance of the witness. If the witness resides in a foreign country, the party may not be able to take the deposition.[45]

703.01(f)(2) Unwilling Witness Residing in United States

If a party wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena.[46]

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[45] *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (after unsuccessfully attempting to take testimony deposition on written questions of adverse party's officer on notice alone, opposer obtained subpoena from U.S. district court ordering appearance); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (it is incumbent on deposing party to have a subpoena issued from the U.S. district court where witness is located and have same properly served on witness with sufficient time to apprise him that he is under order to appear) ; Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and TBMP §§ 703.01(f)(2) (securing attendance of unwilling witness residing in U.S.), 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country), and 703.02 (testimony depositions on written questions). *See also Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 55 n.7 (TTAB 1983) (no adverse inference can be drawn from adverse party's failure to appear and produce requested documents at testimony deposition where party attempted to secure attendance by notice alone), *aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

[46] *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, *supra*; *Consolidated Foods Corp. v. Ferro Corp.*, *supra*; Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness*

The subpoena must be issued, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, from the United States district court in the Federal judicial district where the witness resides or is regularly employed. Occasionally district courts may request a "matter number" for the issuance of a subpoena. If that is the case, the requesting party should obtain one from the court or determine whether the Board's proceeding number will satisfy the court. If, for any reason, a certified copy of the notice of deposition is required in connection with the subpoena, such as for purposes of a motion to quash the subpoena, or a motion to enforce the subpoena, the interested party should contact the clerk of the court to determine whether the court will require a formal certified copy (i.e., a certified copy bearing a USPTO seal) of the notice.[47] A certified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and certified by the USPTO as being a true copy of the notice of deposition filed in the proceeding before the Board. A copy of a notice of deposition cannot be certified by the USPTO unless it has been filed in the Board proceeding.[48]

If a person named in a subpoena compelling attendance at a testimony deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States district court that issued the subpoena. Similarly, any request to quash a subpoena must be directed to the United States district court that issued the subpoena. The Board has no jurisdiction over depositions by subpoena.[49]

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in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). *Cf.* TBMP § 404.03(a)(2) (securing attendance of nonparty residing in U.S. at discovery deposition).

[47] *NOTE: The Board no longer provides verified copies of filings.*

[48] *For further information relating to USPTO certification of a notice of deposition, see* TBMP § 122 (Certification).

[49] *See, for example, In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201, 201 (D.Del. 1973) (no power to grant protective order with respect to depositions taken by subpoena); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (no authority to quash subpoena); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318, 319 n.2 (TTAB 1971) (opposer's allegation in its brief that applicant defied a subpoena to produce witnesses is a matter opposer should have pursued before the court that issued the subpoena); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

703.01(f)(3) Unwilling Witness Residing in Foreign Country

There is no certain procedure for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a nonparty (or an official or employee of an adverse party or nonparty), and is not willing to appear voluntarily to testify. However, the deposing party may be able to obtain the testimony deposition of such a witness through the letter rogatory procedure or The Hague Convention letter of request procedure.[50]

For information concerning these procedures, see TBMP § 404.03(c)(2).

703.01(g) Persons Before Whom Depositions May be Taken

37 CFR § 2.123(d) Persons before whom depositions may be taken. *Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.*

Fed. R. Civ. P. 28. Persons Before Whom Depositions May Be Taken
(a) Within the United States. *Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.*

(b) In Foreign Countries. *Depositions may be taken in a foreign country (1) pursuant to any applicable treaty or convention, or (2) pursuant to a letter of request (whether or not captioned a letter rogatory), or (3) on notice before a person authorized to administer oaths in the place where the examination is held, either by the law thereof or by the law of the United States, or (4) before a person commissioned by the court, and a person so commissioned shall have the power by virtue of the commission to administer any necessary oath and take testimony. A commission or a letter of request shall be issued on application and notice and on terms that are just and appropriate. It is not requisite to the issuance of a commission or a letter of request that the taking of the deposition in any other manner is impracticable or inconvenient; and both a commission and a letter of request may be issued in proper cases. A notice of commission may designate the person before whom the deposition is to be taken either by name or descriptive title. A letter of request may be addressed "To the Appropriate Authority in [here name the country]."*

[50] *See* Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

When a letter of request or any other device is used pursuant to any applicable treaty or convention, it shall be captioned in the form prescribed by that treaty or convention. Evidence obtained in response to a letter of request need not be excluded merely because it is not a verbatim transcript, because the testimony was not taken under oath, or because of any similar departure from the requirements for depositions taken within the United States under these rules.

(c) Disqualification for Interest. *No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.*

Depositions in Board inter partes proceedings may be taken before the persons described in Fed. R. Civ. P. 28.[51]

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a Board proceeding testimony deposition "shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending."[52] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter who is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a Board proceeding testimony deposition may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a Board proceeding testimony deposition taken of a willing witness in a foreign country usually may be taken on notice before a United States consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed.[53] A party which wishes to take a testimony deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. The testimony of an unwilling adverse party or nonparty witness may be taken in a foreign country, if at all, only by the letter rogatory procedure, or by the letter of request procedure provided under the Hague

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[51] 37 CFR § 2.123(d).

[52] *See* Fed. R. Civ. P. 28(a).

[53] *See* Wright, Miller & Marcus, *Federal Practice and Procedure*: Civil 2d § 2083 (1994).

Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, or by any other procedure provided for the purpose by any future treaty into which the United States may enter.[54]

If the parties so stipulate in writing (and if permitted by the laws of the foreign country, in the case of a deposition to be taken in a foreign country), a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[55]

703.01(h) Examination of Witnesses

37 CFR § 2.123(e) Examination of witnesses. (1) *Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition is to be taken.*

(2) *The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be taken stenographically and transcribed, unless the parties present agree otherwise. In the absence of all opposing parties and their attorneys or other authorized representatives, depositions may be taken in longhand, typewriting, or stenographically. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly to the contrary.*

(3) *Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

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[54] *Cf.* TBMP §§ 404.03(c) (concerning discovery deposition of nonparty residing in foreign country) and 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country).

[55] 37 CFR § 2.123(b).

(4) *All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.*

Fed. R. Civ. P. 30(b)(7) *The parties may stipulate in writing or the court may upon motion order that a deposition be taken by telephone or other remote electronic means. For the purposes of this rule and Rules 28(a), 37(a)(1), and 37(b)(1) a deposition taken by such means is taken in the district and at the place where the deponent is to answer questions.*

Before testifying, a witness whose testimony deposition is being taken for use in a Board inter partes proceeding must be duly sworn, according to law, by the officer before whom the deposition is to be taken.[56]

The deposition is taken in answer to questions, and the questions and answers are recorded in order by the officer, or by some other person (who is subject to the provisions of Fed. R. Civ. P. 28) in the presence of the officer, except when the officer's presence is waived on the record by agreement of the parties. The testimony is taken stenographically and transcribed, unless the parties present agree otherwise. If no adverse party, or its attorney or other authorized representative, attends the deposition, the testimony may be taken in longhand, typewriting, or stenographically.[57]

The Board does not accept videotape depositions. A deposition must be submitted to the Board in written form. However, a videotape of a commercial, demonstration, etc., may be submitted as an exhibit to the testimony of a witness.

On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone.[58] A deposition taken by telephone is taken in the district and at the place where the witness is to answer the questions propounded to him or her.

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[56] 37 CFR § 2.123(e)(1). *See Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (objection to deposition taken in Honduras that officer designated in notice did not take deposition and that the transcript did not show due administration of the oath overruled where the person who conducted the deposition had authority to do so under Honduran law and the oath was administered in standard manner under Honduran law). *See also* TBMP § 703.01(g) (Persons Before Whom Depositions May be Taken).

[57] 37 CFR § 2.123(e)(2).

[58] *See* Fed. R. Civ. P. 30(b)(7), and *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552-53 (TTAB 1991) (Board granted request to attend deposition by telephone noting that trademark rules do not specifically provide for or prohibit depositions by telephone and that federal court practice favors use of technological benefits).

Exhibits which are marked and identified at the deposition will be deemed to have been offered in evidence, even if no formal offer thereof is made, unless the intention of the party marking the exhibits is clearly to the contrary.[59]

If exhibits are large, bulky, valuable, or breakable, the Board strongly prefers that they be photographed (or, in the case of documents, photocopied), and that the photographs (or photocopies) be filed with the Board in lieu of the originals. The originals should, of course, be shown to every adverse party. If an original exhibit does not photograph (or photocopy) well, and one of the parties intends to request that an oral hearing be held on the case, the parties may agree that the original be carried to the oral hearing and given to the Board at that time.[60] If the original exhibits require special handling*, e.g.,* they are large, bulky, valuable or breakable, the filing party should contact the Board for hand delivery and safe retrieval.

Every adverse party must be given a full opportunity to cross-examine the witness. If the notice of deposition served by a party is improper or inadequate with respect to the witness, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence.[61]

All objections made at the time of the taking of a testimony deposition as to the qualifications of the officer taking the deposition, the manner of taking the deposition, the evidence presented, the conduct of any party, or any other objection to the proceedings, are noted by the officer upon the deposition. Evidence objected to is taken subject to the objections.[62]

Questions to which an objection is made ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged or confidential.[63] *For information concerning the propounding party's recourse if a witness not only objects to, but also refuses to answer, a particular question, see* TBMP §§ 404.09 and 707.03(d) and authorities cited therein.

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[59] 37 CFR § 2.123(e)(2). *Cf. Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1838 n.4 (TTAB 1989) (decided prior to the rule change which eliminated "formal" introduction of exhibits).

[60] *See* Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

[61] 37 CFR § 2.123(e)(3). *For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, see* 37 CFR § 2.123(e)(3), and TBMP §§ 533.02 and 707.03(b)(2*).*

[62] 37 CFR § 2.123(e)(4). *See also* TBMP § 707.03 (Objections to Trial Testimony Depositions).

[63] *See* TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

For further information concerning the raising of objections to testimony depositions, see TBMP §§ 533 and 707.03 and authorities cited therein.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[64]

703.01(i) Form of Deposition

37 CFR § 2.123(g) Form of deposition. (1) *The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition may be written on legal-size or letter-size paper, with a wide margin on the left hand side of the page, and with the writing on one side only of the sheet. The questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used, and each question must be followed by its answer.*

(2) *Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.*

(3) *Each deposition must contain an index of the names of the witnesses, giving the pages where their examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.*

37 CFR § 2.125(d) *Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.*

A deposition must be submitted to the Board in written form. The Board does not accept videotape depositions.

The particular requirements for the form of a written deposition are specified in 37 CFR § 2.123(g).

Although 37 CFR § 2.123(g)(1) provides, inter alia, that a deposition may be written on either legal-size or letter-size paper, letter-size is recommended, because the case may ultimately be appealed to a Federal court which requires letter-size paper.

[64] 37 CFR § 2.123(b).

Exhibits must be marked as specified in 37 CFR § 2.123(g)(2). The Board, in its discretion, may refuse to enter and consider improperly marked exhibits.[65]

For information concerning deposition objections based on errors or irregularities in form, see TBMP § 707.03(c).

703.01(j) Signature of Deposition by Witness

37 CFR § 2.123(e)(5) *When the deposition has been transcribed, the deposition shall be carefully read over by the witness or by the officer to him, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.*

The signature of a deposition by the witness is governed by 37 CFR § 2.123(e)(5). The deposition does not have to be signed in the presence of the officer before whom the deposition was taken. It may be signed in the presence of any officer authorized to administer oaths.

Reading and signature cannot be waived by mere agreement of the witness; the agreement of every party is required.[66]

703.01(k) Certification and Filing of Deposition

37 CFR § 2.123(f) Certification and filing of deposition.
(1) *The officer shall annex to the deposition his certificate showing:*
(i) Due administration of the oath by the officer to the witness before the commencement of his deposition;
(ii) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his presence;
(iii) The presence or absence of the adverse party;
(iv) The place, day, and hour of commencing and taking the deposition;
(v) The fact that the officer was not disqualified as specified in Rule 28 of the

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[65] 37 CFR § 2.123(g)(2). *Cf. Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (these requirements are for the convenience of the Board; improperly marked exhibits considered); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (the Board has discretion to consider improperly marked exhibits); and G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

[66] *See* 37 CFR § 2.123(e)(5). *See alsoTampa Rico Inc. v. Puros Indios Cigars Inc.*, *supra* at 1383 (TTAB 2000) (where witness did not sign his deposition, the defect was curable and allowed time to file and serve a signed copy) and Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc.,* 63 USPQ2d 1782, 1787 (TTAB 2001) (depositions which were not signed and included no waiver were nevertheless considered where no objections were made).

Federal Rules of Civil Procedure.

(2) *If any of the foregoing requirements in paragraph (f)(1) are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing. The officer or the party taking the deposition, or its attorney or other authorized representative, shall then promptly forward the package to the address set out in § 1.1(a)(2)(i). If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted by the officer or the party taking the deposition, or its attorney or other authorized representative, in a separate package marked and addressed as provided in this section.*

37 CFR § 2.125 Filing and service of testimony.
(a) *One copy of the transcript of testimony taken in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

* * * *

(c) *One certified transcript and exhibits shall be filed with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.*

The certification and filing of a deposition are governed by 37 CFR § 2.123(f).[67] The certified transcript, with exhibits, should be sent to the Board at its mailing address, i.e., Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

[67] The Board interprets "promptly forward," in 37 CFR § 2.123(f)(2), as meaning forwarded at any time prior to the submission of the case for final decision. *See authorities cited in note 69 infra.*

The certified transcript and exhibits must be filed with the Board.[68] The Board will accept transcripts of testimony depositions at any time prior to the submission of the case for final decision.[69] In addition, a notice of reliance on the deposition transcript need not (and should not) be filed.[70] However, notice of the filing of the certified transcript, and accompanying exhibits, with the Board must be served on each adverse party. A copy of each such notice must also be filed with the Board.[71] In addition, one copy of the deposition transcript, together with copies, duplicates, or photographs of the exhibits thereto, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose.[72] *For information concerning the remedy that an adverse party may have if it is not timely served with a copy of the deposition and exhibits, see* TBMP § 703.01(m*).*

703.01(l) Testimony Deposition Must be Filed

37 CFR § 2.123(h) Depositions must be filed. *All depositions which are taken must be duly filed in the Patent and Trademark Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.*

All trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding.[73] If a party which took a testimony deposition refuses to file it,

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[68] *See* 37 CFR § 2.125(c).

[69] *See* Notice of Final Rulemaking, published in the *Federal Register* on September 9, 1998 at 63 FR 48081 and comments and responses published in the notice in regard to amendment of 37 CFR §§ 2.123(f) and 2.125(c). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (where the wording "promptly filed" in an earlier version of Rule 2.125(c) was construed as meaning filed at any time prior to final hearing).

[70] *See, for example, Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1898 n.2 (TTAB 1988) and *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.1 (TTAB 1982) (notice of reliance on exhibits introduced in connection with testimony superfluous).

[71] *See* 37 CFR § 2.125(c). *See also Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, n.4 (TTAB 2001) (testimony depositions are not filed by notice of reliance but instead are filed under cover of notice of filing which must also be served on each adverse party).

[72] *See* 37 CFR § 2.125(a).

[73] *See* 37 CFR § 2.123(h). *See also, for example, Order Sons of Italy in America v. Memphis Mafia, Inc.,* 52 USPQ2d 1364, 1366 n.4 (TTAB 1999); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, *supra* (opposer was not prejudiced by transcript of testimony deposition filed for first time with applicant's brief on the case because opposer should have assumed it would become part of the record); and *Anheuser-Busch, Inc. v. Major*

the Board, in its discretion, may refuse to further hear or consider the party, or may receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.[74]

703.01(m) Service of Deposition

37 CFR § 2.125 Filing and service of testimony.
(a) *One copy of the transcript of testimony taken in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

One copy of the transcript of trial testimony, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose.[75]

The requirement that a copy of the transcript, with exhibits, be served on every adverse party within the time specified in 37 CFR § 2.125(a) is intended to ensure that each adverse party will have the testimony before it has to offer its own evidence, or, if the testimony in question is rebuttal testimony, to ensure that each adverse party will have the testimony before it has to prepare its brief on the case.[76] If a copy of the transcript,

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Mud & Chemical Co., 221 USPQ 1191, 1192 n.7 (TTAB 1984). *Cf. An Evening at the Trotters, Inc. v. A Nite at the Races, Inc.*, 214 USPQ 737, 738 n.2 (TTAB 1982) (deposition which had not been filed but was not completed and was not referred to by either party was considered terminated and omitted by stipulation).

[74] 37 CFR § 2.123(h).

[75] 37 CFR § 2.125(a).

[76] *See Techex, Ltd. v. Dvorkovitz*, 220 USPQ 81, 82 n.2 (TTAB 1983) (opposer's objection to introduction of deposition overruled where opposer had been given time to request additional time for rebuttal in light of late-served copy of transcript but failed to do so), and *S. S. Kresge Co. v. J-Mart Industries, Inc.*, 178 USPQ 124, 125 n.3 (TTAB 1973) (applicant's objection in its brief to opposer's introduction of exhibits which were allegedly missing from service copy of deposition transcript, was untimely).

with exhibits, is not served on each adverse party within that time, any adverse party that was not served may have remedy by way of a motion to the Board to reset its testimony and/or briefing periods, as may be appropriate.[77]

If a party that took a deposition fails to serve a copy of the transcript, with exhibits, on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may take any of the actions mentioned in 37 CFR § 2.125(a).

703.01(n) Correction of Errors in Deposition

37 CFR § 2.125(b) *The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board. The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.*

A party that takes testimony is responsible for having any errors in the transcript corrected, on notice to each adverse party, prior to the filing of the certified transcript with the Board.[78]

If the witness, upon reading the transcript, discovers that typographical or transcription errors need to be made, or that other corrections are necessary to make the transcript an accurate record of what the witness actually said during the taking of his or her testimony, the witness should make a list of all such corrections and forward the list to the officer before whom the deposition was taken. The officer, in turn, should correct the transcript by redoing the involved pages. Alternatively, if there are not many corrections to be made, the witness may correct the transcript by writing each correction above the original text that it corrects, and initialing the correction. Although parties sometimes attempt to correct errors in transcripts by simply inserting a list of corrections at the end of the transcript, this is not an effective method of correction. The Board does not enter corrections for litigants, and the list of corrections is likely to be overlooked and/or disregarded. While corrections may be made in a transcript, to make the transcript an accurate record of what the witness said during the taking of his or her testimony,

[77] 37 CFR § 2.125(a), and *Techex, Ltd. v. Dvorkovitz, supra*.

[78] 37 CFR § 2.125(b), and *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (objection to corrections served four days after filing and less than two weeks prior to due date for reply brief overruled since remedy lies in requesting extension of briefing period rather than having Board exclude the evidence).

material changes in the text are not permitted--the transcript may not be altered to change the testimony of the witness after the fact.[79]

If corrections are necessary, the party that took the deposition must serve on every adverse party a copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.[80]

If errors are discovered after the transcript has been filed with the Board, a list of corrections, signed by the witness, should be submitted to the Board (and served on every adverse party), together with a request for leave to correct the errors. Alternatively, the parties may stipulate that specified corrections may be made. If the request is granted, or if the parties so stipulate, the party that took the deposition should send a representative to the offices of the Board to make the listed corrections by writing them above the original text in the transcript.[81]

703.01(o) Objections to Testimony Depositions

For information concerning objections to testimony depositions, see TBMP § 707.03. *See also* TBMP § 533.

703.01(p) Confidential or Trade Secret Material

37 CFR § 2.125(e) *Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(g).*

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[79] *See Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321, 1325 (TTAB 1992) (any substantive changes made to testimony deposition on written questions would not be considered); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 333 n.4 (TTAB 1985) (Board gave no consideration to response or corrected response when the correction, which changed the percentage of opposer's business income derived from licensing, was substantive); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.2 (TTAB 1982) (change in testimony from "...designing that type of game..." to "...designing that Simon Says type of game..." was substantive in nature and not permitted).

[80] *See* 37 CFR § 2.125(b). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, *supra*.

[81] *See* Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying.[82] Therefore, only the particular exhibits or deposition transcript pages that disclose confidential information should be filed under seal pursuant to a protective order. If a party submits a transcript or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.[83]

Confidential materials filed in the absence of a protective order are not regarded as confidential and are not kept confidential by the Board.[84] The mere stamping of "confidential" on documents does not operate in lieu of a protective order or agreement.

703.02 Testimony Depositions on Written Questions

703.02(a) Depositions on Written Questions: When Available

37 CFR § 2.123(a)*(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) Stipulations. *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By written agreement of*

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[82] *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000) and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

[83] *Cf.* 37 CFR § 2.120(f), and TBMP §§ 120.03 (Files of Terminated Proceedings), 412 (Protective Orders), 526 (Motion for a Protective Order), and 527.01 (Motion for Discovery Sanctions).

[84] *See Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file).

the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.

Ordinarily, the testimony of a witness may be taken either on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124.[85] *For information concerning depositions on oral examination, see* TBMP § 703.01.

However, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--see 37 CFR § 2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination.[86]

In addition, a testimony deposition taken in a foreign country must be taken by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.[87]

703.02(b) Depositions on Written Questions: Before Whom Taken.

37 CFR § 2.124(a) *A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.*

A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28. See 37 CFR § 2.124(a). *For further information, see* TBMP § 703.01(g).

703.02(c) Depositions on Written Questions: When Taken

37 CFR § 2.121 Assignment of times for taking testimony.
(a)(1) *The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times*

[85] 37 CFR § 2.123(a)(1).

[86] *See* 37 CFR § 2.123(a)(1), and TBMP § 703.01(b) (Form of Testimony) and cases cited therein.

[87] 37 CFR § 2.123(a)(2), and TBMP § 703.01(b) and cases cited therein.

assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.
...

37 CFR § 2.124(b)(1) *A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(d)(2) *... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.*

A party may take testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[88]

A party that desires to take a testimony deposition on written questions must serve notice thereof on each adverse party within 10 days from the opening date of the deposing party's testimony period, as originally set or as reset.[89]

On receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions on written questions.[90]

For information concerning the time for taking a discovery deposition, see TBMP § 404.01.

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[88] 37 CFR § 2.121(a)(1). *See* TBMP § 701 (Time of Trial) and authorities cited therein. *For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see* TBMP §§ 509 (Motions to Extend Time and Motion to Reopen Time) and 701.

[89] 37 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notice of testimony depositions on written questions, while served eight months after testimony period originally opened, were nonetheless timely having been served within 10 days of testimony period as last reset).

[90] 37 CFR § 2.124(d)(2). *See also Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) and *Marshall Field & Co. v. Mrs. Field's Cookies*, *supra*.

703.02(d) Depositions on Written Questions: Place of Deposition

A testimony deposition on written questions may be taken at any reasonable place.[91] An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing.

For information concerning the place where a discovery deposition upon written questions is taken, see TBMP §§ 404.03(b), 404.03(c), and 404.04.

703.02(e) Depositions on Written Questions: Notice of Deposition

37 CFR § 2.124(b)*(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

(d)*(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. ...*

To take a testimony deposition on written questions a party must serve notice thereof on each adverse party within 10 days from the opening date of its testimony period, as originally set or as reset.[92] The notice must state the name and address of the witness; it must be accompanied by the name or descriptive title of the officer before whom the

[91] *Cf.* 37 CFR § 2.123(c), and TBMP § 703.01(d) (Time and Place of Deposition). *Cf. also* 37 CFR § 2.123(b) *regarding stipulations as to place, manner and notice of depositions.*

[92] 37 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, *supra*. *See also*. 37 CFR § 2.123(b) *regarding stipulations as to place, manner and notice of depositions.*

deposition is to be taken, and by the written questions to be propounded on behalf of the deposing party.[93] A copy of the notice, but not of the questions, must be filed with the Board.[94]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[95]

For information concerning the notice of deposition in the case of a discovery deposition on written questions, see TBMP § 404.07(d).

703.02(f) Depositions on Written Questions: Securing Attendance of Unwilling Witness

For information concerning securing the attendance of an unwilling witness, see TBMP § 703.01(f) (for a testimony deposition) and 404.03 (for a discovery deposition).

703.02(g) Depositions on Written Questions: Examination of Witness

37 CFR § 2.124(b)*(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

(d)*(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross*

[93] 37 CFR §§ 2.124(b)(1), 2.124(c), and 2.124(d)(1).

[94] 37 CFR § 2.124(b)(1).

[95] 37 CFR § 2.123(b).

questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.

(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.*

A party which desires to take a testimony deposition on written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof on each adverse party.[96]

The notice must be accompanied by the written questions to be propounded on behalf of the deposing party.[97] A copy of the notice, but not of the questions, must be filed with the Board.[98]

Within 20 days from the date of service of the notice (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight

[96] 37 CFR § 2.124(b)(1). *See* TBMP § 703.02(e) (Notice of Deposition on Written Questions).

[97] 37 CFR §§ 2.124(b)(1), 2.124(c), and 2.124(d)(1).

[98] 37 CFR § 2.124(b)(1).

courier--see 37 CFR § 2.119(c)), any adverse party may serve cross questions on the deposing party. A party that serves cross questions on the deposing party must also serve copies of them on every other adverse party. Within 10 days from the date of service of the cross questions (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), any party that served cross questions may serve recross questions on the deposing party. A party that serves recross questions on the deposing party must also serve copies thereof on every other adverse party.[99]

Written objections to questions may be served on the party that propounded the questions. A party that serves objections on a propounding party must also serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). The substitute questions must also be served on every other adverse party.[100]

On motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 CFR § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions. Further, on receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions on written questions.[101]

Within 10 days after the last date when questions, objections, or substitute questions may be served, the deposing party must mail a copy of the notice and copies of all the questions to the officer designated in the notice. A copy of the notice and of all the questions mailed to the officer must also be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question.[102]

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[99] 37 CFR § 2.124(d)(1). *See Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

[100] 37 CFR § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990).

[101] 37 CFR § 2.124(d)(2). *See* TBMP § 703.02(c) (Deposition on Written Questions – When Taken) and cases cited therein.

[102] 37 CFR § 2.124(e).

An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner. When so taken, the deposition may be used like any other deposition.[103]

703.02(h) Depositions on Written Questions: Form, Signature and Certification of Deposition

37 CFR § 2.124(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.*

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question. [104]

For further information on the form for a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(g), and TBMP § 703.01(i).

For information concerning signature of a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(e)(5), and TBMP § 703.01(j).

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. *See* 37 CFR § 2.124(e). *For information concerning certification of a deposition taken in an inter partes proceeding before the Board, see* 37 CFR § 2.123(f), and TBMP § 703.01(k).

When the transcript has been certified, the officer should mail the transcript and exhibits to the party that took the deposition.[105]

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[103] *See* 37 CFR § 2.123(b).

[104] *See* 37 CFR § 2.124(e).

[105] *See* 37 CFR § 2.124(e).

703.02(i) Depositions on Written Questions: Service, Correction and Filing of Deposition

37 CFR § 2.124(f) *The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(j). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.*

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party.[106] The party that took the deposition must also assure that the transcript is correct.[107] *For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, see TBMP § 703.01(n).*

If the deposition is a testimony deposition, the original, with exhibits, must be filed promptly with the Board.[108] By "promptly" the Board means that the transcript, with exhibits, may be filed at any time prior to submission of the case for final decision.[109]

703.02(j) Testimony Depositions on Written Questions Must be Filed

While the offering of a discovery deposition in evidence is voluntary, all trial testimony depositions that are taken in a Board inter partes proceeding must be filed in the USPTO, and, when filed, automatically constitute part of the evidentiary record in the proceeding.[110]

See, with respect to making a discovery deposition of record, 37 CFR § 2.120(j) and TBMP § 704.09.

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[106] 37 CFR § 2.124(f). *See* TBMP § 703.01(m) (Service of Deposition).

[107] 37 CFR § 2.124(f) and 2.125(b).

[108] *See* 37 CFR § 2.124(f).

[109] *See* TBMP § 703.01(k) (Certification and Filing of Deposition).

[110] *See* 37 CFR § 2.123(h), and TBMP § 703.01(l) (Testimony Deposition Must be Filed).

703.02(k) Depositions on Written Questions: Objections to Deposition

37 CFR § 2.124(d)(1) *... Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.*

* * * *

(g) *Objections to questions and answers in depositions upon written questions may be considered at final hearing.*

Written objections to questions propounded for a deposition on written questions may be served on the party that propounded the questions. Any party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party.[111]

Unless waived, objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board at final hearing.[112]

For further information concerning the raising of objections to trial testimony depositions, see TBMP §§ 707.03 and 533.

For information concerning the raising of objections to discovery depositions, see TBMP § 404.08. *For information concerning the raising of objections to a notice of reliance on a discovery deposition,* see TBMP §§ 707.02 and 532.

703.02(l) Depositions on Written Questions: Confidential or Trade Secret Material

For information concerning the protection of confidential or trade secret material forming part of a deposition transcript or exhibits thereto, see 37 CFR § 2.125(e), and TBMP § 703.01(p).

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[111] 37 CFR § 2.124(d)(1). *See* TBMP § 703.02(g) (Deposition on Written Questions – Examination of Witness).

[112] 37 CFR § 2.124(g). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections to questions based on relevancy and materiality will be deferred until final hearing).

703.02(m) Depositions on Written Questions: Utility

A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. Moreover, it deprives an adverse party of the right to confront the witness and ask follow-up questions on cross examination.[113]

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country.[114] Moreover, the deposition on written questions is generally less expensive than the deposition on oral examination and is usually more convenient for the witness. Thus, even for a deposition to be taken in the United States, a deposing party may prefer to use the deposition on written questions, particularly in those cases where the testimony will be short, simple, straight-forward, and not likely to be disputed, such as to establish for the record examples of third-party usage.[115]

704 Introducing Other Evidence

704.01 In General

As noted earlier in this chapter (*see* TBMP § 702) evidence in an inter partes proceeding before the Board can be introduced in a number of ways. The first part of this chapter discussed the introduction of evidence in the form of testimony depositions with accompanying exhibits. The following sections discuss other forms of evidence and the methods available for their introduction.

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[113] *See* 37 CFR § 2.124(d)(1); TBMP § 703.02(g) (Deposition on Written Questions – Examination of Witness); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985). *See also Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989) (motion to take discovery deposition in foreign country orally)

[114] *See* 37 CFR §§ 2.120(c)(1) and 2.123(a)(2), and TBMP §§ 404.03(c) (discovery deposition of nonparty residing in foreign country), 703.01(b) (Form of Testimony), and 703.02(a) (Depositions on Written Questions – When Available).

[115] *Cf. Feed Flavors Inc. v. Kemin Industries, Inc.*, *supra*.

704.02 Notice of Reliance – Generally

Certain types of evidence, such as official records and printed publications as described in 37 CFR § 2.122(e), need not be introduced in connection with the testimony of a witness but may instead be made of record by filing the materials with the Board under cover of one or more notices of reliance during the testimony period of the offering party. A notice of reliance is essentially a cover sheet for the materials sought to be introduced. This cover sheet is entitled "notice of reliance" and it serves, as the title suggests, to notify opposing parties that the offering party intends to rely on the materials submitted thereunder in support of its case. The notice of reliance must include a description of the proffered materials and, in some instances, must indicate the relevance of those materials to the case. A discussion of the types of evidence that may be submitted by notice of reliance and the requirements for introduction of such evidence by notice of reliance can be found in the sections that follow.

704.03 Applications and Registrations

704.03(a) Subject of Proceeding

37 CFR 2.122(b) Application files. (1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.*

The file of an application or registration that is the subject of a Board inter partes proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose.[116]

[116] 37 CFR § 2.122(b)(1). *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984); *Cleveland-Detroit Corp. v. Comco (Machinery) Ltd.*, 277 F.2d 958, 125 USPQ 586, 586-87 (CCPA 1960) (application file automatically forms part of record on appeal); *Uncle Ben's Inc. v. Studenberg International Inc.*, 47 USPQ2d 1310, 1311 n.2 (TTAB 1998) (notice of reliance on application file not necessary as it is automatically of record); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB

However, the fact that the subject application or registration file is automatically part of the record in a proceeding does not mean that the allegations made, and the specimens, documents, exhibits, etc., filed therein are evidence on behalf of the applicant or registrant in the inter partes proceeding. Allegations must be established by competent evidence properly adduced at trial. The specimens, documents, exhibits, etc., in an application or registration file are not properly adduced evidence in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period.[117]

For further information concerning the probative value of applications and registrations, see TBMP § 704.01(b).

704.03(b) Not Subject of Proceeding – In General

The file of a particular application or registration that is not the subject of a proceeding may be made of record either in connection with testimony or by notice of reliance as described below.

704.03(b)(1) Registration Not Subject of Proceeding

704.03(b)(1)(A) Registration Owned by Party

37 CFR § 2.122(d) Registrations. *(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office

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1990) (submission of portions of application unnecessary since file is automatically of record), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

[117] *See* 37 CFR § 2.122(b)(2). *See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, *supra* at 1283 (evidence in application file considered by court, but little weight given to applicant's statements before examining attorney); *Kellogg Co. v. Pack'Em Enterprises Inc, supra*; and TBMP § 704.04 (Statements and Things in Application or Registration).

showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party that wishes to rely on its ownership of a Federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it.[118] This may be done in a number of different ways.

A Federal registration *owned by the plaintiff* in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by two copies of the registration prepared and issued by the USPTO showing both the current status of and current title to the registration.[119]

A Federal registration *owned by any party* to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by a copy of the registration prepared and issued by the USPTO showing both the current status of and current title to the registration.[120]

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[118] *See Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978) (plain copies of registrations introduced through testimony which established ownership of the registrations but failed to establish that they were currently subsisting were not considered); *Maybelline Co. v. Matney,* 194 USPQ 438, 440 (TTAB 1977) (pleaded registration was not considered of record where testimony introduced original certificate of registration into evidence but failed to establish current status and title); and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (mere fact that copies show that registration originally issued to opposer does not establish that title still resides in opposer).

[119] *See* 37 CFR § 2.122(d)(1). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (not of record where opposer's copies of registrations submitted with notice of opposition did not show current status or title); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration did not contain status and title information); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate insufficient to show status of registration); and *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979). *For additional case cites, see Appendix of Cases.*

[120] *See* 37 CFR § 2.122(d)(2). *See also Hewlett-Packard Co. v. Olympus Corp.*, *supra; Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (untimely notice of reliance on status and title copy of registration filed after close of testimony period); and *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.3 (TTAB 1986). *For additional case cites, see Appendix of Cases*.

A party's submission, with a notice of reliance on its registration, of an *order* for status and title copies of the registration is not sufficient to make the registration of record. Although that procedure was once permitted, it is no longer allowed.[121] The status and title copies themselves must accompany the notice of reliance.[122] However, the status and title copies need not be certified.[123] Additionally, a party need not submit the original status and title copy; a photocopy is sufficient.[124]

The registration copies "prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by 37 CFR § 2.122(d), are printed copies of the registration on which the USPTO has entered the information it has in its records, at the time it prepares and issues the status and title copies, about the current status and title of the registration. That information includes information about the renewal, cancellation, publication under Section 12(c) of the Act, 15 U.S.C. § 1062(c); affidavits or declarations under Sections 8 and 15 of the Act, 15 U.S.C. §§ 1058 and 1065; and recorded documents transferring title.[125] Plain copies of the registration, and the electronic equivalent thereof, such as printouts of the registration from the electronic records of the USPTO's trademark automated search system, are not sufficient.[126]

Although the status and title copies need not be certified (s*ee* 37 CFR § 2.122(e)), at present all status and title copies prepared and issued by the

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[121] *See* 37 CFR §2.122(d); Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the Patent and Trademark Office *Official Gazette* of June 21, 1983 at 1031 TMOG 13; and *In re Inter-State Oil Co.*, 219 USPQ 1229 (TTAB 1983).

[122] *See Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1461 n.4 (TTAB 1992).

[123] *See* 37 CFR § 2.122(e).

[124] *See* 37 CFR 2.122(d).

[125] *See Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate not sufficient), and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (constitutes prima facie showing of status and title).

[126] *See, for example, Hewlett-Packard Co. v. Olympus Corp.*, *supra* and *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration without status and title information insufficient to establish prima facie showing).

USPTO are certified.[127] For the cost of a copy of a registration showing status and title, *see* 37 CFR § 2.6(b)(4).

The issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. Status and title copies filed under a notice of reliance during the offering party's testimony period must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter.[128] The fact that there have been no changes in the status and title of a party's registration since the date of its issuance does not mean that a plain photocopy thereof may be used by the party as a substitute for the status and title copy.[129]

When it comes to the attention of the Board that there has been a USPTO error in the preparation of a registration status and title copy made of record in an inter partes proceeding, that is, that the status and title copy does not accurately reflect the status and title information which the USPTO has in its records, the Board will take judicial notice of the correct facts as shown by the records of the USPTO.[130] Further, when a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and the status of the registration changes between the

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[127] *See Industrial Adhesive Co. v. Borden, Inc.*, *supra* at 947 (copies do not have to be certified but must contain status and title information).

[128] *See Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, *supra*; *Jean Patou Inc. v.Theon Inc., supra* at 1075 (whether notice of reliance on status and title copy of registration prepared four years earlier is sufficiently recent goes to the competency, not the admissibility, of the registration); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (status and title copies from 1963 not reasonably contemporaneous with filing of opposition in 1986); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) (prepared two months prior to filing of opposition is reasonably contemporaneous); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); and *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976).

[129] *See*, *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 949 (TTAB 1983) (it is not sufficient that status and title copies might have shown the same facts indicated by a photocopy of an original registration which had recently issued or even if time for filing Sections 8 and 15 affidavits had not yet occurred since ownership could have changed or other events affecting ownership may have occurred); *Acme Boot Co. v. Tony and Susuan Alamo Foundation Inc.*, 213 USPQ 591, 592 (TTAB 1980); *Maybelline Co. v. Matney,* 194 USPQ 438 (TTAB 1977); and *Marriott Corp. v. Pappy's Enterprises, Inc.*, *supra.*

[130] *See Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846, 847 n.5 (TTAB 1978) (USPTO error in identification of owner).

time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the USPTO.[131]

A Federal registration *owned by any party* to a Board inter partes proceeding may be made of record by that party by appropriate identification and introduction during the taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the current status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party.[132]

A Federal registration *owned by a plaintiff* (including a counterclaimant) will be deemed by the Board to be of record in an inter partes proceeding if the defendant's answer to the complaint contains admissions sufficient for the purpose.[133]

Similarly, a registration *owned by any party* to the proceeding may be deemed by the Board to be of record in the proceeding, even though the registration was not properly introduced in accordance with the applicable

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[131] *See Time Warner Entertainment Company v. Jones.* 65 USPQ2d 1650 (TTAB 2002) (review of Office automated records subsequent to filing of status and title copy of registration revealed that Section 8 and 15 affidavits had been accepted and acknowledged); *Ultratan Suntanning Centers Inc. v. Ultra Tan International AB*, 49 USPQ2d 1313, 1314, n.6 (TTAB 1998) (same): *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB 1979) (status and title copy need not be updated after it is submitted; judicial notice of filing of Sections 8 and 15 affidavits); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846 (TTAB 1978); and *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 80 n.3 (TTAB 1979).

[132] *See* 37 CFR § 2.122(d)(2); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985) (no probative value where testimony established opposer's ownership of registration, but not current status); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (identification by witness as having come from opposer's files insufficient to establish ownership and status); and *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980). *For additional case cites, see Appendix of Cases.*

[133] *See Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) (Board erred in refusing to consider registrations of record when applicant admitted "the registrations referred to in the notice of opposition" in its answer); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (applicant effectively admitted active status and ownership of certain specifically identified registrations); *Hewlett-Packard Co. v. Olympus Corp.*, *supra* (admission only of ownership and not validity was not sufficient); and *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (not of record where although applicant admitted that copies attached to opposition were "true copies" applicant did not admit to status and title of those registrations).

rules, if the adverse party in its brief, or otherwise, treats the registration as being of record.[134]

Finally, a registration *owned by any party* to the proceeding may be made of record in the proceeding by stipulation of the parties.[135]

When a subsisting registration on the Principal Register has been properly made of record by its owner in a Board inter partes proceeding, the certificate of registration is entitled to certain statutory evidentiary presumptions.[136]

In contrast, a subsisting registration on the *Supplemental Register*, even when properly made of record by its owner, is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued.[137]

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[134] *See Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) (after filing its answer, respondent filed a "paper" in which respondent admitted existence of petitioner's registration; admission was sufficient to overcome respondent's Rule 2.132 motion for default judgment); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1157 (TTAB 1990) (applicant conceded ownership and validity in trial brief); *Floralife, Inc. v. Floraline International Inc.,* 225 USPQ 683, 684 n.6 (TTAB 1984) (applicant's treatment of pleaded registrations as properly of record in its trial brief was deemed a stipulation as to current status and title); and *Industrial Adhesive Co. v. Borden, Inc.,* 218 USPQ 945, 948 (TTAB 1983) (admission in brief). *See also Jockey International, Inc. v. Frantti*, 196 USPQ 705 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976).

[135] *See* 37 CFR § 2.123(b); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979).

[136] *See, for example*, Section 7(b) of the Act, 15 U.S.C. § 1057(b); *CTS Corp. v. Cronstoms Manufacturing, Inc.*, 515 F.2d 780, 185 USPQ 773, 774 (CCPA 1975) (prima facie evidence of registrant's right to use the mark on the identified goods); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 274 (CCPA 1974) (prima facie evidence of validity of registration, ownership of mark and exclusive right to use it); and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (prima facie evidence of registrant's continuous use of the mark). *See also* Section 7(c) of the Act, 15 U.S.C. § 1057(c) (conferring, contingent on the registration of a mark on the Principal Register, and subject to certain specified exceptions, constructive use priority dating from the filing of the application for registration of the mark); *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216, 1217 n5 (TTAB 1992) (opposer's constructive use date on ITU application was subsequent to applicant's); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991) (constructive use dates intended to give ITU applicants superior rights to others who adopt the mark after filing date). *For additional case cites, see Appendix of Cases.*

[137] *See McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966) (registration on Supplemental Register is not evidence of constructive notice of ownership nor evidence of exclusive right to use); *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978). *For additional case cites, see Appendix of Cases.*

Expired or Cancelled Registrations. Although an expired or cancelled registration may be made of record by any of the methods described above, such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used.[138]

State Registrations. A state registration owned by a party to a Board inter partes proceeding may be made of record therein by notice of reliance under 37 CFR § 2.122(e), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.[139] However, a state registration (whether owned by a party, or not) is incompetent to establish that the mark shown therein has ever been used, or that the mark is entitled to Federal registration.[140]

Foreign Registrations. A foreign registration owned by a party to a Board inter partes proceeding may be made of record in the same manner as a state registration, but a foreign registration is not evidence of the use, registrability, or ownership of the subject mark in the United States.[141]

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[138] *See Action Temporary Services inc. v. Labor Force Inc*., 10 USPQ2d 1307 (Fed. Cir. 1989) (does not provide constructive notice of anything); *Time Warner Entertainment Company v. Jones,* 65 USPQ2d 1650, 1653 n.6 (TTAB 2002) (status and title copy of expired registration); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746-47 (TTAB 1987) (parties stipulated to introduction of photocopy of expired registration having no probative value other than that it issued); *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 818 n.7 (TTAB 1986) (expired "Act of 1920" registration had no probative value); *Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc.*, 191 USPQ 292, 294 (TTAB 1976) (lapsed registration of affiliated company is not evidence of use of mark at any time); and *Bonomo Culture Institute, Inc. v. Mini-Gym, Inc.*, 188 USPQ 415, 416 (TTAB 1975) (expired registration is incompetent evidence of any existing rights in mark). *For additional case cites, see Appendix of Cases.*

[139] *See* TBMP § 704.05 (Official Records).

[140] *See, for example, Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976) (state registrations do not establish use); *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981) (although parties stipulated to introduction of state registration, said registration is incompetent to prove anything material to opposition proceeding); *Plak-Shack, Inc. v. Continental Studios of Georgia, Inc.*, 204 USPQ 242, 246 (TTAB 1979) (incompetent as evidence of use of a mark); and *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 352 (TTAB 1978) (incompetent evidence to establish use of the mark), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982). *For additional case cite, see Appendix of Cases.*

Cf., with respect to ex parte appeals, In re Anania Associates, Inc., 223 USPQ 740, 742 (TTAB 1984) (argument that applicant's state registration for the mark must be taken as prima facie evidence of distinctiveness rejected); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984); and *In re Illinois Bronze Powder & Paint Co.*, 188 USPQ 459 (TTAB 1975).

[141] *See Societe Anonyme Marne et Champagne v. Myers*, 250 F.2d 374, 116 USPQ 153, 156 (CCPA 1957); and *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610, 1618 (TTAB 1988). *See also Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Barash Co. v. Vitafoam*

Making the file history of the registration of record. If a party owns a registration which is not the subject of the proceeding and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, it may do so by 1) filing, during its testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e) (see TBMP § 704.05); or 2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or 3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof.

The file history of a registration owned by another party, but not the subject of the proceeding, may be made of record in the same manner.[142] Copies of official records of the Patent and Trademark Office need not be certified.[143]

704.03(b)(1)(B) Third-Party Registration

37 CFR § 2.122(e) Printed publications and official records. *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

Ltd., 155 USPQ 267 (TTAB 1967), *aff'd*, 427 F.2d 810, 166 USPQ 88 (CCPA 1970). *Cf. In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967).

[142] *See Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of petitioner's registration not of record where respondent noticed it but failed to file a copy of it).

[143] *See* 37 CFR § 2.122(e).

A party to an inter partes proceeding before the Board may introduce as part of its evidence in the case, a registration owned by a party not involved in the proceeding.[144]

A party that wishes to make such a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration together with a notice of reliance thereon specifying the registration and indicating generally its relevance.[145]

A party to a Board inter partes proceeding may also make a third-party registration of record by introducing a copy of it as an exhibit to testimony, or by stipulation of the parties.

It is not necessary that the copy of the third-party registration submitted with a notice of reliance (or with testimony or a stipulation) be certified, nor need it be a current status and title copy prepared by the USPTO; a plain copy (or legible photocopy) of the registration itself, or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the USPTO's trademark automated search system is all that is required.[146]

As stated in TBMP § 704.01(b)(1) above, a current status and title copy of a registration prepared by the USPTO (or other appropriate proof of current status and title) is necessary when the owner of a registration on the Principal Register seeks to make the registration of record for the

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[144] *See* J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297 (1982).

[145] *See* 37 CFR § 2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (printouts of third-party registrations obtained from private search reports are neither printed publications nor official records); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 309 n.5 (TTAB 1976) (reference to third-party registrations in answer, without filing copies with a notice of reliance, was insufficient to make them of record); and J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982).

[146] *See* 37 CFR § 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete excerpts of registrations from TRAM system was insufficient); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); and *Weyerhaeuser Co. v. Katz*, *supra*. *See also Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977); J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977).

purpose of relying on the presumptions accorded to a certificate of registration pursuant to Section 7(b) of the Act, 15 U.S.C. §1057(b). However, the Section 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner, or when the registration is cited by a Trademark Examining Attorney (in an ex parte case) as a reference under Section 2(d) of the Act, 15 U.S.C. § 1052(d), against a mark sought to be registered.[147]

Thus, when third-party registrations are made of record, the party offering them may not rely on the Section 7(b) presumptions; normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose.[148]

On the other hand, a party may *not* make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned; or by filing a printout, from a private company's data base, of information about the registration; or by filing a notice of reliance together with a reproduction of the mark as it appeared in the *Official Gazette* for purposes of publication; or by referring to the registration in its brief or pleading. The Board does not take judicial notice of registrations in the USPTO.[149]

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[147] *See* Section 7(b) of the Act, 15 U.S.C. § 1057(b); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1144 (TTAB 1986) (wholly owned subsidiary of owner of registrations may not rely on registrations to prove priority); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (claim that mark in cited registration is not in use is an impermissible collateral attack on the validity of the registration in an ex parte proceeding); *In re H & H Products*, 228 USPQ 771, 773 (TTAB 1986) (entitled to presumption that marks have overcome any inherent nondistinctiveness); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701, 702 (TTAB 1979) (opposer could not rely on 7(b) presumptions where registration is owned by its parent company); *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473, 475-76 (TTAB 1972) (although petitioner can rely on its wholly owned subsidiary's use of a mark, petitioner cannot rely on the registrations owned by its wholly owned subsidiary for statutory presumptions); and *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394, 395 (TTAB 1968) (opposer cannot rely on registrations owned by its parent or its parent's subsidiaries).

[148] *See Hiram Walker & Sons, Inc. v. Milstone*, 130 USPQ 274, 276 (TTAB 1961) and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977).

[149] *See, for example, In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (listings from commercial trademark search reports); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (search report from private company's database); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1885 (TTAB 1993) (trademark search report wherein registrations are mentioned); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (trademark search reports from private companies are neither printed publications nor official records); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990) (search report), *aff'd*, 951

Even when a third-party Federal registration has been properly made of record, its probative value is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in the registration.[150] Nevertheless, third-party registrations may be entitled to some weight to show the meaning of a mark, or a portion of a mark, in the same manner as a dictionary definition.[151]

F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 532 (TTAB 1986) (reference to third-party registrations in a brief)*;* and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977). *For additional case cites, see Appendix of Cases.*

Cf. TBMP § 528.05(d) (for purposes of responding to a summary judgment motion only, a copy of a trademark search report may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation).

[150] *See AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (not evidence of what happens in the market place or consumer familiarity); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (not evidence of use or that consumers have been exposed to them); and *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988) (not evidence of use to show public awareness of the marks).

See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (may not be given any weight in determining strength of a mark); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 n.12 (CCPA 1977) (little evidentiary value in determining scope of protection); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (little weight on likelihood of confusion); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975) (little weight on question of likelihood of confusion); *Spice Islands, Inc. v. Frank Tea and Spice Co.*, 505 F.2d 1293, 184 USPQ 35, 38 (CCPA 1974) (do not control determination of whether marks are so similar that they are likely to cause confusion); and *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983) (third-party registration only establishes what appears on its face, that application was made claiming adoption and use and that registration was granted), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). *See, in addition,* J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982).

Cf. In re Alpha Analytics Investment Group LLC, 62 USPQ2d 1852, 1856 (TTAB 2002) (registrations under Section 2(f) or on the Supplemental Register, although not conclusive evidence, may be probative evidence of mere descriptiveness). *Cf. also In re Mucky Duck Mustard Co., Inc.,* 6 USPQ2d 1467 (TTAB 1988) (third-party registrations may have some probative value to the extent that they may serve to suggest that goods or services are of a type which may emanate from the same source).

[151] *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) and *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975). *See also Sports Authority Michigan Inc. v. PC Authority Inc., supra* at 1798 (that a term is adopted to convey a particular suggestive meaning); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992) (to show the sense in which the term is employed in the marketplace); *United Foods Inc. v. J.R. Simplot Co.,* 4 USPQ2d 1172, 1174 (TTAB 1987) (to show ordinary usage of a term and descriptive or suggestive significance); and *Bottega Veneta, Inc. v. Volume Shoe Corp.,* 226 USPQ 964, 968 (TTAB 1985) (to show geographic significance of terms).

A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board.[152]

Making file history of third-party registration of record. The file history of a third-party registration (rather than just the certificate of registration), or a portion thereof, may be made of record by 1) filing, during the offering party's testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e) (*see* TBMP § 704.05); or 2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or 3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof.

It is not necessary that the copy of the registration file, or portions thereof, be certified.[153] However, third-party registration histories are of very limited probative value.[154]

704.03(b)(2) Application Not Subject of Proceeding

37 CFR § 2.122(e) Printed publications and official records. *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be*

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[152] *See Allstate Insurance Co. v. DeLibro*, 6 USPQ2d 1220, 1223 (TTAB 1988) (third-party state registrations "are of absolutely no probative value" on the question of likelihood of confusion), and TBMP § 704.01(b)(1)(A) (Registration Owned by Party) and cases cited therein.

[153] *See* 37 CFR § 2.122(e).

[154] *See Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that hey have made an impression on the public).

offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party to a proceeding before the Board may introduce, as part of its evidence in the case, a copy of an application that is not the subject of the proceeding, by filing, during its testimony period, a copy of the application file, or of the portions which it wishes to introduce, together with a notice of reliance thereon specifying the application and indicating generally its relevance.[155] It is not necessary that the copy of the application, or portions thereof, filed under a notice of reliance be certified.[156]

An application that is not the subject of the proceeding may also be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.

An application made of record in a Board inter partes proceeding, whether owned by a party or not, is generally of very limited probative value.[157] However, if the application is owned by a party to the proceeding, the allegations made and documents and things filed in the application may be used as evidence against the applicant, that is, as admissions against interest and the like.[158]

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[155] *See* 37 CFR § 2.122(e); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231 (TTAB 1992) (copy of drawing from abandoned application); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (copies of third-party applications); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778, 780 n.4 (TTAB 1977) (file history of petitioner's application).

[156] *See* 37 CFR § 2.122(e).

[157] *See Glamorene Products Corp. v. Earl Grissmer Co.*, *supra* at 1092 n.5 (evidence only of the filing of the application); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979) (claim of ownership of a registration in an application is not competent evidence of ownership of the registration); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978) (petitioner's application file is proof only of filing, not of any facts alleged in the application); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778 (TTAB 1977) (incompetent to prove use). *See also Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that hey have made an impression on the public); *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449 (TTAB 1976); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); and TBMP § 704.04 (Statements and Things in Application or Registration).

[158] *See* TBMP § 704.04 (Statements and Things in Application or Registration) and cases cited therein.

704.04 Statements and Things in Application or Registration

37 CFR § 2.122(b) Application files. (1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.*

While the file of a particular application or registration may be of record in a Board inter partes proceeding, by operation of 37 CFR § 2.122(b) (*see* TBMP § 704.01(a)) or otherwise (*see* TBMP § 704.01(b)) the allegations made, and documents and other things filed, in the application or registration are not evidence in the proceeding on behalf of the applicant or registrant.[159] Allegations must be established by competent evidence, properly adduced at trial, and the documents and other things in an application or registration file are not evidence, in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period.[160] This is because the adverse

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[159] *See, for example, Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1467 (TTAB 1993) (in the absence of proof of use, the filing date of the application, rather than the dates of use alleged in the application, is treated as the earliest use date on which applicant may rely); *Allied Mills, Inc. v. Kal Kan Foods, Inc., supra* at 396 n.10 (an application is not evidence of anything on behalf of applicant except that it was filed); and *Omega SA v. Compucorp,* 229 USPQ 191, 195 (TTAB 1985) (allegations and documents in application file not evidence unless and to the extent they have been identified and introduced in evidence during testimony).

[160] *See* 37 CFR § 2.122(b); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993) (exhibits, affidavits and market survey which had been submitted by applicant in connection with the prosecution of its application are not evidence in subsequent opposition proceeding to establish acquired distinctiveness unless properly introduced), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.4 (TTAB 1989) (notice of reliance referring to declaration signed by applicant in applying for registration); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.7 (TTAB 1986) (claim of ownership of registration in application does not make registration of record); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985) (statements and materials in registration file bearing on respondent's dates of use not evidence on behalf of respondent unless properly introduced); *Sunbeam Corp. v. Battle Creek Equipment Co.,* 216 USPQ 1101, 1102 n.3 (TTAB 1982) (applicant's claim of distinctiveness in its application is an admission by applicant that term is descriptive but 2(f) affidavit in application not admissible evidence of the truth of statements therein in inter partes proceeding); *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in application not evidence on

party has a right to confront and cross-examine the person making the allegations, and to question the authenticity of the specimens, documents, exhibits, etc.[161] Thus, for example, the allegation in an application or registration of a date of use is not evidence on behalf of the applicant or registrant in an inter partes proceeding; to be relied on by the applicant or registrant, a claimed date of use of a mark must be established by competent evidence.[162] Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used.[163] The specimens in the file of an application or registration are not evidence on behalf of the applicant or registrant, in an inter partes proceeding, unless they are identified and introduced in evidence as exhibits during the testimony period.[164] Affidavits or declarations in an application or registration file cannot be relied on by the applicant or registrant, in an inter partes proceeding, as evidence of the truth of the statements contained therein; the statements must be established by competent evidence at trial.[165] Similarly,

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behalf of respondent); *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470, 474 n.3 (TTAB 1978) (claim of ownership of registration in application does not make registration of record); *Dap, Inc. v. Century Industries Corp.*, 183 USPQ 122, 123 (TTAB 1974) (applicant cannot rely on specimens filed with application to delineate nature and use of its goods); *Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315, 316 n.2 (TTAB 1973) (applicant cannot rely on dates of use alleged in application); *ILC Products Co. v. ILC, Inc.*, 175 USPQ 722, 723 n.3 (TTAB 1972); and *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473, 476 (TTAB 1972) (self-serving statements made during prosecution of application are not admissible in cancellation proceeding). *See also W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273 (TTAB 1962).

[161] *See ILC Products Co. v. ILC, Inc.*, *supra* and *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, *supra*. *See also W.T. Grant Co. v. Grant Avenue Fashions, Inc.*, *supra*.

[162] *See* 37 CFR § 2.122(b)(2). *See also Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1467 (TTAB 1993); *Omega SA v. Compucorp*, 229 USPQ 191, 193 n.10 (TTAB 1985) (applicant may rely on presumption that its mark was in use as of filing date of application in absence of any proof of earlier use); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985); *and Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315 (TTAB 1973).

[163] *See* 37 CFR § 2.122(b)(2), and *Alpha Industries, Inc. v. Alpha Microsystems*, 223 USPQ 96, 96 (TTAB 1984) (Board will not take judicial notice of statements made in third-party applications regarding use). *See also, for example, Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (registrations owned by opposer's parent corporation are third-party registrations and opposer cannot rely on those registrations to prove priority); *Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc.*, 224 USPQ 512, 514 (TTAB 1984); and.*Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that hey have made an impression on the public).

[164] *See* 37 CFR § 2.122(b)(2); *Mason Engineering & Design Corp. v. Mateson Chemical Corp*., 225 USPQ 956, 961 n.11 (TTAB 1985); and *Eikonix Corp. v. CGR Medical Corp*., 209 USPQ 607, 613 n.7 (TTAB 1981). *See also Dap, Inc. v. Century Industries Corp.,* 183 USPQ 122 (TTAB 1974).

[165] *See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993) (2(f) affidavits submitted during prosecution of application), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.4 (TTAB 1989) (declaration in support

statements made by counsel, and exhibits filed, in an application or registration do not constitute admissible evidence in the applicant's or registrant's behalf in an inter partes proceeding; the statements must be established by competent evidence, and the exhibits must be properly identified and introduced in evidence, at trial.[166] Further, the fact that the file of an application or registration which is the subject of a Board inter partes proceeding is automatically of record in that proceeding, does not mean that a registration claimed by applicant or registrant in the application or registration is also automatically of record.[167]

Although the allegations made and documents and things filed in an application or registration are not evidence, in a Board inter partes proceeding, on *behalf* of the applicant or registrant (unless they are properly proved at trial), they may be used as evidence *against* the applicant or registrant, that is, as admissions against interest and the like.[168]

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of application), and *Sunbeam Corp. v. Battle Creek Equipment Co.,* 216 USPQ 1101, 1102 n.3 (TTAB 1982) (2(f) affidavit in application).

[166] *See British Seagull Ltd. v. Brunswick Corp., supra* (exhibits and market surveys to show acquired distinctiveness during prosecution were not competent evidence in subsequent opposition proceeding); *W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273, 275 (TTAB 1962) (explanation of applicant's operations by applicant's counsel during ex parte prosecution was not admissible evidence in subsequent opposition).

[167] *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 530 F.2d 1396, 189 USPQ 138, 140 (CCPA 1976); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n. 7 (TTAB 1986); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470, 474 n.3 (TTAB 1978).

[168] *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n.5 and n.11 (TTAB 1985) (date of first use asserted by opposer in its application may be considered as admission against interest; in evaluating "Morehouse" type defense, Board relied on specimens and other materials in applicant's application as evidence of the nature of applicant's services to find that those services were not "substantially identical" to the goods in applicant's subsisting registration): *Sunbeam Corp. v. Battle Creek Equipment Co.,* 216 USPQ 1101, 1102 n.3 (TTAB 1982) (applicant's claim of distinctiveness in its application is an admission by applicant that term is descriptive but 2(f) affidavit in application not admissible evidence of the truth of statements therein in inter partes proceeding);and *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in respondent's registration may be used as admission against interest of relationship between respondent's and petitioner's goods).

See also, for example, Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (applicant which seeks to prove date of first use earlier than that stated in its application must do so by heavier burden of clear and convincing evidence, rather than a preponderance of the evidence, because of the change of position from one "considered to have been made against interest at the time of filing of the application"); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) (applicant's earlier contrary position before the Examining Attorney as to the meaning of its mark as demonstrated by statements in the application illustrating the variety of meanings that may be attributed to, and commercial impression projected by, applicant's mark, may be relevant); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (fact that party took position in its application inconsistent with its position in inter partes proceeding may be considered as evidence "illuminative of shade and tone in the total picture confronting the decision maker"); *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (in application for mark in typed form, specimens in application may be used to illustrate one form in

704.05 Exhibits to Pleadings or Briefs

704.05(a) Exhibits to Pleadings

37 CFR § 2.122(c) Exhibits to pleadings. *Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.*

37 CFR § 2.122(d) Registrations. *(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

With one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits.[169]

The one exception is a current status and title copy, prepared by the USPTO, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff.[170]

704.05(b) Exhibits to Briefs

Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.[171]

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which mark may actually be used in order to show similarity with opposer's mark); and *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 798 (TTAB 1986) (fact that opposer took position in its application regarding descriptiveness of term inconsistent with its position in inter partes proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

[169] 37 CFR § 2.122(c) and TBMP § 317 (Exhibits to Pleadings) and cases cited therein.

[170] *See* 37 CFR §§ 2.122(c) and (d)(1), and TBMP § 704.01(b)(1)(A) (Registration Owned by Party).

[171] *See, for example, Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.5 (TTAB 1986) (third-party registrations attached to brief not considered); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of Canadian Opposition Board decision attached to brief not considered); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983) *; Plus Products v. Physicians Formula Cosmetics,*

If, after the close of the time for taking testimony, a party discovers new evidence that it wishes to introduce in its behalf, the party may file a motion to reopen its testimony period. However, the moving party must show not only that the proposed evidence has been newly discovered, but also that it could not have been discovered earlier through the exercise of reasonable diligence.[172]

704.06 Statements in Pleadings or Briefs

704.06(a) Statements in Pleadings

Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony.[173]

However, statements in pleadings may have evidentiary value as admissions against interest by the party that made them.[174]

704.06(b) Statements in Briefs

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief

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Inc., 198 USPQ 111 (TTAB 1978); *Astec Industries, Inc. v. Barber-Greene Co.*, 196 USPQ 578 (TTAB 1977); and *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976). *For additional case cites, see Appendix of Cases.*

Compare, for example, Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1405 (TTAB 1998) (dictionary definitions attached to applicant's brief were the proper subject of judicial notice); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, n.5 (TTAB 1979) (evidence which had been timely filed was not objectionable when a reproduction of the evidence was later attached to a trial brief); and TBMP § 704.12 *regarding judicial notice*.

[172] *See* TBMP § 509.01 (Nature of Motions to Extend Time or Reopen Time) and cases cited therein.

[173] *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), and *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656, 662 (TTAB 1979) (statements in answer referring to sales of applicant's magazines were not considered).

[174] *See Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 174 USPQ 395, 396 n.4 (CCPA 1972) (pleadings in prior proceeding available as evidence, although not conclusive evidence, against the pleader); *Bakers Franchise Corp. v. Royal Crown Cola Co.,* 404 F.2d 985, 160 USPQ 192, 193 (CCPA 1969) (admission contained in pleading of one action may be evidence against pleader in another action); *Kellogg Co. v. Pack'Em Enterprises Inc.*, *supra*; *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 196 USPQ 711, 714 (TTAB 1977) (admissions in answer regarding meaning of mark); and *Brown Co. v. American Stencil Manufacturing Co.*, 180 USPQ 344, 345 n.5 (TTAB 1973) (applicant having admitted in its answer that it did not use mark prior to a certain date was estopped from later contending that it has an earlier date of use).

have no evidentiary value, except to the extent that they may serve as admissions against interest.[175]

704.07 Official Records

37 CFR § 2.122(e) Printed publications and official records. *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

A party that wishes to introduce an official record in evidence in a Board inter partes proceeding may do so, if the official record is competent evidence and relevant to an issue in the proceeding, by filing a notice of reliance thereon during its testimony period. The notice of reliance must specify the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence.[176]

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[175] *See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992) (additional revenue figures provided in trial brief not considered); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements made in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (factual statements regarding certain scientific matter which cannot be deemed to be public knowledge not considered); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502, 507 (TTAB 1978); and *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3, 113 (TTAB 1978).

Cf. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) (without copies of relevant documentation including relevant portions of application file, not possible to determine validity of opposer's allegations that applicant took inconsistent position in its application) and *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975).

[176] *See* 37 CFR § 2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports are not official records); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on official records is untimely when filed after oral hearing), *aff'd sub nom.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (sufficiently indicated relevance of third-party registrations); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (official records are records prepared by a public officer); *Plus*

The term "official records" as used in 37 CFR § 2.122(e) refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer.[177] These official records are considered self-authenticating, and as such, require no extrinsic evidence of authenticity as a condition to admissibility.[178]

For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 CFR § 2.122(e), see cases cited in the note below.[179]

Products v. Natural Organics, Inc., 204 USPQ 773, 775 n.5 (TTAB 1979) (submission of duplicate copies of third-party registrations with brief was not untimely where the evidence had been timely filed during course of proceeding); and *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (untimely notice of reliance on official records filed after expiration of testimony period not considered).

[177] *See Black's Law Dictionary* (Fifth Edition, 1979); *Weyerhaeuser Co. v. Katz*, *supra* at 1223 (party's own file copies of documents from a Board proceeding are not official records); and *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, *supra* at 580 n.5 (official records are records prepared by a public officer). *See also* Fed. R. Evid. 902(4).

[178] *See Conde Nast Publications Inc. v. Vogue Travel, Inc.*, *supra* at 580 n.5. *See also Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1369 (TTAB 1998).

[179] *Hard Rock Café International (USA) Inc. v. Elsea,* 56 USPQ2d 1504, 1508 (TTAB 2000) (copy of Board's decision on summary judgment in prior opposition – yes; purported copy of brief in support of summary judgment motion in prior proceeding which did not reflect that it was received by the Board but appeared to be merely applicant's file copy of the document – no); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (trademark search report --no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports--no); *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157, 1159 n.3 (TTAB 1992), *aff'd*, 28 USPQ2d 1687 (Fed. Cir. 1993) (trademark search report -- no; third-party registrations--yes); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 90, 906 n.5 (TTAB 1985) (copy of cancellation proceeding file--yes; party's file copies of documents filed in the PTO--no); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.3 (TTAB 1985) (letters between counsel for parties, and list of party's licensees--no); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (third-party registrations--yes); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (portions of an agreement between applicant and a third party, press release, list of foreign trademark registrations, and a shipping document for applicant's product--no); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (copy of letter from Amtrak to applicant congratulating applicant for having an appointment as an Amtrak agent, copy of a "Passenger Sales Agency Agreement" between the International Air Transport Association and applicant, etc.--no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (brochures and other promotional literature--no); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (certified copies of corporate records maintained by Secretary of State of Missouri --yes); *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 663 n.3 & 664 (TTAB 1977) (plat plan, deed of realty, and confirmatory assignment--not admissible by notice of reliance as official record because not properly authenticated); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 654 n.9 (TTAB 1976) (third-party registrations--yes); *Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of party's registration--yes); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (drawings from Federal trademark applications--yes); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) (certificate of good standing from a United States district court--yes).

For information concerning establishing the authenticity, under the Federal Rules of Evidence, of an official record, see Fed. R. Evid. 901(a), 901(b)(7), and 902(4*)*. The latter rule provides, in effect, that extrinsic evidence of authenticity as a condition precedent to admissibility is not required with respect to a properly certified copy of an official record, and describes the requirements for proper certification. However, a copy of an official record of the USPTO need not be certified to be offered in evidence by notice of reliance.[180]

In lieu of the actual "official record or a copy thereof," the notice of reliance may be accompanied by an electronically generated document (or a copy thereof) which is the equivalent of the official record, and whose authenticity is established under the Federal Rules of Evidence.[181]

Although official records may be made of record by notice of reliance under 37 CFR § 2.122(e), they be introduced this way. They may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.[182] These latter two methods may also be used to introduce types of official records that are not admissible by notice of reliance under 37 CFR § 2.122(e).[183]

For information concerning the raising of objections to notices of reliance and materials filed there under, see TBMP §§ 533 and 707.02.

Materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record.[184]

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[180] *See* 37 CFR § 2.122(e*)*.

[181] *See Weyerhaeuser Co. v. Katz*, *supra* at 1232. *Cf.* TBMP § 704.08 (Printed Publications).

[182] *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 637 n.3 (TTAB 1983); and *Regent Standard Forms, Inc. v. Textron Inc.*, 172 USPQ 379, 380-81 (TTAB 1971).

[183] *See, for example*, *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (an agreement between applicant and a third party, press releases, and a shipping document, although not acceptable for a notice of reliance may be introduced in connection with competent testimony); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (since adverse party did not object to notice of reliance on annual reports, treated as stipulated into the record), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990), and *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (while annual reports and booklets and brochures do not constitute printed publications and are therefore not appropriate for introduction by notice of reliance, they may be introduced in connection with testimony of someone who is familiar with them and can explain the nature and use of such materials).

[184] *See, for example, U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (improper subject matter but adverse party expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, *supra* (neither party objected to the notice of reliance on annual reports by the

704.08 Printed Publications

37 CFR § 2.122(e) Printed publications and official records. *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

Certain types of printed publications may be introduced in evidence in a Board inter partes proceeding by notice of reliance. Specifically, printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, if the publication is competent evidence and relevant to an issue in the proceeding, may be introduced in evidence by filing a notice of reliance thereon during the testimony period of the offering party.[185] The notice must specify the printed publication, including information sufficient to

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other); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered where no objection was raised); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 nn.3 & 4 (TTAB 1984) (improper subject matter deemed stipulated into record where no objection was raised); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (improper subject matter deemed stipulated into record where adverse party did not object and specifically referred to the matter in its brief); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely notice of reliance filed prior to testimony period considered where no objection was raised and error was not prejudicial). *Cf. Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where although there was no objection, no agreement could be inferred) and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (improper subject matter excluded, although adverse party did not object to the material).

[185] *See Hunter Publishing Co. v. Caulfield Publishing Ltd.* 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (while subject matter may be of interest to the general public such materials are not necessarily in general circulation); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 n.5 (TTAB 1984) (objection that applicant failed to indicate relevance of materials overruled); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on printed material filed after oral hearing untimely), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (duplicates of printed publications submitted with brief which had been properly filed by notice of reliance during testimony period considered); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (rule provides safeguard that party against whom evidence is offered is readily able to corroborate or refute authenticity of what is proffered); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB

identify the source and the date of the publication, and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the printed publication or a copy of the relevant portion thereof.[186]

In lieu of the actual "printed publication or a copy of the relevant portion thereof," the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion, as, for example, by a printout from the NEXIS computerized library of an article published in a newspaper or magazine of general circulation.[187] In case of reasonable doubt as to whether printed publications submitted by notice of reliance under 37 CFR § 2.122(e) are "available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue" in the proceeding, the burden of showing that they are so available lies with the offering party.[188]

1976) (plaintiff's catalogs and house publications not considered because it was not shown they are "available to the general public in libraries or in general circulation"; advertisements permitted if publication in which they appeared and dates are provided to allow party to verify authenticity); and *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (publication shown to be available in public library properly submitted under 2.122(e), even though it may constitute hearsay or be of dubious relevance).

[186] *See* 37 CFR § 2.122(e). *See also Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.50 (TTAB 1999) (excerpts that were unidentified as to either source or date were not considered, as the extent to which such material is genuine and available to the public could not be ascertained); *Hard Rock Cafe Licensing Corp. v. Elsea,* 48 USPQ2d 1400, 1405 (TTAB 1998) (finding it sufficient that copies of the excerpted articles contained notations either on the copies themselves or in the notice of reliance as to the source and date of the copied articles, but noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (printed advertisement not identified with the specificity required to be considered a printed publication); and *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (notice of reliance received without appended copy of printed publication).

[187] *See Weyerhaeuser Co. v. Katz*, *supra* and *International Ass'n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 USPQ 940, 942 n.6 (TTAB 1985) (NEXIS printout of excerpted stories published in newspapers, magazines, etc. are admissible because excerpts identify their dates of publication and sources and since complete reports, whether through the same electronic library or at a public library, are available for verification), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Cf. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (electronic excerpts are not hearsay because articles were not used to support the truth of the statements therein but to show descriptive usage of term); *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 174-75 (TTAB 1985) (printouts from databases which themselves comprise abstracts or syntheses of published documents unlike the actual text of the documents, are hearsay as to the context of a term); and TBMP § 707 (Objections to Evidence).

[188] *See Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (private promotional literature is not presumed to be publicly available within the meaning of the rule).

For examples of cases concerning the admissibility of specific materials, by notice of reliance, as "printed publications" under 37 CFR § 2.122(e), see cases cited in the note below.[189]

Printed publications made of record by notice of reliance under 37 CFR § 2.122(e) are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters.[190]

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[189] *Harjo v. Pro-Football Inc*., *supra* at 1722 n.54 (TTAB 1999) (advertisements in newspapers or magazines available to the general public in libraries or in general circulation – yes); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 (TTAB 1998) (press releases, press clippings, studies prepared for a party, affidavits or declarations, or product information -- no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 n.5 (TTAB 1992) (trademark search reports--no); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (annual reports--no); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (conference papers, dissertations, and journal papers--no); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (press releases--no); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (annual reports--no); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (annual report even if in some libraries, or available on request--no; magazine articles--yes); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (promotional literature--no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (promotional literature--no); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (catalogs and other house publications--no); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232, 234 (TTAB 1976) (annual reports, promotional brochures, price list, reprints of advertisements, and copies of advertising mats--no); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (telephone directory pages, indexes from United States Code Annotated, and dictionary pages--yes); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (annual reports--no); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (credit card applications, handouts, and flyers--no; articles from trade publications and other magazines--yes); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets, and product brochures--no); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.2 (TTAB 1973) (article from "Memoirs of the University of California"--no, since publication not shown to be available to the general public).

[190] *See, for example, In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles are not used to support the truth of the statements therein but to show descriptive usage of term); *Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 469 F.2d 1397, 176 USPQ 123, 123 (CCPA 1972) (advertisement from newspaper only showed promotion of the product on the day the publication issued); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report considered stipulated into evidence only for what it showed on its face), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Harjo v. Pro-Football Inc*., *supra* at 1721 n.50 (evidence of the manner in which the term is used in the articles and of the fact that the public has been exposed to the articles and may be aware of the information contained therein); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (magazine article limited to what it showed on its face); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 404, 410 (TTAB 1978) (advertisement submitted with notice of reliance only showed that advertisement appeared on that date in that journal and does not show customer familiarity with marks nor actual sales); *Food Producers, Inc. v. Swift & Co.*, 194 USPQ 299, 301 n.2 (TTAB 1977) (publications limited to their face value because no opportunity to ascertain basis for information or confront and cross-examine individuals responsible therefor); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (advertisements were only probative of fact that opposer advertised its goods under the mark in the publications on those dates); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (even if annual reports were admissible as printed publications, they would only

Although the types of printed publications described above may be made of record by notice of reliance under 37 CFR § 2.122(e), they may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.[191] These latter two methods may also be used for the introduction of printed publications which are not admissible by notice of reliance under 37 CFR § 2.122(e).[192]

For information concerning the raising of objections to notices of reliance and materials filed there under, see TBMP §§ 533 and 707.02.

Materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record.[193]

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be probative of fact that they are opposer's annual reports for the years shown thereon); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310, 312 n.4 (TTAB 1975) (magazine article showed only that the goods under the mark were the subject of the article in that publication); and *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (articles from trade publications admissible to show that they appeared in the publication on a certain date and that they contained certain information, but not that the information is true).

[191] *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 846 (TTAB 1984) (objection on ground that no notice of reliance was filed was not well taken where party had introduced the materials in connection with testimony), and *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 635 n.3 (TTAB 1983) (same).

[192] *See, for example, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, *supra* (annual reports); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (copies of agreements, press releases, shipping documents and foreign registrations); and *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets and brochures).

[193] *See, for example, Plyboo America Inc. v. Smith & Fong Co.,* 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (plaintiff did not object to introduction of curriculum vitae, advertising literature, printout of page from website by notice of reliance and treated materials as of record); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (opposer's improper subject matter considered where applicant expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, *supra* (neither party objected to the annual reports submitted by the other party); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (annual reports improper subject matter considered); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (various documents constituting improper subject matter considered where no objection was raised and adverse party specifically addressed the materials in its brief); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely, but no objection or prejudice).

Cf. Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where adverse party, while not objecting to the improperly offered materials, did not treat the materials as being of record); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection).

Internet evidence and other materials that are not self-authenticating. Certain printed publications qualify for submission by notice of reliance under Trademark Rule 2.122(e) because they are considered essentially self-authenticating.[194] That is, permanent sources for the publications are identified and the nonoffering party is readily able to verify the authenticity of the documents.[195] The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet.[196] Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not "subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered."[197] For this reason, Internet printouts cannot be considered the equivalent of printouts from a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified.[198]

Materials that do not fall within 37 CFR § 2.122(e), that is, materials that are not self-authenticating in nature and thus not admissible by notice of reliance, may nevertheless be introduced into evidence through the testimony of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials.[199] Even if properly made of record, however, such materials, including Internet printouts, would only be probative of what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters.[200]

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[194] *See Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 (TTAB 1999).

[195] *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

[196] *See Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

[197] *Weyerhaeuser v. Katz*, *supra* at 1232 (TTAB 1992) citing *Glamorene Products Corporation v. Earl Grissmer Company, Inc.*, 203 USPQ 1091, 1092 n.5 (TTAB 1979). *See also Raccioppi v. Apogee Inc.*, *supra* at 1370; *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1134 (TTAB 2000) (introduction of telephone listings retrieved from Internet was improper); and *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (printout of page of website is not proper subject matter for a notice of reliance).

[198] *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (examining attorney's request for judicial notice of on-line dictionary definitions denied because the definitions were not available in printed format). *Cf. In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (judicial notice taken of online dictionary definition where resource was also available in book form).

[199] *See Raccioppi v. Apogee Inc.*, *supra* at 1371 *with respect to introducing Internet evidence in connection with a summary judgment motion*.

[200] *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (not evidence of use but may have some probative value to show the meaning of a mark in the same way as third-party registrations) and *Raccioppi v. Apogee Inc.*, *supra* at 1371 (the reliability of the information becomes a matter of weight or probative value to be given the Internet evidence). *See also In re Remacl*e, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (involving Internet articles from sources outside the United States).

704.09 Discovery Depositions

37 CFR § 2.120(j) Use of discovery deposition, answer to interrogatory, or admission.

(1) *The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.*

(2) *Except as provided in paragraph (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.*

(3)*(i) A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.*

* * * *

(4) *If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse*

party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

* * * *

(6) *Paragraph (j) of this section will not be interpreted to preclude the reading or the use of a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.*

(7) *When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(8) *Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.*

The discovery deposition *of a party* (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party) may be offered in evidence *by any adverse party*.[201]

Otherwise, the discovery deposition of a witness, whether or not a party, may not be offered in evidence except in the following situations:

(1) By stipulation of the parties, approved by the Board.[202]

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[201] 37 CFR § 2.120(j)(1). *See Hilson Research Inc. v. Society for Human Resource Management,* 27 USPQ2d 1423, 1427 (TTAB 1993) (deponent was no longer an officer or director at time his deposition was taken); *Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321, 1325 (TTAB 1992) (same); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1630 n.5 (TTAB 1988) (only by adverse party); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (same); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980) (same); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 n.7 (TTAB 1979) (discovery deposition of nonparty taken on written questions inadmissible); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977) (party who takes discovery deposition may place it into evidence); and *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647, 651 n.11 (TTAB 1976) (deposed party may not rely on statements made in discovery deposition if the deposition is not made of record).

[202] 37 CFR § 2.120(j)(2). *See Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of nonparty properly in evidence by stipulation of parties).

(2) By order of the Board, on motion showing that the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The motion must be filed at the time of the purported offer of the deposition in evidence, unless the motion is based on a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion must be filed promptly after the circumstances claimed to justify use of the deposition became known.[203]

(3) If only part of a discovery deposition is submitted and made part of the record by a party entitled to offer the deposition in evidence, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. In such a case, the notice of reliance filed by the adverse party must be supported by a written statement explaining why the adverse party needs to rely on each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.[204]

A discovery deposition that may be offered in evidence under 37 CFR § 2.120(j) may be made of record by filing, during the testimony period of the offering party, the deposition or any part

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[203] 37 CFR § 2.120(j)(2). *See Hilson Research Inc. v. Society for Human Resource Management, supra*; *Marshall Field & Co. v. Mrs. Fields Cookies, supra*; *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (no special circumstances shown by applicant to admit discovery deposition of applicant's president); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, *supra* (mere speculation that nonparty witness would be unavailable is insufficient); and *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691, 692 n.4 (TTAB 1978) (no special circumstances shown to admit discovery deposition of nonparty).

[204] 37 CFR § 2.120(j)(4). *See Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804, 1806 n.2 (TTAB 1990) (adverse party failed to show how portions submitted were misleading), *aff'd*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (Board refused to consider pages of a deposition relied on by applicant in its brief since they were not relied on by opposer and not properly made of record by applicant and since opposer objected thereto); *First International Services Corp. v. Chuckles Inc.*, *supra* (where applicant submitted entire deposition of its president in response to opposer's partial submission, without identifying specific relevant testimony Board refused to consider additional portions); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.6 (TTAB 1986) (pages of additional portions should be clearly marked); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (Board refused to consider additional exhibits since they did not serve to correct misimpression engendered by those of record); *Dynamark Corp. v. Weed Eaters, Inc.*, *supra* (distinguishing mandatory filing of trial deposition in its entirety from discovery deposition where only the portion or portions which are properly introduced are of record); and *Johnson Publishing Co. v. Cavin & Tubiana OHG*, *supra.*

thereof with any exhibit to the part that is filed, together with a notice of reliance.[205] The notice of reliance need not indicate the relevance of the deposition, or parts thereof, relied on.[206] When only part of a deposition is relied on, the notice of reliance must specify the part or parts relied on.[207]

When a discovery deposition has been made of record by one party in accordance with 37 CFR § 2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.[208] If only part of a discovery deposition has been made of record pursuant to 37 CFR § 2.120(j), that part only may be referred to by any party for any purpose permitted by the Federal Rules of evidence. If one party has filed a notice of reliance on a discovery deposition or part thereof and an adverse party has based its presentation of evidence on the belief that the deposition or the part thereof is of record, the notice of reliance may not later be withdrawn.[209]

A discovery deposition not properly offered in evidence under 37 CFR § 2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto, or treats the deposition as being of record, or improperly offers a discovery deposition in the same manner.[210]

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[205] 37 CFR § 2.120(j)(3)(i). *See BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978) (mere presence of discovery responses in the file does not make them of record without a notice of reliance); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, *supra*; *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, *supra*; *Ethicon, Inc. v. American Cyanamid Co.*, *supra*; *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495, 496 n.2 (TTAB 1970) (discovery depositions not in evidence since notice of reliance not filed); and *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition inadmissible where it was timely filed but not accompanied by notice of reliance).

[206] *See* 37 CFR § 2.120(j)(3)(i). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) (noting that it is more effective to file only those portions of the deposition that are relevant and explain their relevancy in the notice of reliance).

[207] *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440, 441 n.4 (TTAB 1983) (vague reference to reliance on "only those portions of the deposition pertaining to the descriptive nature of the opposed mark" insufficient).

[208] 37 CFR § 2.120(j)(7). *See Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, *supra* at 955 n.4 (notice of reliance on deposition already made of record by the other party is superfluous); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.6 (TTAB 1985) (stipulation that deposition relied on by opposer may also be considered as part of applicant's case was unnecessary); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984); and *Miles Laboratories, Inc. v. SmithKline Corp.*, 189 USPQ 290, 291 n.4 (TTAB 1975).

[209] *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440, 441 n.4 (TTAB 1983) (opposer's notice of reliance as to deposition designation indefinite and given time to clarify; response severely narrowed original designation to applicant's prejudice and not permitted).

[210] *See, for example, Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1737 n.11 (TTAB 1990) (no objection to applicant's introduction of discovery deposition of officer of opposer's parent corporation); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (deposition taken during discovery but treated by both

Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. The Board may return discovery papers or materials filed under other circumstances.[211]

Nothing in 37 CFR § 2.120(j) will be interpreted to preclude the reading or the use of a discovery deposition as part of the examination or cross-examination of any witness during the testimony period of any party.[212]

For information concerning the taking of a discovery deposition, and the raising of objections thereto, see TBMP §§ 404, 532, and 707.02.

NOTE: *Some of the cases cited in this section established principles later codified in current 37 CFR § 2.120(j), or were decided under rules that were the predecessors to such provisions.*

704.10 Interrogatory Answers; Admissions

37 CFR § 2.120(j)

* * * *

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section*

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parties as a testimonial deposition introduced by deposed party treated as trial deposition taken prior to testimony period pursuant to stipulation); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (deposition of nonparty treated as stipulated into the record since adverse party did not object and referred to it as being of record in its brief); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.7 (TTAB 1982 (discovery deposition of nonparty treated by both parties as properly of record); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (considered of record where although opposer did not file a notice of reliance on discovery depositions, both parties referred to the depositions in their briefs); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (plaintiff's notice of reliance filed during rebuttal testimony period improper where defendant introduced no evidence; but since defendant filed improper notice of reliance in response thereto and because neither party objected to the untimely evidence of the other and moreover addressed each other's evidence, all material was considered); and *Insta-Foam Products, Inc. v. Instapak Corporation*, 189 USPQ 793, 795 n. 4 (TTAB 1976) (discovery deposition of nonparty deemed stipulated into the record where there was no objection and both parties relied on the deposition).

[211] 37 CFR § 2.120(j)(8). *See Electronic Industries Assn v. Potega*, 50 USPQ2d 1775, 1776 n.3 (TTAB 1999); and TBMP § 409 (Filing Discovery Requests and Responses with Board) and authorities cited therein.

[212] 37 CFR § 2.120(j)(6). *Cf. West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (party may testify as to veracity of information contained in interrogatory answers or use such answers to refresh memory of witness during testimony deposition).

may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * * *

(5) *An answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party except that, if fewer than all of the answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance any other answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the inquiring party. The notice of reliance filed by the responding party must be supported by a written statement explaining why the responding party needs to rely upon each of the additional discovery responses listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses.*

(6) *Paragraph (j) of this section will not be interpreted to preclude the reading or the use of a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.*

(7) *When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(8) *Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.*

Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party.[213]

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[213] *See* 37 CFR § 2.120(j)(5). *See also Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.,* 222 USPQ 1012, 1015 n.7 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.8 (TTAB 1982);

However, if fewer than all of the answers to a set of interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce, under a notice of reliance, any other answers to interrogatories, or any other admissions which should be considered so as to avoid an unfair interpretation of the responses offered by the inquiring party.[214] The notice of reliance must be supported by a written statement explaining why the responding party needs to rely on each of the additional interrogatory answers, or admissions, listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses.[215]

An interrogatory answer (including documents provided as all or part of an interrogatory answer), or an admission to a request for admission, that may be offered in evidence under 37 CFR § 2.120(j) may be made of record by notice of reliance during the testimony period of the offering party. The party should file a copy of the interrogatory and the answer thereto, with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with its notice of reliance thereon.[216]

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and *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981). *For additional case cite, see Appendix of Cases.*

[214] *See* 37 CFR § 2.120(j)(5) and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988).

[215] *See* 37 CFR § 2.120(j)(5). *See also Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.,* 35 USPQ2d 1125, 1128 n.4 (TTAB 1995) (notice of reliance on responses stricken since responses did not clarify answers relied on by inquiring party); *Heaton Enterprises of Nevada Inc. v. Lang*, *supra* at 1844 n.5 (TTAB 1988) (answering party is expected to select only the relevant answers and to inform the Board of the relationship of that answer to those offered by propounding party); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (other answers may be introduced to clarify, rebut or explain responses relied on by inquiring party; opposer failed to indicate the relevance of its interrogatory responses to rebut those relied on by applicant); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (broad statement by answering party that without the additional responses the selected responses would be misleading is insufficient); *Packaging Industries Group, Inc. v. Great American Marketing, Inc.*, 227 USPQ 734, 734 n.3 (TTAB 1985) (applicant did not introduce the additional responses referred to in its brief by notice of reliance); *Holiday Inns, Inc. v. Monolith Enterprises*, *supra* at 950 (may not simply rely on all remaining answers and expect Board to determine which, if any, answers require explanation or clarification); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647 (TTAB 1976).

[216] 37 CFR § 2.120(j)(3)(i). *See BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance must specify and be accompanied by the interrogatory to which each document was provided in lieu of an answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986) (documents provided in lieu of interrogatory answer admissible by notice of reliance); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (notice of reliance filed after close of testimony period untimely); and *Bausch & Lomb Inc. v. Gentex Corp.*, 200 USPQ 117, 119 n.2 (TTAB 1978) (neither party filed notice of reliance on the other party's interrogatories and therefore not of record). *For additional case cites, see Appendix of Cases. Cf.*

The notice of reliance need not indicate the relevance of the discovery responses relied on.[217] Offering interrogatory answers, or admissions, on the record during the taking of a testimony deposition is the equivalent of serving and filing a notice of reliance by mail.[218]

An interrogatory answer may also be made of record by stipulation of the parties, accompanied by a copy of the interrogatory and the answer thereto with any exhibit made part of the answer. Similarly, an admission may be made of record by stipulation of the parties, accompanied by a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto).[219]

When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 CFR § 2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.[220]

An interrogatory answer, or an admission, not properly offered in evidence under 37 CFR § 2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the answer, or admission, as being of record; and/or improperly offers an interrogatory answer, or an admission, in the same manner.[221]

Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on responses which were already made of record by opposer was superfluous).

[217] *See* 37 CFR § 2.120(j)(3)(i), and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (not required to set forth the relevance of interrogatory answers).

[218] *See Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp*., 204 USPQ 945, 947 (TTAB 1979).

[219] *See Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1015 n.7 (TTAB 1984) (although parties stipulated that certain interrogatory answers were part of evidentiary record, because copies of the interrogatories and answers were never submitted to the Board they could not be considered). *See also Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978), and *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977). *Cf. Wella Corp. v. California Concept Corp.*, 192 USPQ 158, 160 n.4 (TTAB 1976) (supplemental answers to interrogatories were not covered by the stipulation), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

[220] 37 CFR § 2.120(j)(7). *See Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on matter already made of record by opposer is superfluous). *See also Henry Siegel Co. v. M & R International Mfg. Co.,* 4 USPQ2d 1154, 1155 n.5 (TTAB 1987); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976) (where party relies on all of adversary's answers to interrogatories, the adversary need not file its own notice of reliance thereon).

[221] *See, for example, Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (no objection to party's reliance on its own answers and moreover the responses set forth facts which were described in the parties' stipulation); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988) (no objection to responding party's notice of reliance on remaining answers and such answers were deemed as explanatory or clarifying); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987) (no objection to party's reliance on its own answers); *Board of Trustees of the University of Alabama*

Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. The Board may return discovery papers or materials filed under other circumstances.[222]

Nothing in 37 CFR § 2.120(j) precludes reading or using an interrogatory answer, or an admission, as part of the examination or cross-examination of any witness during the testimony period of any party.[223]

For information concerning the taking of discovery by way of interrogatories, see TBMP §§ 405. *For information concerning the taking of discovery by way of requests for admission, see* TBMP §§ 407. *For information concerning the raising of objections to notices of reliance and materials filed there under, see* TBMP §§ 532 and 707.02.

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v. BAMA-Werke Curt Baumann, 231 USPQ 408, 409 n.3 (TTAB 1986) (objection which was raised for first time in brief waived since defect of failing to explain why the additional responses were necessary could have been cured);*Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.4 (TTAB 1979) (no objection to untimely notice of reliance or to failure to submit copies of the discovery requests or responses thereto); *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025, 1027 n.1 (TTAB 1979) (no objection by either party to the other's improper reliance on its own answers; opposer did not object to interrogatories introduced by applicant and in fact referred to answers to other of opposer's interrogatories without benefit of notice of reliance); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (discovery depositions filed without a notice of reliance were treated as being of record where both parties referred to the depositions in their briefs and in view of stipulations concerning marking of exhibits in the depositions); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978) (both parties relied on answers given by each to the other's interrogatories without objection); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977) (same); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976) (neither party objected to improper notice of reliance by the other and each relied on the contents of the other's notice of reliance); and *Plus Products v. Sterling Food Co.*, 188 USPQ 586, 587 n.2 (TTAB 1975) (applicant did not file required notice of reliance on opposer's answers but both parties referred to the answers in their briefs).

[222] 37 CFR § 2.120(j)(8). *See* TBMP § 409 (Filing Discovery Requests and Responses with Board) and authorities cited therein.

[223] 37 CFR § 2.120(j)(6). *See West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (use of interrogatory answers to refresh memory of witness and testifying as to veracity of interrogatory answers permitted). *Cf. Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169-70 (TTAB 1984) (reading answers into record when witness was present at deposition inadmissible because no written copy given to refresh witnesses' memory), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

NOTE: *Some of the cases cited in this section established principles later codified in the cited provisions in current 37 CFR § 2.120(j), or were decided under rules which were the predecessors to such provisions.*

704.11 Produced Documents

37 CFR § 2.122(e) Printed publications and official records. *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

37 CFR § 2.120(j)(3)(ii) *A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).*

Documents provided as all or part of an answer to an interrogatory may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR §§ 2.120(j)(3)(i) and 2.120(j)(5).[224]

However, a party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR § 2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding -- *see* TBMP §§ 704.07 and 704.08).[225]

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[224] *See M-Tek Inc. v. CVP Systems Inc.,* 17 USPQ2d 1070, 1073 (TTAB 1990), (notice of reliance failed to indicate that documents were being introduced under Rule 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer) and *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, *supra.*

[225] 37 CFR § 2.120(j)(3)(ii). *See, for example, M-Tek Inc. v. CVP Systems Inc*., *supra* at 1073; *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc*., 1 USPQ2d 1445, 1447 n.9 (TTAB 1986); *Osage Oil & Transportation,*

Listed below are a number of methods by which documents produced in response to a request for production of documents may be made of record:

(1) A party that has obtained documents under Fed. R. Civ. P. 34 may serve on its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under 37 CFR § 2.120(j)(3)(i), on the requests for admission, the exhibits thereto, and its adversary's admissions (or a statement that its adversary failed to respond to the requests for admission). However, if a party wishes to have an opportunity to serve requests for admission after obtaining documents under Fed. R. Civ. P. 34, it must serve its request for production of documents early in the discovery period, so that when it obtains the produced documents, it will have time to prepare and serve requests for admission prior to the expiration of the discovery period.[226]

(2) A party that has obtained documents under Fed. R. Civ. P. 34 may offer them as exhibits in connection with the taking of its adversary's discovery deposition. Again, however, the request for production of documents must be served early in the discovery period, so that there will still be time remaining, after the requested documents have been produced, to notice and take a discovery deposition.[227]

(3) A party that has obtained documents under Fed. R. Civ. P. 34 may introduce them as exhibits during the cross-examination of its adversary's witness.[228] This method is available only if the adversary takes testimony and the documents pertain to matters within the scope of the direct examination of the witness.

(4) A party that has obtained documents under Fed. R. Civ. P. 34 may, during its own testimony period, take the testimony of its adversary as an adverse witness and introduce the obtained documents as exhibits during direct examination.[229]

Inc. v. Standard Oil Co., 226 USPQ 905, 906 n.5 (TTAB 1985) (documents were neither official records nor printed publications); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co*., 221 USPQ 58, 59 n.4 (TTAB 1984) (documents were not printed publications); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977). *For additional case cites see Appendix of Cases.*

[226] *See* TBMP §§ 403.05(a) and 403.05(b) regarding the need for early initiation of discovery.

[227] *See* TBMP §§ 403.05 (Need for Early Initiation of Discovery).

[228] *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976).

[229] *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, *supra.*

(5) A party that has obtained documents under Fed. R. Civ. P. 34 may, during its own testimony period, make of record by notice of reliance, under 37 CFR § 2.122(e), any of the documents which falls into the category of "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue."[230]

(6) A party that wishes to obtain documents under Fed. R. Civ. P. 34 may combine its request for production of documents with a notice of taking discovery deposition, and ask that the requested documents be produced at the deposition. However, the combined request for production and notice of deposition must be served well before the date set for the deposition, because a discovery deposition must be both noticed and taken before the close of the discovery period, and because Fed. R. Civ. P. 34(b) allows a party 30 days in which to respond to a request for production of documents (this period is lengthened to 35 days if service of the request is made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)).[231]

(7) Documents obtained under Fed. R. Civ. P. 34 may be made of record by stipulation of the parties.

(8) Documents obtained by request for production of documents under Fed. R. Civ. P. 34, and improperly offered in evidence, may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the documents as being of record; and/or in the same manner improperly offers documents which it obtained under Fed. R. Civ. P. 34.[232]

For information concerning the obtaining of discovery by way of a request for production of documents, see TBMP § 406.

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[230] *See* 37 CFR § 2.120(j)(3)(ii). *See also* TBMP §§ 704.07 (Official Records) and 704.08 (Printed Publications) and cases cited in the first paragraph of this section.

[231] *See* TBMP §§ 403.05 (Need for Early Initiation of Discovery).

[232] *See*, *for example*, *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (improper subject of notice of reliance but no objection raised); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978) (neither party objected to other's offering of Rule 34 documents by notice alone); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 569 n.1 (TTAB 1977) (applicant did not object to documents produced and introduced by notice alone and referred to those documents in its brief); and *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, *supra* (no objection to notice of reliance). *Cf. Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.8 (TTAB 1985).

704.12 Judicial Notice

37 CFR § 2.122(a) Rules of Evidence. *The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.*

Fed. R. Evid. 201. Judicial Notice of Adjudicative Facts
(a) Scope of rule. *This rule governs only judicial notice of adjudicative facts.*

(b) Kinds of facts. *A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.*

(c) When discretionary. *A court may take judicial notice, whether requested or not.*

(d) When mandatory. *A court shall take judicial notice if requested by a party and supplied with the necessary information.*

(e) Opportunity to be heard. *A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken.*

(f) Time of taking notice. *Judicial notice may be taken at any stage of the proceeding.*

In appropriate instances, the Board may take judicial notice of adjudicative facts. *See* 37 CFR § 2.122(a) and Fed. R. Evid. 201.

704.12(a) Kind of Fact That May be Judicially Noticed

The only kind of fact which may be judicially noticed by the Board is a fact which is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."[233]

[233] Fed. R. Evid. 201(b) and *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999). *See, for example, Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999); *Omega SA v. Compucorp*, 229 USPQ 191 (TTAB 1985); and *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977).

For examples of decisions concerning whether particular facts are appropriate subject matter for judicial notice by the Board, see cases cited in the note below.[234]

704.12(b) When Taken

The Board will take judicial notice of a relevant fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), if a party (1) requests that the Board do so, and (2)

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[234] *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (dictionary definition of term as trademark--yes, indicates mark is reasonably famous; also, encyclopedias may be consulted); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (home cold permanent wave kits have for many years been sold directly to nonprofessional consumers through retail outlets--yes); *Boswell v. Mavety Media Group Ltd, supra* (that violations of the rights of members of the African American community, and acts of disrespect to members of said community, by members of the majority community are likely to lead to an antagonistic attitude on the part of many members of the minority community – no); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (that there are thousands of registered marks incorporating the term NEW YORK for goods and services that do not originate there – no) *aff'd* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (dictionary definitions--yes); *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396 (TTAB 1979), *aff'd*, *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc*., 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (frequent use of famous marks on collateral products such as clothing, glassware, trash cans, etc.--yes); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (online dictionary definition where resource was also available in book form – yes); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works – yes); *In re 3Com Corp*., 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (dictionary definitions and technical reference works, e.g., computer dictionary--yes); *Continental Airlines Inc. V. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) (dictionary definitions noticed although not made of record by either party); *In re Total Quality Group Inc.*, 51 USPQ2d 1471, 1476 (TTAB 1999) (on-line dictionaries which otherwise do not exist in printed format-- no); *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1999) ("Physicians' Desk Reference" --yes); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1704 (TTAB 1998) (that "U.S." means the United States, which is a geographic area with defined boundaries--yes); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) (third-party registrations--no); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C.--yes); *Los Angeles Bonaventure Co. v. Bonaventure Associates*, 4 USPQ2d 1882 (TTAB 1987) (whether other companies have expanded from restaurant services to hotel services under a single mark, and, if so, when--no); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (files of applications and/or registrations, where no copies thereof are filed, and where they are not the subject of the proceeding--no); *Hertz System, Inc. v. A-Drive Corp.*, 222 USPQ2d 625 (TTAB 1984) (the numeral "1" is widely used to indicate superiority--yes); Hamilton Burr Publishing Co. v. E.W. Communications, Inc., 216 USPQ 802, 804 n.5 (TTAB 1982) (probation report–no); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819 (TTAB 1981) (use of antimicrobial agents in the floor covering industry--no); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981) (dictionary definitions--yes); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980) (standard reference works--yes); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978) (third-party registrations and listings in trade directories, where no copies thereof are submitted--no); *Quaker Oats Co. v. Acme Feed Mills, Inc*., 192 USPQ 653 (TTAB 1976) (law of any jurisdiction, when a copy thereof is submitted under notice of reliance--yes); *Plus Products v. Sterling Food Co.*, 188 USPQ 586 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products--yes); and *Bristol-Myers Co. v. Texize Chemicals, Inc.*, 168 USPQ 670 (TTAB 1971) (operations of opposer and applicant--no).

supplies the necessary information.[235] The request should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information.[236] The Board, in its discretion, may take judicial notice of a fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), whether or not it is requested to do so.[237]

704.12(c) Opportunity to be Heard

A party to a proceeding before the Board is entitled, on timely request, "to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken."[238] This does not mean, however, that when judicial notice is taken without prior notification, a party is automatically entitled to a hearing on request, even if it makes no offer to show that the taking of judicial notice was improper.[239]

704.12(d) Time of Taking Notice

Judicial notice may be taken at any stage of a Board proceeding, even on review of the Board's decision on appeal.[240] However, the Federal Circuit may decline to consider a request for judicial notice made at the late stage of oral argument on appeal.[241]

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[235] Fed. R. Evid. 201(d). *See United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, *supra*, and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, *supra*.

[236] *See Litton Business Systems, Inc. v. J. G. Furniture Co., supra*. *See also Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985), and *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980).

[237] Fed. R. Evid. 201(c). *See Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999) (declined to take judicial notice of slang dictionary definition when submitted as part of rebuttal testimony when could have been submitted with case in chief); *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977); and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976).

[238] Fed. R. Evid 201(e). *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, *supra*.

[239] *See In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). *See also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

[240] *See, for example*, Fed. R. Evi. 201(f); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (request for judicial notice as to fame of mark made in the briefs on appeal); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (judicial notice of banking business on appeal); *American Security Bank v. American Security and Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 n.1 (CCPA 1978) (judicial notice of absence of listing in local telephone directories); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 n.5 (CCPA 1977) (fact of common knowledge, e.g., of purchasers and channels of trade for home permanent wave kits, appropriate for judicial notice); *Food Specialty Co. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136, 139 n.3 (CCPA 1973)

704.13 Testimony From Another Proceeding

37 CFR § 2.122(f) Testimony from other proceedings. *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

On motion granted by the Board, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or their privies, may be used in a pending Board inter partes proceeding, to the extent that the testimony is relevant and material, subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony."[242]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony,[243] or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

(judicial notice on appeal of general sentiment towards kittens which differs from that toward other small animal pets); and *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999) (judicial notice may be taken at any time).

[241] *See Packard Press Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (Court declined to consider whether to take judicial notice of fame where request for judicial notice was made for first time at oral argument on appeal).

[242] 37 CFR § 2.122(f). *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992) (stating that there is no prerequisite that the Board must have considered the testimony or determined the relevancy in the prior opposition, or that the adverse party have actually attended the deposition when originally taken); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061, 1063 n.2 (TTAB 1988) (motion to use testimony from prior district court proceeding granted as uncontested and right to recall the witness waived since no request to do so was made), *rev'd on other grounds*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989);*Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57, 58 (TTAB 1975) (motion to rely on testimony from prior cancellation proceeding between the parties granted, subject to applicant's right to recall witnesses), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); and *Izod, Ltd. v. La Chemise Lacoste,* 178 USPQ 440 (TTAB 1973).

[243] *See MarCon Ltd. v. Avon Products Inc.*, 4 USPQ2d 1474, 1475 n.3 (TTAB 1987) (discovery deposition from previous proceeding to which applicant was not a party would not be admissible under this rule but in this case it was made of record by another means) and *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 182 (TTAB 1986) (*cf.* dissent at 182 n.15 contending that discovery deposition should have been admitted as admission against interest).

Testimony from another proceeding between the parties or their privies may be used, on motion granted by the Board, as evidence in connection with a motion for summary judgment, or as evidence at trial.[244] However, when the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken on recall of the same witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, on motion granted by the Board, during the appropriate trial period.[245]

For information on filing a motion for leave to use testimony from another proceeding, see TBMP § 530.

A testimony deposition from another proceeding may also be made of record in a Board proceeding by stipulation of the parties approved by the Board. The same is true of a discovery deposition.

705 Stipulated Evidence

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence. The use of stipulated evidence normally results in savings of time and expense for all concerned. Notwithstanding such a stipulation, a party may reserve the right to object to stipulated evidence on the grounds of competency, relevance, and materiality.[246]

For example, parties may stipulate that a party may rely on specified responses to requests for discovery, or on other specified documents or exhibits; or that the testimony of a witness may be submitted in the form of an affidavit by the witness; or what a particular witness would testify to if called; or to the facts in the case of any party; or that a discovery deposition may be used as testimony; or that evidence from another proceeding may be used as evidence in the proceeding in which the stipulation is filed.[247]

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[244] *See, for example*, *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, *supra* (evidence on the case), and *Oxy Metal Industries Corp. v. Technic, Inc.*, *supra* (summary judgment evidence).

[245] *See* TBMP §§ 528.05(a) (Summary Judgment Evidence in General) and 528.05(f) (Testimony from Another Proceeding).

[246] *See* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397-398 (1985).

[247] *See, for example*, 37 CFR § 2.123(b), and TBMP §§ 704.07-704.11 for a discussion of the various types of evidence and 703.01(b) (Form of Testimony).

706 Noncomplying Evidence

37 CFR § 2.123(l) Evidence not considered. *Evidence not obtained and filed in compliance with these sections will not be considered.*

Evidence not obtained and filed in compliance with the rules of practice governing inter partes proceedings before the Board will not be considered by the Board.[248]

707 Objections to Evidence

707.01 In General

37 CFR § 2.122(a) Rules of Evidence. *The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.*

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations).[249] A party to a Board inter partes proceeding that believes that proffered evidence should, under these rules, be excluded from consideration, may, raise an objection. The procedure for raising an objection to proffered evidence depends on the nature of the evidence and the ground for objection.[250]

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[248] 37 CFR § 2.123(l). *See Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (stating that a party may not reasonably presume evidence is of record when that evidence is not offered in accordance with the rules); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to main brief and not otherwise properly made of record was not considered); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983) (neither a recent photocopy of opposer's claimed registration attached to pleading without status and title notation nor introduction during testimony of original certificate of registration without testimony as to status and title is sufficient); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976) (evidence submitted for first time with brief not considered); *Plus Products v. General Mills, Inc.*, 188 USPQ 520, 521 n.1 (TTAB 1975) (evidence submitted after filing of reply brief not considered); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition timely filed but not accompanied by notice of reliance not considered); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 393 (1985).

[249] 37 CFR § 2.122(a). *Cf.* TBMP §§ 101.01 (Statute and Rules of Practice) and 101.02 (Federal Rules).

[250] *See, for example, Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998).

707.02 Objections to Notices of Reliance

707.02(a) In General

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered.[251] Trademark Rule 2.120(j), 37 CFR § 2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR § 2.122(e). Trademark Rule 2.122(d)(2), 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Trademark Rule 2.122(e), 37 CFR § 2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records.[252]

Some grounds for objection to a notice of reliance are waived unless promptly made (generally errors of any kind which might be obviated or cured if promptly presented) while other grounds that cannot be cured may be raised at any time. The various grounds for objection to a notice of reliance, and the time and procedure for raising them, are discussed in the sections that follow.[253]

707.02(b) On Procedural Grounds

Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike if the defect is one that can be cured.[254] However, if the ground for the objection is one that could not be cured even if raised promptly, the

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[251] *See generally* TBMP §§ 702 (Manner of Trial and Introducing Evidence – In General) and 704 (Introducing Other Evidence).

[252] *See also* TBMP §§ 704.01(b) (Not Subject of Proceeding – In General) and 704.07-704.11 discussing other types of evidence.

[253] *See also* TBMP § 707.04 (waiver of objection).

[254] *See, for example*, *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (objection waived where respondent received notice of reliance without referenced publications appended thereto but did not raise the issue until briefing); and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (objection that notice of reliance did not set forth relevance of appended documents raised for first time in brief waived).

adverse party may wait and raise the procedural objection in or with[255] its brief on the case.[256]

For information concerning motions to strike notices of reliance, see TBMP § 532.

707.02(b)(1) On Ground of Untimeliness

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted there under), in its entirety, as untimely.[257] Alternatively, an adverse party may raise this ground for objection in its brief on the case.[258]

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[255] *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1489, 1492 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief were not untimely and paper did not result in violation of page limitation for final briefs).

[256] *See Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (defect of failing to append copy of printed publication identified in notice of reliance could have been cured); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (petitioner's objection that respondent's justification for reliance on its own discovery responses was insufficient raised for first time in petitioner's brief was untimely since defect is one which could have been cured if raised promptly); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (objection that items submitted by notice of reliance were neither official records nor printed publications raised in brief sustained); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 655 n.9 (TTAB 1976) (objection to notice of reliance as to statement of relevance of third-party registrations untimely); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (objection that notice of reliance failed to indicate relevance of materials was curable and should have been raised when notice was filed); and *Johnson & Johnson v. American Hospital Supply Corporation*, 187 USPQ 478, 479 (TTAB 1975) (Board, on reconsideration, reversed its decision to treat defendant's objection to notice of reliance as motion to strike since opposer did not file a brief in response to objections but instead intended to argue against the objections in its trial brief).

[257] *See, for example, Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (motion to strike untimely supplemental notice of reliance to admit current status and title copy of registration in place of timely but older status and title copy granted) and *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (motion to strike untimely notice of reliance on interrogatory answers and certified copies of corporate records filed with the state granted).

[258] *See, for example, Questor Corp. v. Dan Robbins & Associates, Inc.,* 199 USPQ 358, 361 n.3 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979) and *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976) (respondent's objection to untimely notice of reliance raised for the first time in its brief was not waived), *pet. to Comm'r denied*, 198 USPQ 485 (Comm'r 1977). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

707.02(b)(2) On Other Procedural Grounds

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 CFR § 2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, or does not indicate the general relevance thereof,[259] or that the proffered materials are not appropriate for introduction by notice of reliance.[260]

When, on a motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the relying party time to cure the defect, failing which the notice will stand stricken.[261]

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[259] *See, for example, Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (motion to strike granted where notice of reliance was filed under inapplicable provision of rules in that items did not constitute discovery materials admissible under 2.120(j)(3) and opposer failed to explain relevance of appended copy of notice of opposition from a different case); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance failed to indicate that documents were being introduced under Rule 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (motion to strike notice of reliance granted where opposer failed to indicate how its own answers clarified rebutted or explained those relied on by applicant); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 951 (TTAB 1981) (motion to strike notice of reliance granted in part where applicant failed to identify specific answers sought to be introduced by answering party or indicate how they explained, clarified or rebutted answers relied on by inquiring party); *Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478, 479 (TTAB 1975) (applicant's objection to opposer's notice of reliance on letters between applicant and attorneys for third party well taken because such documents were not printed publications or official records and were not properly identified during deposition so as to lay foundation for introduction into evidence); *Rogers Corp. v. Fields Plastics & Chemicals, Inc.,* 172 USPQ 377, 378-79 (TTAB 1972) (motion to strike notice of reliance on entire remainder of deposition granted); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 124 (TTAB 1971) (motion to strike items in applicant's notice of reliance stricken as they were either duplicative of evidence already made of record**,** not deemed to be printed publications in general circulation, or, in view of the purpose stated by applicant in the notice of reliance, hearsay).

[260] *See, for example, Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance).

[261] *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (allowed 20 days to submit substitute notice of reliance remedying defects including submission of proper official record); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (allowed time to clarify that the documents submitted by notice of reliance were in fact produced in response to interrogatories rather than in response to document requests); and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (documents remained stricken where party did not correct deficiencies).

If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), the Board will defer determination of the motion until final hearing.[262] When determination of a motion to strike a notice of reliance is deferred until final hearing, the parties should argue the matter alternatively in their briefs on the case.

707.02(c) On Substantive Grounds

An adverse party may object to a notice of reliance on substantive grounds, such as that evidence offered under the notice constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial. Objections of this nature normally should be raised in or with[263] the objecting party's brief on the case, rather than by motion to strike, unless the ground for objection is one that could be cured if raised promptly by motion to strike.[264] This is because it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final deliberations in the proceeding.[265] If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing.[266]

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any

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[262] *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992), and *M-Tek Inc. v. CVP Systems Inc., supra* at 1073 (under the circumstances, whether documents were properly admissible under 2.120(j)(3)(i) and/or 2.120(j)(3)(ii) deferred).

[263] *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1489, 1492 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief were not untimely and paper did not result in violation of page limitation for final briefs).

[264] *See*, *in this regard*, 37 CFR § 2.123(k), and Fed. R. Civ. P. 32(d)(3)(A). *See also* Louise E. Frugé, *TIPS FROM THE TTAB: An "Object" Lesson*, 72 Trademark Rep. 211 (1982). *Cf.* TBMP §§ 707.02(b)(2) (Other Procedural Grounds) and 707.03(c) (Other Procedural Grounds and on Substantive Grounds).

[265] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

[266] *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (whether notice of reliance sought to introduce improper rebuttal evidence deferred), and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (whether documents submitted by notice of reliance were properly authenticated and whether they constituted hearsay deferred).

outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing.[267]

Because the parties to an inter partes Board proceeding generally will not know until final decision whether a substantive objection to a notice of reliance has been sustained, they should argue the matter alternatively in their briefs on the case.

707.03 Objections to Trial Testimony Depositions

707.03(a) In General

As in the case of an objection to a notice of reliance, an objection to a testimony deposition must be raised promptly if the defect is one that can be obviated or removed, failing which it is waived. The objections, which are waived unless promptly raised, are basically procedural in nature. Objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, *provided* that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections are basically substantive in nature. The grounds for objection to testimony depositions and the procedures for raising them are discussed below.

707.03(b) On Procedural Grounds

707.03(b)(1) On Ground of Untimeliness

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.[268]

When there is no such approved stipulation, granted motion or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety,

[267] *See, for example, Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (timely notice of reliance on four-year old status and title copy of pleaded registration was not stricken); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (copies of USPTO drawings are official records and therefore would not be stricken; however, their probative value is limited); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) ("Certificate of Good Standing" from a U.S. district court is admissible as an official record and therefore would not be stricken; however its probative value would be determined at final hearing). *Cf.* TBMP § 707.03(c) (On Other Procedural Grounds and on Substantive Grounds).

[268] 37 CFR § 2.121(a) and TBMP § 701 (Time of Trial).

as untimely.[269] Alternatively, an adverse party may raise this ground for objection in its brief on the case.[270]

On the other hand, when a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, an adverse party which fails to promptly object to the scheduled deposition on the ground of untimeliness may be found to have waived this ground for objection, because the premature scheduling of a deposition is an error which can be corrected on seasonable objection.[271]

707.03(b)(2) On Ground of Improper or Inadequate Notice

37 CFR § 2.123(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.*

* * * *

(e)*(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be*

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[269] *See* TBMP § 533.01 (On Ground of Untimeliness) and authorities cited therein.

[270] *Cf.* TBMP § 707.02(b)(1) (Untimeliness) and cases cited therein.

[271] *See Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (objection to timeliness of testimony deposition taken two days before period opened, but raised for the first time in its brief waived).

decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

Before testimony depositions on oral examination may be taken by a party, the party must give every adverse party due notice in writing of the time when and place where the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be deposed. If the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead.[272]

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record.[273]

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances.[274]

For further information concerning the motion to strike a testimony deposition for improper or inadequate notice, see TBMP § 533.02.

707.03(c) On Other Procedural Grounds and on Substantive Grounds

37 CFR § 2.123(e)*(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to*

[272] 37 CFR § 2.123(c). *See also* TBMP § 703.01(e) (notice of deposition). *Cf.* Fed. R. Civ. P. 30(b)(1).

[273] *See* 37 CFR § 2.123(e)(3) and TBMP § 533.02 (motion to strike testimony deposition on ground of improper or inadequate notice) and cases cited therein. *See also Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (while respondent's objection to notice was raised at the deposition, respondent failed to preserve the objection by moving to strike testimony promptly thereafter).

[274] 37 CFR § 2.123(e)(3).

object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

* * * *

(j) Effect of errors and irregularities in depositions. *Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.*

(k) Objections to admissibility. *Subject to the provisions of paragraph (j) of this section, objection may be made to receiving in evidence any deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections will not be considered until final hearing.*

Fed. R. Civ. P. 32(d) Effect of Errors and Irregularities in Depositions.
(1) As to Notice. *All errors and irregularities in the notice for taking a deposition are waived unless written objection is promptly served upon the party giving the notice.*

(2) As to Disqualification of Officer. *Objection to taking a deposition because of disqualification of the officer before whom it is to be taken is waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence.*

(3) As to Taking of Deposition.

> *(A) Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.*

> *(B) Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.*

An adverse party may object to a testimony deposition not only on the grounds of untimeliness[275] and improper or inadequate notice,[276] but also on the ground that the deposing party has not complied with one or more of the other procedural requirements specified in the rules governing the taking of testimony in Board inter partes proceedings. In addition, objection may be made to a testimony deposition on one or more substantive grounds, such as that the witness is incompetent to testify, or that the testimony is irrelevant or constitutes hearsay or improper rebuttal. The time and procedure for raising these objections is described below.

As noted in TBMP § 707.03, some objections to testimony depositions must be raised promptly, or they are waived. The objections, which are waived unless raised promptly, are basically procedural in nature. They include:

> (1) Objections to errors and irregularities in the notice for taking a deposition (waived unless written objection is promptly served on the party giving the notice, in the case of an objection based on improper or inadequate notice, waived unless the provisions of 37 CFR § 2.123(e)(3) are followed);[277]
>
> (2) Objections to taking a deposition because of disqualification of the officer before whom the deposition is to be taken (waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence);
>
> (3) Objections based on errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties; and

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[275] *See* TBMP § 707.03(b)(1) (Untimeliness).

[276] *See* TBMP § 707.03(b)(2) (Improper or Inadequate Notice).

[277] *See* TBMP § 707.03(b)(2).

(4) Errors of any kind that might be obviated, removed, or cured if promptly presented (waived unless seasonable objection thereto is made at the taking of the deposition).[278]

Moreover, notice will not be taken of merely formal or technical objections, unless they were timely raised, and appear to have caused substantial injury to the party raising them.[279] This applies not only to errors and irregularities in the taking of a deposition, but also in the form of a deposition transcript (such as, improperly numbered pages or questions, improperly marked exhibits, etc.).[280]

Other objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, *provided* that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections, which are basically substantive in nature, include objections

(1) to the competency of a witness, or

(2) to the competency, relevance, or materiality of testimony, or

(3) that the testimony constitutes hearsay or improper rebuttal.[281]

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[278] *See* 37 CFR §§ 2.123(e)(3) and 2.123(j), and Fed. R. Civ. P. 32(d)(1),(2), and (3)(A) and (B). *See also Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1271 n.4 (TTAB 1999) (objection raised for the first time in brief to manner in which testimonial depositions were filed, waived since purported defect could have been cured if promptly raised); *Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389, 391 (TTAB 1985) (foundation objections to a survey submitted by opposer raised for the first time in brief waived); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (objection on grounds of improper identification or authentication of exhibits waived since defects could have been cured if made during the deposition); and TBMP § 707.03(b)(1).
Cf. TBMP § 707.02(b)(2) (Other Procedural Grounds), and *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977) (objection to untimeliness of notice of reliance raised for first time in brief was not waived since defect could not have been cured or remedied).

[279] *See* 37 CFR § 2.123(j). *See also, for example*, *Pass & Seymour, Inc. v. Syrelec*, *supra* (regarding technical deficiencies in marking exhibits). *See also* Fed. R. Civ. P. 61 and, *with respect to notices of reliance, Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1292 n.1 (TTAB 1986) (noting precept of Fed. R. Civ. P. 61, Board stated that plaintiff's failure to serve notice of reliance was not fatal per se to the notice of reliance).

[280] *See* Fed. R. Civ. P. 61, and, *for example, Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (improperly marked exhibits considered) and *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Board has discretion to consider improperly marked exhibits).

[281] *See* 37 CFR § 2.123(k); Fed. R. Civ. P. 32(d)(3)(A); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, *supra*; and *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 769 n.4 (TTAB 1985) (objection that testimony is immaterial because it is outside scope of pleading is not waived).

When an objection of this type could not have been obviated or removed if presented at the deposition, the Board will consider it even if the objection is raised for the first time in or with[282] a party's brief on the case.[283]

Substantive objections to testimony (that is, objections going to such matters as the competency of a witness, or the competency, relevance, or materiality of testimony, or the asserted hearsay or improper rebuttal nature of the testimony) are not considered by the Board prior to final hearing.[284] This is because depositions are taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to deliberations on the final decision.[285] Further, testimony regularly taken in accordance with the applicable rules ordinarily will not be stricken on the basis of a substantive objection; rather, any such objection (unless waived) will be considered by the Board in its evaluation of the probative value of the testimony at final hearing.[286]

Similarly, if the propriety of a procedural objection to a testimony deposition (such as an objection to the form of a question) cannot be determined without reading the deposition, or examining other trial evidence, it generally will not be considered by the Board until final hearing.[287]

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[282] *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1489, 1492 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief were not untimely and paper did not result in violation of page limitation for final briefs).

[283] *See* Louise E. Frugé, *TIPS FROM THE TTAB: An "Object" Lesson*, 72 Trademark Rep. 211 (1982). *Cf. Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Objection on ground of hearsay with no foundation for establishing an exception waived since defect could have been cured if objection was raised during the deposition).

[284] *See, for example, Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy and materiality deferred); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 307 n.1 (TTAB 1979) (objections to relevance and materiality of exhibits offered at a deposition deferred); *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPQ 44, 47-48 (TTAB 1978) (objection on hearsay grounds or that witness offered opinion testimony without adequate foundation deferred); and *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as lacking foundation deferred). *Cf.* TBMP § 707.02(c) (Substantive Grounds).

[285] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

[286] *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992); *Liqwacon Corp. v. Browning-Ferris Industries, Inc., supra*; *Primal Feeling Center of New England, Inc. v. Janov, supra*; and *Globe-Union Inc. v. Raven Laboratories Inc., supra*. *Cf.* TBMP § 707.02(c) (Substantive Grounds).

[287] *See, for example, Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as based on leading questions deferred). *Cf.* TBMP § 707.02(b)(2) (Other Procedural Grounds).

For the foregoing reasons, the objections described in this section (as opposed to the objection to testimony as late-taken, which may be raised by motion to strike--*see* TBMP §§ 533.01 and 707.03(b)(1); and the objection based on improper or inadequate notice of the taking of a deposition, which is the subject of the motion to strike procedure described in 37 CFR § 2.123(e)(3), and TBMP §§ 533.02 and 707.03(b)(2)), generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the rules cited above, or orally "on the record" at the taking of the deposition, as appropriate. These objections, if properly asserted and not waived or rendered moot, normally will be considered by the Board in its determination of the case at final hearing.[288]

Additionally, in order to preserve an objection that was seasonably raised at trial, a party should maintain the objection in its brief on the case.[289]

When a deposition is taken on written questions pursuant to 37 CFR § 2.124, written objections to questions (that is, the direct questions, cross questions, redirect questions, and recross questions) may be served on the party propounding the subject questions. A party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party.[290] Objections to questions and answers in depositions on written questions generally are considered by the Board (unless waived) at final hearing.[291]

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[288] *See* 37 CFR § 2.123(k). *Cf.* TBMP § 707.02(c) (Substantive Grounds).

[289] *See Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Donut Shops Management Corporation v. Mace,* 209 USPQ 615 (TTAB 1981); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections in its brief and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977). *See also* TBMP § 707.04 (Waiver of Objection)

[290] *See* 37 CFR § 2.124(d)(1), and TBMP § 703.02(g) (Depositions on Written Questions -- Examination of Witness).

[291] *See* TBMP § 703.02(k) (Depositions on Written Questions – Objections to Deposition).

Because parties that have raised objections to testimony depositions generally will not know the disposition thereof until final decision, they should argue the matters alternatively in their briefs on the case.

707.03(d) Refusal to Answer Deposition Question

When an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. However, a witness may properly refuse to answer a question asking for information that is, for example, privileged or confidential.[292]

If a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by the unwieldy process of adjourning the deposition and applying, under 35 U.S.C. §24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer.[293]

There is no mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition.[294] Accordingly, where the witness in a testimony deposition refuses to answer a particular question; no court action is sought; and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony.[295]

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[292] *See* TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

[293] *See* TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

[294] *See* TBMP §§ 404.02 (Discovery Depositions Compared to Testimony Depositions) and 707.03(c) ([Objections on] Other Procedural Grounds and Substantive Grounds) and authorities cited therein.

[295] *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer's objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer's position); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346 (TTAB 1983); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982); *Data Packaging Corp. v. Morning Star, Inc.,* 212 USPQ 109 (TTAB 1981); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615 (TTAB 1981); *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.,* 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953). *Cf. Land v. Regan*, 342 F.2d 92, 144 USPQ 661 (CCPA 1965). *But see University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983).

For information concerning refusal to answer a discovery deposition question, see TBMP §§ 404.03(a)(2) regarding deposition of nonparty residing in U.S., 404.08(c) (Objections During Deposition), 404.09 (Discovery Depositions Compared to Testimony Depositions), 411.03 (Discovery Depositions [Remedy for Failure to Provide Discovery]), and 523 (Motion to Compel Discovery).

707.04 Waiver of Objection

A party may waive an objection to evidence by failing to raise the objection at the appropriate time.[296]

For example, an objection to a notice of reliance on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted generally should be raised promptly. If a party fails to raise an objection of this nature promptly, the objection may be deemed waived, unless the ground for objection is one that could not have been cured even if raised promptly.[297]

Similarly, an objection to a testimony deposition on the ground that it does not comply with the applicable procedural rules generally is waived if not raised promptly, unless the ground for objection is one which could not have been cured even if raised promptly.[298]

On the other hand, objections to a notice of reliance, or to a testimony deposition, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly.[299]

If testimony is submitted in affidavit form by stipulation of the parties pursuant to 37 CFR §2.123(b), any objection, which is waived if not made at deposition, must be raised promptly after receipt of the affidavit submission, failing which it is waived.[300]

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[296] *See* 37 CFR §§ 2.123(e)(3), 2.123(j), and 2.123(k); Fed. R. Civ. P. 32(d)(1),(2), and (3)(A) and (B); and TBMP §§ 707.02 (Objections to Notices of Reliance) and 707.03 (Objections to Trial Testimony Depositions).

[297] *See* TBMP §§ 707.02(b)(1) (Untimeliness) and 707.02(b)(2) (Other Procedural Grounds) and authorities cited therein.

[298] *See* TBMP §§ 707.03(b)(1) (Untimeliness) and 707.03(c) (On Other Procedural Grounds and on Substantive Grounds) and authorities cited therein.

[299] *See* TBMP §§ 707.02(c) (On Substantive Grounds) and 707.03(c) (On Other Procedural Grounds and on Substantive Grounds) and authorities cited therein.

[300] *See Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389 (TTAB 1985).

If a party fails to attend a testimony deposition, any objection, which is waived if not made at the deposition, is waived.[301]

Additionally, by failing to preserve the objection in its brief on the case, a party may waive an objection that was seasonably raised at trial.[302]

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[301] *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, at 23132, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, at 22; *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 274 (1984).

[302] *See Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977). *See also* TBMP § 707.03(c) (On Other Procedural Grounds and on Substantive Grounds).

801 Briefs on the Case

801.01 In General

After the close of all testimony periods in an inter partes proceeding before the Board, the parties are allowed time in which to file briefs on the case. The brief is a party's "opportunity to present, in a systematic and coherent manner, and in a form which is permanent and can be referred to, a discussion of the facts in light of the law," its strongest affirmative arguments, and a rebuttal of its adversary's arguments.[1]

Subject to Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. However, the facts and arguments presented in the brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence.[2]

For information concerning briefs and oral hearings in ex parte appeals, see TBMP §§ 1203.01 and 1216, respectively.

801.02 Time for Filing

37 CFR § 2.128(a)(1) *The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.*

(2) *When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.*

(3) *When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response*

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[1] *See* David J. Kera, *TIPS FROM THE TTAB: Preparing and Filing Briefs With the Trademark Trial and Appeal Board*, 66 Trademark Rep. 141, 141 (1976).

[2] *See* TBMP §§ 704.05(b) (Exhibits to Briefs) and 704.06(b) (Statements in Briefs) and authorities cited therein.

to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

801.02(a) Plaintiff's Main Brief

The main brief of the party in the position of plaintiff is due not later than 60 days after the date set for the close of the rebuttal testimony period.[3]

If a party in the position of plaintiff fails to file a main brief, the Board may issue an order allowing plaintiff until a set time, not less than 15 days, in which to show cause why its failure to file a main brief should not be treated as a concession of the case. If the plaintiff fails to file a response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff.[4] The purpose of this order to show cause procedure is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board, or where the plaintiff has lost interest in the case. It is the policy of the Board not to enter judgment against a plaintiff, for failure to file a main brief on the case, where the plaintiff, in its response to the show cause order, indicates that it has not lost interest in the case.[5]

For further information concerning the 37 CFR § 2.128(a)(3) order to show cause procedure, see TBMP § 535.

801.02(b) Defendant's Main Brief

The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant.[6]

However, if a party in the position of defendant wishes to file a brief on the case, the brief is due not later than 30 days after the due date of the plaintiff's main brief.[7]

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[3] 37 CFR § 2.128(a)(1).

[4] 37 CFR § 2.128(a)(3). *See CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1998) (opposer's failure to respond to order to show cause under Rule 2.128 resulted in entry of judgment).

[5] *See* TBMP § 536 (Motion for Order to Show Cause Under Rule 2.128(a)(3)) and authorities cited therein.

[6] 37 CFR § 2.128(a)(1). *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

[7] 37 CFR § 2.128(a)(1). *See Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250, 250 (TTAB 1972) (uncontested motion to strike brief filed three weeks after due date granted). *For information on extensions of time, see* TBMP § 509.

801.02(c) Plaintiff's Reply Brief

The filing of a reply brief is optional for a party in the position of plaintiff.[8]

However, if a party in the position of plaintiff wishes to file a reply brief, the brief is due not later than 15 days after the due date of the defendant's main brief.[9]

801.02(d) Reply Brief for Defendant Not Permitted

There is no provision for filing a reply brief, rebuttal brief, rejoinder brief, etc. by a party in the position of defendant. If a party in the position of defendant files such a brief, it may be stricken, or given no consideration, by the Board.[10]

However, if a defendant has counterclaimed to cancel a registration owned by the plaintiff, the defendant, as plaintiff in the counterclaim, may file a reply brief directed to the counterclaim.[11]

801.02(e) Special Situations

In certain special situations, the Board will set, by written action, the due dates for the filing of briefs on the case. This occurs when **(1)** there is a counterclaim, **(2)** proceedings have been consolidated, and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or **(3)** there is an interference or a concurrent use registration proceeding involving more than two parties.[12]

For example, if there is a counterclaim, the Board will issue an order setting the due dates for plaintiff's main brief in the original proceeding (due the 60th day after the date set for the close of rebuttal testimony); defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim (due the 30th day after the due date of the plaintiff's main brief); plaintiff's combined reply brief in the original proceeding and its brief as defendant in the counterclaim (due the 30th day after the due date of defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim); and defendant's

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[8] *See* 37 CFR § 2.128(a)(1), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

[9] *See* 37 CFR § 2.128(a)(1).

[10] *See* TBMP § 539 (Motion to Strike Brief on Case) and cases cited therein.

[11] *See* TBMP § 801.02(e) (Time for Filing – Special Situations).

[12] *See* 37 CFR § 2.128(a)(2).

reply brief as plaintiff in the counterclaim (due the 15th day after the due date of plaintiff's combined reply brief in the original proceeding and brief as defendant in the counterclaim).[13]

In an interference or concurrent use registration proceeding, the Board will schedule briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief in which it may meet the brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief.[14]

801.03 Form and Contents of Brief

37 CFR § 2.128(b) *Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Each brief shall contain an alphabetical index of cases cited therein. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Three legible copies, on good quality paper, of each brief shall be filed.*

A brief on the case must comply with the requirements of 37 CFR § 2.128(b).[15]

The description of the record should comprise a list of the evidence properly introduced by the parties, such as, "The evidence of record consists of opposer's Registration No. 1,234,567; applicant's answers to opposer's interrogatories; the discovery deposition of Mr. X; and the testimony depositions of opposer's witnesses, Mr. Y and Ms. Z." For each significant fact recited, the recitation of facts should include, a citation to the portion of the evidentiary record where supporting evidence may be found.

Without prior leave of the Board, a main brief on the case may not exceed 55 pages in length in its entirety, and a reply brief may not exceed 25 pages in its entirety. The parts of the brief that fall within the length limit include the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary. Extensive single-spaced

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[13] *See the Appendix of Forms for a sample briefing schedule.*

[14] *See* TBMP § 1007 (example of a briefing schedule in an interference proceeding), and TBMP § 1109 (example of a briefing schedule in a concurrent use proceeding). *Cf.* 37 CFR § 2.121(b)(2).

[15] *See also*, *with respect to briefs on the case,* David J. Kera, *TIPS FROM THE TTAB: Preparing and Filing Briefs With the Trademark Trial and Appeal Board*, 66 Trademark Rep. 141 (1976).

footnotes may not be used as a subterfuge to avoid the page limit.[16] Exhibits or appendices to a brief, not being part of the brief itself, are not included within the page limit.[17] In addition, evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit.[18]

For information concerning motions for leave to file a brief exceeding the page limit, *see* 37 CFR § 2.128(b) and TBMP § 537.

The brief must contain an alphabetic index of all cited cases. When cases are cited in a brief, the case citation should include a citation to *The United States Patent Quarterly* (USPQ), if the case has appeared in that publication.

If a mark that is the subject of, or is pleaded in, a proceeding includes stylization or a design feature, a reproduction of the mark should be included in the brief on the case.

If a plaintiff files a reply brief, the brief must be confined to rebutting the defendant's main brief.

801.04 Amicus Briefs

The Board may, in its discretion, entertain an amicus brief.[19] An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. *For information concerning motions for leave to file an amicus brief, see* TBMP § 538.

801.05 Motion to Strike Brief on Case

A party may move to strike a brief on the case on a variety of grounds, including that the brief was untimely filed, exceeds the page limit for a brief on the case, violates the format

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[16] *See Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.,* 23 USPQ2d 1894, 1896 n.3 (TTAB 1992) (warned that single-spaced footnotes containing substantial discussion may be viewed as a subterfuge to avoid page limit).

[17] *See* 37 CFR § 2.128(b); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (raising evidentiary objections in appendices was not viewed as subterfuge to avoid page limit); *United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1543 (TTAB 1994) (motion to file 30-page reply brief denied as unnecessary where main brief was 18 pages and responsive brief was 37 pages), and *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, *supra*.

[18] *See Harjo v. Pro-Football Inc.*, *supra* at 1792 (appropriate evidentiary objections may be raised in appendix or separate paper rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) and *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc., supra*.

[19] *See* TBMP § 538 (Motion for Leave to File Amicus Brief) and authorities cited therein.

requirements for such a brief, is a brief not provided for by the applicable rules (e.g., is a reply brief filed by the defendant). In addition, a party may move to strike evidentiary matter attached to a brief where the evidentiary matter was not properly made of record during the time for taking testimony. *For information concerning motions to strike a brief on the case, or matter attached to such a brief, see* TBMP § 539 and cases cited therein.

802 Oral Hearing

37 CFR § 2.129(a) *If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.*

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives.

802.01 In General

The oral hearing on the case in an inter partes proceeding before the Board corresponds to the oral summation in court proceedings after all the evidence is in.[20]

An oral hearing is optional and is scheduled only if a timely request therefor is filed by a party to the proceeding. The oral hearing provides a party with one last opportunity to emphasize its strongest arguments, and to refute its adversary's arguments. It is particularly useful in cases with complex issues or a complex record, or where the defendant needs to respond to arguments in the plaintiff's reply brief.[21]

Subject to Fed. R. Civ. P. 11, a party is entitled to offer at oral hearing any argument it feels will be to its advantage. However, the facts recited and arguments made at oral hearing must be

[20] *See* 37 CFR § 2.116(f). *For information on oral hearings in ex parte cases, see* TBMP § 1216.

[21] *For information concerning situations in which it may be advisable to request an oral hearing on a case*, *see* Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977).

based on the evidence offered at trial. An oral hearing may not be used as a vehicle for the introduction of evidence.[22]

802.02 Request for Oral Hearing

A party that wishes to have an oral hearing on the case must file a request, by separate paper (not as part of its brief on the case), not later than 10 days after the due date for filing the last reply brief in the proceeding.[23] Any party to the proceeding may request a hearing.

If an oral hearing is not requested, the case will be decided in due course after the due date for filing the last reply brief on the case.

802.03 Time and Place of Hearing

When a timely request for an oral hearing on the case has been filed by a party to an inter partes proceeding before the Board, the Board sets the date and time for the hearing, and sends each party a written notice of hearing specifying the date, time, and location of the hearing.[24] Oral hearings are ordinarily scheduled on Tuesdays, Wednesdays and Thursdays. In setting an oral hearing it is the normal practice of the Board, to telephone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing. A written notice formally scheduling the hearing is mailed.

Oral hearings are almost exclusively held at the offices of the Board. However, there are two off-site video conference centers available for use for oral hearings. The two video conference centers are located in Sunnyvale, California and Detroit, Michigan. To request a hearing by video conference, a party must make the request in its written request for an oral hearing. When a request is received, the Board will contact the off-site video conference centers to obtain available times and dates, as well as the on-site video conference center for tentative scheduling options that coincide with the off-site video conference center. Once the information is obtained, counsel will be contacted and informed of the nearest center location, the available scheduling dates/times and the fee required by the off-site center. The requesting party is responsible for the fee for the off-site center. Once agreement is made on the conference, the Board will secure the hearing centers and provide written notice to the parties.

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[22] *See* 37 CFR § 2.123(l); TBMP § 704.06 (Statements in Pleadings or Briefs); and Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977). *Cf.* TBMP § 801.01 (Briefs on the Case – In General).

[23] *See* 37 CFR § 2.129(a).

[24] *See* 37 CFR § 2.129(a).

Attendance at a scheduled oral hearing is voluntary, not mandatory. If any party appears at the specified time, the party will be heard, whether or not the party that appears is the one that requested the hearing.[25] If a party elects not to attend a scheduled hearing, the party should notify the Board, well in advance of the scheduled hearing date, that it will not attend the hearing.

If a party that requested an oral hearing fails to appear at the appointed time, without giving prior notice to the Board of nonappearance, the failure to appear will be construed by the Board as a withdrawal of the request for an oral hearing. Any new request for an oral hearing will be granted only upon a showing that the failure to appear was occasioned by extraordinary circumstances.

If the Board is prevented from hearing the case at the time specified in the notice of hearing, a new hearing date will be set.[26] The Board will reschedule an oral hearing, at the request of the parties, if there is a reasonable basis for the request. But, absent compelling circumstances, a hearing date will not be changed if the request for rescheduling is made within two weeks of the scheduled hearing date unless both parties agree to the change. When the parties agree to the resetting of an oral hearing, they should determine a new date and time convenient to every party and then contact the Chief Administrative Trademark Judge's secretary by telephone, well prior to the scheduled hearing date, to request that the hearing be reset for the new date and time. The parties should also file a written stipulation or consented motion confirming their agreement. If the parties agree to reset an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations. If agreement cannot be reached, the party that wishes to have the hearing reset should file a motion therefor.[27] However, parties should not file repeated requests to reset an oral hearing. *For information concerning requests to reset an oral hearing, see* TBMP § 541.01

802.04 Before Whom Held

An oral hearing is held before a panel of at least three members of the Board (i.e., its statutory members, generally administrative trademark judges).[28] Normally, an oral hearing panel consists of only three Board members. If for some reason a member of a panel of three that held the oral hearing is unable to participate in the final decision, another Board member may be substituted at

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[25] *See* 37 CFR § 2.129(a).

[26] *See* 37 CFR § 2.129(a).

[27] *See* 37 CFR § 2.129(b).

[28] *See* 37 CFR § 2.129(a). *Cf.* Section 17 of the Act, 15 U.S.C. § 1067; *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 420 n.8 (CCPA 1972) (where only one Board member signed decision, court presumed the proper number participated in decision) and 37 CFR § 2.142(e)(1).

final decision for the missing member, even though the substituted member was not present at the oral hearing; no new oral hearing is necessary.[29]

The Board may, in its discretion, use an augmented panel to hear a case.[30] A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding.[31]

For information concerning motions for an augmented panel hearing, *see* TBMP § 540. *For further information concerning the constitution of Board panels, see In re Alappat,* 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994).

802.05 Length of Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral argument. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal.[32] If there is a counterclaim, the defendant, as the plaintiff in the counterclaim, may also reserve part of its 30 minutes for rebuttal on the counterclaim.

There is no requirement that a party use all of its allotted 30 minutes for oral argument. Often, a case may be presented in considerably less than 30 minutes.

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[29] *See In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1, 3-4 (Fed. Cir. 1985) (statutory requirement that a case be heard "means judicially heard not physically heard"), and *Jockey International, Inc. v. Bette Appel Unltd.*, 216 USPQ 359, 360 (TTAB 1982). *Cf. Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464, 464 (TTAB 1983) (final decision rendered by only two Board members vacated); *Ronson Corp. v. Ronco Teleproducts, Inc.*, 197 USPQ 492, 494 (Comm'r 1978) (final decision heard by three Board judges but rendered by only two, vacated and oral hearing rescheduled); and *Ethicon, Inc. v. American Cyanamid Co.*, 193 USPQ 374, 377 (Comm'r 1977).

[30] *See* TBMP § 540 (Motion for Augmented Panel Hearing) and cases cited therein.

[31] *See, for example, In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992) (augmented panel used to overrule previous decision barring examining attorneys from requesting reconsideration), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (in view of issues presented, oral hearing held before augmented panel of eight Board members); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986) (augmented five-member panel); and *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services). *See also Crocker National Bank v. Canadian Imperial Bank of Commerce,* 223 USPQ 909 (TTAB 1984) (augmented panel of eight members because of the importance of the issues).

Cf. Federal Circuit Rule 35. *Cf. also Fioravanti v. Fioravanti Corrado S.R.L,* 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

[32] *See* 37 CFR § 2.129(a).

On the other hand, if a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time.[33] If the request is granted, each party will be allowed the same amount of time for oral argument. *For information concerning requests or motions for additional time for oral argument, see* TBMP § 541.02.

802.06 Audiotaping and Videotaping

Upon motion showing good cause and with prior arrangement, the Board will usually permit a party to make an audiotape recording of an oral hearing. The recording, when permitted by the Board, is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board). The motion should be filed well in advance of the date set for the oral hearing, so if an objection is raised, the Board will have time to rule on the matter. *For information concerning motions for leave to audiotape an oral hearing*, *see* TBMP § 542.

If permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audio taping equipment in an unobtrusive manner.

A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, *an oral hearing before the Board may not be videotaped.*[34]

802.07 Visual Aids, etc.

The Board will generally allow certain types of materials, such as graphs, large depictions of marks, schedules, charts, etc., to be used at oral hearing, either for clarification or to eliminate the need for extended description, when such materials are based on evidence properly of record.[35]

A party may also bring to the oral hearing any materials introduced as exhibits at trial, including audiotapes or videotapes of commercials or demonstrations. A party that introduced an audiotape or videotape as an exhibit at trial, and wishes to play it at the oral hearing, should notify the Board in advance. In addition, a party that wishes to play such a tape at oral hearing is

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[33] *See* 37 CFR § 2.129(a); TBMP § 541.02 (Motion for Additional Time for Oral Argument) and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1981) (additional time for arguments allowed in view of voluminous record).

[34] *See* TBMP § 542.

[35] *See Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.5 (TTAB 1990).

responsible for furnishing, operating, and removing the necessary equipment in an unobtrusive manner.

A party may not, however, use an oral hearing for the purpose of offering new evidence, whether in the form of charts, graphs, exhibits, or other such materials.[36] Nor may a party submit in writing the text of its oral argument; to allow such a practice would be to permit a party, in effect, to file an additional brief on the case.[37]

802.08 Nature of Hearing

Prior to an oral hearing, the Board panel members read the briefs on the case and, if necessary, examine the case files. Thus, persons presenting oral arguments should not read from the briefs on the case, except to emphasize an admission contained in an adversary's brief.

Normally, an oral hearing case is not assigned to a particular Board member to draft a final decision until some time after the oral hearing. Thus, the Board member who sits in the middle of the panel of three is not necessarily the person to whom the case will be assigned for decision; rather, the middle panel member is usually (but not always) the senior panel member.

A person presenting oral arguments should be prepared to answer questions from Board panel members at any point in the arguments. If exhibits or visual aids have been brought to the oral hearing, they should be shown to the adversary before they are shown to the Board panel. Further, a person presenting oral arguments should never interrupt the oral arguments of the adversary.

For further information on how to argue a case before the Board, *see* Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board,* 67 Trademark Rep. 283 (1977).

803 Final Decision

After an oral hearing has been held in a Board inter partes proceeding, the case is set down for final decision. If no oral hearing is requested, the case is set down for final decision after the due date for filing the last reply brief.

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[36] *See* TBMP § 802.01 (Oral Hearing – In General) and authorities cited therein.

[37] *See Reflange Inc. v. R-Con International*, *supra*.

A panel of at least three Board members renders the final decision.[38] When there has been an oral hearing in a case, the final decision normally is rendered by the panel before which the oral hearing was held. If a member of a panel of three before which an oral hearing was held is unable to participate in the final decision, another Board member may be substituted at final decision for the missing member.[39]

The Board may use an augmented panel at final decision. *For information concerning the use of an augmented panel, see* TBMP § 540. *For further information concerning the constitution of Board panels, see In re Alappat,* 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

Every member of the panel assigned to decide the case does not read the evidentiary record in a case. Rather, one panel member is assigned to read the testimony and examine the other evidence of record, discuss the case with the other panel members, and then draft a decision and supporting opinion. The draft is circulated to the other panel members for their approval and signature. A panel member who does not agree with the decision may write a dissent. A panel member who agrees with the decision, but disagrees with the reasoning expressed in the opinion supporting the decision, or wishes to express additional reasons, may write a concurring opinion.

When the members of the panel rendering the decision have signed a final decision, a copy is mailed to every party to the proceeding. All final decisions are posted on the USPTO web site as final decisions of the TTAB. The decisions are grouped first by year decided and then by issues. Within the groupings of issues, the decisions are listed by proceeding number.

Section 21 of the Trademark Act, 15 U.S.C. § 1071, and 37 CFR § 2.145 govern any appeal from a final decision of the Board.[40]

804 Request for Rehearing, Reconsideration, or Modification of Final Decision

A party may file a request for rehearing, reconsideration, or modification of a decision issued after final hearing.[41] The request must be filed within one month from the date of decision and a responsive brief, if any, is due within 15 days of the date of service of the request. *For*

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[38] *See* Section 17 of the Act, 15. U.S.C. § 1067. *See also* TBMP § 802.04 (Oral Hearing – Before Whom Held) and cases cited therein.

[39] *See* TBMP § 802.04 and cases cited therein.

[40] *See* TBMP Chapter 900 *regarding appeals.*

[41] *See* 37 CFR § 2.129(c).

information concerning requests for rehearing, reconsideration, or modification of a decision issued after final hearing, *see* TBMP § 543.

805 Final Decision Remand to Examining Attorney

37 CFR § 2.131 Remand after decision in inter partes proceeding.
If, during an inter partes proceeding, facts are disclosed which appear to render the mark of an applicant unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may refer the application to the examiner for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon receiving the application, the examiner shall withhold registration pending reexamination of the application in the light of the reference by the Board. If, upon reexamination, the examiner finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

If, during the course of an opposition, concurrent use, or interference proceeding, facts are disclosed which appear to render the subject mark of an involved applicant unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to Fed. R. Civ. P. 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, remand the application to the Trademark Examining Attorney for further examination in light of the disclosed facts. That is, the Board may include in its decision a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the Examining Attorney reexamine the application in light of the disclosed facts.[42]

If a party to an opposition, concurrent use, or interference proceeding believes that the facts disclosed therein appear to render the subject mark of an involved application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR § 2.131 remand to the Examining Attorney. The request may be made in the party's brief on the case, or by separate motion.

806 Termination of Proceeding

When an inter partes proceeding before the Board has been finally determined (that is, when the time for filing an appeal from a decision of the Board determining the case has expired, and no

[42] *See* 37 CFR § 2.131 and TBMP § 515 (Motion to Remand Application to Examining Attorney) and cases cited therein. *Cf.* TBMP § 1217 (Final Decision).

appeal has been filed, or when any appeals filed have been determined), the Board takes certain further steps, based on the judgment entered, to close out the proceeding file and give effect to the judgment.[43] The same is true when a proceeding ends by stipulation of the parties, or by a voluntary withdrawal or consent to judgment by one party.

For example, when a decision of the Board dismissing an opposition becomes final (that is, the time for filing an appeal has expired, and no appeal has been filed), or the opposition is dismissed pursuant to a stipulation of the parties or as the result of a withdrawal by opposer, among other things, the Board normally takes the following steps:

(1) The testimony depositions, any discovery depositions made of record in the case, and one copy of each brief on the case (that is, materials which, because of their bulkiness, would not have been kept by the Board in the proceeding file), are all placed in the proceeding file. The two extra copies of each brief are discarded.

(2) The word "TERMINATED" is stamped on the proceeding file.

(3) The proceeding file is sent to the USPTO warehouse where terminated proceeding files are stored.

(4) Exhibits, which, because of their size, were too bulky to put in the proceeding file, and therefore were stored separately by the Board, are returned to the party that filed them.

(5) Confidential materials filed under protective order are returned to the party that filed them.

(6) The applicant's subject application is sent to the appropriate section of the USPTO for further appropriate action, such as, issuance of a notice of allowance under 37 CFR § 2.81(b), in an intent-to-use application for which no amendment to allege use under 37 CFR § 2.76 has been submitted and accepted; issuance of a registration pursuant to 37 CFR § 2.81(a); republication, if necessary for some reason; or reexamination by the Trademark Examining Attorney pursuant to a 37 CFR § 2.131 remand.[44] Alternatively, if the applicant has abandoned the subject application, the abandoned application is sent to the USPTO warehouse where newly abandoned applications are stored (pending their destruction approximately two years after abandonment).

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[43] *See* Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34896, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 34.

[44] *See* TBMP § 805 (Final Decision Remand to Examining Attorney).

When a decision of the Board granting a petition for cancellation becomes final, the first five steps listed above are taken, and the subject registration is cancelled by separate order of the Director. When a decision of the Board dismissing a petition for cancellation becomes final, the first five steps are taken, and the file of the registration is returned to the USPTO warehouse where "live" (subsisting) registrations are stored.

Because the Board will take the termination steps described above when a Board decision appears to be final, a party that commences a civil action, seeking review of the Board's decision pursuant to Section 21(b) of the Act, 15 U.S.C. § 1071(b), must file written notice thereof in the USPTO, addressed to the Board, within one month after the expiration of the time for appeal or civil action.[45] If a party files a civil action, but fails to notify the Board, the Board, believing that its decision has become final, will terminate the proceeding. As a result, a registration may be issued or cancelled prematurely, while the civil action seeking review of the Board's decision is still pending.

807 Status of Application After Proceeding

37 CFR § 2.136 Status of application on termination of proceeding.
On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.

When an opposition, concurrent use or interference proceeding ends with a judgment which is not adverse to an involved applicant, the application returns to the status it had before commencement of the proceeding, unless the Board indicates in its decision that the application must be republished for some reason, or includes in its decision a 37 CFR § 2.131 remand to the Trademark Examining Attorney.[46]

If the proceeding ends with a judgment that is adverse to the applicant, the application stands refused, the file thereof is stamped "ABANDONED," and all proceedings are considered terminated.[47]

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[45] *See* 37 CFR § 2.145(c)(4).

[46] *See* TBMP § 805 (Final Decision Remand to Examining Attorney) and 37 CFR § 2.136.

[47] *See* 37 CFR § 2.136; *Forest Laboratories Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1060 n.3 (TTAB 1999) (if opposition is sustained, application is deemed abandoned); and *In re Vesper Corp.*, 8 USPQ2d 1788, 1789 (Comm'r 1988) (there is no authority for the Commissioner to reopen an application for entry of an amendment after a successful opposition). *See also National Patent Development Corp. v. Hercules Inc.*, 192 USPQ 491, 492 (Comm'r 1976) (Commissioner refused to reopen application for motion to amend after adverse final judgment in opposition).

901 Appeals--In General

15 U.S.C. § 1071 [Section 21(a)(1) of the Trademark Act] Review of Director's or Trademark Trial and Appeal Board's Decision

(a)*(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.*

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

* * * *

(b)*(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).*

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

* * * *

37 CFR § 2.145 Appeal to court and civil action.

(a) Appeal to U.S. Court of Appeals for the Federal Circuit. *An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. . . .*

* * * *

(c) Civil Action.

(1) Any person who may appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. Such civil action must be commenced within the time specified in paragraph (d) of this section.

(2) Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Director within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.

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(d) Time for appeal or civil action.

(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or § 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons

and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

* * * *

901.01 Avenues of Appeal

A party to a Board proceeding who is dissatisfied with the decision of the Board is provided, under the Act, with two possible (mutually exclusive) remedies. The dissatisfied party may either:

(1) Appeal to the United States Court of Appeals for the Federal Circuit, which will review the decision from which the appeal is taken on the record before the USPTO, or

(2) Have remedy by civil action (in a United States District Court), in which the court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear."[1]

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[1] *See* Section 21 of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145. *See also CAE Inc. v. Clean Air Engineering Inc.,* 60 USPQ2d 1449, 1458 (7th Cir. 2001) (choice of appealing to Federal Circuit on closed record of Board proceedings or a federal district court with the option of presenting additional evidence and raising additional claims); *Spraying Systems Co. v. Delavan Inc.,* 975 F.2d 387, 24 USPQ2d 1181, 1183 (7th Cir. 1992) (appeal to district court is in part an appeal and in part a new action); and *Alltrade Inc. v. Uniweld Products Inc.,* 946 F.2d 622, 20 USPQ2d 1698, 1703 (9th Cir. 1991) (where winning and losing party each appealed to different district court; discussion of appealability of those aspects of a ruling with which "winning" party is dissatisfied, and dismissal, stay or transfer of second-filed appeal).

In an inter partes proceeding, if a dissatisfied party chooses to file an appeal to the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file notice that it elects to have the appeal dismissed, and to have further proceedings conducted instead by way of civil action.[2] Within 30 days after the filing of a notice of election by an adverse party, the appellant must commence a civil action for review of the Board's decision, failing which the Board's decision will govern further proceedings in the case.[3]

For a discussion of forum selection considerations, see Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board,* 75 Trademark Rep. 323, 400-405 (1985).

901.02 What May be Appealed

901.02(a) Final Decision Versus Interlocutory Decision

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a final dispositive ruling that ends litigation on the merits before the Board.[4]

Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable.[5]

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[2] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145(c)(3).

[3] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145(d)(3).

[4] *See R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 1005, 204 USPQ 195, 197 (CCPA 1979) (the word "decision" in the statute means "final decision") and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) (same).

[5] *See Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (where Board granted partial summary judgment dismissing allegation of misuse of registration symbol but denied summary judgment on other potentially dispositive ownership and consent issues, appeal was premature since appealed issues did not result in a disposition of the case). *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 n.2 (Fed. Cir. 1988) (ordinarily denial of summary judgment is interlocutory and not appealable except where, as in this case, the decision was a final decision of dismissal [i.e., the Board, in effect, entered judgment in favor of nonmoving party]); *Parker Brothers v. Tuxedo Monopoly, Inc.*, 757 F.2d 254, 226 USPQ 11, 11 (Fed. Cir. 1985) (order denying summary judgment was interlocutory and thus non-final and non-appealable); and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) ([Director] is without jurisdiction to certify an order to the Federal Circuit and court is without jurisdiction to hear it).

Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board.[6]

On the other hand, if the Board resolves a merits issue prior to final hearing, but other merits issues remain, that is, the litigation is still before the Board as a whole, the Board's decision on the merits issue is interlocutory, rather than final, for purposes of judicial review. For example, in a case in which there is a counterclaim, if the Board grants summary judgment only as to the counterclaim, the case is not ripe for appeal until there has been a final decision with respect to the original claim; similarly, if the Board grants summary judgment only as to the original claim, the case is not ripe for appeal until there has been a final decision with respect to the counterclaim.[7] When the Board, prior to final hearing, issues a decision resolving one or more, but not all, of the merits issues in a case before it, it is the usual practice of the Board to include in its decision the following statement: "This decision is interlocutory in nature. Appeal may be taken within two months after the entry of a final decision in the case."[8]

When an appeal is taken from a decision of the Board, it is the court to which an appeal is taken, not the Board, which determines whether the involved decision is appealable, that is, whether the court has jurisdiction to entertain the appeal.[9]

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[6] *See, e.g., Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1711 (Fed. Cir. 1991) (decision denying reconsideration of Board's order dismissing opposition for failure to prosecute was reviewable); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1477 (Fed. Cir. 1990) (decision granting summary judgment was reviewable); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, *supra* (denial of motion for summary judgment where it resulted in judgment against moving party was reviewable); *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 422 (CCPA 1976) (decision granting motion to dismiss for failure to state a claim is reviewable); and *Williams v. Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744, 745 (CCPA 1975) (decision denying petitioner's 60(b) motion to vacate earlier decision granting respondent's uncontested motion for summary judgment was reviewable).

[7] *See Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589, 1594 and n.4 (TTAB 1992) (decision granting opposer's motion for summary judgment on counterclaim and denying opposer's motion for partial summary judgment in the opposition was not appealable) and *Interlocutory Decisions by the Trademark Trial and Appeal Board*, 1123 TMOG 36 (February 19, 1991). *See also Copelands' Enterprises Inc. v. CNV Inc.*, *supra* at 1565 (appeal of order granting partial summary judgment was premature).

[8] *See, e.g., Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1896 n.17 (TTAB 1998); *Interlocutory Decisions by the Trademark Trial and Appeal Board, supra*, and *Procter & Gamble Co. v. Sentry Chemical Co., supra* at 1594 n.4.

[9] *See R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 204 USPQ 195, 197 n.3 (CCPA 1979) (following Board's denial of motion for summary judgment on issue of res judicata, Board's attempt to "certify" an interlocutory decision as appealable given no effect in Court's determination of whether it had jurisdiction over the appeal), and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, *supra* ([Director] has no statutory authority to "certify" interlocutory orders of the Board for appeal). *See also*, *with respect to jurisdiction to entertain an appeal*, *Alltrade Inc. v. Uniweld Products Inc.*, *supra*.

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case.[10]

A party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely petition to the Director.[11] A party may also file a request with the Board for reconsideration of such an order or decision.[12]

The mandamus procedure may not be used as a substitute for the appeal procedure specified in Section 21 of the Act, 15 U.S.C. § 1071.[13]

901.02(b) Judgment Subject to Establishment of Constructive Use

In an inter partes proceeding before the Board, no final judgment will be entered in favor of an applicant under Section 1(b) of the Act, 15 U.S.C. § 1051(b), before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Section 7(c) of the Act, 15 U.S.C. §1057(c).[14] Rather, in those cases where the Board finds that a Section 1(b) applicant is entitled to prevail only if it establishes constructive use, the Board will enter judgment in favor of that applicant, subject to the applicant's establishment of constructive use.[15] If, after entry of that judgment, the Section 1(b)

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[10] *See Questor Corp. v. Dan Robbins & Associates, Inc.,* 199 USPQ 358 (TTAB 1978), *aff'd sub nom.*, 202 USPQ 100, 104 (CCPA 1979) (denial of motion to strike deposition as untimely filed was a purely procedural issue not a decision sufficiently related to the merits of the appealable issues); and *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971) (Board's decision to deny applicant's motion to amend description of services not logically related to the "jurisdiction-giving issues" in the case*, i.e.*, the issues of likelihood of confusion and laches, and not reviewable).

[11] *See Palisades Pageants, Inc. v. Miss America Pageant, supra; and* TBMP § 905 (Petition to the Director), and authorities cited therein.

[12] *See* TBMP § 518 (Motion for Reconsideration).

[13] *See Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 646 (CCPA 1979), *cert. denied*, 442 U.S. 917, 202 USPQ 159 (1979) (stating that this is particularly true where the issue involves jurisdictional questions that Board is competent to decide and that are reviewable in the regular course of appeal).

[14] *See* Sections 21(a)(4) and 21(b)(1) of the Act, 15 U.S.C.§§ 1071(a)(4) and 1071(b)(1).

[15] *See* 37 CFR § 2.129(d). *See also Larami Corp. v. Talk To Me Programs Inc.,* 36 USPQ2d 1840, 1844 (TTAB 1995) (constructive use provision of Section 7(c) interpreted differently in Board cases involving right to register and civil actions, such as infringement action, involving a party's right to use a mark); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

applicant files an acceptable statement of use, and obtains a registration, thus establishing its constructive use, final judgment will be entered in behalf of the Section 1(b) applicant. If, on the other hand, the Section 1(b) applicant fails to establish constructive use, that is, fails to file an acceptable statement of use and obtain a registration, judgment will instead be entered in favor of the adverse party.

When the Board enters judgment in favor of a Section 1(b) applicant subject to that party's establishment of constructive use, the time for filing an appeal or commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use.[16]

902 Appeal to Court of Appeals for the Federal Circuit

902.01 Notice of Appeal

15 U.S.C. § 1071(a)(2) [Section 21(a)(2) of the Trademark Act] *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

37 CFR § 2.145 Appeal to court and civil action.

(a) Appeal to U.S. Court of Appeals for the Federal Circuit. *An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:*

(1) In the Patent and Trademark Office give written notice of appeal to the Director (see paragraphs (b) and (d) of this section);

(2) In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.

(b) Notice of appeal.

(1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Director, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this

[16] *See* 37 CFR § 2.129(d) and *Zirco Corp. v. American Telephone and Telegraph Co.*, *supra.*

section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(2) In inter partes proceedings, the notice must be served as provided in § 2.119.

(3) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel as provided in § 104.2.

37 CFR § 104.2 Address for mail and service; telephone number.

(a) *Mail under this part should be addressed to:*

General Counsel, United States Patent and Trademark Office
P.O. Box 15667
Arlington, VA 22215.

(b) *Service by hand should be made during business hours to the:*

Office of the General Counsel
Crystal Park Two Suite 905
2121 Crystal Drive
Arlington, Virginia.

(c) *The Office of the General Counsel may be reached by telephone at 703-308-2000 during business hours.*

A party taking an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board must give written notice thereof both to the Director and to the Court of Appeals for the Federal Circuit, and pay to the Court the fee required by the Court's rules.[17]

Specifically, the original notice of appeal must be filed in the USPTO, within the time required by 37 CFR § 2.145(d) (*see* TBMP § 902.02).[18] The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for filing a notice of appeal. The notice must specify the party or parties taking the appeal and designate the decision or part thereof appealed from. However, reasons for appeal need not be given.[19] A copy of the decision being appealed, and a copy of any

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[17] *See* 37 CFR §§ 2.145(a) and 2.145(b), and Fed. Cir. R. 15. (The Federal Circuit Rules and Forms can be found on the Court's website at: www.fedcir.gov.)

[18] *See* Section 21(a)(2) of the Act, 15 U.S.C. § 1071(a)(2); 37 CFR §§ 2.145(a) and 2.145(b)(1).

[19] *See* 37 CFR § 2.145(b)(1).

decision on reconsideration thereof, should be attached to the notice of appeal.[20] If the appeal is taken from a decision of the Board in an inter partes proceeding, a copy of the notice must be served on every other party to the proceeding, in the manner prescribed in 37 CFR § 2.119 (*see* TBMP § 113).[21] The written notice, if mailed to the USPTO (rather than hand-delivered to the Office of the General Counsel), must be addressed to General Counsel, United States Patent and Trademark Office, P.O. Box 15667, Arlington, VA 22215.[22]

For information concerning the ways (i.e., by hand delivery, first-class mail, etc.) in which a notice of appeal may be filed in the USPTO, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the USPTO, see 37 CFR §§ 1.1(a)(3), 1.6, 1.8, 1.10, and 2.145(b)(3); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990) (NOTE: the 1990 Official Gazette notice must be read in light of subsequent rule amendments--for example, the 37 CFR § 1.8 certificate procedures are now applicable to a notice of appeal from a decision of the Board, but were not in 1990).

For further information concerning how to file a notice of appeal, contact the Office of the General Counsel in the USPTO.

Three copies of the notice of appeal must be filed in the Court of Appeals for the Federal Circuit (NOTE: while 37 CFR § 2.145(a) requires the filing of only one copy of the notice with the Federal Circuit, Fed. Cir. R. 15(a)(1) requires that three copies of the notice be filed with the Federal Circuit), and the appeal fee required by the rules of the Court must be paid to the Court.[23] A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the copy of the notice.[24]

902.02 Time for Filing Notice of Appeal, Cross-Appeal

15 U.S.C. § 1071(a)(2) [Section 21(a)(2) of the Trademark Act] *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

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[20] *See Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[21] *See* 37 CFR § 2.145(b)(2).

[22] *See* 37 CFR §§ 1.1(a)(3)(i) and 104.2.

[23] *See* 37 CFR § 2.145(a).

[24] *See* Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). *See also* the website for the Court of Appeals for the Federal Circuit at: www.fedcir.gov.

37 CFR § 2.145(d) Time for appeal or civil action.

(1) *The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires* ***(i)*** *14 days after service of the notice of appeal or the summons and complaint; or* ***(ii)*** *two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.*

(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

37 CFR § 2.145(e) Extensions of time to commence judicial review. *The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit is two months from the date of the Board decision which is the subject of the appeal.[25] When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. § 1051(b), applicant subject to that party's establishment of constructive use (*see* TBMP § 901.02(b)), the time for filing an appeal runs from the date of the entry of judgment subject to establishment of constructive use.[26]

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[25] *See* Section 21(a)(2) of the Act, 15 U.S.C. § 1071(a)(2); 37 CFR § 2.145(d)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[26] *See* 37 CFR § 2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§ 2.127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for filing an appeal expires two months after action on the request.[27]

In an inter partes case, the time for filing a notice of cross-appeal expires (1) 14 days after service of the notice of appeal, or (2) two months from the date of the Board decision which is the subject of the appeal, whichever is later.[28]

The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for filing a notice of appeal or a notice of cross-appeal.

If a written request to extend the time for appeal is filed before the expiration of the appeal period, the Director may grant the request on a showing of good cause. If the request is not filed until after the expiration of the appeal period, the Director may grant the request only on a showing that the failure to act was the result of excusable neglect.[29] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor.[30]

It is the Director, not the Board, who determines whether a notice of appeal has been timely filed. If the Director determines that a notice of appeal was not timely, the Director notifies the Clerk of the Federal Circuit thereof. The Clerk in turn issues an order to the appellant to show cause why the appeal should not be dismissed, and refers appellant's response to the Court.[31]

An appellant which has received an order to show cause from the Clerk of the Federal Circuit may file a request under 37 CFR § 2.145(e) for an extension of time to file an appeal, accompanied by a showing that the late filing of the notice of appeal was the result of excusable neglect. The request should be filed in the Office of the Solicitor, which will notify the Clerk of the court of the Director's decision on the request.

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[27] *See* 37 CFR § 2.145(d)(1).

[28] *See* 37 CFR § 2.145(d)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[29] *See* 37 CFR § 2.145(e), and *Appeals to the Federal Circuit From PTO*, *supra*.

[30] *See Appeals to the Federal Circuit From PTO, supra*.

[31] *See* Fed. Cir. R. 15(b)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

902.03 Appeal to Federal Circuit Waives Appeal by Civil Action

A party which takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board thereby waives its right to have remedy by way of civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b).[32]

However, in an inter partes case, if an adverse party, in response to the notice of appeal to the Federal Circuit, files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case.[33]

902.04 Notice of Election to Have Review by Civil Action

15 U.S.C. § 1071(a)(1) [Section 21(a)(1) of the Trademark Act] *An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.*

37 CFR § 2.145(c)(3) *Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Director within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.*

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[32] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act), and 37 CFR § 2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act). *Cf.* Section 21(b)(1) of the Act, 15 U.S.C. § 1071(b)(1) (party dissatisfied with decision of Board may, unless appeal has been taken to the Federal Circuit, have remedy by civil action), and TBMP § 903.05 (Information Concerning Times Specified in 37 CFR § 2.145)

[33] *See* TBMP §§ 901.01 (Avenues of Appeal) and 902.04 (Notice of Election).

* * * *

(d)(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

When a defeated party in an inter partes proceeding before the Board takes an appeal to the United States Court of Appeals for the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file a notice with the Director electing to have all further proceedings conducted by way of civil action, under Section 21(b) of the Act, 15. U.S.C. § 1071(b), seeking review of the decision which was the subject of the appeal.[34] The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for filing a notice of election. A copy of the notice must be served on every other party to the proceeding, in the manner prescribed in 37 CFR § 2.119 (*see* TBMP § 113).[35] A copy of the notice must also be filed with the Federal Circuit.[36]

If an adverse party files a notice electing to have further proceedings conducted by way of civil action under Section 21(b) of the Act, the appeal to the Federal Circuit will be dismissed, (see Fed. Cir. R. 15(e)) and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case.[37] Any cross-action must be filed within 14 days after service of the summons and complaint in the civil action.[38]

902.05 Information Concerning Times Specified in 37 CFR § 2.145

37 CFR §2.145(d)(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of*

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[34] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1), and 37 CFR § 2.145(c)(3).

[35] *See* 37 CFR § 2.145(c)(3).

[36] *See* Fed. Cir. R. 15(e).

[37] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1), and 37 CFR § 2.145(d)(3).

[38] *See* 37 CFR § 2.145(d)(3).

Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

In 37 CFR § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for filing an appeal falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for filing an appeal is extended to the next day which is not a Saturday, Sunday, or Federal holiday.[39]

902.06 Certified List

15 U.S.C. § 1071(a)(3) [Section 21(a)(3) of the Trademark Act] *The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.*

When notice is filed in the USPTO of an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the Director sends to the Federal Circuit a statement indicating whether the notice of appeal was considered timely filed, and a certified list of the documents comprising the record in the USPTO, i.e., a certified copy of the list of docket entries on the file jacket containing the USPTO record of the proceeding accompanied by a copy of the decision appealed.[40] A copy of the certified list is mailed by the USPTO to every party to the proceeding.[41]

When the Federal Circuit receives the notice of appeal and the certified list, the Court dockets the appeal, and gives notice to all parties of the date of docketing.[42] The appellant's time in which to file its initial brief runs from the date of service of the certified list or the date of docketing the appeal, whichever is later. Because an appeal is not docketed until after the

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[39] 37 CFR § 2.145(d)(2).

[40] *See* Section 21(a)(3) of the Act, 15 U.S.C. § 1071(a)(3); Fed. Cir. R. 15(b)(1) and 17(b)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[41] *See* Fed. Cir. R. 17(c) and *Appeals to the Federal Circuit From PTO, supra*.

[42] *See* Fed. Cir. R. 15(b)(1), and *Appeals to the Federal Circuit From PTO*, *supra.*

certified list is served in appeals from Board decisions, the appellant's time for filing its brief normally runs from the date of docketing.[43]

902.07 Appeal Briefs, Appendix, etc.

For information concerning other matters of practice and procedure during an appeal to the United States Court of Appeals for the Federal Circuit from a Board decision, including information concerning motions, briefs, the appendix to the briefs, oral argument, etc., see Federal Circuit Rules and Appeals to the Federal Circuit From PTO, 1120 TMOG 22 (November 13, 1990).

For information concerning the appendix to the briefs, in particular, see Fed. Cir. R. 30 and 32, and Appeals to the Federal Circuit From PTO, supra at 25. All of the information is also available on the court's website at www.fedcir.gov.

902.08 Special Provisions for Ex Parte Cases

15 U.S.C. § 1071(a)(3) [Section 21(a)(3) of the Trademark Act] ... *In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.*

37 CFR § 2.145(c)(2) *Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under § 21(b) of the Act.*

If an applicant in an ex parte case takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the applicant thereby waives its right to proceed by way of civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b).[44]

On appeal to the Federal Circuit in an ex parte case, the Director files a brief in support of the Board's decision.[45]

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[43] *See* Fed. Cir. R. 31(a), and *Appeals to the Federal Circuit From PTO, supra*.

[44] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1), and 37 CFR § 2.145(c)(2).

[45] *See* Section 21(a)(3) of the Act, 15 U.S.C. § 1071(a)(3).

903 Appeal by Civil Action

903.01 Notice of Civil Action

37 CFR § 2.145(c)(4) *A party to a proceeding before the Trademark Trial and Appeal Board which commences a civil action, pursuant to Section 21(b) of the Act, seeking review of a decision of the Board should file written notice thereof in the Patent and Trademark Office, addressed to the Board, within one month after the expiration of the time for appeal or civil action, in order to avoid premature termination of the Board proceeding.*

A party which commences a civil action, under Section 21(b) of the Act, 15 U.S.C. § 1071(b) seeking review of a decision of the Board should file written notice thereof in the USPTO, addressed to the Board, within one month after the expiration of the time for appeal or civil action. Failure to notify the Board of the commencement of the civil action may result in premature termination of the proceeding by the USPTO. *See* 37 CFR § 2.145(c)(4). That is, if the Board is unaware of the commencement of the civil action, it will treat the Board's decision as governing further proceedings in the case, and will take steps, based on the judgment entered in that decision, to close out the proceeding file and give effect to the judgment. *See* TBMP § 806.

903.02 Parties to and Service of Civil Action

15 U.S.C. § 1071(b) [Section 21(b) of the Trademark Act]

* * * *

(2) *The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.*

(3) *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. . . .*

(4) *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. . . .*

When a party to a Board inter partes proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, the Director shall not be made a party to the civil

action. However, the clerk of the court in which the civil action is filed must notify the Director of the filing of the complaint, and the *Director* has the right to intervene in the action.[46]

The suit may be instituted against the party in interest as shown by the records of the USPTO at the time of the decision of which review is sought, but any party in interest may become a party to the action.[47]

When an applicant in an ex parte proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, a copy of the complaint must be served on the Director (who is a party to the proceeding).[48] Service of a complaint on the Director is governed by Fed. R. Civ. P. 4(i), "Serving the United States, Its Agencies, Corporations, Officers, or Employees."[49]

903.03 Place of Civil Action

15 U.S.C. § 1071(b)(4) [Section 21(b)(4) of the Trademark Act] *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.*

Generally, a civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b), may be brought in any Federal district court which has jurisdiction over the person. However, if there are adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia has jurisdiction.[50]

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[46] *See* Section 21(b)(2) of the Act, 15 U.S.C. § 1071(b)(2).

[47] *See* Section 21(b)(4) of the Act, 15 U.S.C. § 1071(b)(4).

[48] *See* Section 21(b)(3) of the Act, 15 U.S.C. § 1071(b)(3).

[49] *See also* 37 CFR § 104.2.

[50] *See* Section 21(b)(4), 15 U.S.C. § 1071(b)(4); *Pro-Football Inc. v. Harjo,* 57 USPQ2d 1140, 1141-42 (D.D.C. 2000) (U.S. District Court of the District of Columbia has jurisdiction where defendants reside in plurality of districts not within the same state); *Del-Viking Productions Inc. v. Estate of Johnson*, 31 USPQ2d 1063, 1064 (W.D.Pa. 1994) (civil action improperly brought in Pennsylvania was transferred to U.S. District Court for the District of Columbia in view of existence of multiple adverse parties residing in different states); and Saul Lefkowitz

903.04 Time for Filing Civil Action, Cross-Action

15 U.S.C. § 1071(b)(1) [Section 21(b)(1) of the Trademark Act] *Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. . . .*

37 CFR § 2.145(d) Time for appeal or civil action.
(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires ***(i)*** *14 days after service of the notice of appeal or the summons and complaint; or* ***(ii)*** *two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

* * * *

(e) Extensions of time to commence judicial review. *The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for commencing a civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b), is two months from the date of the Board decision of which review is sought.[51] A civil action is

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and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 405-407 (1985).

Cf. regarding application of "first to file" rule, Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698, 1703 (9th Cir. 1991) (district court erred in dismissing rather than staying second-filed suit), and, *regarding the transfer of an action to a different forum, Chocoladefabriken Lindt & Sprungli Aktiengesellschaft v. Rykoff-Sexton Inc.*, 24 USPQ2d 1236, 1238 (S.D.N.Y. 1992) (civil action filed in New York transferred to California where defendant's witnesses and relevant documents and records were located).

[51] *See* Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1); 37 CFR § 2.145(d)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

commenced by the filing of a complaint with the court.[52] When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. § 1051(b), applicant subject to that party's establishment of constructive use (*see* TBMP § 901.02(b)), the time for commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use.[53]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§ 2 .127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for commencing a civil action expires two months after action on the request.[54]

In an inter partes case, the time for filing a cross-action expires (1) 14 days after service of the summons and complaint, or (2) two months from the date of the Board decision which is the subject of the civil action, whichever is later.[55]

If a written request to extend the time for commencing a civil action is filed before the expiration of the period for commencing a civil action, the Director may grant the request on a showing of good cause. If the request is not filed until after the expiration of the period for commencing a civil action, the Director may grant the request only on a showing that the failure to act was the result of excusable neglect.[56] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor.[57]

903.05 Information Concerning Times Specified in 37 CFR § 2.145

37 CFR § 2.145(d)(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of*

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[52] *See* Fed. R. Civ. P. 3.

[53] *See* 37 CFR § 2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

[54] *See* 37 CFR § 2.145(d)(1).

[55] *See* 37 CFR § 2.145(d)(1).

[56] *See* 37 CFR § 2.145(e). *Cf. Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[57] *Cf. Appeals to the Federal Circuit From PTO, supra*.

Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

In 37 CFR § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for commencing a civil action falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for commencing a civil action is extended to the next day which is not a Saturday, Sunday, or Federal holiday.[58]

903.06 Civil Action Precluded by Appeal to Federal Circuit

In a proceeding before the Board, a party which is dissatisfied with the decision of the Board may have remedy by way of civil action, *unless* an appeal to the United States Court of Appeals for the Federal Circuit has been taken.[59]

However, in an inter partes case, if an appeal has been taken to the Federal Circuit, and a party adverse to the appellant files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case.[60]

903.07 Special Provisions for Ex Parte Cases

15 U.S.C. § 1071(b)(3) [Section 21(b)(3) of the Trademark Act] *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.*

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[58] 37 CFR § 2.145(d)(2).

[59] *See* Section 21(b)(1) of the Act, 15 U.S.C. § 1071(b)(1). *Cf.* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act); 37 CFR § 2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act); and TBMP § 902.03 (Appeal to Federal Circuit).

[60] *See* TBMP §§ 901.01 (Avenues of Appeal) and 902.04 (Notice of Election).

When an applicant in an ex parte case seeks review of a decision of the Board by way of civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b), it must effect service on the agency pursuant to Fed. R. Civ. P. 4(i), and all the expenses, including expert witness fees and travel, of the proceeding must be paid by the applicant which brought the suit, whether the final decision is in favor of the applicant or not, unless the court finds the expenses to be unreasonable.[61]

904 Access to Record During Appeal

904.01 Access During Appeal to Federal Circuit

During an appeal to the United States Court of Appeals for the Federal Circuit, from a decision of the Board in an *inter partes* case, the original USPTO record of the case is kept at the Office of the Solicitor. However, when it deems necessary, the Federal Circuit may, on motion or sua sponte, order transmission (via the Office of the Solicitor) of the original or certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal.[62]

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the Federal Circuit amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the Court's order.[63]

During an appeal to the Federal Circuit from a decision of the Board in an *ex parte* case, the subject application file is kept at the Office of the Solicitor. Any request for access to the application should be directed to the Office of the Solicitor.

904.02 Access During Appeal by Civil Action

During a civil action seeking review of a decision of the Board in an *inter partes* case, the Board retains the original USPTO record of the case. The Board will release the original record for submission (via the Office of the Solicitor) to the court in which the civil action is pending only upon order of the court.

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[61] Section 21(b)(3) of the Act, 15 U.S.C. § 1071(b)(3).

[62] *See* Section 21(a)(3) of the Act, 15 U.S.C. § 1071(a)(3), and Fed. Cir. R. 17(a).

[63] *See* Fed. Cir. R. 17(d) and 17(e).

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the court amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the court's order.

During a civil action seeking review of a decision of the Board in an *ex parte* case, the subject application file is kept at the Office of the Solicitor. Any request for access to the application should be directed to the Office of the Solicitor.

905 Petition to the Director

37 CFR § 2.146 Petitions to the Director.
(a) *Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§ 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

(c) *Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the requisite fee (see § 2.6). Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits or declarations in accordance with § 2.20, and any exhibits, shall accompany the petition.*

(d) *A petition must be filed within two months of the mailing date of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter..*

(e)*(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the denial of the request. A petition from the grant of a request shall be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the*

denial of a request shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by § 2.119(a). The potential opposer or the applicant, as the case may be, may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by § 2.119(a). No further paper relating to the petition shall be filed.
(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board shall be filed within thirty days after the date of mailing of the order from which relief is requested. Any brief in response to the petition shall be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection shall be served on every adverse party pursuant to § 2.119(a).

(f) *An oral hearing will not be held on a petition except when considered necessary by the Director.*

(g) *The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§ 2.63(b) and 2.65 are applicable to an ex parte application.*

(h) *Authority to act on petitions, or on any petition, may be delegated by the Director.*

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a "final dispositive ruling that ends litigation on the merits" before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board.[64]

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case.[65]

In an inter partes proceeding, a party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board),

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[64] *See* TBMP § 901.02(a) (Final Decision vs. Interlocutory Decision) and cases cited therein.

[65] *See* TBMP § 901.02(a) and cases cited therein.

and does not put an end to the litigation before the Board, by timely petition to the Director.[66]

A petition to the Director from an interlocutory order or decision of the Board, in a Board inter partes proceeding, must be filed within 30 days after the mailing date of the order or decision from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within 15 days from the date of service of the petition. Petitions from an interlocutory order or decision of the Board, responses to such petitions, and any papers accompanying a petition or response, must be served on every adverse party in the manner prescribed in 37 CFR § 2.119(a).[67]

For information concerning a petition to the Director from the denial, or from the granting, of a request for an extension of time to file a notice of opposition, see 37 CFR § 2.146(e)(1), and TBMP § 211.03.

A petition on any matter not otherwise specifically provided for must be filed within 60 days from the mailing date of the action from which relief is requested.[68]

The mere filing of a petition to the Director will not act as a stay in any ex parte appeal or inter partes proceeding pending before the Board.[69]

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[66] *See* 37 CFR § 2.146; *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (grant of summary judgment motion although essentially a procedural decision is appealable not petitionable in view of its substantial substantive effect); *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971) (whether Board abused discretion in denying motion to amend description of services was a matter to be determined by Commissioner, not the Court since not part of the central issue), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971); *Jack Lenor Larsen Inc. v. Chas. O. Larsen Co.*, 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (petition to Director seeking reopening of cancellation proceeding is inappropriate as petition because it seeks review of final decision of Board); *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent Inc.,* 60 USPQ2d 1703 (Comm'r 2000) (petition from Board's finding that registration issued inadvertently and to direct Board to dismiss opposition granted in view of defect in request for extension of time to oppose); *Kimberly Clark Corp. v. Paper Converting Industry Inc.,* 21 USPQ2d 1875 (Comm'r 1991) (decision denying motion to dismiss opposition as untimely filed reviewed by petition); *Miss Nude Florida, Inc. v. Drost*, 198 USPQ 485, 486 (Comm'r 1977) (Board's decision not to consider untimely evidence was critical factor leading to Board's final decision and to that extent was "logically related" to the central issue and therefore appropriate for appeal rather than petition); and *Johnson & Johnson v. Cenco Medical/Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973) (Board's decision granting motion to amend pleading to add new claim reviewable by petition).

Cf. 37 CFR § 2.146(b) (questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under Sections 2, 3, 4, 5, 6, and 23 of the Act, 15 U.S.C. §§ 1052, 1053, 1054, 1055, 1056, and 1091, are not considered to be appropriate subject matter for petition to the Director).

[67] *See* 37 CFR § 2.146(e)(2) and TBMP § 113 (Service of Papers).

[68] *See* 37 CFR § 2.146(d).

[69] *See* 37 CFR § 2.146(g). *See also In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Commr 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

A petition to the Director must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by 37 CFR § 2.6. Any brief in support of the petition must be embodied in or accompany the petition. When facts are to be proved in ex parte cases, the proof, in the form of affidavits or declarations in accordance with 37 CFR § 2.20, and any exhibits, must accompany the petition.[70]

An oral hearing will not be held on a petition to the Director except when considered necessary by the Director.[71]

For further information on petitions to the Director, see 37 CFR § 2.146. *Cf.* TMEP Chapter 1700.

906 Standards of Review of Board Decisions

As stated at the outset of this chapter, after the Board determines and decides "the respective rights of registration" under 15 U.S.C. § 1067, any party dissatisfied with the TTAB's decision may appeal either to the United States Court of Appeals for the Federal Circuit or to a federal district court.[72]

906.01 Appeal to Federal Circuit or by Civil Action

In an appeal to the Federal Circuit, the case proceeds on the closed administrative record and no new evidence is permitted.[73] In contrast, an appeal to the district court is both an appeal and a new action, which allows the parties to submit new evidence and raise additional claims.[74]

Questions of fact. The district court sits as the appellate reviewer of facts found by the Board and as the fact-finder with respect to new evidence and additional claims.[75] Both the Federal

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[70] *See* 37 CFR § 2.146(c). *See also, for example*, *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (respondent's petition did not specify which subsection of 2.146(a) provided basis for Director's review).

[71] *See* 37 CFR § 2.146(f).

[72] *See* 15 U.S.C. § 1071.

[73] 15 U.S.C. § 1071(a)(4).

[74] *See CAE Inc. v. Clean Air Engineering Inc.*, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (appeal from district court's review of Board's finding of no likelihood of confusion, and from district court's decision on added claims of infringement, unfair competition and dilution).

[75] *See CAE Inc., supra* at 1457.

Circuit and the district court, in reviewing factual findings, will afford deference to those fact-findings.[76]

The degree of deference that the reviewing courts must afford the Board's findings of fact was decided by the U.S. Supreme Court in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). In that decision the Supreme Court held that the proper standard of judicial review of findings of fact made by the USPTO is not the traditional "clearly erroneous" standard of review but rather the "slightly more" deferential standard of the Administrative Procedure Act (APA), 5 U.S.C. § 706(2).[77] Thus, whether a party elects direct review by the Federal Circuit or initiates a new action in the district court, the APA standard of review should be applied to the Board's fact-finding.[78]

The Supreme Court did not decide which of the two standards of review under § 706(2) of the APA, the "arbitrary, capricious" test under § 706(2)(A) or the "substantial evidence" test under § 706(2)(E), should be applied.[79] Of the two tests, the Federal Circuit has determined that the "substantial evidence" standard is the appropriate standard of review for USPTO findings of fact.[80] A number of circuit courts of appeals have also indicated that "substantial evidence" review is appropriate.[81]

The substantial evidence standard requires the reviewing court to ask whether a reasonable person might accept that the evidentiary record supports the agency's conclusion.[82] Considered to be less deferential than the "arbitrary, capricious" standard of the APA, "substantial evidence"

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[76] *See In re Dr Pepper Co*., 836 F.2d 508, 5 USPQ2d 1207, 1209 (Fed. Cir. 1987) and *CAE Inc., supra* at 1458.

[77] *CAE Inc., supra* at 1458 *quoting Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930 (1999).

[78] *See Dickinson v. Zurko*, 50 USPQ2d at 1936 (rejecting the argument that the "two paths" for review would create "an anomaly" in the standard of review). *See also Pro-Football Inc. v. Harjo*, 57 USPQ2d 1140, 1142 (D.D.C. 2000) (district court review of Board decision is "a hybrid deferential treatment and de novo scrutiny"; deference given to findings of fact made by the Board and de novo review of legal conclusions).

[79] 5 U.S.C. §§ 706(2)(A) & (E). *See In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1773 (Fed. Cir. 2000).

[80] *See Gartside*, *supra* at 1775. *See also On-line Careline Inc. v. America Online Inc.,* 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); and *Recot, Inc. v. M.C. Becton,* 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

[81] *See CAE Inc., supra* at 1459 and *Gartside, supra* at 1773.

[82] *Dickinson v. Zurko*, *supra* 50 USPQ2d at 1935 and *Gartside, supra* at 1773, quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938) ("substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. ... Mere uncorroborated hearsay or rumor does not constitute substantial evidence.").

requires a stricter judicial review of agency fact-finding.[83] A review for substantial evidence "involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision."[84] Moreover, "the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence."[85]

Conclusions of law. While the Board's findings of fact are reviewed for substantial evidence, conclusions of law are reviewed de novo, without deference to the Board.[86]

906.02 Petition to Director

In reviewing non-final rulings of the Board, the Director will exercise supervisory authority under Trademark Rule 2.146(a)(3) and reverse the Board's ruling only where there is a clear error or abuse of discretion.[87]

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[83] *Dickinson v. Zurko*, *id.* and *In re Gartside, supra* at 1772 (the "arbitrary, capricious" standard of review is the most deferential of the APA standards of review).

[84] *Gartside, supra* at 1773.

[85] *Id., quoting Consolo v. Federal Maritime Comm'n,* 383 U.S. 607, 620 (1966).

[86] *See Herbko International Inc. v. Kappa Books Inc.,* 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) (conclusions of law are reviewed without deference); *In re International Flavors & Fragrances Inc.,* 183 F.3d 1361, 51 USPQ2d 1513, 1515 (Fed. Cir. 1999) (legal conclusions are reviewed de novo); and *Allied-Signal Inc. v. Allegheny Ludlum Corp.,* 29 USPQ2d 1039, 1043 (DC Conn 1993) (conclusions of law are reviewed de novo).

See also, regarding types of decisions and particular issues, In re California Innovations, Inc., 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003) (Board's interpretations of the Lanham Act are reviewed without deference); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) (determination of likelihood of confusion is a question of law); *Herbko International Inc. v. Kappa Books Inc., supra at* 1377 (grant of summary judgment is reviewed without deference and court must decide for itself whether moving party has shown that it is entitled to judgment as a matter of law); *In re Save Venice New York Inc.,* 59 USPQ2d 1778, 1781 (Fed. Cir. 2001) (validity of the Board's adaptation of the related goods test to geographic marks is a question of law that is reviewed de novo); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000) (ultimate question of whether a likelihood of confusion exists is a question of law, based on underlying factual determinations); *Sunrise Jewelry Mfg. Corp. v. Fred, S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1534 (Fed. Cir. 1999) (whether Board properly granted defendant's motion to dismiss is a question of law that is reviewed "independently"); and *Spraying Systems Co. v. Delavan Inc.,* 24 USPQ2d 1181, 1184 (7th Cir. 1992) (Board's grant of summary judgment is reviewed de novo). *In addition, see Valu Engineering Inc. v. Rexnord Corp.,* 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002) (functionality is a question of fact); *On-line Careline Inc. v. America Online Inc.,* 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000) (abandonment is a question of fact); and *Towers v. Advent Software Inc.,* 913 F.2d 942, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990) (descriptiveness is a question of fact).

[87] *See In re Sasson Licensing Corp.,* 35 USPQ2d 1510, 1511 (Comm'r 1995); *Huffy Corp. v. Geoffrey Inc..* 18 USPQ2d 1240, 1242 (Comm'r 1990); and *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899 (Comm'r 1990).

Chapter 1000
INTERFERENCES

1001 In General

15 U.S.C.§ 1066. *Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.*

37 CFR § 2.83 Conflicting marks.
(a) *Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the Official Gazette for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.*

(b) *In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the Official Gazette for opposition or issued on the Supplemental Register.*

(c) *Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.*

37 CFR § 2.91 Declaration of interference.
(a) *An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.*

(b) *Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.*

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict) is entitled to registration.[1] A "conflict" exists, for interference purposes, whenever

[1] *See* Sections 16 and 18 of the Act, 15 U.S.C. §§ 1066 and 1068.

"application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive."[2]

Ordinarily, when conflicting applications are pending, the application with the earliest effective filing date is approved for publication in the *Official Gazette* for opposition (if the mark is eligible for registration on the Principal Register), or is registered on the Supplemental Register (if the mark is eligible for registration on the Supplemental Register). Action on any later-filed conflicting application is suspended until the earlier-filed application is registered or abandoned. 37 CFR § 2.83, and TMEP § 1208.01.

If the owner of an application which conflicts with one or more pending applications wishes to have the USPTO set up an interference proceeding between the conflicting applications, rather than have the USPTO follow the procedure described in 37 CFR § 2.83, that applicant must file a petition to the Director to declare an interference.[3]

NOTE: Although the Director is authorized by Section 16 of the Act to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Act of 1920, and registrations of marks the right to use of which has become incontestable), it is not the Director's practice to do so.[4]

1002 Declaration of Interference

15 U.S.C. § 1066. *Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to use of which has become incontestable.*

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[2] Section 16 of the Act, 15 U.S.C. § 1066. *See also* Section 2(d) of the Act, 15 U.S.C. § 1052(d); 37 CFR § 2.83; and TMEP § 1208.01(a).

[3] *See* Section 16 of the Act, 15 U.S.C. § 1066; 37 CFR § 2.91(a); and TBMP § 1002 (Declaration of Interference).

[4] *See* TBMP § 1002 and authorities cited therein.

37 CFR § 2.91 Declaration of interference.
(a) *An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.*

(b) *Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.*

Under Section 16 of the Act of 1946, 15 U.S.C. § 1066, the Director, upon petition showing extraordinary circumstances, may declare that an interference exists when an application conflicts with a registration issued to another, or with an application previously filed by another, that is, "when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive."

A petition for declaration of an interference will be granted by the Director only if the petition shows "extraordinary circumstances which would result in a party being unduly prejudiced without an interference."[5] Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding.[6] However, a petition to the Director to declare an interference has been granted where, but for the interference, multiple oppositions would be necessary.[7]

Although the Director is authorized by Section 16 of the Act to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Act of 1920, and registrations of marks the right to use of which has become incontestable[8] it is not the Director's practice to do so.[9] This is because a registration will not be cancelled as a result of a decision in an interference proceeding. A

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[5] *See* 37 CFR § 2.91(a). *See also In re Ratny*, 24 USPQ2d 1713, 1715 (Comm'r 1992); *In re Kimbell Foods, Inc.*, 184 USPQ 172, 173 (Comm'r 1974); and *In re Family Inns of America, Inc.*, 180 USPQ 332, 332 (Comm'r 1974).

[6] *See* 37 CFR § 2.91(a). *See also In re Kimbell Foods, Inc., supra*.

[7] *See In re Family Inns of America, Inc., supra*. *See also* TMEP §§ 1208.03 and 1208.03(b).

[8] *See* Sections 16, 26, and 46(b) of the Act, 15 U.S.C. §§ 1066, 1094, and 1051 [note],;and 37 CFR § 2.91(b)).

[9] *See In re Kimbell Foods, Inc.*, *supra*, and *Ex parte H. Wittur & Co.*, 153 USPQ 362, 363 (Comm'r 1966).

formal petition for cancellation must still be filed and granted, and the registration must be cancelled, before any registration will be issued to the applicant.[10] The interference proceeding is superfluous, since the cancellation proceeding by itself will accomplish the same purpose as the two proceedings together.

A petition to the Director to declare an interference should be made by separate paper bearing the title "PETITION TO THE DIRECTOR," and be accompanied by the fee specified in 37 CFR § 2.6. *For further information concerning the form for a petition to the Director, see* 37 CFR § 2.146(c), TMEP § 1208.03 and TBMP § 905.

A petition to declare an interference should not be filed in an application until the application has been examined by the Trademark Examining Attorney, and the mark has been found registrable but for the existence of one or more pending conflicting applications. When such a petition is filed, the Examining Attorney will immediately forward the petition, together with the application file, to the Office of the Commissioner for Trademarks for determination of the petition.[11]

1003 Institution of Interference

37 CFR § 2.92 Preliminary to interference.
An interference which has been declared by the Director will not be instituted by the Trademark Trial and Appeal Board until the Examiner of Trademarks has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.

37 CFR § 2.93 Institution of interference.
An interference is instituted by the mailing of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

An interference proceeding does not commence with the granting of a petition to the Director to declare an interference. Rather, the interference proceeding will not be instituted unless and until

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[10] *See* 37 CFR § 2.96; *In re Kimbell Foods, Inc., supra*; and *Ex parte H. Wittur & Co., supra*. *Cf. Hy-Pure Laboratories, Inc. v. Foley & Co.*, 98 USPQ 280, 281 (Chief Examiner 1953); and *Cudahy Packing Co. v. York Pharmacal Co.*, 93 USPQ 227, 228 (Comm'r 1952).

[11] *See* TMEP § 1208.03(a).

the Trademark Examining Attorney has determined that the marks which are to be included in the interference are registrable, but for the interfering marks; and all of the marks have been published (preferably together) in the *Official Gazette* for opposition, subject to the interference.[12]

If an application published subject to interference is opposed by an entity which is not to be a party to the interference, the opposition may be determined first, following which the interference, if still necessary and appropriate, will be instituted;[13] alternatively, depending upon the circumstances, the opposition and interference may go forward contemporaneously. If an opposition is filed by an entity which is to be a party to the interference, and the interference is to involve three or more parties, the opposition will be dismissed without prejudice in favor of the interference proceeding, wherein the rights of all parties can be determined in a single proceeding. If an opposition is filed by an entity which is to be a party to the interference, and the interference is to involve only two parties, the rights of the parties will be determined in the opposition, and the interference will not be instituted.

If the marks which are to be included in an interference (1) are found by the Trademark Examining Attorney to be registrable, (2) are published for opposition, and (3) survive the opposition period (as indicated in the preceding paragraph), the interference proceeding will be instituted by the Board.

The Board prepares a "Notice of Interference" notifying the parties that the interference proceeding is thereby instituted, and setting trial and briefing dates in the case. The notice specifies the name and address of each party to the proceeding and of each party's attorney or other authorized representative, if any; the mark of each party; and the serial number, filing date, and publication date of each involved application.[14]

An interference proceeding commences when the Board mails the notice of interference to the parties. The notice is mailed to the attorney or other authorized representative of each involved applicant, or, if the applicant does not have an attorney or other authorized representative, to the applicant.[15]

It is not the Director's practice to declare an interference with a registration.[16] However, should the Director elect to declare an interference with one or more registrations, the notice of

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[12] *See* 37 CFR § 2.92 and TMEP § 1208.02(c).

[13] C*f.* 37 CFR § 2.99(c).

[14] *See* 37 CFR § 2.93.

[15] *See* 37 CFR § 2.93.

[16] *See* TBMP § 1002 (Declaration of Interference) and cases cited therein.

interference would specify the registration number and issuance date of each involved registration, and would be mailed to the registrant or its assignee of record.[17]

There are no pleadings in an interference proceeding.[18] The notice of interference takes the place of pleadings, to the extent that it serves to provide each party with information concerning the involved application (or registration, if an interference should be declared with one or more registrations) of every adverse party.

There is no fee for an interference proceeding, beyond the fee required for a petition to the Director to declare an interference.[19]

1004 Issues in Interference

37 CFR § 2.96 Issue; burden of proof.
The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. ... The issue in an interference between an application and a registration shall be the same, but in the event the final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.

Normally, the issue to be determined in an interference proceeding is priority of use. However, such additional issues as the registrability of each mark, and whether there is, in fact, a conflict between the marks involved in the proceeding (i.e., whether the marks do so resemble one another as to be likely, when used in connection with the respective goods and/or services of the parties, to cause confusion, mistake, or deception), are always before the Board in an interference, and may also be determined; there is no requirement that a party file an affirmative pleading of such matters in order to be heard thereon.[20]

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[17] *See* 37 CFR § 2.93.

[18] *Cf.* TBMP §§ 1004 (Institution of Interference), 1106 (Commencement of Concurrent Use), and 1107 (Answer; Default in Concurrent Use).

[19] *See* 37 CFR § 2.6. *Cf.* TBMP § 1002.

[20] *See, for example*, Sections 17 and 18 of the Act, 15 U.S.C. §§ 1067 and 1068; 37 CFR § 2.96; *Giant Food Inc. v. Malone & Hyde, Inc.*, 522 F.2d 1386, 187 USPQ 374, 380 (CCPA 1975); *Dynamet Technology, Inc. v. Dynamet Inc.*, 197 USPQ 702 (TTAB 1977), *aff'd*, 593 F.2d 1007, 201 USPQ 129 (CCPA 1979); *Jos. Schlitz Brewing Co. v. United Vintners, Inc.*, 166 USPQ 493, 494 (TTAB 1970); *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214, 217-18 (TTAB 1970); *Tudor Square Sportswear, Inc. v. Pop-Op Corp.*, 160 USPQ 50, 53-54 (TTAB 1968); *La Jolla Sportswear Co. v. Maskuline Underwear Co.*, 114 USPQ 130, 131 (Comm'r 1957); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 325 (1985); and Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13 (deleting former 37 CFR § 2.97, which contained a requirement for an affirmative pleading of registrability issues).

1005 Burden of Proof

37 CFR § 2.96 Issue; burden of proof.
... The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party.
...

37 CFR § 2.116(b) *... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

In an interference proceeding, the party whose involved application has the latest filing date is the junior party. When there are three or more parties to an interference, a party is a junior party to every other party whose involved application has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution is deemed to have the latest filing date, and that applicant is the junior party.[21]

A junior party in an interference proceeding is in the position of plaintiff, and has the burden of proof, as against every party that is senior, that is, as against every party whose involved application has an earlier filing date. Conversely, a senior party is in the position of defendant as against every party that is junior, that is, as against every party whose involved application has a later filing date.[22]

1006 Addition of Party

37 CFR § 2.98 Adding party to interference.
A party may be added to an interference only upon petition to the Director by that party. If an application which is or might be the subject of a petition for addition to an interference is not added, the examiner may suspend action on the application pending termination of the interference proceeding.

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[21] *See* 37 CFR § 2.96.

[22] *See* 37 CFR §§ 2.96 and 2.116(b). *See also Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673 (CCPA 1972); and *McNeil v. Mini Mansions, Inc.*, 178 USPQ 312 (TTAB 1973).

A party may be added to an interference only upon petition to the Director filed, pursuant to 37 CFR § 2.98, by the party to be added.

For information concerning joining or substituting a transferee when there has been an assignment of a mark which is involved in an interference proceeding, see TBMP §512.01.

1007 Conduct of Proceeding

Once commenced,[23] an interference proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that there are no pleadings,[24] and therefore no motions relating to pleadings; the issues of priority of use, likelihood of confusion, and registrability are always before the Board,[25] a party's burden of proof as against another party to the proceeding depends upon the filing date of its involved application[26] and additional parties may be added to the proceeding upon petition to the Director filed by the party to be added.[27]

In addition, the trial and briefing schedule in an interference involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation. In the notice of interference which commences an interference proceeding, the Board sets trial and briefing dates in the case.[28] Specifically, the Board sets an opening and closing date for discovery and schedules testimony periods so that each party in the position of plaintiff[29] will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal; the testimony periods are separated from the discovery period and from each other by 30-day intervals.[30] Similarly, the Board schedules briefing periods so that each party, beginning with the junior-most party and ending with the senior-most party, will have a

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[23] *See* TBMP §§ 1002 (Declaration) and 1003 (Institution).

[24] *See* TBMP §§ 1003 and 1004 (Issues in Interference).

[25] *See* TBMP § 1004.

[26] *See* TBMP § 1005 (Burden of Proof).

[27] *See* TBMP § 1006 (Addition of Party).

[28] *See* TBMP § 1003.

[29] *See* TBMP § 1005.

[30] *See* TBMP § 701 (Time of Trial).

time for filing its main brief on the case, and each junior party will have a time for filing a reply brief.[31]

Set forth below is a sample trial and briefing schedule for an interference involving parties A, B, C, D, and E, where A is junior to every other party; B is junior to C, D, and E, and senior to A; C is junior to D and E, and senior to A and B; D is junior to E, and senior to A, B, and C; and E is senior to every other party:

THE PERIOD FOR DISCOVERY TO OPEN	: January 2, 2003
THE PERIOD FOR DISCOVERY TO CLOSE	: July 2, 2003
30-day testimony period for A to close	: August 31, 2003
30-day testimony period for B to close	: October 30, 2003
30-day testimony period for C to close	: December 31, 2003
30-day testimony period for D to close	: March 1, 2004
30-day testimony period for E to close	: April 30, 2004
15-day rebuttal testimony period for A to close	: June 14, 2004
15-day rebuttal testimony period for B to close	: July 29, 2004
15-day rebuttal testimony period for C to close	: September 12, 2004
15-day rebuttal testimony period for D to close	: October 28, 2004

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for A shall be due	: December 27, 2004

[31] *See* TBMP § 801.02(e) (Special Situations for filing brief).

Brief for B shall be due	: January 26, 2005
Brief for C shall be due	: February 25, 2005
Brief for D shall be due	: March 27, 2005
Brief for E shall be due	: April 26, 2005

Reply briefs, if any, shall be due as follows:

Reply brief for A shall be due	: May 11, 2005
Reply brief for B shall be due	: May 26, 2005
Reply brief for C shall be due	: June 10, 2005
Reply brief for D shall be due	: June 25, 2005

With the exceptions noted above, the practices and procedures for taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in an interference as in an opposition or cancellation.

Chapter 1100
CONCURRENT USE

1101 In General

15 U.S.C. § 1052. *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 --*

* * * *

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: ***Provided****, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to* ***(1)*** *the earliest of the filing dates of the applications pending or of any registration issued under this Act;* ***(2)*** *July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or* ***(3)*** *July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.*

15 U.S.C. § 1067. *In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration. ...*

15 U.S.C. § 1068. *In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings: Provided, That in the case of the registration of any mark based on concurrent use, the Director shall determine and fix the conditions and limitations provided for in subsection (d) of section 2 of this Act. ...*

Chapter 1100
CONCURRENT USE PROCEEDINGS

1101.01 Nature of Proceeding

A concurrent use registration proceeding (hereafter referred to as a "concurrent use proceeding") is an inter partes proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used.[1]

Section 2(d) of the Act, 15 U.S.C. § 1052(d), governs the Board's determination of registrability in a concurrent use proceeding. That section provides, in part, that if the Director (acting through the Board--*see* Section 17 of the Act, 15 U.S.C. § 1067):

> *... determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to ...*

a certain specified date (normally, prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding, or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905.[2]

The proviso of Section 2(d) of the Trademark Act sets out two requirements for issuance of concurrent use registration in a proceeding before the Board.[3] A concurrent use applicant needs to meet the jurisdictional requirement of use in commerce prior to the applicable date specified

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[1] *See, for example*, Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§ 1052(d), 1067, and 1068; *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 831 (CCPA 1980) (the conditions and limitations imposed by Section 2(d) are for the purpose of preventing consumer confusion); *Terrific Promotions Inc. v. Vantex Inc.,* 36 USPQ2d 1349, 1353 (TTAB 1995); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985, 1988 (TTAB 1988); and *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984).

[2] *See* TBMP § 1103.01(b) (Jurisdictional Requirement).

[3] *See In re Beatrice Foods Co*., 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc*., 227 USPQ 879, 882 (TTAB 1985).

in Section 2(d) of the Act[4] and the requirement that there be no likelihood of confusion in that use of a concurrent registration.[5]

1101.02 Context for USPTO Determination of Concurrent Rights

37 CFR § 2.99(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

37 CFR § 2.133(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

Within the USPTO, the Board determines the right to concurrent registration.[6] Concurrent rights are considered and determined by the Board only in the context of a concurrent use proceeding.[7]

A registration cannot be restricted territorially by amendment under Section 7(e) of the Act, 15 U.S.C. § 1057(e), and 37 CFR § 2.173(a).[8] Thus, when a registration is the subject of a cancellation proceeding, the proceeding may not be settled by amending the registration to include territorial restrictions.[9]

Moreover, a Section 7(e) amendment may generally not be used to remove a concurrent use restriction from a registration. However, removal of a concurrent use restriction by amendment under Section 7(e) may be permitted where an entity which was the only exception to registrant's

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[4] *For information concerning the dates specified in Section 2(d) of the Act and a discussion of the jurisdictional requirement, see* TBMP § 1103.01(b).

[5] *See Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 (TTAB 1990) and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc*., *supra* at n.4.

[6] *See* Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§1052(d), 1067 and 1068.

[7] *See* Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§ 1052(d), 1067, and 1068. *See also, for example*, 37 CFR §§ 2.99(h) and 2.133(c); *Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984) (attempt to interject concurrent use proceeding into cancellation unavailing); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 400 (Fed. Cir. 1983) (concurrent use not available in cancellation by way of counterclaim); *Rosso & Mastracco, Inc. v. Giant Food Inc.,* 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983); *Selfway, Inc. v. Travelers Petroleum, Inc.,* 579 F.2d 75, 198 USPQ 271, 277 (CCPA 1978) (concurrent rights can only be adjudicated in concurrent use proceeding).

[8] *See In re Forbo,* 4 USPQ2d 1415 (Comm'r 1984).

[9] *See, e.g., Chichi's, Inc. v. Chi-Chi's, Inc.,* 222 USPQ 831, 832 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner). *See also* TBMP § 1114 (Alteration of Restrictions on Concurrent Registration) and cases cited therein.

right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant.[10]

1102 Generation of Proceeding

1102.01 Means of Generation

A concurrent use proceeding before the Board may be generated only by way of an application for registration as a lawful concurrent user (hereafter referred to as a "concurrent use application").[11] A concurrent use application is an application in which applicant:

(1) concedes that its use is not exclusive,

(2) specifies the goods and/or services and area or mode of use for which it desires registration,

(3) identifies, as exceptions to its claim of exclusive use, one or more persons (unrelated to applicant) which use the same or similar mark, for the same or similar goods or services, concurrently with applicant, and

(4) provides, to the extent of the applicant's knowledge, certain information concerning use of the mark by each listed concurrent user.[12]

For further information concerning the requirements for a concurrent use application, see TBMP § 1103.

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[10] *See In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987) (geographic restriction removed by amendment when excepted rights assigned to registrant).

[11] *See Chichi's, Inc. v. Chi-Chi's, Inc.*, *supra; Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977); *Hollowform, Inc. v. Delma AEH*, 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975); Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982); and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977).

[12] *See* Sections 1(a)(1)(A) and 2(d) of the Act, 15 U.S.C. §§ 1051(a)(1)(A) and 1052(d); 37 CFR § 2.42; and TMEP §§ 1207.04(b); and 1207.04(d).

1102.02 Bases for Concurrent Registration – Board Determination; Court Determination

There are two bases upon which a concurrent registration may be issued.

First, a concurrent registration may be issued when the Board has determined in a prior or to-be instituted concurrent use proceeding, that an applicant for concurrent registration is entitled thereto.[13]

Second, a concurrent registration may be issued "when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce."[14]

These two types of concurrent use registrations are the only means by which a geographically restricted registration may be obtained.[15] Thus, for example, an applicant may not, by including a geographical restriction in its identification of goods and/or services, obtain a geographically restricted registration without a concurrent use proceeding.[16]

If an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding meets certain requirements (in addition to those necessary for all concurrent use applications,[17] the registration sought, if otherwise appropriate, will be issued based on the Board's prior decision. A new concurrent use proceeding before the Board will not be necessary, because of the legal principles of res judicata and stare decisis.[18]

Similarly, if an application seeking concurrent registration on the basis of a prior court determination of concurrent rights meets certain requirements, in addition to those necessary for

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[13] *See* TBMP § 1101.01 (Nature of Proceeding) and authorities cited therein.

[14] *See* Section 2(d) of the Act, 15 U.S.C. § 1052(d). *See also* 37 CFR § 2.99(f); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976) (district court found applicant entitled to restricted registration); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961) (court ordered restricted registration), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987); and *In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984).

[15] *See* TBMP §§ 1101.02 (Context for USPTO Determination of Concurrent Rights) and 1102.02 (Bases for Concurrent Registration).

[16] *See In re Home Federal Savings & Loan Ass'n*, 213 USPQ 68, 69 (TTAB 1982).

[17] *See* 37 CFR § 2.42 and TBMP § 1103 (Requirements for Concurrent Use Application).

[18] *Cf.* 37 CFR § 2.99(f). *For information concerning the requirements for an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding, see* TBMP § 1103.02.

all concurrent use applications, the registration sought, if otherwise appropriate, will be issued based on the court determination, without any concurrent use proceeding before the Board.[19]

1103 Requirements for Concurrent Use Application

15 U.S.C. § 1051(a)(1) *The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.*

(3)(D) *... except that, in the case of every application claiming concurrent use, the applicant shall –*

(i) state exceptions to his claim of exclusive use; and
(ii) shall specify, to the extent of the verifier's knowledge --
(I) any concurrent use by others;
(II) the goods on or in connection with which and the areas in which each concurrent use exists;
(III) the periods of each use and
(IV) the goods and area for which the applicant desires registration.

* * * *

15 U.S.C.§ 1052. *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 --*

* * * *

(d) *Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive:* ***Provided****, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to* ***(1)*** *the earliest of the filing dates of the applications pending or of any registration issued under this Act;* ***(2)*** *July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or* ***(3)*** *July 5, 1947, in the case of*

[19] *See* 37 CFR § 2.99(f). *For information concerning the requirements for an application seeking concurrent registration on the basis of a prior court determination of concurrent rights*, *see* TBMP §1103.03.

applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

37 CFR § 2.42 Concurrent use.
An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

37 CFR § 2.73(b) *An application under § 1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of § 2.42. The examiner will determine whether the application, as amended, is acceptable.*

37 CFR § 2.99 Application to register as concurrent user.
(a) *An application for registration as a lawful concurrent user will be examined in the same manner as other applications for registration.*

(b) *When it is determined that the mark is ready for publication, the applicant may be required to furnish as many copies of his application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application for registration.*

(c) *Upon receipt of the copies required by paragraph (b) of this section, the examiner shall forward the application for concurrent use registration for publication in the Official Gazette as provided by § 2.80. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board shall prepare a notice for the applicant for concurrent use registration and for each applicant, registrant or user specified as a concurrent user in the application. The notices for the specified parties shall state the name and address of the applicant and of the applicant's attorney or other authorized representative, if any, together with the serial number and filing date of the application.*

(d) *(1) The notices shall be sent to each applicant, in care of his attorney or other authorized representative, if any, to each user, and to each registrant. A copy of the application shall be forwarded with the notice to each party specified in the application.*
(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the mailing of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the mailing of the notice.
(3) If an answer, when required, is not filed, judgment will be entered precluding the specified user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the applicant(s) will remain with the burden of proving entitlement to registration(s).

(e) *The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.*

(f) *When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:*
(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and
(2) The court decree specifies the rights of the parties; and
(3) A true copy of the court decree is submitted to the examiner; and
(4) The concurrent use application complies fully and exactly with the court decree; and
(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.

(g) *Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications to register under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88 has been filed.*

(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

1103.01 Application Based on Board Determination

1103.01(a) Application Must Assert Use in Commerce

A basic requirement for any concurrent use application (whether it is to be based on a Board determination, through a concurrent use proceeding, of applicant's right to concurrent registration, or whether it is based on a prior court determination of applicant's concurrent use rights) is that it must assert use in commerce of the mark sought to be registered. Section 2(d) of the Act, 15 U.S.C. § 1052(d), provides, in pertinent part:

> *[I]f the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons* ***when they have become entitled to use such marks as a result of their concurrent lawful use in commerce*** *prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; ... Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks* ***in commerce****.*[20] (Emphasis added.)

If a concurrent use application is filed as an intent-to-use application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), rather than as a use application under Section 1(a) of the Act, 15 U.S.C. § 1051(a), the applicant may not amend the application to seek concurrent use until use is effected.[21] Thus, an intent-to-use application for an unrestricted registration may be amended to seek concurrent registration when an acceptable

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[20] *See also* 37 CFR § 2.99(g), and *Fleming Companies v. Thriftway Inc.*, 26 USPQ2d 1551, 1553 (S.D.Ohio 1992) (use must be lawful).

[21] *See* 37 CFR § 2.99(g); TMEP § 1207.04(b).

amendment to allege use under 37 CFR § 2.76, or an acceptable statement of use under 37 CFR § 2.88, has been filed in the application.[22]

An application for registration under the provisions of Section 44 of the Act, 15 U.S.C. § 1126, may not seek concurrent registration unless the application also includes, as a second basis for registration, an allegation of use in commerce pursuant to Section 1(a) of the Act.[23]

1103.01(b) Jurisdictional Requirement

An application seeking concurrent registration based on a Board determination, through a concurrent use proceeding, of applicant's right thereto, must allege use in commerce "prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act [of 1946]; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947."[24] As a practical matter, this means that an application seeking concurrent registration through a concurrent use proceeding normally must assert a date of first use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905).

This requirement is jurisdictional in nature.[25] If it is not met, applicant normally is not entitled to a concurrent registration, and the Trademark Examining Attorney in charge of the application should refuse registration.

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[22] *See* 37 CFR § 2.73(b), and Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications,* 83 Trademark Rep. 416 (1993).

[23] *See* TMEP § 1207.04(b).

[24] *See* Section 2(d) of the Act, 15 U.S.C. § 1052(d).

[25] *See Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of concurrent use proceeding, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *In re Beatrice Foods Co*., 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (applicant's lawful use outside of conflicting claimant's area is jurisdictional in nature and must begin prior to filing date by conflicting claimant; extent of such actual use in commerce is irrelevant so long as it is more than a token use); *Morgan Services Inc. v. Morgan Services Inc.*, 12 USPQ2d 1841, (TTAB 1989) (assignees (excepted users) stand in the shoes of the assignor (concurrent use applicant) for purposes of determining jurisdictional requirement and therefore assignee's acquisition of rights through territorial assignment meets jurisdictional requirement); *My Aching Back Inc. v. Klugman*, 6 USPQ2d 1892, 1894 (TTAB 1988) (jurisdiction requirement not met where applicant was not a lawful concurrent user since applicant used mark after filing date of excepted user's registration and therefore had constructive notice of use of

However, an application for concurrent registration need not meet the jurisdictional requirement, that is, need not assert use in commerce prior to the earliest application filing date of the application(s), or registration(s) (if any), involved in the proceeding if the owner of such application(s) or registration(s) consents to the grant of a concurrent registration to the applicant.[26]

In addition, the jurisdictional requirement does not apply to an application seeking concurrent registration based on a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark.[27]

1103.01(c) Application Must Meet Requirements Applicable to Non-Restricted Application

A concurrent use application must specify and contain all the elements required by those of the rules of practice in trademark cases for a non-restricted application.[28]

1103.01(d) Application Must Identify Nature and Extent of Restriction Sought

1103.01(d)(1) In General

The applicant must:

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same mark for same goods by another party); and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 (TTAB 1985) (jurisdictional requirement met where excepted users had no registration or application).

Cf. The Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587, 1592 (TTAB 1995) (where Board declined to institute concurrent use proceeding).

[26] *See* Section 2(d) of the Act, 15 U.S.C. § 1052(d).

[27] *See* TBMP § 1103.03 (Application Based on Court Determination) and authorities cited therein. *See also In re Home Federal Savings and Loan Association*, 213 USPQ 68, 69 (TTAB 1982).

[28] *See* 37 CFR §§ 2.32-2.41. *See DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862, 1866 (TTAB 1991), *aff'd sub nom.,* 35 USPQ2d 1554 (Fed. Cir. 1995) (before an applicant may obtain concurrent use registration, it must first satisfy requirements which apply to any application whether restricted or unrestricted; may not obtain concurrent use registration where designation does not function as a mark in non-territory); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of concurrent use proceeding, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); and *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (extent of such use in commerce is irrelevant so long as it is more than a token use).

(1) *State in the application the geographic area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration of the mark.*[29]

The statement in the application of the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration serves to give notice, both when the mark is published for opposition (assuming it is approved for publication) and when a concurrent use proceeding is thereafter instituted (if no opposition is filed, or if all oppositions filed are dismissed), of the scope of the registration sought by applicant, and the extent of applicant's acknowledgment of the concurrent rights of others.[30]

1103.01(d)(2) Geographic Restrictions

The vast majority of concurrent use applications seek a registration that is restricted geographically. The area for which registration is sought is usually more extensive than the area in which the applicant is actually using its mark. Generally, concurrent rights arise when a party, in good faith, and without knowledge of a prior party's use in another geographic area, adopts and uses the same or similar mark for the same or similar goods or services within its own geographic area.[31] If applicant believes that it is the prior user as against the other party or parties to the proceeding, applicant may, as the prior user, seek registration for all of the United States except for the subsequent user's area of

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[29] *See* 37 CFR § 2.42. *See also* Section 1(a) of the Act, 15 U.S.C. § 1051(a)(3)(D).

[30] *See* 37 CFR §§ 2.99(d)(1) and 2.99(d)(3); *In re Wells Fargo & Co.,* 231 USPQ 95, (TTAB 1986); and *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968). *See also Pro-Cuts v. Schilz-Price Enterprises Inc.,* 27 USPQ2d 1224, 1230 (TTAB 1993) (at late stage in contested concurrent use proceeding, Board will generally not permit concurrent use applicant to enlarge territory for which it seeks registration).

[31] *See Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1726 (TTAB 1990) (actual use in a territory is not necessary to establish rights in that territory and depends on a number of factors). *See also Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1307 (Fed. Cir. 1987) (issue of likelihood of confusion was properly resolved by looking at the concurrent use applicant's area of actual use, not merely the area claimed in its application); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 829 (CCPA 1980) (mere knowledge of the existence of the prior user should not, in itself, constitute bad faith); *In re Beatrice Foods Co*., 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970); *Fleming Companies v. Thriftway Inc.,* 26 USPQ2d 1551, 1553 (S.D.Ohio 1992) (plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user); *DataNational Corp. v. BellSouth Corp.,* 18 USPQ2d 1862, 1866 (TTAB 1991), *aff'd sub nom.,* 35 USPQ2d 1554 (Fed. Cir. 1995); and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.,* 227 USPQ 879, 884 (TTAB 1985) (primary concern in concurrent use proceeding is the avoidance of likelihood of confusion; here, confusion inevitable; applicant unable to establish its entitlement to registration in area claimed, where senior user was national franchise).

actual use and (possibly) natural expansion.[32] If applicant is not the prior user, but believes that the prior user, through its failure to expand over a long period of time, has abandoned its right as prior user to expand into all of the United States except for the subsequent user's area of actual use and natural expansion, applicant may seek registration for all of the United States except for the prior user's area of actual use.[33] If the concurrent use applicant is a subsequent user, it normally will seek registration not only for its area of actual use but also for its area of natural expansion. If another party to the proceeding owns a registration of its mark, the right to use of which has become incontestable, any registration issued to applicant will be limited (even if applicant is the prior user) to applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise.[34]

The description of the geographic area sought by the concurrent use applicant should be sufficiently definite. If the excepted area is less than an entire state, it should be described in terms of counties or in other specific and definite terms.[35]

1103.01(d)(3) Mode of Use Restrictions

In very rare instances, a concurrent use applicant may seek concurrent registration based only on conditions or limitations as to the mode of use of its mark or as to the goods and/or services on or in connection with which the mark is used, i.e., a restriction as to the form in which it may use its mark; a limitation as to the trade

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[32] *See Pinocchio's Pizza Inc. v. Sandra Inc.,* 11 USPQ2d 1227, 1229 (TTAB 1989) (as a general rule prior user is entitled to registration covering entire U.S. except for geographic area in which subsequent user has actually used the mark plus an area shown to be within the natural expansion of its business, but rule is not absolute); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984) (later user may obtain registration for area of actual use as well as area of natural expansion and later user who adopts in good faith is not necessarily precluded from further expansion after learning of senior user); and *Zimmerman v. Holiday Inns of America, Inc.,* 123 USPQ 86 (TTAB 1959) (acknowledged the right of the later user to operate in areas into which it had expanded after notice of the existence of the prior user).

Cf. Terrific Promotions inc. v. Vantex Inc., 36 USPQ2d 1349, 1353 (TTAB 1995) (where good faith second user that had vigorously expanded under mark was given most of U.S.).

[33] *See, for example, Weiner King, Inc. v. Wiener King Corp.,* 615 F.2d 512, 204 USPQ 820, 832 (CCPA 1980), and *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 (TTAB 1989).

[34] *See* Sections 15 and 33(b)(5) of the Act, 15 U.S.C. §§ 1065 and 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.,* 534 F.2d 312, 189 USPQ 630, 633 (CCPA 1976) (court determination of rights); and *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330, 334 (TTAB 1980) (agreement by parties found to obviate likelihood of confusion).

[35] *See Pro-Cuts v. Schilz-Price Enterprises Inc.,* 27 USPQ2d 1224 (TTAB 1993) (description excepting "the San Francisco Bay area" indefinite) and *El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968) (merely stating that there are various users in various states for similar services is insufficient).

channels in which its goods are sold; a requirement that the mark always be used in conjunction with a particular trade dress or house mark, or a specified disclaimer of affiliation; etc.[36] Usually, "mode of use" cases arise before the Federal district courts, which, for equitable reasons, may permit a continuation of concurrent use even if there is some resulting confusion. Notwithstanding the likelihood of confusion, a party to the court proceeding may obtain concurrent registration on the basis of such a court determination, if its application is otherwise acceptable.[37] In contrast, when concurrent registration is sought by way of a concurrent use proceeding before the Board, the Board cannot allow registration if it finds that there would be likelihood of confusion from the continued concurrent use of the marks.[38]

An applicant seeking registration on the basis of "mode of use" conditions or limitations should request concurrent registration only if its application includes a condition or limitation not capable of being incorporated into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another.[39]

Where an applicant seeks registration on the basis of "mode of use" conditions or limitations which are incorporated, or are capable of being incorporated, into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another, a concurrent use proceeding is unnecessary and will not be instituted by the Board. The application should be presented as a

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[36] *See, for example, Holiday Inn v. Holiday Inns, Inc.,* 534 F.2d 312, 189 USPQ 630 (CCPA 1976) (restrictions, inter *alia*, to form of mark and geographic area of use); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962) (restrictions, inter *alia*, to form of mark and types of goods).

Cf. The Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995) (request for concurrent use registration based on asserted dissimilarity of trade channels denied); and *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (court imposed geographic restriction and mode of use requirements involving, *inter alia*, trade dress and advertising).

[37] *See, for example*, Section 2(d) of the Act, 15 U.S.C. §1052(d); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976) (application presenting mark in plain typed capital letters did not violate judgment but accompanying specimen showing mark in prohibited script did); and *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962).

[38] *See* Section 2(d) of the Act, 15 U.S.C. § 1052(d); and *Holiday Inn v. Holiday Inns, Inc.*, *supra.*

[39] *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995).

regular application, not as a concurrent use application.[40] If an applicant which has incorporated mode of use conditions or limitations into its drawing and/or identification is unable to obtain a registration in the absence of corresponding conditions or limitations in a conflicting application or registration, and the owner thereof is not willing to amend its application or registration to include the conditions or limitations, applicant's remedy lies in an opposition or a petition for cancellation, respectively, to restrict the application or registration appropriately.[41]

For information concerning a claim for partial opposition or partial cancellation, i.e., a request to restrict, see TBMP § 309.03(d).

1103.01(e) Application Must Identify Excepted Users and Their Asserted Rights

In addition to the requirements noted above, the applicant must:

(2) *State in the application, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to or applications filed by them, if any.*[42]

A concurrent use applicant must specify the extent of its knowledge of the concurrent rights of others.[43] It is not necessary that an applicant for concurrent registration list, as exceptions to its claim of exclusive use, every entity known to it to be using the same or similar mark for the same or similar goods or services. Rather, applicant's duty is to list any entity known to it to be a senior user of a clearly conflicting mark, as well as any

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[40] *See The Tamarkin Co. v. Seaway Food Town Inc.*, *supra*.

[41] *See The Tamarkin Co. v. Seaway Food Town Inc., supra* (concurrent use proceeding not instituted where only limitation was trade channels that could be adequately dealt with under main clause of 2(d) in ordinary ex parte or inter partes proceeding).

[42] *See* 37 CFR § 2.42.

[43] *See* 37 CFR § 2.42. *See also* Section 1(a) of the Act, 15 U.S.C. § 1051(a); *Gallagher's Restaurants Inc, v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (motion to amend concurrent use application to add additional users denied where it was filed late in proceeding, existence of the users were known to applicant years earlier, and applicant failed to specify the marks or the goods/services allegedly used by those parties); *In re Wells Fargo & Co.*, 231 USPQ 106, 116 (TTAB 1986) (concurrent use registration denied where, *inter alia*, applicant failed to specify areas of use and services of excepted user); and *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968) (merely stating that there are various users in various states for similar services is insufficient).

junior user known to it to have clearly conflicting rights which are clearly established, as, for example, by court decree, by settlement agreement, or by a registration.[44]

1103.01(f) Other Requirements

(3) *When it is determined that applicant's mark is ready for publication, applicant may also be required to furnish a copy of its application, specimens and drawing for each applicant, registrant or user specified in the application as a concurrent user*.[45]

The additional application copies required by 37 CFR § 2.99(b) are used by the Board, when it institutes a concurrent use proceeding, to provide each specified concurrent user with information concerning the scope of the concurrent registration sought by each concurrent use applicant, and the extent of each concurrent use applicant's acknowledgment of the concurrent rights of others.[46]

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement:

> SUBJECT TO CONCURRENT USE PROCEEDING
> WITH _____. APPLICANT CLAIMS EXCLUSIVE
> RIGHT TO USE THE MARK IN THE AREA
> COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

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[44] *See Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983) (no requirement to investigate and report all possible users; senior user ordinarily need not identify junior users in the oath unless rights of a junior user have been "clearly established"), and *Pennsylvania Fashion Factory, Inc. v. Fashion Factory*, *Inc.*, 215 USPQ 1133, 1137 (TTAB 1982) (duty to investigate only known prior users; existence of other users came to applicant's attention after applicant began use and then only as result of computer-generated search report). *See also In re Sun Refining & Marketing Co.*, 23 USPQ2d 1072, 1073 (TTAB 1991) (obligated to amend declaration to acknowledge rights recognized by the terms of a settlement agreement).

Cf. SCOA Industries Inc. v. Kennedy & Cohen, Inc., 188 USPQ 411, 414 (TTAB 1975) (no duty to identify other user where there are arguable differences between the marks).

[45] *See* 37 CFR § 2.99(b). *Cf.* 37 CFR § 2.99(c).

[46] *See* TBMP § 1106 (Commencement of Proceeding).

For information concerning the examination by the Trademark Examining Attorney of a concurrent use application, *see* TMEP §§ 1207.04(d)(i) and 1207.04(e)(i).

1103.02 Application Based on Prior Board Decision

An application seeking concurrent registration on the basis of the Board's final decision in a prior concurrent use proceeding[47] must assert use in commerce of the mark sought to be registered.[48] The application must also specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR § 2.42; and must comply with the requirements of 37 CFR § 2.42 (described in TBMP § 1103.01)), namely, the requirements that applicant state in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any.[49] In addition, the applicant should, of course, submit a copy of the Board decision upon which it relies.

When an application for concurrent registration is based on a final determination by the Board, in a prior concurrent use proceeding, that applicant is entitled to a concurrent registration of its mark, a new concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a new concurrent use proceeding, provided that the following conditions are met:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the prior concurrent use proceeding; and

(2) The Board's prior decision specifies applicant's right to concurrent registration; and

(3) A copy of the Board's prior decision is submitted to the Trademark Examining Attorney; and

(4) The concurrent use application complies with the Board's prior decision (that is, seeks registration for the same or a more limited geographic area, or mode of use, and for substantially the same mark and substantially the same goods and/or services as, or more limited goods and/or services than, those listed in the Board's prior specification of

[47] *See* TBMP § 1102.01 (Means of Generation).

[48] *See* TBMP § 1103.01(a) (Application Must Assert Use in Commerce) and authorities cited therein.

[49] *See* 37 CFR § 2.42.

applicant's entitlement to concurrent registration), or seeks registration for the same or a more limited area, or mode of use, than that accorded to applicant in the prior decision, and for a mark and goods and/or services less similar to those of the other party or parties than applicant's mark and goods and/or services in the prior proceeding;[50] and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted in accordance with the Board's prior decision.

If an application seeking concurrent registration on the basis of the Board's determination in a prior concurrent use proceeding of applicant's entitlement thereto, meets all of the conditions specified above, a new concurrent use proceeding is unnecessary, because of the legal principles of res judicata and stare decisis.[51] If any of the conditions is not satisfied, a new concurrent use proceeding will be prepared and instituted. In the event that the first four conditions are met, but an involved registration, through some happenstance, has not already been restricted in accordance with the Board's prior decision, a new concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the Board's decision. In such cases, the Board sends out, with the notice of institution, an order to the registrant to show cause why its registration should not be restricted in accordance with the Board's prior decision. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

If all of the five conditions specified above are satisfied so that a new concurrent use proceeding is not necessary, there is no need for applicant to furnish the extra copies of its application, specimens and drawing referred to by 37 CFR § 2.99(b).[52] When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING
PURSUANT TO CONCURRENT USE PROCEEDING NO. ____.
CONCURRENT REGISTRATION WITH _____.

The area specified in the Board's decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations

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[50] *Cf., regarding comparison of marks and goods/services in context of prior registration defense, Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028 (TTAB 1988); *Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc.*, 222 USPQ 979 (TTAB 1983), *recon. denied*, 222 USPQ 727 (TTAB 1983); and *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022 (TTAB 1983).

[51] *Cf.* 37 CFR § 2.99(f).

[52] *Cf.* TBMP § 1103.01(c)-(f) (Requirements for Concurrent Use Application)

imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If the five conditions are *not* all satisfied so that a new concurrent use proceeding is necessary, applicant normally will be required, at least if its mark is determined to be ready for publication, to furnish as many copies of its application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application.[53] When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement:

> SUBJECT TO CONCURRENT USE PROCEEDING WITH
> ____APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE
> THE MARK IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

The Board does not determine, in a concurrent use proceeding, the right to concurrent registration of a party that is included in the proceeding only as a common law concurrent user, i.e., a party that does not own an involved application or registration.[54] A party which was included in a prior concurrent use proceeding only as a common law concurrent user may not thereafter obtain a concurrent registration, on the basis of the Board's decision in the prior proceeding, without going through a new concurrent use proceeding.

1103.03 Application Based on Court Determination

An application for concurrent registration that is based on a final determination by a court of competent jurisdiction, must assert use in commerce of the mark sought to be registered.[55] The application must also specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR § 2.42; and must comply with the requirements of

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[53] *See* 37 CFR § 2.99(b).

[54] *See* TBMP § 1108 (Issue In Concurrent Use Proceeding; Burden of Proof) and cases cited therein.

[55] *See* TBMP § 1103.01(a) (Application Must Assert Use in Commerce) and authorities cited therein.

37 CFR § 2.42 (described in TBMP §§ 1103.01(c) – (f)), namely, the requirements that applicant state in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any.[56] In addition, the applicant must, of course, submit a copy of the court decree upon which it relies.

When an application for concurrent registration is based on a final determination by a court of competent jurisdiction that applicant is entitled to concurrently use its mark, a concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a concurrent use proceeding, provided that all of the following conditions, specified in 37 CFR § 2.99(f), are met:

> **(1)** The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the court proceeding; and
>
> **(2)** The court decree specifies the rights of the parties; and
>
> **(3)** A true copy of the court decree is submitted to the Trademark Examining Attorney; and
>
> **(4)** The concurrent use application complies fully and exactly with the court decree,[57] and
>
> **(5)** The excepted use specified in the concurrent use application does not involve a registration, or, if it does, the involved registration has been restricted by the Director in accordance with the court decree.

If any of the five conditions specified above is not satisfied, a concurrent use registration proceeding will be prepared and instituted.[58] If the first four conditions are met, but the Director in accordance with the court decree has not already restricted an involved registration, a concurrent use proceeding will be instituted solely for the purpose of restricting the involved

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[56] *See* 37 CFR § 2.42.

[57] *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (application was properly limited geographically and as to the form of the mark, but the specimens appeared to violate the judgment), and *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962).

[58] *See* 37 CFR § 2.99(f), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984).

registration in accordance with the court decree. In such cases, the Board sends out, with the notice of institution, an order to the registrant to show cause why its registration should not be restricted in accordance with the court decree. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

If all of the five conditions specified above are satisfied, so that a concurrent use proceeding is not necessary, there is no need for applicant to furnish the extra copies of its application, specimens and drawing referred to by 37 CFR § 2.99(b).[59] When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement:

> REGISTRATION LIMITED TO THE AREA COMPRISING_____
> PURSUANT TO THE DECREE OF _____. CONCURRENT
> REGISTRATION WITH _____.

The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If the five conditions are not all satisfied, so that a concurrent use proceeding is necessary, applicant normally will be required, at least if its mark is determined to be ready for publication, to furnish as many copies of its application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application.[60] When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement:

> SUBJECT TO CONCURRENT USE PROCEEDING
> WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT
> TO USE THE MARK IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted

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[59] *Cf.* TBMP § 1103.01(c)-(f) (Requirements for Concurrent Use Application).

[60] *See* 37 CFR § 2.99(b).

in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

Jurisdictional requirement, and requirement that there be no likelihood of confusion need not be met. An application for concurrent registration on the basis of a court determination of applicant's right to concurrently use its mark in commerce does *not* need to meet the jurisdictional requirement of use in commerce prior to the applicable date specified in Section 2(d) of the Act, 15 U.S.C. § 1052(d).[61] Similarly, such an application is *not* subject to the requirement that the Director determine, prior to issuance of a concurrent registration, that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. These two requirements are conditions precedent to the issuance of a concurrent registration by way of a concurrent use proceeding before the Board, but they are not conditions precedent to the issuance of a concurrent registration on the basis of a court decree. The sentence in Section 2(d) permitting the Director to issue concurrent registrations when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce is wholly independent of these two provisions. Thus, a concurrent registration may (and should, if otherwise appropriate) be issued on the basis of a court decree even though the application for registration does not claim use in commerce prior to the applicable date specified in Section 2(d), and even though there is likelihood of confusion by reason of the concurrent use of the marks of the parties to the court proceeding.[62]

For information concerning the examination by the Trademark Examining Attorney of a concurrent use application, see TMEP §§ 1207.04(d)(i).

1104 Parties to Proceeding; Involved Applications, Registrations

The parties to a concurrent use proceeding are the concurrent use applicant(s), and all of those persons listed in the concurrent use application(s) as exceptions to applicant's claim of exclusive use. The persons listed as exceptions may themselves own one or more Federal applications (either for concurrent registration, or for an unrestricted registration) or Federal registrations for a conflicting mark, or may simply be common law users of a conflicting mark. Thus, a concurrent use proceeding may involve the concurrent use applicant(s) and one or more other applicants (either for concurrent registration or for unrestricted registration), and/or one or more registrants, and/or one or more common law concurrent users that do not own an involved application or registration. Often, the only parties to a concurrent use proceeding are the

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[61] *For information concerning the dates specified in Section 2(d) of the Act, see* TBMP § 1103.01(b).

[62] *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976), and TMEP § 1207.04(d)(i). *Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962).

concurrent use applicant, and a common law user that does not own an involved application or registration.[63]

If, after the commencement of a concurrent use proceeding, the concurrent use applicant learns of another person with conflicting concurrent rights, the applicant may file a motion to amend its application to list that person as an additional exception to applicant's claim to exclusive use. If the motion is granted, the person listed in the amendment will be added as a party to the proceeding.[64] Similarly, if the concurrent use applicant learns that a person listed as an exception to applicant's claim of exclusive use has abandoned its mark, or if the person assigns its rights in its mark to the applicant, the applicant may file a motion to amend its application to delete reference to that person. The motion should include an explanation of the facts that serve as the basis for the motion. If the motion is granted, the amendment will be entered, and the person in question will be dropped as a party to the proceeding.

The applications and/or registrations involved in a concurrent use proceeding include the concurrent use application(s); every conflicting unrestricted application which is identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent applicant's claim of exclusive use, and which has a filing date prior to the filing date of the concurrent use application(s); every conflicting registration identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent applicant's claim of exclusive use; and every registration claimed by the concurrent use applicant(s) in the concurrent use application(s), unless there is no conflict between the mark(s) in such registration(s) and the mark(s) of the other party or parties to the proceeding[65] Further, when the Board institutes the concurrent use proceeding, inquiry will be made as to whether any party owns any other application or registration which is for the same or similar mark, and same or similar goods and/or services, and thus should be added to the proceeding. A conflicting application or registration identified in response to this inquiry normally will be added to the proceeding.

However, if a party to the proceeding owns a conflicting application which seeks an unrestricted registration, and which was not filed until after the concurrent use application(s), the Trademark Examining Attorney will suspend action on the subsequent unrestricted application (once the application is otherwise in condition for approval for publication) pending disposition of the

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[63] *See Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1308 (TTAB 1984) (two concurrent use applicants).

[64] *See Gallagher's Restaurants Inc. v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (motion to amend concurrent use application to add additional users denied where it was filed late in proceeding, existence of the users were known to applicant years earlier, and applicant failed to specify the marks or the goods/services allegedly used by those parties).

[65] *See Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1842 (TTAB 1989).

concurrent use application(s).[66] In the event that the concurrent use application(s) matures into concurrent registration(s), the concurrent registration(s) will be cited, under Section 2(d) of the Act, 15 U.S.C. § 1052(d), as a reference(s) against the subsequent unrestricted application.[67] Alternatively, if the owner of the subsequent unrestricted application amends it to seek concurrent registration, the application will be published for opposition and, if no opposition is filed, or if all oppositions filed are dismissed, the application will be added to the concurrent use proceeding, if the amendment is filed early enough so that addition to the concurrent use proceeding is feasible, or will be the subject of a new concurrent use proceeding, if the amendment is not filed early enough.[68]

1105 Applications and Registrations Not Subject to Proceeding

37 CFR § 2.73(b) *An application under section 1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of § 2.42. The examiner will determine whether the application, as amended, is acceptable.*

37 CFR § 2.99(g) *Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications to register under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88 has been filed.*

Applications on Supplemental Register. Applications for registration on the Supplemental Register, registrations on the Supplemental Register, and registrations issued under the Act of 1920 are not subject to concurrent use proceedings.[69]

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[66] *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1226 (TTAB 1993) (Board has no jurisdiction over user/registrant's application that was pending before Examining Attorney unless application is amended to seek concurrent use, and is published without successful opposition, and is added to the proceeding), and *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, n.5 (TTAB 1990) (user's later filed application pending before Examining Attorney is not in issue in concurrent use proceeding but if it is not amended to seek concurrent use, applicant's concurrent use registration will be a 2(d) bar to an unrestricted registration to user).

[67] *See Georgia-Southern Oil Inc. v. Richardson, supra*.

[68] *See Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1480 (TTAB 1998); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993), and *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990).

[69] *See* Sections 26 and 46(b) of the Act of 1946, 15 U.S.C. §§ 1094 and 1051 note; 37 CFR § 2.99(g); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984).

Applications under Section 1(b) of the Trademark Act. Applications to register under Section 1(b) of the Act, 15 U.S.C. § 1051(b), i.e., intent-to-use applications, are subject to concurrent use proceedings only after an acceptable amendment to allege use under 37 CFR § 2.76, or an acceptable statement of use under 37 CFR § 2.88, has been filed.[70] If a concurrent use application is filed as an intent-to-use application under Section 1(b) of the Act rather than as a use application under Section 1(a) of the Act, 15 U.S.C. § 1051(a), the applicant may not amend the application to seek concurrent use until use is effected.[71]

Limitations of rights as against incontestable marks. An "incontestable registration," that is, a registration of a mark the right to use of which has become incontestable pursuant to Section 15 of the Act, 15 U.S.C. § 1065, *is* subject to a concurrent use proceeding. However, any registration issued to the concurrent use applicant as against the owner of an incontestable registration will be limited (even if applicant is the prior user) to applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise.[72]

The five-year incontestability period for a registration is tolled with respect to an applicant's concurrent rights if, prior to expiration of the five-year period, the applicant files a proper concurrent use application (or an amendment converting its unrestricted application into one seeking concurrent use registration) naming the registrant as the exception to applicant's right of exclusive use.[73]

1106 Commencement of Proceeding

1106.01 Marking of Concurrent Use Application

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement:

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[70] *See* 37 CFR § 2.99(g). *Cf.* 37 CFR § 2.73(b), and TBMP § 1103.01(a) (Application Must Assert Use in Commerce).

[71] *See* 37 CFR § 2.99(g); TMEP § 1207.04(b); and Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications*, 83 Trademark Rep. 416 (1993).

[72] *See* Sections 15 and 33(b)(5) of the Act, 15 U.S.C. §§ 1065 and 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPT 630, 636 (CCPA 1976) (only the right to use may become incontestable, not the registration); and *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980) (applicant involved in concurrent use proceeding with registration with incontestable rights is normally only entitled to specific area in which it has established rights prior to actual or constructive notice of the registration).

[73] *See Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982).

SUBJECT TO CONCURRENT USE PROCEEDING WITH _____.
APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK
IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

If an application approved for publication seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto, and meets the conditions described in TBMP § 1103.02), so that a new concurrent use proceeding is unnecessary, the application is marked with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING_____
PURSUANT TO CONCURRENT USE PROCEEDING NO. ___.
CONCURRENT REGISTRATION WITH _____.

The area specified in the Board's decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If an application approved for publication seeks concurrent registration on the basis of a court determination of concurrent rights, and meets the conditions of 37 CFR § 2.99(f),[74] so that a concurrent use proceeding is unnecessary, the application is marked with the following statement:

REGISTRATION LIMITED TO THE AREA
COMPRISING_____ PURSUANT TO THE DECREE
OF_____. CONCURRENT REGISTRATION WITH _____

The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court

[74] *See* TBMP § 1103.03 (Application Based on Court Determination).

proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

1106.02 Publication of Concurrent Use Application; Opposition Period

The application is then published, with the indicated statement, in the *Official Gazette* for opposition. If the application seeks concurrent registration on the basis of a court decree, meets the requirements of 37 CFR § 2.99(f), and is not opposed, or all oppositions filed are dismissed, the application goes to issue without a concurrent use proceeding.[75] Similarly, if the application seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto, meets the conditions described in TBMP § 1103.02, and is not opposed, or all oppositions filed are dismissed, the application goes to issue without a new concurrent use proceeding.[76]

If the application seeks concurrent registration by way of a concurrent use proceeding before the Board, and is not opposed, or all oppositions filed are dismissed, a concurrent use proceeding is instituted.[77] Similarly, if the application seeks concurrent registration on the basis of a court decree but does not meet the requirements of 37 CFR § 2.99(f), or seeks concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding but does not meet the conditions described in TBMP § 1103.02, and the application is not opposed, or all oppositions filed are dismissed, a concurrent use proceeding is instituted.[78]

After the opposition period has expired, and no opposition is filed, or all oppositions filed are dismissed, the file of a concurrent use application that must go through a concurrent use proceeding before the Board is forwarded to the Board for institution of the proceeding. There is no fee for the institution of a concurrent use proceeding.

1106.03 Obtaining Included Application and Registration Files

The Board obtains the files of all of the other applications and registrations, if any, to be included in the proceeding. If any such application has not yet been published in the *Official Gazette,* or has been published but has not yet cleared the opposition period, the proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. The Board may, in its discretion, suspend proceedings in the concurrent use

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[75] *See* 37 CFR § 2.99(f), and TBMP § 1103.03.

[76] *See* TBMP § 1103.02 (Application Based on Prior Board Decision). *Cf.* 37 CFR § 2.99(f), and TBMP § 1103.03 (Application Based on Court Determination).

[77] *See* 37 CFR § 2.99(c).

[78] *See* 37 CFR §§ 2.99(c) and 2.99(f), and TBMP §§ 1103.02 and 1103.03.

proceeding until the unpublished application either becomes abandoned, or is published in the *Official Gazette* and survives the opposition period; and then, if the application is published and survives the opposition period, add it to the proceeding, and change the proceeding position of its owner from that of common law user to applicant.[79]

1106.04 Preparing Concurrent Use Notices

When the Board has obtained the files of all other applications and registrations, if any, to be included in the proceeding, the Board prepares a notice for each party advising the party that the concurrent use proceeding is thereby instituted; supplying information concerning the filing of an "answer" to the notice and specifying a due date therefor;[80] and allowing the party until a specified time to advise the Board of any relevant, but as yet uninvolved, application(s) and/or registration(s), which should be included in the proceeding. The notice to each party listed as an exception to a concurrent use applicant's claim of exclusive use also specifies the name and address of the concurrent use applicant and the concurrent use applicant's attorney or other authorized representative, if any, together with the concurrent use applicant's mark, goods and/or services, application filing date and serial number, and claimed territory;[81] the name and address of any other involved applicant or registrant; the name and address of any other involved applicant's attorney or other authorized representative, if any; the mark, goods and/or services, application filing date, application serial number, and claimed territory of any other involved applicant, as reflected in its involved application (if the application is unrestricted, the claimed territory will be described in the notice as "The entire United States"); the mark, goods and/or services, registration filing and issue date, registration number, and claimed territory of any other involved registrant, as reflected in its involved registration; and the name and address of any other involved party which is simply a common law concurrent user, i.e., does not own an involved application or registration of its mark.

The notices are sent to each involved applicant, in care of the applicant's attorney or other authorized representative, if any; to any involved user; and to any involved registrant. A copy of each concurrent use applicant's involved application(s) is forwarded with the notice to each party specified in the concurrent use application as an exception to applicant's claim of exclusive use.[82]

The concurrent use proceeding commences when the Board mails the notices to the parties.[83]

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[79] *Cf.* TBMP §§ 1104 (Parties to Proceeding; Involved Applications, Registrations) and 1108 (Issue in Concurrent Use Proceeding; Burden of Proof).

[80] *For information concerning the "answer" in a concurrent use proceeding, see* TBMP § 1107 (Answer; Default).

[81] *See* 37 CFR § 2.99(c).

[82] *See* 37 CFR § 2.99(d)(1).

[83] *Cf.* 37 CFR § 2.93.

1106.05 Locating Excepted Users

It is the responsibility of the concurrent use applicant, which has the burden of proving its entitlement to concurrent registration, to provide information concerning the current address of each specified excepted user, as well as information concerning each user's use of its particular mark in its particular area or mode of use.[84] The address used by the Board in mailing the notice to a specified excepted user is the address provided by the concurrent use applicant in its application, unless the user itself owns an involved application or registration which includes an address more current than the one provided by the concurrent use applicant.

If a notice or other communication sent by the Board to a specified excepted user is returned as undeliverable, the concurrent use applicant will be required to investigate further and furnish the correct address. Unless and until the concurrent use applicant does so, the proceeding cannot go forward. Alternatively, if, upon further investigation, the concurrent use applicant learns that a specified excepted user has abandoned its use of its mark, the concurrent use applicant may file a motion to amend its application to delete reference to that user.[85]

If the owner of a registration is listed as an excepted user and the concurrent use applicant is unable, after reasonable investigation, to locate the registrant, applicant may file a petition to cancel the registration owned by the user on the ground of abandonment. The concurrent use proceeding would be suspended pending the outcome of the petition to cancel. Once a petition to cancel is filed, it is the responsibility of the Board to attempt to locate the registrant. If the Board is unable to do so, notice of the filing of the petition to cancel will be published in the *Official Gazette*. If the registrant fails to appear within the thirty-day period of time allowed by the notice, default judgment will be entered against the registrant and the petition to cancel will be granted. In the event the petition is granted, applicant may file a motion to amend its application to delete reference to registrant as the exception to applicant's exclusive right to use the mark in commerce, and to seek a geographically unrestricted registration of the mark.

1107 Answer; Default

There is no complaint in a concurrent use proceeding.[86] Instead, there is a notice which informs the parties to the proceeding of the institution thereof, supplies information concerning the filing of an "answer" to the notice, and specifies a due date therefor. In addition, the notice, (including the copy of each involved concurrent use application, which is mailed with the notice to every

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[84] *See* 37 CFR §§ 2.42 and 2.99(e). *See also* TBMP §§ 1103.01(c)-(f) (Requirements for Concurrent Use Application) and 1108 (Issue in Concurrent Use Proceeding).

[85] *See* TBMP § 1104 (Parties to Proceeding).

[86] *Cf.* TBMP § 1003 (Institution of Interference).

person specified in the application) takes the place of a complaint to the extent that it informs every specified person of the scope of the concurrent registration sought by each concurrent use applicant, and the extent of each concurrent use applicant's acknowledgment of the concurrent rights of others--i.e., the essence of what each concurrent use applicant intends to prove at trial.[87]

The "answer" in a concurrent use proceeding is a response to the notice. In the "answer," the answering party sets forth its position with respect to the registration(s) sought by the concurrent use applicant(s).[88]

An answer to the notice is not required of an applicant or registrant whose application or registration is involved in the proceeding,[89] but such a party may file an answer if it so desires. Any other party specified as a concurrent user in an involved concurrent use application must file an answer to avoid default. Any answer filed must be filed within 40 days after the mailing date of the notice, or within an extension of time for the purpose. [90]

If a party that is required, under 37 CFR § 2.99(d)(2), to file an answer fails to do so, judgment will be entered against that party precluding the party from claiming any right more extensive than that acknowledged in the involved concurrent use application(s). However, each concurrent use applicant still will have the burden of proving its entitlement to the registration(s) sought as against every party specified in its application(s), including any party against which default judgment for failure to answer has been entered. That is, the concurrent use applicant still will have to prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary,[91] that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Section 2(d) of the Act, 15 U.S.C. § 1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if

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[87] *See* TBMP §§ 1103.01(c)-(f) (Requirements) and 1106 (Commencement of Proceeding).

[88] *See, for example, Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912 (TTAB 1984); T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984); and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982).

[89] *For information concerning which applications and registrations are involved in a concurrent use proceeding*, *see* TBMP § 1104.

[90] *See also* 37 CFR § 2.99(d)(2); TBMP §§ 501(Stipulations) and 509 (Motion to Extend Time; Motion to Reopen Time); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984). *Cf.* TBMP § 316 (Motions Relating to Pleadings).

[91] *See* TBMP § 1103.01(b) (Jurisdictional Requirement).

any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)].[92] Moreover, if, after the entry of default judgment against a party for failure to answer, the concurrent use applicant seeks to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting party, the defaulting party will be allowed an opportunity to object thereto. If the amendment is permitted, the defaulting party will be allowed to contest the registration sought by the applicant, to the extent that the applicant claims a greater right, as against the defaulting party, than that previously claimed.

When default judgment for failure to file an answer is entered against a party to a concurrent use proceeding, the Board does not continue to send to that party copies of all of the communications issued by the Board in the proceeding, nor do the other parties to the proceeding need to continue serving on the defaulting party copies of all papers which they file in the proceeding. However, a copy of the Board's final decision in the case is mailed to the defaulting party. Moreover, any request by the concurrent use applicant to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting party must be served upon that party. If the amendment is permitted, the Board will send a copy of its action on the request, and copies of all further communications issued by the Board in the proceeding, to the defaulting party. Similarly, after approval of such an amendment, copies of all further papers filed by the other parties to the proceeding should be served on the defaulting party.

If a concurrent use proceeding involves only a concurrent use applicant and one or more specified common law concurrent users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, or applicant has entered into a persuasive settlement agreement with every party against which default judgment has not been entered, applicant may prove its entitlement to registration as against the defaulting users by an "ex parte" type of showing. That is, applicant may prove its entitlement to registration by less formal procedures (such as by the submission of affidavit evidence) than those (such as depositions upon oral examination) normally required for the introduction of evidence in an inter partes proceeding.[93] In such a case, the Board, instead of setting formal trial dates, simply allows the concurrent use applicant time (usually 60 days) in which to submit proof of its entitlement to registration.[94]

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[92] *See* 37 CFR § 2.99(d)(3). *See also Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984).

[93] *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, *supra*. *See also Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992).

[94] *For an example of proof of entitlement to concurrent registration in such a situation*, *see Precision Tune Inc. v. Precision Auto-Tune Inc., supra*.

1108 Issue in Concurrent Use Proceeding; Burden of Proof

37 CFR § 2.99(e) *The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.*

37 CFR §2.116(b) *... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

The issue to be determined in a concurrent use proceeding is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. The Board does not determine the right to registration of a party that is included in the proceeding only as a common law concurrent user, i.e., a party that does not own an involved application or registration (for information concerning the parties to a concurrent use proceeding, and the applications and registrations involved therein.[95]

Each applicant for concurrent registration has the burden of proving its entitlement thereto as against every other party specified in its application as an exception to its claim of exclusive right to use. That is, a concurrent use applicant must prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary,[96] that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Section 2(d) of the Act, 15 U.S.C. § 1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding

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[95] *See* TBMP § 1104 (Parties to Proceeding). *See also Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349 (TTAB 1995); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992);.and *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990).

[96] *See* TBMP § 1103.01(b) (Jurisdictional Requirement).

(or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)].[97]

Any other party may attempt to prove any ground for refusal of registration which might be asserted with respect to an application for an unrestricted registration, as well as other matters, such as, that the concurrent use applicant is entitled to a concurrent registration covering only some of the area specified in its application; that the concurrent use applicant is not entitled to registration at all because it is a bad faith junior user; that applicant does not meet the jurisdictional requirement of use of its involved mark prior to the applicable date specified in Section 2(d) of the Act (*see* TBMP § 1103.01(b)); that applicant's use of its mark is unlawful; etc.[98]

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[97] *See, for example*, Section 2(d) of the Act, 15 U.S.C. § 1052(d); 37 CFR § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *Fleming Companies v. Thriftway Inc., supra* (party is entitled to concurrent use registration for a given territory only if the party actually used the mark in that territory prior to registration by the other party; plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user); *Terrific Promotions Inc. v. Vantex Inc.*, supra (good faith second user that has vigorously expanded under mark given most of U.S.); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Georgia-Southern Oil Inc. v. Richardson*, *supra* (actual use in a territory is not necessary to establish rights in that territory and depends on a number of factors); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc*., 227 USPQ 879, 884 (TTAB 1985) (primary concern in concurrent use proceeding is the avoidance of likelihood of confusion; applicant unable to establish its entitlement to registration in area claimed where senior user was national franchise); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912 (TTAB 1984); *Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351 (TTAB 1974); Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982); and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977). *See also* TBMP § 1103.01(d)(2) (Geographic Restrictions).

[98] *See Bell South Corp. v. DataNational Corp.*, 35 USPQ2d 1554, 1557-59 (Fed. Cir. 1995) (the term "use" means use as a trademark; a concurrent use applicant may claim less than the entire country as the place of use but only when there is actual or potential concurrent use of the mark by another lawful user that is not likely to cause confusion, and where mark is generic in the non-claimed area, there can be no lawful user in the non-claimed area); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (allegation of bad faith adoption and use of mark in U.S. subsequent to user's adoption in foreign country); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of claim of concurrent rights, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *Fleming Companies v. Thriftway Inc.*, *supra* (junior user was not lawful user in that it did not lawfully use the mark in expanded territory prior to defendant's registration); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985, 1988 (TTAB 1988) (plaintiff's use, albeit geographically remote, was not lawful because plaintiff had actual knowledge of defendant's prior use); *Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc.*, 216 USPQ 897, 899 (TTAB 1982) (applicant's first use was neither innocent nor in good faith since applicant had constructive notice of user's mark); and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982); and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977).

In a concurrent use proceeding, a junior party stands in the position of plaintiff, and a senior party stands in the position of defendant.[99] When there are two or more concurrent use applications involved in a concurrent use proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date, and that applicant will be the junior party. A party which is specified in an involved concurrent use application as an excepted user, but which does not have an involved application, shall be considered a party senior to every party that has an application involved in the proceeding.[100]

1109 Conduct of Proceeding

Once commenced,[101] a concurrent use proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that, inter alia, there is no complaint (*see* TBMP § 1107), and thus no motions relating to the complaint; the "answer" is not an answer in the usual sense of the word, and is not always required;[102] if an answer, when required, is not filed, default judgment is entered against the non-answering party, precluding that party from claiming any right more extensive than that acknowledged in the involved concurrent use application(s), but each concurrent use applicant will still have the burden of proving its entitlement to the registration(s) sought;[103] the issue is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof;[104] the order in which the parties offer evidence depends upon whether or not they own an involved application or registration, and, if two or more parties own an involved concurrent use application, the filing dates of such applications;[105] and in certain cases, where default judgment is entered for failure to answer, a concurrent use applicant may be permitted to prove its entitlement to registration by less formal

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[99] *See* 37 CFR § 2.116(b).

[100] *See* 37 CFR § 2.99(e). *See also* Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982).

[101] *See* TBMP § 1106 (Commencement of Proceeding).

[102] *See* TBMP § 1107 (Answer; Default).

[103] *See* TBMP § 1107.

[104] *See* TBMP § 1108 (Issue in Concurrent Use Proceeding; Burden of Proof).

[105] *See* TBMP § 1108.

procedures than those normally required for the introduction of evidence in an inter partes proceeding.[106]

In addition, the trial and briefing schedule in a concurrent use proceeding involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation proceeding. After the time for answer has passed, the Board sends out an order setting trial and briefing dates in the case (except in those default judgment situations where the concurrent use applicant is permitted to prove its entitlement to registration by less formal procedures than those normally required for the introduction of evidence in an inter partes proceeding).[107] Specifically, the Board sets the opening and closing date for discovery, and schedules testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.[108] The testimony periods are separated from the discovery period and from each other by 60-day intervals. Similarly, the Board schedules briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief and meeting the main brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief.[109]

Set forth below is a sample trial and briefing schedule for a concurrent use proceeding involving parties A, B, C, D, and E, where A, B, C, and D are all concurrent use applicants, A's application has the latest filing date, B's application has the next-latest filing date, C's application has the next-latest filing date, D's application has the earliest filing date, and E is a specified concurrent user which does not own an involved application or registration (the trial and briefing schedule would look the same if E were a concurrent use applicant whose application had the earliest filing date, or if E owned an involved registration):

MAILING DATE	1/1/2003
DISCOVERY PERIOD TO OPEN	1/21/2003

[106] *See* TBMP § 1107.

[107] S*ee* TBMP § 1107 (Answer; Default).

[108] *See* 37 CFR § 2.121(b)(2). *See also* TBMP § 701 (Time of Trial).

[109] *See* TBMP § 801.02(e) (Special Situations – Time for Filing).

DISCOVERY PERIOD TO CLOSE	7/20/2003
30-DAY TESTIMONY PERIOD FOR A to close	10/18/2003
30-DAY TESTIMONY PERIOD FOR B to close	12/17/2003
30-DAY TESTIMONY PERIOD FOR C to close	2/15/2004
30-DAY TESTIMONY PERIOD FOR D to close	4/15/2004
30-DAY TESTIMONY PERIOD FOR E to close	6/14/2004
15-DAY REBUTTAL TESTIMONY PERIOD FOR A to close	7/29/2004
15-DAY REBUTTAL TESTIMONY PERIOD FOR B to close	9/12/2004
15-DAY REBUTTAL TESTIMONY PERIOD FOR C to close	10/27/2004
15-DAY REBUTTAL TESTIMONY PERIOD FOR D to close	12/11/2004

BRIEFS ON FINAL HEARING (37 CFR 2.128) shall become due as follows:

BRIEF FOR A is due	2/9/2005
BRIEF FOR B is due	3/11/2005
BRIEF FOR C is due	4/10/2005
BRIEF FOR D is due	5/10/2005
BRIEF FOR E is due	6/9/2005

REPLY BRIEFS, if any, shall be due as follows:

REPLY BRIEF FOR A is due	7/9/2005
REPLY BRIEF FOR B is due	7/24/2005
REPLY BRIEF FOR C is due	8/8/2005
REPLY BRIEF FOR D is due	8/23/2005

Set forth below is another sample trial and briefing schedule for a concurrent use proceeding involving parties X, Y, and Z, where X is a concurrent use applicant, Y owns a registration which is involved in the proceeding, and Z is a specified concurrent user which does not own an involved application or registration:

MAILING DATE	1/1/2003
DISCOVERY PERIOD TO OPEN	1/21/2003
DISCOVERY PERIOD TO CLOSE	7/20/2003
30-DAY TESTIMONY PERIOD FOR X to close	10/18/2003
30-DAY TESTIMONY PERIOD FOR Y to close	12/17/2003
30-DAY TESTIMONY PERIOD FOR Z to close	2/15/2004
15-DAY REBUTTAL TESTIMONY PERIOD FOR X to close	3/31/2004

BRIEFS ON FINAL HEARING (37 CFR 2.128) shall become due as follows:

BRIEF FOR X is due	5/30/2004
BRIEF FOR Y is due	6/29/2004
BRIEF FOR Z is due	7/29/2004

REPLY BRIEFS, if any, shall be due as follows:

REPLY BRIEF FOR X is due	8/13/2004

The trial and briefing schedule set forth immediately above would look the same if Y and Z were both specified concurrent users that did not own an involved application or registration. If X, Y, and Z were all concurrent use applicants, there would be a separate testimony period for each party, and X and Y would each have a separate rebuttal testimony period; each party would also be allowed time to file a brief on the case, but only X and Y would be allowed time in which to file a reply brief.

With the exceptions noted above, the practices and procedures for taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in a concurrent use proceeding as in an opposition or cancellation proceeding.

1110 Settlement Providing for Concurrent Registration

Most concurrent use proceedings before the Board are not litigated to final decision on the merits, but rather are settled on the basis of an agreement between the parties which provides for the issuance to the concurrent use applicant(s) of the concurrent registration(s) sought. Such an agreement is usually filed by the concurrent use applicant(s) together with a request for issuance of the concurrent registration(s) sought.

The Board will not enter judgment on behalf of the concurrent use applicant(s), and find such applicant(s) entitled to concurrent registration, on the basis of a settlement agreement, unless the terms of the agreement are sufficient to persuade the Board that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks.[110]

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[110] *See* Section 2(d) of the Act, 15 U.S.C. § 1052(d); *Meijer, Inc. v. Purple Cow Pancake House*, 226 USPQ 280, 282 (TTAB 1985) (initial agreement deficient in view of, *inter alia*, provision allowing for "spill over" advertising); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351, 352 (TTAB 1974) (mere naked agreement wherein parties have not delineated measures taken to preclude likelihood of confusion is not persuasive); and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982).

For information concerning settlement agreements offered in a concurrent use proceeding as a basis for the issuance of the concurrent registration(s) sought, see Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (agreements to be given "substantial weight"); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 438 (CCPA 1970) (agreements should be given "serious consideration"); *Meijer, Inc. v. Purple Cow Pancake House, supra*; *Handy Spot Inc. v. J. D. Williams Co., supra*; and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, supra*. *Cf. Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208, 1212 (Fed. Cir. 1990) (agreements entitled to "great

If a settlement agreement does not include every party to the proceeding, each concurrent use applicant still will have the burden of proving its entitlement to registration as against every party to the proceeding that is not also a party to the agreement, even if a default judgment for failure to answer has been entered against a non-included party.[111]

1111 Effect of Abandonment of Involved Application

For information concerning the effect of the abandonment of an application that is a subject of a concurrent use proceeding, see TBMP § 603.

1112 Effect of Adverse Decision in Opposition or Cancellation

A party which receives an adverse decision, in an opposition, cancellation, or interference proceeding, on the issue of priority of use is not precluded thereby from seeking concurrent registration, unless its first use in commerce was subsequent to the earliest application filing date of any conflicting application or registration owned by another party to the opposition, cancellation, or interference proceeding; that other party does not consent to the grant of a concurrent registration to the applicant; and concurrent registration is sought by way of a concurrent use proceeding before the Board.[112]

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weight"; although the agreement did not contain explicit provisions designed to avoid confusion or explicit statement that concurrent use of the marks would not cause confusion, the provisions in the agreement reflected recognition by parties that concurrent use by marks in their respective, albeit in contiguous geographic areas, would not cause likelihood of confusion).

[111] *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987) (ex parte type showing permitted).

[112] *See* Section 2(d) of the Act, 15 U.S.C. § 1052(d); *U.S. Soil, Inc. v. Colovic*, 214 USPQ 471 (TTAB 1982) (opposition cannot proceed where it has been established through prior litigation that applicant has superior rights, and where opposer only alleges that it has rights in certain geographic areas); *Home Federal Savings & Loan Ass'n v. Home Federal Savings & Loan Ass'n of Chicago*, 205 USPQ 467 (TTAB 1979); *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265 (TTAB 1977); and *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner). *For information concerning the jurisdictional requirement of Section 2(d) of the Act, see* TBMP § 1103.01(b).

1113 "Conversion" of Opposition or Cancellation Proceeding to Concurrent Use Proceeding

1113.01 Conversion of Opposition Proceeding

In certain situations, an opposition proceeding may be "converted" into a concurrent use proceeding. In these cases, the opposition proceeding is not actually transformed into a concurrent use proceeding. Rather, the opposition is terminated, usually by dismissal without prejudice, in favor of the concurrent use proceeding. The concurrent use proceeding, in turn, is instituted immediately. In fact, notice of the institution of the concurrent use proceeding is normally included in the decision terminating the opposition proceeding.[113]

An opposition may be terminated in favor of a concurrent use proceeding in the situations described below:

> **(1)** When an opposition to a concurrent use application is filed by a party specified in the application as an exception to applicant's claim of exclusive use, the opposition may be dismissed without prejudice in favor of a concurrent use proceeding.[114] This action may be taken by the Board upon its own initiative, or upon motion.
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> **(2)** When an opposition to a concurrent use application is filed by a party which is *not* specified in the application as an exception to applicant's claim of exclusive use, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if opposer files an application for concurrent registration, naming applicant as an exception to its claim of exclusive use. However, the opposition will not be dismissed, and the concurrent use proceeding instituted, unless opposer's concurrent use application is published in the *Official Gazette* for opposition, and no opposition is filed, or all oppositions filed are dismissed.

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[113] *See* Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings*, 76 Trademark Rep. 252 (1986). *Cf.* 37 CFR § 2.99(c) (in effect providing, inter alia, that when a concurrent use application has been published in the *Official Gazette* for opposition, a concurrent use proceeding will not be instituted unless no opposition is filed, or unless all oppositions that are filed are dismissed).

[114] *See Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977) (applicant's motion to dismiss opposition and institute concurrent use granted; party named as exception filed opposition against concurrent use application; by setting forth opposer as exception to applicant's exclusive right to use, applicant has, in effect, admitted that it is not entitled to unrestricted registration).

(3) When an opposition to a concurrent use application is filed by a party which is *not* specified in the application as an exception to applicant's claim of exclusive use, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if applicant amends its application to specify the opposer as an additional exception to its claim of exclusive use.

(4) When an opposition is filed against an application for an unrestricted registration, the applicant may file a motion to amend its application to one for concurrent registration, reciting opposer as an exception to applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If opposer consents to the amendment, the opposition will be dismissed without prejudice, and the concurrent use proceeding will be instituted. If opposer does not consent to the amendment, but applicant consents to entry of judgment against itself with respect to its right to an unrestricted registration, judgment will be entered against applicant, in the opposition, with respect to applicant's right to an unrestricted registration; the amendment will be approved; and a concurrent use proceeding involving the amended application will be instituted, all in one Board action.[115]

1113.02 Conversion of Cancellation Proceeding

In appropriate situations, a cancellation proceeding may also be terminated in favor of a concurrent use proceeding, if one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; the application is published in the *Official Gazette* for opposition; and no opposition is filed, or all oppositions filed are dismissed.[116]

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[115] *See Terrific Promotions Inc. v. Vanlex Inc.*, 36 USPQ2d 1349, 1350 (TTAB 1995) (opposer objected to amendment; judgment entered; concurrent use proceeding instituted); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 920 (TTAB 1983) (applicant accepted judgment in opposition; concurrent use proceeding instituted); Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications*, 83 Trademark Rep. 416 (1993); and Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings*, 76 Trademark Rep. 252 (1986).

See also Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982), and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977) (NOTE: these two articles were written at earlier stages in the development of the Board's practice concerning termination of an opposition in favor of a concurrent use proceeding).

[116] *See Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner).

1114 Alteration of Restrictions on Concurrent Registration

A concurrent registration may be issued only pursuant to the decision of the Board in a concurrent use proceeding, or on the basis of a final determination, by a court of competent jurisdiction, that more than one person is entitled to use the same or similar marks in commerce.[117] A registration cannot be restricted territorially by amendment under Section 7(e) of the Act, 15 U.S.C. § 1057(e), and 37 CFR § 2.173(a).[118]

Further, a concurrent registrant which wishes to alter the restriction to its registration ordinarily may do so, if at all, only through an appropriate decision in a new concurrent use proceeding before the Board, or a new civil action before a court of competent jurisdiction; a Section 7(e) amendment cannot be used to alter a concurrent use restriction.[119]

However, removal of such a restriction by amendment under Section 7(e) may be permitted where an entity which was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant.[120]

In addition, if every concurrent user specified in a concurrent registration abandons its use of its involved mark, and owns no subsisting registration thereof, the owner of the remaining concurrent registration may file a new application for an unrestricted registration of the mark.

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[117] *See* TBMP § 1102.02 (Bases for Concurrent Registration) and authorities cited therein.

[118] *See Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841 (TTAB 1989); *In re Alfred Dunhill Ltd.,* 4 USPQ2d 1383 (Comm'r 1987); and *In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984).

[119] *See Morgan Services Inc. v. Morgan Linen Services Inc.*, *supra; In re Alfred Dunhill Ltd., supra;* and *In re Forbo*, *supra.*

[120] *See In re Alfred Dunhill Ltd., supra.*

1201 Propriety of Appeal

1201.01 Readiness of Case for Appeal

15 U.S.C. § 1070 [Section 20 of the Trademark Act] Appeal from examiner to Trademark Trial and Appeal Board.

An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

37 CFR § 2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) the requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see § 2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 CFR § 2.64(a) *On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by § 2.63(b).*

37 CFR § 2.64(b) *During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action. The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Director, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three months after the date of the final action. Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.*

37 CFR § 2.141 Ex parte appeals from the Examiner of Trademarks.
Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

Chapter 1200
EX PARTE APPEALS

37 CFR § 2.146(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§ 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

On the first or any subsequent reexamination or reconsideration of an application for registration of a trademark, the Examining Attorney may state that the refusal of the registration or the insistence upon a requirement is final.[1] When the Examining Attorney states that his or her action is final, the applicant's response is limited to an appeal to the Board, or to compliance with any requirement, or to a petition to the Director if a petition is permitted by 37 CFR § 2.63(b).[2] An applicant may, pursuant to 37 CFR § 2.64(b), file a request for reconsideration, but the submission of such a request does not automatically extend the applicant's time for filing a notice of appeal. Thus, if an applicant submits a request for reconsideration within the six-month time period from the mailing date of the final action, but does not file a notice of appeal within that time period, if the request for reconsideration fails to persuade the Examining Attorney, and the Examining Attorney does not issue a new final refusal, the application will be deemed abandoned.[3]

An applicant may consider a second refusal on the same ground(s), or a repeated requirement, as final for purposes of appeal.[4] All grounds and/or requirements must be repeated in order for the second refusal to be considered as final.[5]

Thus, an application is ripe for appeal when the Examining Attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or from a repeated requirement.[6] However, an Office action that repeats one or more grounds for refusal or requirements but also raises a new ground or requirement may not be considered as final for purposes of appeal.

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[1] *See* Section 12(b) of the Act; 15 U.S.C. § 1062(b); 37 CFR § 2.64(a); and TMEP §§ 713, 714.03.

[2] *See* 37 CFR § 2.64(a), and TMEP § 715.01. *See also* Section 20 of the Act, 15 U.S.C. § 1070, and TMEP § 1501.

[3] *In re GTE Education Services*, 34 USPQ2d 1478, 1480 (Comm'r 1994).

[4] *See In re MediaShare Corp.*, 43 USPQ2d 1304, 1305 n.2 (TTAB 1997); *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053, 1054 n.2 (TTAB 1991); and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985); 37 CFR § 2.141; and TMEP § 1501.

[5] *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

[6] *See In re Hechinger Investment Co. of Delaware Inc., supra*; and *In re Citibank, N.A.*, *supra;* Section 20 of the Act; 15 U.S.C. § 1070; 37 CFR §§ 2.64(a) and 2.141; and TMEP § 1501.

1201.02 Premature Final

15 U.S.C. § 1062(b) *If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.*

A refusal of registration or an insistence upon a requirement may be made final by the Trademark Examining Attorney only on the first or any subsequent reexamination or reconsideration of an application; a refusal or requirement may not be made final in a first action.[7]

An action should not be stated to be final until the applicant has had at least one opportunity to reply to each ground of refusal, and each requirement, asserted by the Examining Attorney.[8] Moreover, a final action should not be issued until all matters but for those which are to be the subject of the final action have been resolved, and a clear issue has been developed between the Examining Attorney and the applicant with respect to each remaining ground of refusal or requirement.[9] As stated in TMEP § 714.03:

> No requirement may be made final, even if it is a repeated requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.

Examples of new issues that would preclude the issuance of a final action until applicant has had an opportunity to respond are amendments to the drawing,[10] and amendments to the Supplemental Register or to assert acquired distinctiveness.[11] However, if the amendment is

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[7] *See* Section 12(b) of the Act, 15 U.S.C. § 1062(b); 37 CFR § 2.64(a); and TMEP § 714.01

[8] *See* TMEP § 714.01. *See also In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1154 (TTAB 1992), and *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986).

[9] *See* TMEP § 714.03. *See also In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (ground for refusal first raised in Examining Attorney's appeal brief given no consideration).

[10] *See In re Abolio y Rubio S.A.C.I. y G.*, *supra.*

[11] *See In re Audio Book Club Inc.*, 52 USPQ2d 1042, 1043 n.2 (TTAB 1999) and TMEP § 714.05 *et seq*.

irrelevant to an outstanding refusal or is merely cumulative, it is not deemed to raise a new issue.[12]

If an applicant believes that a refusal to register, or the insistence upon a requirement, has been made final prematurely, applicant may raise the matter by request to the Examining Attorney for reconsideration or by contacting the managing attorney or senior attorney in the Examining Attorney's law office. If the Examining Attorney does not withdraw the finality, the applicant may file a petition under 37 CFR § 2.146.[13]

The prematureness of a final action is not a ground for appeal to the Board.[14] However, if it comes to the attention of the Board, when an appeal has been filed from a final refusal to register or a final requirement, that the final action was issued prematurely, the Board normally will decline to institute the appeal and will forward the case to the Examining Attorney for appropriate action. That action is generally that the finality of the Examining Attorney's action is withdrawn and a new nonfinal action is issued. The Board letter will generally indicate that if the Examining Attorney finds, upon consideration of applicant's response to the new nonfinal action, that the application is in condition for publication (or for registration, if the application seeks registration on the Supplemental Register), the applicant may request a refund of the previously submitted appeal fee; and that if the Examining Attorney ultimately issues a new final action, and the applicant wishes to appeal, a new notice of appeal should be filed, in which the applicant requests that the previously submitted appeal fee should be applied to the appeal.

1201.03 Premature Appeal

An application is ripe for appeal when the Trademark Examining Attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or a repeated requirement; an appeal from a first refusal or requirement is premature.[15] All grounds and/or requirements must be repeated in order for the second refusal to be considered as final.[16] If, in response to a final Office action, applicant files a request for reconsideration that raises a new

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[12] *See In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (amendment to the Supplemental Register in response to a refusal of registration under § 2(a) does not raise a new issue); *In re GTE Education Services*, 34 USPQ2d 1478, 1480 (Comm'r 1994) (Examining Attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for same reason as the original specimens). *See also* TMEP §§ 714.05, 714.05(a), and 714.05(a)(i);

[13] *See* TMEP § 714.06.

[14] *See* TMEP § 714.06.

[15] *See* TBMP § 1201.01 (Readiness of Case for Appeal) and authorities cited therein.

[16] *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

issue, and does not file a notice of appeal, applicant may not then file an appeal until a final Office action issues with respect to the new issue.[17]

The Board has no jurisdiction to entertain a premature appeal. Thus, if an appeal is filed prematurely the Board, in a written action, will notify applicant that the appeal was filed prematurely and forward the application to the Trademark Examining Attorney for further appropriate action. The Examining Attorney will normally treat the premature notice of appeal as an incomplete response under 37 CFR § 2.65(b) and allow applicant time to submit a complete response. If applicant has also filed a request for reconsideration or an appeal brief, the request for reconsideration or brief may be treated as a response.[18] In the event that the Examining Attorney ultimately issues a final action, or a second refusal on the same ground(s) or a repeated requirement, and applicant wishes to appeal, applicant should file a new notice of appeal, and request that the appeal fee previously submitted be applied to the new appeal. If, on the other hand, no new appeal is ever filed in the case, applicant may request that the appeal fee submitted with the premature appeal be refunded.

1201.04 Compliance With Requirements Not Subject of Appeal

37 CFR § 2.142(c) *All requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal.*

Prior to the filing of an appeal, the applicant should comply with all requirements that the Trademark Examining Attorney, has made, but which are not the subject of appeal. If an applicant who files an appeal to the Board fails to comply with a requirement not the subject of appeal, the refusal to register may be affirmed by the Board as to that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal.[19]

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[17] *In re Virshup*, 42 USPQ2d 1403, 1404 (TTAB 1997) (after final refusal on Principal Register, applicant amended to Supplemental Register; applicant's appeal of initial refusal on Supplemental Register held premature).

[18] *In re Virshup*, *supra*.

[19] *See* 37 CFR § 2.142(c); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Cord Crafts Inc.*, 11 USPQ2d 1157, 1157 n.2 (TTAB 1989); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371, 373 (TTAB 1978); and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984). *Cf. In re Walker-Home Petroleum, Inc.*, 229 USPQ 773, 774 (TTAB 1985), and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985).

NOTE: A possible alternative approach for use in situations where informalities that are not the subject of the appeal have not been resolved, suggested in *In re Variable Speech Control Co.*, 209 USPQ 431, 433 (TTAB 1980), of including in the Board's decision on the appealed issues a recommendation that no registration be granted to applicant until the informalities have been resolved, is no longer appropriate. This is because (1) the current 37 CFR § 2.142(c), adopted thereafter, provides that all requirements made by the Examining Attorney and not the subject of appeal shall be complied with prior to the filing of an appeal, and (2) it is now settled that once the Board decides an appeal, the Examining Attorney is without jurisdiction to take further action in the case, nor may the Board, in its decision on the appealed issues, remand the case for further action on a matter not before it in the appeal. S*ee In re*

Thus, an applicant may not defer compliance with an outstanding requirement, such as the submission of a proper drawing or declaration to support substitute specimens, until after the Board rules on any substantive grounds for refusal.

1201.05 Appeal Versus Petition

37 CFR § 2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) the requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see § 2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 CFR § 2.64(a) *On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by § 2.63(b).*

37 CFR § 2.146(a) *Petition may be taken to the Director: (1) from any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*
(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§ 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

An action taken on a matter arising during the ex parte prosecution of an application for registration may, depending on the nature of the matter and the posture of the case, be reviewable only by appeal to the Board, or only by petition to the Director or by either appeal or petition.

Hamilton Bank, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 397 n.2 (TTAB 1982); and TBMP §§ 1202.01 (Readiness of Case for Appeal) and 1217 (Final Decision).

Chapter 1200
EX PARTE APPEALS

The following discussion contains general guidelines for determining whether a matter is appealable or petitionable.

An appeal to the Board may be taken from any final action, second refusal to register on the same ground(s), or repeated requirement issued by the Trademark Examining Attorney during the ex parte prosecution of an application for registration, whether the matter involved in the Examining Attorney's action is substantive or procedural in nature, except that a formal requirement which was the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board.[20]

Substantive questions arising during the ex parte prosecution of an application, including, but not limited to, issues arising under Sections 2, 3, 4, 5, 6, and 23 of the Act, 15 U.S.C. §§ 1052, 1053, 1054, 1055, 1056, and 1091, are considered to be appropriate subject matter for appeal to the Board (after issuance of a final action, or a second refusal on the same ground(s)),[21] but not for petition to the Director.[22]

A wide variety of matters are petitionable. Petition may be taken to the Director in the following situations:

> (1) From any repeated or final formal requirement made by the Trademark Examining Attorney, during the ex parte prosecution of an application, if **(i)** the requirement is repeated, but the Examining Attorney's action is not made final and the subject matter of the requirement is appropriate for petition to the Director;[23] or **(ii)** the Examining Attorney's action is made final and is limited to subject matter appropriate for petition to the Director.[24] If the petition is denied, the applicant will have six months from the date

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[20] *See* Section 20 of the Act, 15 U.S.C. § 1070; 37 CFR §§ 2.63(b), 2.64(a), and 2.141; *In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986); and TBMP § 1201.01 (Readiness of Case for Appeal).

[21] *See* TBMP § 1201.01

[22] *See* 37 CFR § 2.146(b); TMEP § 1704; *In re The Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778, 1781 (Comm'r 1995); *In re Mission Pharmacal Co., Inc.*, 33 USPQ2d 1060, 1061 (Comm'r 1993); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393, 1393 (Comm'r 1993); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990); *In re Hart*, 199 USPQ 585, 586-87 (Comm'r 1978); and *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978).

[23] *See, in this regard,* 37 CFR § 2.146(b), and the preceding paragraph.

[24] *See* 37 CFR §§ 2.63(b) and 2.146(a)(1); *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997) (question of whether Examining Attorney's failure to issue substantive refusal during initial, pre-Statement-of-Use examination was clear error is procedural and reviewable on petition to Director; Board's decision on appeal is limited to the correctness of underlying substantive refusal; applicant that wishes to challenge procedural propriety must file petition after issuance of final refusal); *In re The Du Pont Merck Pharmaceutical Co.*, *supra* (proper signatory for an application and Statement of Use filed by a partnership); and *In re Stenographic Machines, Inc.*, *supra* (requirement for a more particular identification of goods).

of the Office action which repeated the requirement or made it final, or 30 days from the date of the Director's decision on the petition, whichever is later, to comply with the requirement. A formal requirement that was the subject of a petition to the Director may not thereafter be the subject of an appeal to the Board.[25]

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or Part 2 of 37 CFR (i.e., the rules of practice in trademark cases) specifies that the matter is to be determined directly or reviewed by the Director.[26] Insofar as applications for registration are concerned, this includes petitions to review the denial of requests for extensions of time to file statements of use under 37 CFR §2.89(g), petitions to review the actions of Post Registration examiners under 15 U.S.C. §§1057, 1058 and 1059, and petitions to record a document in the Assignment Services Division of the USPTO.[27]

(3) To invoke the supervisory authority of the Director in appropriate circumstances.[28] Under this provision, an applicant generally may petition to the Director for relief from, *inter alia*, a nonfinal refusal to register based on a procedural matter, *i.e.*, an alleged failure of the applicant to comply with a technical requirement of the rules of practice governing trademark cases; or an alleged failure of the Examining Attorney to act in accordance with those rules and/or proper practice thereunder.[29]

(4) In any case not specifically defined and provided for by Part 2 of 37 CFR (*i.e.*, the rules of practice in trademark cases).[30] Under this provision, an applicant may petition the Director with respect to any situation, not covered by the rules, from which applicant seeks relief.[31]

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[25] *See* 37 CFR § 2.63(b). *See also In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

[26] *See* 37 CFR § 2.146(a)(2).

[27] *See* TMEP §§ 1702**,** 1703 and 1704.

[28] *See* 35 U.S.C. § 2 and 37 CFR § 2.146(a)(3).

[29] *See, for example, In re Mission Pharmacal Co., Inc.*, 33 USPQ2d 1060, 1061 (Comm'r 1993) (whether Examining Attorney acted properly in issuing final Office action); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393, 1393 (Comm'r 1993) (whether Examining Attorney properly suspended application); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990) (whether Examining Attorney properly refused to allow amendment of drawing to correct an allegedly obvious typographical error); and TMEP §§ 1702 and 1703. *For further information concerning the matters that are petitionable under this provision*, *see* TMEP § 1707.

[30] *See* 37 CFR § 2.146(a)(4).

[31] *See* TMEP § 1708

(5) In an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules which is not also a requirement of the Act of 1946.[32]

However, petition may not be taken to the Director on a question of substance arising during the ex parte prosecution of an application; nor may petition be taken from a final action of the Examining Attorney, except that an applicant may petition for relief from an action making a formal requirement final if the action is limited to subject matter appropriate for petition to the Director (*i.e.*, involves questions such as the applicant's alleged failure to comply with one or more of the technical requirements of the rules of practice in trademark cases, rather than a question of substance).[33]

For examples of matters that are appealable and those that are petitionable, see TMEP §§ 1703 and 1704.

1202 Filing an Appeal

1202.01 In General

15 U.S.C. § 1070. *An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.*

37 CFR § 2.141 Ex parte appeals from the Examiner of Trademarks.
Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

37 CFR § 2.142(a) *Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal and paying the appeal fee.*

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[32] *See* 37 § 2.146(a)(5). *For information concerning the meaning of the words "extraordinary situation" see* TMEP § 1708.

[33] *See* 37 CFR §§ 2.63(b), 2.64(a), 2.146(a), and 2.146(b); *In re Tetrafluor Inc.*, *supra; In re Hart*, *supra; In re Stenographic Machines, Inc.*, *supra;* and TMEP §§ 1702 and 1704.

An appeal to the Board from a Trademark Examining Attorney's final action, second refusal on the same ground(s), or repeated requirement, is taken by timely[34] filing in the USPTO both a notice of appeal *and* the prescribed appeal fee.[35] If the notice of appeal *and* fee are not timely filed, the application will be deemed to have been abandoned, and the Board cannot entertain the appeal unless applicant successfully petitions the Director to revive the application.[36]

All requirements which have been made by the Trademark Examining Attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal.[37] If an applicant which files an appeal to the Board fails to comply with such a requirement, the refusal to register may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues which are the subject of appeal.[38]

If an application contains multiple classes, and a final refusal or requirement pertains to some, but not all, of the classes in the application, the applicant has the option of filing an appeal for the application as a whole, or filing a request to divide the application to sever those classes for which there has been no final requirement or refusal. In the former case, the application will not be published for opposition (or a registration will not issue in the case of an application on the Supplemental Register) for those classes for which no refusal or requirement was made final until the appeal is decided. If a request to divide the application is filed,[39] the classes for which there is no final requirement or refusal which have been divided out of the application will proceed to publication or registration, as appropriate, and an appeal will be instituted for the remaining classes for which an appeal has been filed.[40]

1202.02 Time for Appeal

An appeal to the Board may be taken from any final action, second refusal on the same ground(s), or repeated requirement issued by the Trademark Examining Attorney during the ex parte prosecution of an application for registration, except that a formal requirement which was

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[34] *See* TBMP § 1202.02 (Time for Appeal).

[35] *See* 37 CFR § 2.6(a)(18) and TBMP § 1202.04 (Appeal Fee). *See also* Section 20 of the Act, 15 U.S.C. § 1070; 37 CFR §§ 2.141 and 2.142(a); and TMEP § 1501.

[36] *See* Section 12(b) of the Act, 15 U.S.C. § 1062; 37 CFR §§ 2.64(a), 2.65(a), and 2.66; and TMEP §§ 718.02, 718.05, 1501.04, 1714 and 1714.01(a).

[37] *See* 37 CFR § 2.142(c).

[38] *See* TBMP § 1201.04 (Compliance with Requirements Not Subject of Appeal) and authorities cited therein.

[39] *See* 37 CFR § 2.87.

[40] *See* TBMP § 1202.05 (Multiple Class Applications).

the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board.[41]

An appeal to the Board must be filed within six months from the date of the action from which the appeal is taken.[42] If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned.[43] .

The notice of appeal to the Board (unlike other correspondence to be filed with the Board) may be filed by facsimile transmission, as well as by any of the ordinary methods for filing correspondence intended for the Board.[44] The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for the filing of an appeal to the Board.[45]

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence.[46] However, the filing of a request for reconsideration will *not* serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate.)[47] If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response[48] to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned.[49] Thus, if

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[41] *See* TBMP §§ 1201.01 (Readiness of case for Appeal) and 1201.05 (Appeal vs. Petition) and authorities cited therein.

[42] *See* Section 12(b) of the Act, 15 U.S.C. § 1062, and 37 CFR § 2.142(a).

[43] *See* TBMP § 1202.01 and authorities cited therein

[44] *See* 37 CFR § 1.6(d)(8), and TBMP § 107 (How and Where to File Papers).

[45] *See* 37 CFR §§ 1.8(a) and 1.10(a), and TBMP §§ 110 (Certificate of Mailing/Transmission) and 111 ('Express Mail' Procedure). It is noted that the examining operation has eliminated the Express Mail procedure, *see* TMEP § 305.03. However, because the notice of appeal is filed with the Board, rather than the examining operation, the Express Mail procedure is available for such filings.

[46] *See* 37 CFR § 2.64(b) and TBMP § 1204 (Effect of Request for Reconsideration). *See also* TMEP §§ 715.02 and 715.03(a), and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984).

[47] *See* 37 CFR §§ 2.63(b) and 2.64(a), and TBMP § 1201.05 (Appeal vs. Petition). *See also* 37 CFR § 2.64(b), and TMEP §§ 715.03 and 715.03(c).

[48] *See* 37 CFR § 2.64(a), and TMEP § 715.01.

[49] *See* 37 CFR §§ 2.64 and 2.142(a), and TMEP § 715.03(a).

an applicant who has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant must file an appeal prior to the expiration of the six-month period following issuance of the final action.

If an appeal is late filed, but applicant timely filed some other response to the appealed action, such as an amendment or request for reconsideration, the Board will issue a written action informing applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the Examining Attorney for appropriate action with respect to the paper that was timely filed. An applicant may petition the Director to revive an application for failure to file a timely appeal, as an appeal is considered a response to an Office action.[50]

1202.03 Notice of Appeal

A notice of appeal is a simple statement indicating that applicant appeals from the decision of the Trademark Examining Attorney refusing registration; reasons for appeal need not be given. The notice of appeal should bear at its top the wording "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application in which the appeal is being filed, namely, applicant's name, the serial number and filing date of the application, and the involved mark. Only one copy of the notice of appeal should be submitted.

A notice of appeal need not be verified, and it may be signed by the applicant or its attorney or other authorized representative.

Although the notice of appeal must be signed, an unsigned notice of appeal will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board.[51] The same is true of other unsigned papers filed in an application during an ex parte appeal to the Board.

For further information concerning signature of papers, see TBMP § 106.02.

The Board prefers that a notice of appeal be submitted in typewritten or printed form, double-spaced. A notice of appeal may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended.[52]

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[50] *See* 37 CFR § 2.66(a).

[51] *Cf.* 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

[52] *See* TBMP § 106.03 (Form of Papers).

The USPTO has no printed form for use in filing a notice of appeal. However, as an aid to applicants, the USPTO has prepared a suggested format for a notice of appeal. A notice of appeal need not follow the suggested format, as long as it includes the necessary information. The suggested format for a notice of appeal can be found in the Appendix of Forms in this manual.

If applicant files a request for reconsideration or amendment along with the notice of appeal, or at the time of filing the notice of appeal applicant had filed a request for reconsideration or amendment which is still pending before the Examining Attorney, the applicant should indicate this in its notice of appeal so that the Board can obtain the request for reconsideration prior to instituting the appeal.[53] However, the request for reconsideration or amendment should not be combined in the body of the notice of appeal.

1202.04 Appeal Fee

37 CFR § 2.85(e) *Where the amount of the fee received on filing an appeal in connection with an application or on an application for renewal or in connection with a petition for cancellation is sufficient for at least one class of goods or services but is less than the required amount because multiple classes in an application or registration are involved, the appeal or renewal application or petition for cancellation will not be refused on the ground that the amount of the fee was insufficient if the required additional amount of the fee is received in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office, or if action is sought only for the number of classes equal to the number of fees submitted.*

37 CFR § 2.141 Ex parte appeals from the Examiner of Trademarks.
Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

An ex parte appeal to the Board is taken by timely filing in the USPTO both a notice of appeal *and* the prescribed appeal fee. If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned.[54] In such circumstance, however, the applicant may file a petition to revive.[55] Further, if a party fails to

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[53] *See* TBMP §§ 1204 (Effect of Request for Reconsideration of Final Action) and 1205 (Amendment of Application During Appeal).

[54] *See* TBMP § 1202.01 (Filing an Appeal in General) and authorities cited therein.

[55] *See generally*, TMEP § 1714, and particularly § 1704.01(f)(ii).

timely file an appeal fee but has previously given a general authorization to charge all fees that may become due during the pendency of an application to a deposit account, such authorization will be accepted upon petition to the Director.[56]

The amount of the fee required for an ex parte appeal to the Board is specified in 37 CFR § 2.6(a)(18). If an application in which an appeal is filed has more than one class of goods and/or services[57] the required fee must be paid for each class in which appeal is taken.[58] If an appeal is taken in, and an appeal fee is submitted for, fewer than all of the classes in the application, the class or classes in which the appeal is taken should be specified.[59] If the final requirement or refusal does not pertain to all classes in the application, the appeal fee need be submitted only for those classes for which a final requirement or refusal has issued.[60]

If an applicant timely submits a fee sufficient to pay for an appeal in at least one class, but the fee submitted is less than the required amount because multiple classes in an application are involved, and applicant has not specified the class or classes to which the submitted fee applies, the Board will issue a written notice allowing applicant until a set time in which to submit the required fee or to specify the class or classes appealed. If the required fee is not submitted, or the specification made, within the time set in the notice, the fee submitted will be applied to the classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which sufficient fees have been submitted.[61]

1202.05 Multiple Class Applications

If an application contains multiple classes, and the final refusal or requirement pertains to some but not all of the classes, an applicant may choose to file an appeal for the application as a whole, or it may choose to file a request to divide the application. In the former case, the classes for which an appeal has not been taken remain part of the file. After a decision on the appeal is rendered, the classes that were not part of the appeal (and those classes for which the refusal or requirement was reversed) will be published for opposition or, in the case of an application on the Supplemental Register, will proceed to registration. If a request to divide is filed along with a notice of appeal, the appeal will be suspended until action is taken on the request to divide.

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[56] *See In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r 1996).

[57] *See* 37 CFR § 2.86(b)).

[58] *See* 37 CFR § 2.6(a)(18).

[59] *See* 37 CFR § 2.141, and TMEP § 1403.05(a).

[60] *See* TBMP § 1202.05 (Multiple Class Applications).

[61] *See* 37 CFR §§ 2.85(e) and 2.141.

Those classes for which there is no final requirement or refusal, and which have been divided out, will immediately proceed to publication or, in the case of an application on the Supplemental Register, to registration, and will not be delayed pending a decision on the appeal.

If the final refusals or requirements do not apply to all the classes in a multiple class application, an appeal fee is required only those classes for which the appeal is taken, that is, those classes for which a final refusal or requirement is made. This is true whether or not the applicant requests that the application be divided.

1203 Appeal Briefs

It should be noted that if the ground or one of the grounds for refusal is likelihood of confusion with a registered mark, it is suggested, before applicant and the Examining Attorney file their respective briefs, that they check the records of the USPTO to ascertain whether the cited registration has been cancelled or has expired.[62]

For information about requesting suspension pending a determination as to whether a cited registration has been cancelled or has expired, see *TBMP § 1213.*

1203.01 Form of Brief

37 CFR § 2.142(b)(2) *Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety.*

A brief filed in an ex parte appeal to the Board should conform to the requirements of 37 CFR § 2.142(b)(2). Only one copy of the brief should be submitted. The twenty-five pages allowed for an appeal brief does not refer to any exhibits attached to the brief. However, material that was not previously made of record should not be submitted with the appeal brief.[63] Also, the appeal brief is placed in the application file, so papers which are already in the file should not, as a matter of course, be resubmitted as exhibits to the brief. Most appeal briefs are far less than the twenty-five pages allowed by the rule and, given the limited issues and record in an appeal, the Board will rarely grant a motion for leave to exceed the twenty-five page limit.[64] If an applicant

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[62] *See* TBMP § 1212 (Cancellation or Assignment of Cited Registration).

[63] *See* TBMP §§ 1203.02(e) (Material Submitted with Briefs) and 1207.01 (Evidence Submitted After Appeal Untimely – General Rule).

[64] *See In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (applicant's request for a waiver in order to include an additional 10 pages denied; applicant's attempt to submit discussion as an appendix to brief treated by Board as an attempt to circumvent the Board's order denying the waiver, and sanctions imposed).

files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal.

The brief should indicate that it is an appeal brief, and include information identifying the application in which it is filed, namely, the applicant's name, the serial number and filing date of the application, and the mark sought to be registered.[65] An appeal brief need not include the formal requirements, such as a table of contents, index of cases and description of the record, of a trial brief.[66]

For further information concerning the form and contents of the Trademark Examining Attorney's appeal brief, in particular, see TMEP §1501.02.

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 CFR § 2.142(b)(1) *The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.*

An applicant's main brief in an ex parte appeal to the Board must be filed within 60 days from the date of appeal, or within an extension of time for that purpose. The time for filing the brief is set by rule; therefore, although the Board attempts to send the applicant an acknowledgement of the receipt of the notice of appeal which indicates the date the brief is due, the failure to receive such acknowledgement does not affect the deadline for such filing.[67] If no brief is filed, the appeal will be dismissed.[68] If the brief is filed late, applicant will be allowed an opportunity to submit an explanation for the late filing; in the absence of an adequate explanation, the appeal will be dismissed. The determination of whether to accept the brief will depend on the circumstances, including the length of time after the due date that the brief is filed.

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[65] *Cf.* TMEP § 302.03.

[66] *Cf.* 37 CFR § 2.128(b).

[67] *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

[68] *See* 37 CFR § 2.142(b)(1).

If the appeal is dismissed for failure to file a timely brief, applicant's recourse is to file a petition to the Director under the provisions of 37 CFR § 2.146(a)(3). Because such a petition invokes the supervisory authority of the Director, it is determined under the clear error/abuse of discretion standard, that is, whether the Board has committed clear error or abused its discretion in its determination not to accept the late-filed brief.[69] The applicant should not file a petition to the Director until it has first filed with the Board a request/motion to accept the late-filed brief, and that request/motion has been denied.

Further, a petition to revive is not available when applicant has failed to file an appeal brief or has filed its appeal brief late. The petition to revive procedure provided in 37 CFR § 2.66(a) applies only to situations in which the applicant did not timely respond to an Office action or notice of allowance. The filing of an appeal brief is not a response to an Office action. Thus, the "unintentional delay" standard of 37 CFR § 2.66(a) does not apply to the determination of whether a late-filed brief will be accepted.

If a notice of appeal (accompanied by the required fee) is filed with a certificate of mailing by first-class mail pursuant to 37 CFR § 1.8, the date of mailing specified in the certificate will be used for determining the timeliness of the notice of appeal. However, the actual date of receipt of the notice of appeal in the USPTO will be used for all other purposes, including the running of the time for filing applicant's main brief.[70]

If an applicant which has filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, also files a timely appeal, and the Examining Attorney has not yet considered the request for reconsideration when the appeal is filed, or if applicant files a request for reconsideration along with the notice of appeal, the file of the application, with the appeal and the request for reconsideration, will be forwarded to the Board. However, because papers may become separated, if applicant files a request for reconsideration along with the notice of appeal, it should indicate in the notice of appeal that a request for reconsideration is being filed contemporaneously. The Board will acknowledge receipt of the appeal and request, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Examining Attorney for consideration of the request. Because proceedings in the appeal are automatically suspended when a request for reconsideration is pending, the applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 CFR § 2.142(b)(1), even if the Board has not issued its order suspending proceedings prior to

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[69] *See* TMEP § 1706.

[70] *See* 37 CFR § 1.8(a).

the date the appeal brief would otherwise be due. Nor does the applicant need to verify with the Board that the due date for its brief will be changed if necessary.[71]

If, upon the Examining Attorney's consideration of the request for reconsideration, all refusals and requirements are not withdrawn, and a new final refusal to register is issued (either in the Examining Attorney's action on the request for reconsideration, or in a subsequent action)[72] the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief. If the Examining Attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. The Examining Attorney should so notify the applicant either in a written action or by telephone.[73]

1203.02(b) Trademark Examining Attorney's Brief

When the applicant's main appeal brief has been received by the Board and entered in the application file, the Board sends the file to the Trademark Examining Attorney. Within 60 days after the date of the Board's written action forwarding the file to the Examining Attorney, or within an extension of time for the purpose, the Examining Attorney must file an appeal brief answering the applicant's main brief.[74] The Examining Attorney must also mail a copy of his or her brief to the applicant.[75] If the Examining Attorney's brief is late filed, the Board may exclude it in the absence of an adequate explanation for the late filing.[76]

If the Examining Attorney, having received the application for preparation of his or her appeal brief, is persuaded, by applicant's appeal brief, that applicant is entitled to the

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[71] *See In re Live Earth Products Inc.*, *supra*. *See also* TBMP § 1204 (Effect of Request for Reconsideration of Final Action).

[72] *See* TBMP § 1205 for procedure when request for reconsideration contains an amendment.

[73] TMEP § 715.04.

[74] *See* 37 CFR § 2.142(b)(1); *In re Wells Fargo & Co.*, 231 USPQ 106, 107 n.2 (TTAB 1986); *In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984); TMEP § 1501.02; and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984). *See also In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

[75] *See* 37 CFR § 2.142(b)(1). *See also In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475, 1476 n.3 (Fed. Cir. 1993).

[76] *See In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, supra*.

registration sought, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The Examining Attorney should notify the applicant by telephone.[77] If there is more than one ground of refusal or requirement and the Examining Attorney determines that one ground or requirement is no longer tenable, the Examining Attorney should state in his or her appeal brief that the refusal or requirement has been withdrawn. The appeal will then go forward on the remaining ground(s)/requirement(s). NOTE: Even if the Examining Attorney does not specifically state in the appeal brief that the refusal or requirement has been withdrawn, the Board may treat the refusal/requirement to have been withdrawn if no mention is made of it in the brief.[78]

On the other hand, the Examining Attorney, having received the application for preparation of his or her appeal brief, may decide that registration should be refused on an additional ground, or that a new requirement should be made, or that the application should be suspended. In that event, the Examining Attorney, during the time for and instead of preparing an appeal brief, should send to the Board a written request that the application be remanded to him or her for further examination.[79] If the request is denied, the Board will reset the Examining Attorney's time in which to file an appeal brief.[80] If the request is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the Examining Attorney for further examination in accordance with the request for remand. If, during the course of the further examination, the application is ultimately approved for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. If the Examining Attorney refuses registration on a new ground, or makes a new requirement, and the new refusal or requirement is ultimately made final, the new final action should not include a six-month response clause; the application should be returned to the Board; and the Board will resume proceedings with respect to the appeal and allow applicant 60 days in which to submit a supplemental appeal brief directed to the new issue or issues, following which the application will be returned to the Examining Attorney for preparation of his or her appeal brief.

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[77] *See* TMEP § 1501.03.

[78] *See* TBMP § 1203.02(g) (Waiver of Claim or Requirement in Brief).

[79] *See* TMEP § 1501.02. *See also In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (ground for refusal first raised in Examining Attorney's appeal brief given no consideration). *For information concerning requests for remand, see* TBMP § 1209.02 (Remand Upon Request by Examining Attorney), and TMEP §§ 1504.05 and 1504.05(a).

[80] *See In re Miller Brewing Co.*, *supra*.

1203.02(c) Applicant's Reply Brief

Within 20 days from the mailing date of the Trademark Examining Attorney's appeal brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief.[81] However, the filing of a reply brief is not mandatory.

If the applicant files a reply brief, the Board will notify the Trademark Examining Attorney. If the Examining Attorney, having read the applicant's reply brief, is persuaded thereby that applicant is entitled to the registration sought, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The Examining Attorney should advise the Board (by e-mail to the Board's administrator) that the application is being approved for publication (or registration) as soon as possible after being notified of the reply brief in order to avoid the possibility of the Board's scheduling an oral argument or drafting a decision. The Examining Attorney should also notify the applicant by telephone.[82]

There is no provision in the rules for the filing by the Examining Attorney of a written response to the applicant's reply brief. However, if the applicant requests an oral hearing, the Examining Attorney may respond orally, at the oral hearing, to arguments raised in applicant's reply brief.[83]

1203.02(d) Extension of Time for Filing Brief

An extension of time for filing an appeal brief in an ex parte appeal to the Board may be granted by the Board upon written request showing good cause for the requested extension.[84] The determination of good cause will be based upon all relevant circumstances, including the length of time of any previously granted extensions. Thus, a reason such as the press of other business, which may be sufficient to show good cause for a first extension of thirty days, may not be sufficient for a second extension of time. Depending on the totality of the circumstances, good cause has been found when there has been an appointment of a new attorney, illness, the need to get instructions from a

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[81] *See* 37 CFR § 2.142(b)(1); *In re Gena Laboratories, Inc.*, 230 USPQ 382, 383 n.4 (TTAB 1985); and *In re Randall & Hustedt*, 226 USPQ 1031, 1033 n.2 (TTAB 1985). *Cf. In re Gale Hayman Inc.*, 15 USPQ2d 1478, 1478 n.3 (TTAB 1990).

[82] *See* TMEP § 1501.03.

[83] *See* TMEP § 1501.02(a).

[84] *See In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985). *See also In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984).

foreign applicant, and attempting to negotiate a consent agreement. If a request is found not to be sufficient to warrant an extension, the Board may allow applicant a limited period of time, such as ten days, in which to file the appeal brief, or may grant the requested extension, but advise that no further extensions will be granted absent a showing of extraordinary circumstances.

1203.02(e) Material Submitted with Briefs

The record in the application should be complete prior to the filing of an appeal.[85] Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered.[86] However, if the Examining Attorney, in his or her brief, discusses the exhibits attached to the applicant's brief without objecting to them, or if applicant discusses, in its reply brief, exhibits attached to the Examining Attorney's brief without objection, they will be deemed to have been stipulated into the record and will be considered.[87]

1203.02(f) Cases Which May Be Cited

Decisions which are designated by the Board "citable as precedent" or "for publication in full" are citable as precedent. Decisions which are not so designated, or which are designated for publication only in digest form, are not citable authority and will not be considered by the Board.[88]

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[85] 37 CFR § 2.142(d).

[86] *See In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Couture*, 60 USPQ2d 1317, 1319 n.3 (TTAB 1999); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1446 n.2 (TTAB 2000) (although applicant had properly submitted copies of third-party registrations, additional registrations listed in applicant's brief, which were not commented on by Examining Attorney in her brief, not considered); *In re Polo International Inc.*, 51 USPQ2d 1061,1062 n.2 (TTAB 1999) (typed list of third-party registrations submitted with applicant's brief which were objected to by Examining Attorney, not considered); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1703 n.2 (TTAB 1998) (third-party registrations submitted with reply brief not considered); *In re North American Free Trade Association*, 43 USPQ2d 1282, 1287 n.9 (TTAB 1997) (letter submitted with applicant's brief was not made of record during prosecution, and therefore not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (copy of unpublished case submitted with applicant's reply brief no considered); and TBMP § 1207.01 (Evidence Submitted After Appeal Untimely – General Rule).

[87] *See* TBMP § 1207.03 (Evidence Considered Due to Actions of Nonoffering Party).

[88] *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001); *In re Polo International Inc.*, *supra* at 1063, n.3 (TTAB 1999) (non-precedential case disregarded); and *In re Caterpillar Inc.*, *supra* (decisions which are not designated for publication are not citable as precedent, even if a complete copy of the unpublished decision is submitted). *See also* TBMP § 101.03 (Decisional Law).

1203.02(g) Waiver of Claim or Requirement in Brief

If applicant, in its appeal brief, does not assert a claim made during prosecution, it may be deemed waived by the Board.[89] Similarly, if applicant, in its appeal brief, complies with a requirement and the Examining Attorney does not discuss the requirement, or if the Examining Attorney does not discuss a ground for refusal in his brief, the requirement or refusal may be deemed withdrawn.[90] However, the better practice, if applicant seeks to comply with a requirement, is to request remand rather than simply offering the amendment as part of its brief.[91]

1204 Effect of Request for Reconsideration of Final Action

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence.[92] However, the filing of a request for reconsideration will *not* serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate).[93] If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response[94] to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned.[95] Thus, if an applicant who has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant must file an appeal prior to the expiration of the six-month period following issuance of the final action.

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[89] *See In re Gibson Guitar Corp.*, 61 USPQ2d 1948,1950 n.2 (TTAB 2001) (applicant did not, in its appeal brief, pursue claim of inherent distinctiveness, and therefore the claim was not considered by Board).

[90] *See In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1512 n.2 (TTAB 2001) (requirement for translation deemed moot because applicant, in its appeal brief, offered translation, and Examining Attorney, in her appeal brief, did not address issue). *See also* TBMP § 1203.02(b) (Trademark Examining Attorney's Brief).

[91] *See* TBMP § 1205 (Amendment of Application During Appeal).

[92] *See* 37 CFR § 2.64(b). *See also* TMEP § 715.03, and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984).

[93] *See* 37 CFR §§ 2.63(b) and 2.64(a) & (b); TBMP §§ 1201.02 (Premature Final) and 1201.05 (Appeal vs. Petition); and TMEP §§ 715.03 and 715.03(c).

[94] *See* 37 CFR § 2.64(a), and TMEP § 715.01.

[95] *See* 37 CFR §§ 2.64 and 2.142(a), TMEP § 715.03 and TBMP § 1202.02 (Time for Appeal).

When an applicant files, in response to a final action or a second refusal on the same ground(s), or a repeated requirement, both a request for reconsideration and an appeal, the request for reconsideration should be made by separate submission and should specify the reasons why applicant believes reconsideration is warranted. The request for reconsideration should not be combined in the body of the notice of appeal; however, the applicant should indicate, in the notice of appeal, that a request for reconsideration has also been filed, so that the Board will be alerted to obtain that submission prior to instituting the appeal.[96]

A request for reconsideration filed more than six months from the final refusal is treated by the Board as a request for remand.[97] A request for reconsideration or request for remand should not be combined with the applicant's appeal brief.[98]

If an applicant which has filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, also files a timely appeal, and the Examining Attorney has not yet considered the request for reconsideration when the appeal is filed, the file of the application, with the appeal and the request for reconsideration, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and request, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Examining Attorney for consideration of the request. Where an applicant has timely filed both a notice of appeal and a request for reconsideration, but has not heard from the Board within sixty days with regard to the appeal and reconsideration request, the applicant should not file its appeal brief. Rather, it may assume that the Board will institute the appeal, and then suspend proceedings and remand the application to the Examining Attorney, so that the due date for the appeal brief will be reset in the event that the Examining Attorney denies the request for reconsideration.[99] The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary.[100]

In particular, if the request for reconsideration raises a new issue, the Examining Attorney must give the applicant an opportunity to respond before issuing a new final refusal and returning the file to the Board. New issues are typically raised by a request for reconsideration which amends the application to seek registration under the provisions of Section 2(f) of the Trademark Act, 15

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[96] *See* TBMP § 1202.03 (Notice of Appeal).

[97] *See* TBMP § 1209.04 (Remand Upon Request by Applicant).

[98] *See In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 (TTAB 1984).

[99] *For information concerning the actions that an Examining Attorney may take in response to a request for reconsideration of a final action, see* TMEP §§ 715.03(a), 715.03(b) and 715.04. *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992).

[100] *In re Live Earth Products Inc.*, *supra;* and TBMP § 1203.02(a) (Applicant's Main Brief).

U.S.C. § 1052(f), or to seek registration on the Supplemental Register, or to amend the identification of goods, if a requirement for an acceptable identification of goods was not the subject of the final Office action.[101] If the Examining Attorney believes that the outstanding issue(s) can be resolved, the Examining Attorney may contact applicant and attempt to work out a resolution.

Occasionally when an applicant files its notice of appeal and a request for reconsideration at the same time, the papers become separated, and the Examining Attorney acts on the request for reconsideration before the Board can institute the appeal and remand the application. In that event, the Board will institute the appeal after the Examining Attorney acts on the request for reconsideration. Depending on the action the Examining Attorney has taken, the Board will either remand the application to the Examining Attorney (generally to await the applicant's response to a nonfinal Office action) or, if the Examining Attorney has denied the request for reconsideration, will proceed with the appeal, and allow applicant 60 days from the mailing date of the Board action in which to file its appeal brief. The date for filing the appeal brief is reset in this situation because the applicant, at the time it filed its notice of appeal and request for reconsideration, had the expectation that the Board would follow its normal procedure and suspend proceedings in the appeal.[102]

If, after suspension and remand for consideration by the Examining Attorney of a timely request for reconsideration, the Examining Attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. However, the Examining Attorney should notify the applicant by telephone.[103] If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and a new final refusal to register or action maintaining the finality of a prior Office action is issued (either in the Examining Attorney's action on the request for reconsideration, or in a subsequent action), the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief. The Examining Attorney must, prior to returning the file to the Board to resume proceedings in the appeal, issue a written Office action apprising applicant of that fact, indicating the Examining Attorney's withdrawal and maintenance of any refusals or requirements and acceptance of any amendments; it is not sufficient to make a note in the file and return the file to the Board.

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[101] *See* TMEP § 714.05 and TBMP § 1201.02 *for examples of new issues that would preclude the issuance of a final action.*

[102] *See In re Live Earth Products Inc.*, *supra.*

[103] *See* TMEP § 715.04.

If an appeal is late filed, but applicant timely filed a request for reconsideration, the Board will issue an action informing applicant of the lateness of its appeal, stating that the late appeal cannot be entertained by the Board, and forwarding the application to the Examining Attorney for consideration of the request for reconsideration.[104]

A timely request for reconsideration of an appealed action may be accompanied by an amendment and/or by additional evidence. The evidentiary record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal normally will be given no consideration by the Board.[105] The Board will regard additional evidence a proper part of the record on appeal if it is submitted, together with a request for reconsideration, before the expiration of the six-month response period, even if it is submitted after the notice of appeal is filed.[106]

If the Examining Attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new final or nonfinal action, the Examining Attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought. Unless the action is a nonfinal action, the applicant may not submit additional evidence, even in response to evidence submitted by the Examining Attorney. If the applicant wishes to submit additional evidence, it must file a request for remand.[107]

1205 Amendment of Application During Appeal

1205.01 In General

If, within six months following the issuance of a final action, or a second refusal on the same ground(s), or a repeated requirement, applicant files both an amendment to its application and an ex parte appeal to the Board, and the Examining Attorney has not yet acted on the amendment when the appeal is filed, the file of the application, with the amendment and the appeal, will be forwarded to the Board. However, because of the possibility that papers may be separated,

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[104] *See* TBMP § 1202.02 (Time for Appeal).

[105] *See* 37 CFR § 2.142(d). *See also* TBMP § 1207 (Submission of Evidence During Appeal).

[106] *See* Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984), and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310 (1983). *See also In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1598 n.4 (TTAB 1999); *In re Corning Glass Works*, 229 USPQ 65, 65 n.5 (TTAB 1985), and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 n.3 (TTAB 1984).

[107] *See* 37 CFR § 2.142(d); TBMP §§ 1207.02 (Request to Remand for Additional Evidence) and 1209.04 (Remand Upon Request by Applicant).

applicant should indicate in its notice of appeal that it has also filed an amendment with the notice of appeal.[108] The Board will acknowledge receipt of the amendment and appeal, suspend further proceedings (including applicant's time for filing its appeal brief,[109] with respect to the appeal, and remand the application to the Trademark Examining Attorney for consideration of the amendment. The Board's remand letter will also include instructions to the Examining Attorney with respect to the further actions that may and/or should be taken by the Examining Attorney in conjunction with the Examining Attorney's consideration of the amendment.[110] Further, if the Examining Attorney believes that the outstanding issue(s) can be resolved, the Examining Attorney may contact applicant and attempt to work out a resolution. The Examining Attorney may not, however, assert a new refusal or requirement or submit evidence unrelated to the amendment or material submitted therewith, unless the Examining Attorney files with the Board a request under 37 CFR § 2.142(f)(6) for remand to assert the new refusal or requirement or submit additional evidence, and the request is granted.

Where an applicant has timely filed both a notice of appeal and an amendment, but has not heard from the Board within sixty days with regard to the appeal and amendment, the applicant should not file its appeal brief. Rather, it may assume that the Board will institute the appeal, and then suspend proceedings and remand the application to the Examining Attorney, so that the due date for the appeal brief will be reset in the event that the amendment does not place the application in condition for publication (or registration, in the case of an application on the Supplemental Registration). The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary.[111]

If the Examining Attorney is persuaded, on the basis of the amendment, that applicant is entitled to the registration sought, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The Examining Attorney should notify the applicant by telephone.[112] .

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[108] *See* TBMP §§ 1202.03 (Notice of Appeal) and 1204 (Effect of Request for Reconsideration of Final Action).

[109] *See* TBMP § 1203.02(a) (Applicant's Main Brief)

[110] *For information concerning the actions which may be taken by the Examining Attorney upon consideration of the amendment see* TMEP §§ 715.03(a), 715.03(b) and 715.04; and TBMP § 1204 (Effect of Request for Reconsideration of Final Action). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992); *In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1153-54 (TTAB 1992); and *In re Pierce Foods Corp.,* 230 USPQ 307, 308 n.1 (TTAB 1986).

[111] *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998) and TBMP § 1203.02(a) (Applicant's Main Brief).

[112] *See* TMEP §§ 715.04 and 1501.05.

If the Examining Attorney, after consideration of the amendment filed after appeal, accepts the amendment but adheres to the final refusal to register, either because there are other grounds for refusal or requirements which have not been satisfied, or because the amendment, while acceptable, does not obviate the requirement/refusal, the Examining Attorney should issue a written action to that effect. That is, the Office action should indicate that the amendment has been accepted, and also indicate what refusals/requirements remain. The six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief. If the Examining Attorney refuses to accept the amendment, and the amendment raises a new issue, the Examining Attorney must allow applicant an opportunity to respond before issuing a final refusal and returning the file of the application to the Board. Therefore, the first Office action that considers and refuses the amendment must be a nonfinal action, and must include the six-month response clause.[113]

If an applicant which has filed a timely appeal to the Board files an amendment to its application more than six months after the issuance of the final action, or the second refusal on the same ground(s), or the repeated requirement, from which the appeal was taken, the Board will treat the amendment as a request for remand.[114] Such a request will be granted upon a showing of good cause. Good cause will be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods in response to a requirement for an acceptable identification, or when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register or an amendment to assert a Section 2(f) claim (15 U.S.C. § 1052(f)) in order to avoid or overcome a refusal under Sections 2(e)(1), 2(e)(2) or 2(e)(4) of the Trademark Act, 15 U.S.C. §§ 1052(e)(1), 1052(e)(2) or 1052(e)(4). If the remand is granted, the Board will suspend proceedings with respect to the appeal and remand the application to the Examining Attorney for consideration of the amendment. The Board's remand letter will also include instructions to the Examining Attorney with respect to the further actions that may and/or should be taken by the Examining Attorney in conjunction with the Examining Attorney's consideration of the amendment. Remand in an ex parte appeal is a matter of discretion with the Board, and the Board may refuse to remand for consideration of an amendment filed more than six months after the date of the action from which the appeal was taken, if, for example, the amendment was filed in bad faith, or would serve no useful purpose. Further, if remand is made, the Board's instructions to the Examining Attorney concerning the handling of the amendment, and further action in connection therewith, may differ, for an amendment filed more than six months after the date of the action from which the appeal was taken, from those given by the Board for an amendment filed within six months after that date.

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[113] *See* TBMP § 1201.02 (Premature Final) and TMEP § 714.05 regarding amendments which raise new issues.

[114] *See* TBMP § 1209.04 (Remand Upon Request by Applicant).

If an appeal is late filed, but applicant timely filed an amendment to its involved application, the Board will issue a written action informing applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the Examining Attorney for appropriate action with respect to the amendment.

If, at the time applicant files its appeal brief, it also wishes to amend its application in order to, for example, attempt to comply with a final requirement or to overcome a final refusal, the proper procedure is to file a request for remand and a request to suspend proceedings in the appeal pending the Board's decision on the request for remand.[115] However, occasionally an applicant will include an amendment as part of its brief. If this amendment is noted by the Board (and frequently it will not be noted if it is not made by a separate paper), the Board will treat the proposed amendment as a request for remand, and consider whether good cause has been shown in determining the request. If the Board does not note the request, but the Examining Attorney, upon reviewing applicant's appeal brief, considers the amendment and allows it, the amendment will be entered.[116]

An application which has been considered and decided on appeal may be amended, if at all, only in accordance with 37 CFR § 2.142(g).[117]

1205.02 Request to Divide

An applicant may submit a request to divide the application to divide out goods or classes prior to, with or after the filing of a notice of appeal.[118] An applicant may wish to submit such a request in a situation where a refusal to register applies only to certain classes in a multi-class application or to certain goods or services within a class in either a single-class or multi-class application. If an applicant submits a request to divide along with a notice of appeal, the Board will institute the appeal, suspend proceedings in it, and forward the file to the ITU/Divisional Unit of the Office for action on the request to divide. If a request to divide is pending at the time a notice of appeal is submitted, the Board will await receipt of the divided applications after the ITU/Divisional Unit has acted on the request to divide, and then institute the appeal.

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[115] *See above discussion.*

[116] *See In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1512 n.2 (TTAB 2001) (one ground for refusal was requirement for translation of mark; because applicant offered translation in appeal brief and Examining Attorney did not address the issue in his brief, Board treated requirement as moot).

[117] *For further information concerning amendment after decision on appeal, see* TBMP § 1218 and TMEP § 1501.06**.**

[118] *See generally,* TMEP § 1110 regarding requests to divide.

In either situation, after the request to divide has been processed, the Board receives both the parent and child applications. If the appeal applies to only one of the files, the Board will institute the appeal with respect to that file, and allow the applicant 60 days in which to submit its appeal brief. If the appeal applies to both files, the Board will resume action in the appeals with respect to both files. In the latter situation, the Board may consolidate the appeals.

If the appeal applies to only one of the files, and if applicant had previously submitted a request for reconsideration or an amendment with respect to this file, the Board will suspend action on the appeal and remand the application to the Examining Attorney, in the same procedure that is followed for any request for reconsideration or amendment.[119] The remaining file will be forwarded to the Examining Attorney for further action, as appropriate. Such action may be approval of the application for publication, or for consideration of a request for reconsideration or amendment. However, unless the Examining Attorney issues a new final action with respect to that application, applicant may not subsequently submit a notice of appeal.

If a request to divide is submitted after an appeal is instituted, the Board will determine whether to suspend action on the appeal and forward the file to the ITU/Divisional Unit, or defer the processing of the request to divide and continue proceedings in the appeal. Such a determination will be based on such factors as the reason for the request to divide (e.g., if the division will result in the withdrawal of the refusal as to certain of the classes) and the stage of the appeal.

1206 Amendment to Allege Use; Statement of Use

1206.01 Amendment to Allege Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. § 1051(c), may be filed in an intent-to-use application, i.e., an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), after the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).[120] Thus, because an ex parte appeal occurs prior to the approval of a mark for publication, an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely.[121]

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[119] *See generally,* TBMP §§ 1204 (Effect of Request for Reconsideration of Final Action) and 1205 (Amendment of Application During Appeal).

[120] *See* 37 CFR § 2.76(a). *See also In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1991).

[121] *See* 37 CFR § 2.76(a) and TMEP §§ 1104.03 and 1104.07.

If an applicant which has filed an amendment to allege use during the six-month response period following issuance of a final action also files a timely appeal, and the Examining Attorney has not yet acted on the amendment to allege use when the appeal is filed, the file of the application, with the appeal and the amendment to allege use, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and amendment to allege use, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Examining Attorney for consideration of the amendment to allege use. That is, the amendment to allege use will be handled by the Board in the same manner as any other amendment filed during the six-month response period following issuance of a final action.[122] Applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 CFR § 2.142(b)(1), even if the Board has not issued its order suspending proceedings prior to the date the appeal brief would otherwise be due. Nor does the applicant need to verify with the Board that the due date for its brief will be changed if necessary. *See* TBMP § 1203.02(a). However, because papers may become separated, if applicant files an amendment to allege use along with the notice of appeal, it should indicate in the notice of appeal that an amendment to allege use in being filed contemporaneously.[123]

If, in the course of examination of the amendment to allege use, the application is approved for publication (or for registration, in the case of an application amended to seek registration on the Supplemental Register), or becomes abandoned, the appeal will be moot. The Examining Attorney should so notify the applicant, by telephone or e-mail, if e-mail communications have been authorized.[124] If the Examining Attorney, after consideration of the amendment to allege use, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.[125]

If an applicant which has filed a timely appeal to the Board files an amendment to allege use, in the application which is the subject of the appeal, more than six months after issuance of the appealed action, the Board may, in its discretion, suspend proceedings with respect to the appeal and remand the application to the Examining Attorney for consideration of the amendment to allege use. Alternatively, the Board may continue proceedings with respect to the appeal, thus deferring examination of the amendment to allege use until after final determination of the

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[122] *See in this regard,* TBMP § 1205 (Amendment of Application During Appeal).

[123] *For information concerning examination by the Examining Attorney of an amendment to allege use filed in conjunction with a notice of appeal, see* TMEP § 1104.07.

[124] *See* TMEP § 1104.07.

[125] *See* TMEP § 1104.07.

appeal. If the final determination of the appeal is adverse to applicant, the amendment to allege use will be moot.

1206.02 Statement of Use

A statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application, i.e., an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).[126] .

A notice of allowance is not issued in an intent-to-use application (for which no amendment to allege use under Section 1(c) of the Act, 15 U.S.C. § 1051(c) has been timely filed and accepted) unless and until the application is approved for publication, and then published in the *Official Gazette* for opposition; no timely opposition is filed or all oppositions filed are dismissed; and no interference is declared.[127]

Therefore, a statement of use filed during an ex parte appeal to the Board is premature. A premature statement of use will not be considered.[128] Instead, the premature statement of use will be returned to applicant and the fee will be refunded.

1207 Submission of Evidence During Appeal

1207.01 General Rule--Evidence Submitted After Appeal Untimely

37 CFR § 2.142(d) *The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.*

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[126] *See* 37 CFR § 2.88(a).

[127] *See* Section 13(b)(2) of the Act, 15 U.S.C. § 1063, and 37 CFR § 2.81(b). *See also* TMEP § 1109.04 and TBMP § 219 (Amendment to Allege Use).

[128] *See* 37 CFR § 2.88(a).

The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Additional evidence filed after appeal normally will be given no consideration by the Board.[129]

However, if the applicant or the Examining Attorney submits excerpts from articles, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed.[130] If the nonoffering party wishes to have the entire article considered, the better practice is to submit the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief the Board need not remand the application, and may instead consider the article as part of the record.[131]

1207.02 Request to Remand for Additional Evidence

If an applicant or Trademark Examining Attorney wishes to introduce additional evidence after an appeal has been filed, the applicant or Examining Attorney may file a written request with the Board to suspend the appeal and remand the application for further examination.[132]

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[129] *See* 37 CFR § 2.142(d). *See also In re Trans Continental Records Inc*, 62 USPQ2d 1541 (TTAB 2002) (materials from web search engines submitted with appeal brief not considered); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, n.2 (TTAB 2000); *In re Psygnosis Ltd.,* 51 USPQ2d 1594 (TTAB 1999)*; In re Posthuma*, 45 USPQ2d 2011, n.2 (TTAB 1998) (third-party registration attached to appeal brief not considered); *In re Wada*, 48 USPQ2d 1689, n.2 (TTAB 1998), *aff'd,* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (evidence submitted with reply brief not considered); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379, n.3 (TTAB 1998) (third-party registrations first submitted with appeal brief not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997) (new material attached to appeal and reply briefs, and submitted at oral hearing and subsequent to hearing untimely and not considered); and *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

Cf. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), and *In re Volvo White Truck Corp.*, 16 USPQ2d 1417 (TTAB 1990). *For additional case cites see the Appendix of Cases.*

[130] *See In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986) (if only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came).

[131] *See also* TBMP § 1208.01 (Evidence from NEXIS Database or Publications). *But see In re Psygnosis Ltd.*, *supra* (if, after appeal, an applicant attempts to submit a full printout of articles from the NEXIS database which were revealed in an Examining Attorney's search, but which were not introduced by the Examining Attorney, such articles are considered to be additional evidence and therefore untimely).

[132] *See* 37 CFR § 2.142(d). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992); *In re Wells Fargo & Co.*, 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 940 n.6 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363, 363 n.3 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 46 n.1 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 n.1 (TTAB 1984); *In re Jeep Corp.,* 222 USPQ 333, 336 n.3 (TTAB 1984); *In re Consolidated Foods Corp.*, 218 USPQ 184, 186 n.2 (TTAB 1983); and *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982).

A request under 37 CFR § 2.142(d) to suspend and remand for additional evidence must be filed prior to the rendering of the Board's final decision on the appeal.[133] In addition, the request must include a showing of good cause therefor (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced.[134] The length of the delay in making the request after the reason for the remand becomes known, or the point in the appeal process at which the request for remand is made, will be considered in the determination of whether good cause exists. Generally, the later in the appeal proceeding that the request for remand is filed, the stronger the reason that must be given for good cause to be found.[135]

Examples of circumstances that have been found to constitute good cause for a remand for additional evidence include the following:

> **(1)** The evidence was not previously available.[136] Even if the evidence was not previously available, good cause may not be found if the newly available evidence is merely cumulative in nature. Thus, if the Examining Attorney requests remand in order to submit an article which was published subsequent to the filing of the appeal, but which is of substantially the same nature as articles previously made of record, the request may be denied. Nor can the Examining Attorney use the subsequent publication of a single article to make of record articles which were previously available. Similarly, if the applicant requests remand to make of record its most recent monthly sales or advertising figures in support of a Section 2(f) claim, the request may be denied. There is a point at which prosecution or examination must come to an end.
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> **(2)** A new attorney for the applicant, or a new Examining Attorney, has taken over the case and wishes to supplement the evidence of record. The transfer of a

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[133] *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984), and *In re Carvel Corp.*, *supra*.

[134] *See In re Big Wrangler Steak House, Inc.*, *supra*; *In re Bercut-Vandervoort & Co.*, *supra*; *In re Chung, Jeanne & Kim Co.*, *supra*; *In re Mayer-Beaton Corp.*, *supra*; *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, *supra*; *In re Jeep Corp., supra*; and *In re Historic Wharf's Associates, Inc.*, 222 USPQ 92, 93 n.1 (TTAB 1984).

[135] *See also In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984); and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310 (1983).

[136] *See In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001); and *In re Central Sprinkler Co.*, 49 USPQ2d 1194, n.2 (TTAB 1998) (applicant's request for remand made in its appeal brief in order to allow Examining Attorney to consider additional third-party registrations denied because such evidence could have been submitted earlier in the prosecution).

case from one firm member to another is not considered by the Board to constitute good cause for a remand under the "new attorney" rationale. However, the transfer of the case from in-house counsel to an outside firm is treated as a new attorney taking over the case. Similarly, a different Examining Attorney being assigned to the file is treated as a new attorney taking over the case.

(3) The applicant and Examining Attorney have agreed to the remand.

In addition, because a consent agreement offered in response to a refusal to register under Section 2(d) of the Act, 15 U.S.C. § 1052(d)[137] is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.

If a request to remand for additional evidence is granted, the nonrequesting party may submit additional evidence in response to the evidence submitted with the request.[138]

When an applicant's request to suspend and remand for additional evidence is granted, and the application is remanded to the Examining Attorney for further examination, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), or adhere to the action from which the appeal was taken. The Examining Attorney may also issue a new nonfinal action asserting any new refusal or requirement necessitated by the new evidence. The Examining Attorney may not, however, assert a new refusal or requirement unrelated to the new evidence, unless the Examining Attorney files with the Board a request under 37 CFR § 2.142(f)(6) for remand to assert the new refusal or requirement, and the request is granted. If the Examining Attorney is persuaded, on the basis of the new evidence, that applicant is entitled to the registration sought, and approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. However, the Examining Attorney should so notify the applicant by telephone.[139] If the Examining Attorney, after consideration of the new evidence, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted from the action; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.

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[137] *See, for example, In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985), and *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

[138] *See In re Northland Aluminum Products, Inc.*, 221 USPQ 1110, 1112 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). *Cf. In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 (TTAB 1983).

[139] *See* TMEP § 715.04.

When an Examining Attorney's request to suspend and remand for additional evidence is granted, the Board, in its action granting the request, will allow the Examining Attorney time in which to issue an Office action (with no six-month response clause) relating to the new evidence to be submitted therewith. After the Examining Attorney's new action has been issued, the application should be returned to the Board; proceedings with respect to the appeal will be resumed; applicant will be allowed an opportunity to submit, if it so desires, responsive evidence; and further appropriate action with respect to the appeal will be taken. If applicant's appeal brief has already been filed, applicant will be allowed an opportunity, if it so desires, to file a supplemental brief directed to the new evidence submitted by the Examining Attorney.

1207.03 Evidence Considered Due to Actions of Nonoffering Party

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence[140] may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, *and* (2) discusses the new evidence or otherwise affirmatively treats it as being of record.[141] In such a situation, the Board may consider evidence submitted by the nonoffering party to rebut the untimely evidence.[142]

Copies of third-party registrations which are submitted with an applicant's brief may be considered in certain circumstances, even if the Examining Attorney objects to the registrations or does not discuss them in the Examining Attorney's brief. If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the Examining Attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a

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[140] *See* TBMP § 1207.02 (Request to Remand for Additional Evidence).

[141] *See, for example, In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 n.5 (TTAB 2001) ("evidence" of sales mentioned for first time in applicant's brief and thus not timely submitted, but because in her brief Examining Attorney treated the information as though of record, Board did also); *In re Urbano,* 51 USPQ2d 1776, 1778 n.4 (TTAB 1999) (third-party registrations submitted with Examining Attorney's brief considered of record because applicant did not object and discussed the evidence on its merits in reply brief); *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 n.2 (TTAB 1990); *In re Dana Corp.*, 12 USPQ2d 1748, 1749 n.8 (TTAB 1989); *In re Pencils Inc.*, 9 USPQ2d 1410, 1411 (TTAB 1988); Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984); and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310 (1983). *For additional case cites see Appendix of Cases.*

[142] *See In re Development Dimensions International, Inc., supra*. *Cf. In re Northland Aluminum Products, Inc.*, 221 USPQ 1110, 1112 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

point when the applicant could cure the insufficiency, the Examining Attorney will be deemed to have waived any objection as to improper form.[143]

1207.04 Evidence Filed With Timely Request for Reconsideration

A timely request for reconsideration of an appealed action may be accompanied by additional evidence, which will thereby be made part of the evidentiary record in the application. There is no need, in such a situation, for a 37 CFR § 2.142(d) request to suspend and remand for additional evidence. Evidence submitted with a timely request for reconsideration of an appealed action, that is, a request filed during the six-month response period following issuance of the appealed action, is considered by the Board to have been filed prior to appeal, even if the notice of appeal was, in fact, filed earlier in the six-month response period than the request for reconsideration.[144]

When a timely request for reconsideration of an appealed action is filed (with or without new evidence), the Examining Attorney may submit, with his or her response to the request, new evidence directed to the issue(s) for which reconsideration is sought. However, the applicant may not submit additional evidence in response to any evidence submitted by the Examining Attorney unless the Examining Attorney's action is a nonfinal action to which a response may be filed. Otherwise, if the applicant wishes to submit additional evidence, it must file a request for remand.[145]

1207.05 Submission of Evidence Upon Remand for New Refusal

Additional evidence may be submitted, both by the Examining Attorney and by the applicant, if (1) an appealed application is remanded by the Board for further examination under 37 CFR § 2.142(f) (i.e., sua sponte remand by the Board when it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable),[146] or under 37 CFR § 2.142(f)(6) (i.e., remand by the Board upon written request by the Examining Attorney when it appears to the Examining Attorney that an issue not involved in the appeal may render the mark

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[143] *See* TBMP § 1208.02 (Third-Party Registrations)*, including discussion of evidentiary value of such listings. See also In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945 n.4 (TTAB 2000) (applicant provided list of third-party registration numbers in its response; because Examining Attorney did not object and made no mention of the marks, they were deemed to be of record).

[144] *See* TBMP § 1204 (Effect of Request for Reconsideration of Final Action) and authorities cited therein.

[145] *See* 37 CFR § 2.142(d), TBMP §§ 1207.01 (Evidence Submitted After Appeal Untimely) and 1207.02 (Request to Remand for Additional Evidence).

[146] *See* TBMP § 1209.01 (Remand Upon Board's Own Initiative).

of the applicant unregistrable),[147] *and* (2) the Examining Attorney, upon remand, does, in fact, issue a new refusal to register or requirement.[148] If no new refusal or requirement is made, and the Examining Attorney instead returns the file to the Board, no additional evidence may be submitted.[149]

1207.06 Letter of Protest Evidence

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the USPTO by filing, with the Office of the Commissioner for Trademarks, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. The Office of the Commissioner for Trademarks will determine whether the information should be given to the Trademark Examining Attorney for consideration.[150] If the Examining Attorney issues an Office action that includes any materials submitted with the letter of protest, that material becomes part of the record of the file for appeal.[151]

Proceedings in an ex parte appeal will not be suspended pending determination by the Commissioner for Trademark's Office of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the Examining Attorney, having considered the supporting evidence submitted with the letter of protest, wishes to make that evidence of record in the application, that is, wishes to rely on the evidence to support the appealed refusal of registration, the Examining Attorney may file a written request with the Board, pursuant to 37 CFR § 2.142(d), to suspend the appeal and remand the application for further examination.[152]

The request must be filed prior to the rendering of the Board's final decision on the appeal, and must be accompanied by the additional evidence sought to be introduced.[153] In addition, the request must include a showing of good cause therefor, in the same manner as any other request to remand for additional evidence.[154]

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[147] *See* TBMP § 1209.02 (Upon Request by Trademark Examining Attorney).

[148] *See In re Bank America Corp.*, 229 USPQ 852, 853 n.4 (TTAB 1986).

[149] *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 n.3 (TTAB 1986).

[150] *See* TBMP § 215 (Effect of Letter of Protest) and authorities cited therein.

[151] *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999).

[152] *For information concerning a request for remand for additional evidence see* TBMP § 1207.02.

[153] *See* TBMP § 1207.02 (Request to Remand for Additional Evidence).

[154] *For information concerning good cause for a remand for additional evidence, see* TBMP § 1207.02.

Evidentiary value of material submitted by a third party through a letter of protest will depend on whether it meets evidentiary requirements for authentication or foundation, identified as to nature or source and are not self-authenticating.[155]

1208 Treatment of Evidence

The Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an ex parte proceeding than it does in an inter partes proceeding. That is, in an ex parte proceeding the Board tolerates some relaxation of the technical requirements for evidence and focuses instead on the spirit and essence of the rules of evidence. The reason for this more relaxed approach in ex parte cases is that in an ex parte proceeding, there is no cross-examination of witnesses or any compelling need for the strict safeguards required in an inter partes proceeding.[156]

For example, the Board is somewhat more lenient in its approach in the consideration of surveys in ex parte proceedings than inter partes proceedings.[157] Also, the affidavit or 37 CFR § 2.20 declaration is an established method for the introduction of evidence in an ex parte proceeding.[158] In an inter partes proceeding, however, evidence may not be offered in affidavit or 37 CFR § 2.20 declaration form except by agreement of the parties.[159]

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[155] *In re Urbano*, *supra* (documents of limited evidentiary value because no affidavits or other evidence establishing foundation, and no information establishing authenticity or source).

[156] *See In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10 and 1924 n.18 (TTAB 1996) (Board allowed NEXIS evidence to show psychological effect of color blue, despite hearsay nature, recognizing the difficulty for Examining Attorney to establish such fact without relying on NEXIS evidence; Board also accepted sufficiency of evidence showing features of applicant's trade dress were common, recognizing that USPTO's limited resources constrain an Examining Attorney's ability to acquire photographs of interiors of retail establishments); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996); *In re Murphy Door Bed Co.*, 223 USPQ 1030, 1032 n.9 (TTAB 1984); and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310, 315 (1983). *See also In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993).

[157] *In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996); and *In re Pillsbury Co.*, 174 USPQ 318, 320 (TTAB 1972).

[158] *See, for example*, 37 CFR § 2.41(b); *In re Manco Inc.*, 24 USPQ2d 1938, 1941 n.8 (TTAB 1992); *In re Bauhaus Designs Canada Ltd.*, 12 USPQ2d 2001, 2004 (TTAB 1989); *In re Motorola, Inc.*, 3 USPQ2d 1142, 1143 (TTAB 1986); *In re Peterson Manufacturing Co.*, 229 USPQ 466, 468 (TTAB 1986); *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986); *In re Gammon Reel, Inc.*, 227 USPQ 729, 731 (TTAB 1985); and *In re Original Red Plate Co.*, 223 USPQ 836, 838 (TTAB 1984).

[159] *See* 37 CFR § 2.123(b), and TBMP § 703.01(b) (Form of Testimony) and cases cited therein.

It is the better practice to provide evidence as to sales figures and the like by affidavit or declaration. However, representations by applicant's counsel may, in certain circumstances, be accepted.[160] Affidavits or declarations may have probative value even if they are form documents, or are prepared by applicant's attorney.[161]

However, while the evidentiary requirements in an ex parte record are less formal than in an inter partes context, documents submitted by a third party by letter of protest must still comply with inter partes evidentiary requirements of foundation and authentication to have evidentiary value.[162]

For information as to how the Court of Appeals for the Federal Circuit, in reviewing a decision of the Board on an ex parte appeal, evaluates the sufficiency of the evidence offered by the Trademark Examining Attorney, see the cases cited in the note below.[163]

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[160] *See In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997) (Examining Attorney never objected to attorney's representations, and figures uncontradicted by other information).

[161] *See In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396, 399 (CCPA 1972) (fact that affidavits were drafted by applicant's attorney and were practically identical in wording detracts little or nothing from their sufficiency to make out a prima facie case of trademark recognition); and *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 n.15 (TTAB 1998) (fact that applicant's attorney assisted consumers in preparing statements--form letters--to show acquired distinctiveness does not make the submissions less honest or valid).

But see In re Audio Book Club Inc., 52 USPQ2d 1042, 1047 (TTAB 1999) (fact that 49 form letters were couched in legal terms and presumably drafted by applicant's counsel raises some questions as to whether signers understood the legal import of their statements); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1217 (TTAB 1998) (form statements that do not provide basic background information about the declarants and their experience with applicant have limited probative value); and *In re EBSCO Industries Inc.*, *supra* (declarations deserve little weight because there are questions as to whether they reflect views of the declarants since declarants filled in only their names and addresses in forms, and declarants failed to notice that drawing was missing from the declaration when the focus of the declaration was the configuration shown in the drawing).

[162] *See In re Urbano*, 51 USPQ2d 1776, 1779 n.6 (TTAB 1999) (affidavit should have been submitted to identify and authenticate documents that are not clearly identified as to nature or source and are not self-authenticating).

[163] *In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988) (Court, being mindful that the USPTO has limited facilities for acquiring evidence--it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits--concludes evidence of record is sufficient to establish a prima facie case of deceptiveness), and *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) ("...practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action.").

But see In re Mavety Media Group Ltd., 33 F.3d 1367, 31 USPQ2d 1923, 1928 (Fed. Cir. 1994) ("...the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under §1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public.").

1208.01 Evidence from NEXIS Database or Publications

Applicant or the Trademark Examining Attorney may submit articles or excerpts from articles taken from periodicals or the NEXIS database as evidence.[164] Such material is evidence of how a term or mark may be perceived, rather than of the truth of the underlying information in the article.[165] Accordingly, stories from newswires or foreign publications are of minimal evidentiary value because it is not clear that such stories have appeared in any publication available to the consuming public.[166] Wire service stories are competent to show how their authors used particular terms, but since they are circulated primarily to newspapers, they are not assumed to have influenced the attitudes of prospective customers.[167]

It is not necessary that all NEXIS articles retrieved by a search be submitted and, indeed, the Board discourages such submissions where they are unnecessarily redundant or not probative. Examining Attorneys should not submit articles or excerpts that are not relevant.[168] However,

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[164] *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998).

[165] *See In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (use of term in articles, particularly those periodicals with a general circulation, reflects a perception that the public is familiar with the term and will readily understand it).

[166] *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 n.7 (TTAB 2001) (newswire stories, presumably unpublished, and stories from foreign publications, not considered); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1538 n.2 (TTAB 1998) (in the absence of evidence of the extent of circulation of foreign publications in the United States, they cannot serve to show the significance in this country of the designation at issue); and *In re Wilcher Corp.*, 40 USPQ2d 1929, 1931 (TTAB 1996) (in absence of evidence establishing substantial circulation of foreign publications in U.S., they are not competent to show significance of term to general American public).

[167] *See In re Organik Technologies Inc.*, 41 USPQ2d 1690, 1691 n.3 (TTAB 1997) (newswire articles given minimal consideration as they are circulated primarily to newspapers whose editors select those stories of sufficient interest to publish; thus, such articles do not prove that the news release appeared as a story in any newspaper or magazine and are evidence only of the opinion of the author). *See also In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Couture*, 60 USPQ2d 1317, 1318 n.2 (TTAB 1999); *In re Urbano*, 51 USPQ2d 1776, 1778 n. 3 (TTAB 1999); *In re Manco Inc.*, 24 USPQ2d 1938, 1939 n.4 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917, 1918-19 (TTAB 1986).

But see In re Hudson News Co., 39 USPQ2d 1915, 1920 n.10 (TTAB 1996) (Board allowed use of NEXIS evidence to show psychological effect of color blue, despite applicant's hearsay objection, noting the difficulties for Examining Attorneys to establish this kind of fact, and although the evidence has a hearsay element, there is no bias in the evidence, which was not prepared for purposes of the case).

[168] *See In re Couture*, *supra* (many excerpts were repetitive or used the searched term for services not related to the applicant's); and *In re Lamb-Weston Inc.*, *supra* (articles which bear no relationship to applicant's goods are irrelevant).

Examining Attorneys should not submit only those articles that support the USPTO's position, and deliberately not submit those which are helpful to the applicant.[169]

If applicant or the Examining Attorney submits excerpts from articles, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed.[170] If only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came.[171] If the nonoffering party wishes to have the entire article considered, the better practice is to submit the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief the Board need not remand the application, and may instead consider the article as part of the record. However, if, after appeal, an applicant attempts to submit a full printout of articles from the NEXIS database which were revealed in an Examining Attorney's search, but which were not introduced by the Examining Attorney, such articles are considered to be additional evidence and therefore untimely.[172]

1208.02 Third-party Registrations

To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the USPTO, should be submitted.[173] Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record.[174] There are limited circumstances in which the Board will consider such listings. In particular, if an applicant includes a listing of registrations in a response to an Office action, and the Examining Attorney does not advise applicant that the listing is insufficient to make the registrations of record at a point when applicant can correct the error, the Examining Attorney will be deemed to have stipulated the registrations into the record.[175] Similarly, if the Examining Attorney discusses the registrations in an Office action or

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[169] *See In re Trans Continental Records Inc.*, 62 USPQ2d 1541, 1544 (TTAB 2002) (although the Examining Attorney described the NEXIS articles which were submitted as a "sample," Board concerned by the fact that the NEXIS search retrieved 441 articles, and the first of the ten stories submitted was number 257).

[170] *See* TBMP § 1207.01 for general rule that evidence submitted after appeal is untimely.

[171] *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986).

[172] *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1597-98 (TTAB 1999).

[173] *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974).

[174] *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) and *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).

[175] *See In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002) (Board considered third-party registrations submitted with reply brief because applicant had submitted copies of Official Gazettes showing marks published for opposition

brief, without objecting to them, the registrations will be treated as stipulated into the record.[176] However, the Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registrations numbers and/or marks, the list will have very limited probative value.

An improper listing of third-party registrations will not be considered if the list is submitted at a point where applicant cannot correct the format of the submission if the Examining Attorney does not discuss the registrations or otherwise treat them as of record.[177]

Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed.[178]

1208.03 Internet Material

Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings.[179] Because website contents and search engine results are accessible by the consuming public (although search engine results may be retrieved only if members of the public enter the identical search strategy), they constitute evidence of potential public exposure.[180] Material obtained from an applicant's website, or that of a third party, may provide information about, for example, products or services, customers, and channels of trade, although their probative value will vary depending on the facts of the particular case. On the other hand, a search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value. Such search results do not show use of a term or phrase as a heading, link or content on a website. Use in a search

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during prosecution, and Examining Attorney did not advise applicant that copies of the registrations were necessary to make them of record); and *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (Examining Attorney's objection, raised in appeal brief, to "mere listing" of registrations deemed waived because it was not interposed in response to applicant's reliance on such listing in its response to initial Office action).

[176] *See In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999) (Examining Attorney did not object to listing of third-party registrations, and considered registrations as if they were of record) and In *re Dos Padres Inc.*, *supra* (listings from a commercial trademark search report submitted by applicant during prosecution). *See also* TBMP § 1207.03 (Evidence Considered Due to Actions of Nonoffering Party).

[177] *In re Caserta*, 46 USPQ2d 1088, 1090 n.4 (TTAB 1998) (list of third-party registered marks from an unidentified source submitted with request for reconsideration, and objected to by Examining Attorney, not considered).

[178] *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

[179] *Compare* use in inter partes proceedings, TBMP §§ 704.08 (Printed Publications) and 528.05(e) (Printed Publications and Official records).

[180] *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

summary may indicate only that the two words in an overall phrase appear separately in the website literature.[181]

Evidence from on-line dictionaries that do not otherwise appear in printed format must be submitted prior to appeal so that the nonoffering party has an opportunity to check the reliability of the evidence and/or timely offer rebuttal evidence.[182] The Board will not take judicial notice of such material.[183]

1208.04 Judicial Notice

The Board may take judicial notice of dictionary definitions.[184] Definitions found in slang dictionaries are also appropriate for judicial notice.[185]

The Board may also take judicial notice of encyclopedia entries, standard reference works and of commonly known facts.[186]

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[181] *In re Fitch IBCA, Inc., supra.*

[182] *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) and *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

[183] *See* TBMP § 1208.04 (Judicial Notice)

[184] *In re Styleclick.com*, 58 USPQ2d 1523, 1525 (TTAB 2001) (definitions from computer dictionaries, i.e., *net.speak—the internet dictionary, The Computing Dictionary* and *The Illustrated Dictionary of Microcomputers*); *In re 3Com Corp.*, 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (judicial notice of definitions in technical reference works); *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1210 n.6 (TTAB 1999) (dictionary definition submitted with Examining Attorney's brief); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1537 (TTAB 1998) (well settled that dictionary listings comprise matter of which Board can take judicial notice); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (definitions from *Webster's New Geographical Dictionary* submitted with Examining Attorney's appeal brief); and *In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 n.6 (TTAB 1997) (definition in *Black's Law Dictionary*); *In re Analog Devices Inc.,* 6 USPQ2d 1808, 1810 n.2 (TTAB 1988) (judicial notice of technical trade dictionaries such as *IEEE Standard dictionary of Electric and Electronics Terms*); and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983);

[185] *In re Wilcher Corp.*, 40 USPQ2d 1929, 1933 n.4 (TTAB 1996).

[186] *See*, *for example*, *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.5 (TTAB 2001) (judicial notice taken of *The Encyclopedia of Furniture*, *The Complete Guide To Furniture Styles,* and *Seng Furniture Facts* showing that Danish, Scandinavian and Mediterranean are styles of furniture); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 n.2 (TTAB 2001) (the National League is part of Major League Baseball); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 n.5 (TTAB 2001) (common knowledge that radio broadcasts may be heard in real-time on the Internet); *In re Dial-A-Mattress Operating Corp.*, 52 USPQ2d 1910, 1916 (TTAB 1999), *rev'd. on other grounds*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (toll-free telephone area codes such as "1-888" are used by numerous persons and businesses); *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1998) (judicial notice taken of *Physician's Desk Reference* and other PDR publications); *In re U.S. Cargo*

The Board will not take judicial notice of definitions found only in on-line dictionaries and not available in a printed format; however, it will consider them if made of record during the prosecution of the application.[187] Nor will the Board take judicial notice of third-party registrations or marks.[188]

For a full discussion of judicial notice see TBMP § 704.12.

1209 Remand

1209.01 Upon Board's Own Initiative

37 CFR § 2.142(f)(1) *If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examiner for further examination to be completed within thirty days.*

(2) *If the further examination does not result in an additional ground for refusal of registration, the examiner shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.*

(3) *If the further examination does result in an additional ground for refusal of registration, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. If the ground for refusal is made final, the examiner shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the*

Inc., 49 USPQ2d 1702, 1704 n.3 (TTAB 1998) ("U.S." means the United States, and the United States is a geographic area with defined boundaries); and *In re Perry Manufacturing Co.*, 12 USPQ2d 1751, 1752 (TTAB 1989) (New York is world-renowned center of culture and high fashion and people from throughout world go to New York to purchase latest styles in clothing, from haute couture to off-the-rack garments).

[187] *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *See also In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1447 n.3 (TTAB 2000) and *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

[188] *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998), *aff'd,* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (request in reply brief that Board take judicial notice of "thousands of registered marks incorporating the term NEW YORK for products and services that do not originate in New York state or city" denied); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998); and *In re Caserta*, 46 USPQ2d 1088, 1090 n.4 (TTAB 1998) (Board refused to take judicial notice of the characters listed in registrations and their manner of use).

supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

(4) *If the supplemental brief of the appellant is filed, the examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.*

(5) *If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section. If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.*

If, during an ex parte appeal to the Board, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may issue a written action suspending the appeal and remanding the application to the Trademark Examining Attorney for further examination with respect to that issue.[189] Thus, the Board will not remand an application for consideration of a ground for refusal if the Examining Attorney had previously refused registration on that ground and then withdrew the refusal.

The Board may also sua sponte remand an application to the Examining Attorney if, after examination and/or briefing has been completed, a decision is rendered which is likely to have a bearing on the Examining Attorney's position.[190] Or the Board may remand an application for clarification of the issues on appeal, where, for example, the Examining Attorney and the applicant appear to be arguing different grounds of refusal.

The further examination must be completed within 30 days from the date of remand, or within an extension of time for that purpose.[191]

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[189] *See* 37 CFR § 2.142(f)(1). *See also In re Opryland USA Inc.*, 1 USPQ2d 1409, 1411 (TTAB 1986); *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *In re Johanna Farms, Inc.*, 223 USPQ 459, 461 (TTAB 1984); and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984). *See, in addition, In re Wella A.G.*, 230 USPQ 77, 79 (TTAB 1986) (*but see In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365, 1369 (Fed. Cir. 1988)).

[190] *See In re Dekra e.V.*, 44 USPQ2d 1693, 1694-95 (TTAB 1997) (after briefs were filed, the Federal Circuit issued a decision with applicability to the case; Board remanded case to Examining Attorney to consider refusal in light of that decision).

[191] *See* 37 CFR § 2.142(f)(1).

If the Examining Attorney, upon consideration of the issue specified in the Board's remand letter, does not believe that the specified issue renders the mark of the applicant unregistrable, the Examining Attorney must promptly return the application to the Board with a written statement that further examination did not result in an additional ground for refusal of registration.[192]

If the Examining Attorney returns the remanded application to the Board with a written statement that further examination did not result in an additional ground for refusal of registration, the Board will resume proceedings with respect to the appeal, and take further appropriate action therein. The issues ultimately determined by the Board will be those that were the subject of the appeal; no consideration will be given to the issue that was the subject of the remand.[193]

If, on the other hand, the further examination does result in an additional ground for refusal of registration, the Examining Attorney and applicant should proceed as specified in 37 CFR §§ 2.61 through 2.64.[194] If the additional ground for refusal of registration is ultimately made final, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. Specifically, the Board will issue an order allowing applicant 60 days from the date of the order in which to file a supplemental brief directed (solely) to the additional ground for refusal of registration.[195]

If applicant fails to file a supplemental brief within the specified 60-day period, or during an extension of time for that purpose, the appeal may be dismissed.[196] If applicant files a supplemental brief, the Board will send the application file, with applicant's supplemental brief entered therein, to the Examining Attorney. Within 60 days after the date of the Board's written action forwarding the file to the Examining Attorney, or within an extension of time for that purpose, the Examining Attorney must file a written brief answering the supplemental brief of the applicant. If the Examining Attorney had not previously submitted an appeal brief, the written brief may answer not just the applicant's supplemental brief, but also its original appeal brief.[197] The Examining Attorney must also mail a copy of his or her brief to the applicant.[198] If

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[192] *See* 37 CFR § 2.142(f)(2). *See also In re Diet Tabs, Inc.*, *supra*.

[193] *See In re Diet Tabs, Inc.*, *supra.*

[194] *See* 37 CFR § 2.142(f)(3).

[195] *See* 37 CFR § 2.142(f)(3).

[196] *See* 37 CFR § 2.142(f)(3).

[197] *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

[198] *See* 37 CFR § 2.142(f)(4).

the Examining Attorney's brief is late filed, the Board may exclude it in the absence of an adequate explanation for the late filing.[199] Within 20 days from the mailing date of the Examining Attorney's brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief.[200] However, the filing of a reply brief is not mandatory. If the applicant files a reply brief, the Board will notify the Examining Attorney so that it can be reviewed.

If an oral hearing on the appeal had been requested by applicant prior to the remand of the application, but had not yet been held, the oral hearing will be set after the expiration of applicant's time for filing a reply brief directed to the additional ground for refusal of registration.[201] If an oral hearing had been held prior to the remand, or had not previously been requested by applicant, an oral hearing may be requested by applicant by separate paper filed not later than 10 days after the due date for a reply brief on the additional ground for refusal of registration; the oral hearing will be set by the Board upon receipt of the request.[202]

If the Examining Attorney is persuaded by applicant's supplemental brief and/or reply brief that the additional ground for refusal of registration should be withdrawn, the Examining Attorney should issue a written action withdrawing the additional ground, and return the application to the Board for resumption of proceedings with respect to the appeal.

The Examining Attorney may not, upon remand under 37 CFR § 2.142(f)(1), refuse registration on a new ground not specified in the Board's remand letter. If the Examining Attorney, upon remand, wishes to refuse registration on a new ground not specified in the Board's remand letter, the Examining Attorney must file a request with the Board, pursuant to 37 CFR § 2.142(f)(6), for jurisdiction to refuse registration on the new ground. Nor may the Examining Attorney, upon remand under 37 CFR § 2.142(f)(1), submit evidence relating to a ground not specified in the Board's remand letter.[203]

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[199] *Cf. In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984), and TBMP § 1203.02(b) (Trademark Examining Attorney's Brief).

[200] *See* 37 CFR § 2.142(f)(4).

[201] *See* 37 CFR § 2.142(f)(5).

[202] *See* 37 CFR § 2.142(f)(5).

[203] *For information on informalities which are noted by the Board in its final decision, but for which remand was not considered necessary*, *see* TBMP § 1217. *See also In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1545 n.1 (TTAB 1996) (in final decision, Board recommended that applicant, if it ultimately prevailed, amend description of mark to clearly set forth claim); and *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing).

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP § 1207.05.

1209.02 Upon Request by Trademark Examining Attorney

37 CFR § 2.142(f)(6) *If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand the application to the examiner for further examination. If the request is granted, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. After the additional ground for refusal of registration has been withdrawn or made final, the examiner shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.*

If, during an ex parte appeal to the Board, it appears to the Trademark Examining Attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable, the Examining Attorney may file a written request with the Board to suspend the appeal and remand the application for further examination.[204] Such a request may be filed at any point in the appeal prior to the Board's rendering a final decision, including at the point the Examining Attorney is to submit his appeal brief or supplemental appeal brief.[205]

Because the mandate of the USPTO is to register only eligible marks, an Examining Attorney's request for remand will generally be granted unless there is no valid basis for the request, e.g., remand is requested to require a disclaimer of a term which is not part of the mark. If the Examining Attorney's request for remand is granted, the Board will forward the application to the Examining Attorney for further examination in accordance with the request. In its action granting the request, the Board will allow the Examining Attorney a specified time in which to issue an Office action pursuant to the request. Thereafter, the Examining Attorney and applicant should proceed as provided in 37 CFR §§ 2.61 through 2.64.[206]

When, upon remand, the Examining Attorney determines that registration should not be finally refused on the additional ground for refusal of registration mentioned in the request for remand,

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[204] *See* 37 CFR § 2.142(f)(6).

[205] *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998) (Board granted Examining Attorney's request for remand which was filed after submission of applicant's appeal brief and supplemental appeal brief in order to allow Examining Attorney to refuse registration on additional ground). *See also In re Wells Fargo & Co.*, 231 USPQ 116, 119 (TTAB 1986); *In re Wells Fargo & Co.*, 231 USPQ 95, 101 (TTAB 1986); and *In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227, 228 (TTAB 1986). [*NOTE:* The latter three cases were decided prior to the adoption of 37 CFR § 2.142(f)(6)].

[206] *See* 37 CFR § 2.142(f)(6). *Cf.* 37 CFR § 2.142(f)(3).

the Examining Attorney should issue a written Office action in which the six-month response clause is omitted and return the file of the case to the Board; proceedings with respect to the appeal will be resumed and further appropriate action will be taken therein.[207] If the Examining Attorney determines, after considering applicant's response to the nonfinal Office action, that a final refusal on that ground should issue, the Examining Attorney should issue a new action, omitting the six-month response clause, which makes the refusal final as to both the additional ground and the ground(s) asserted in the previous final action. The file should then be returned to the Board, and proceedings in the appeal will be resumed.[208]

The Examining Attorney may not, upon remand under 37 CFR § 2.142(f)(6), refuse registration on a new ground not mentioned in the Examining Attorney's request for remand. If the Examining Attorney, upon remand, wishes to refuse registration on a new ground not mentioned in the request for remand, the Examining Attorney must file a new request with the Board for jurisdiction to refuse registration on the new ground. Nor may the Examining Attorney submit evidence that does not relate to the ground mentioned in the request for remand; thus, the Examining Attorney may not submit evidence that supports the grounds for refusal on which the appeal was originally filed.

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP § 1207.05.

1209.03 Upon Granted Letter of Protest

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the USPTO by filing, with the Office of the Commissioner for Trademarks, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. The Office of the Commissioner for Trademarks will determine whether the information should be given to the Trademark Examining Attorney for consideration.[209]

Proceedings in an ex parte appeal will not be suspended pending determination by the Office of the Commissioner for Trademarks of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the Examining Attorney, having considered the supporting evidence submitted with the letter of protest, believes that an issue not involved in the

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[207] *See* 37 CFR § 2.142(f)(6).

[208] *See In re Boston Beer Co. L.P., supra. See also, for information as to the further action taken by the Board, i.e., for information concerning the filing of supplemental briefs, and a request for oral hearing,* TBMP § 1209.01 (Remand Upon Board's Own Initiative).

[209] *See* TBMP § 215 (Effect of letter of Protest) and authorities cited therein.

appeal may render the mark of the applicant unregistrable, the Examining Attorney may file a written request with the Board, pursuant to 37 CFR § 2.142(f)(6), to suspend the appeal and remand the application for further examination.

For information concerning requests for remand for a new refusal or new requirement, and the further proceedings in the case if such a request is granted by the Board, see 37 CFR § 2.142(f)(6), and TBMP § 1209.02.

1209.04 Upon Request by Applicant

A request filed by an applicant to remand the application to the Examining Attorney which is filed within six months of the issuance of a final Office action is treated as a request for reconsideration, whether it is denominated as such, or is captioned as a request for remand. Requests for reconsideration are granted by the Board as a matter of right.[210] However, a if the request is filed more than six months after the issuance of the final refusal (generally after the filing of the notice of appeal), it will be treated as a request for remand, whether it is captioned as such or is captioned as a request for reconsideration.

Requests for remand are generally filed by applicants because they wish to make additional evidence of record, or because they wish to amend the application. Applicants may also request remand so that the Examining Attorney can consider a refusal in light of a recently decided case.[211] No matter what the purpose, the request for remand must include a showing of good cause.[212] In determining whether good cause has been shown, the Board will consider both the reason given and the point in the appeal at which the request for remand is made.

If applicant has not filed its appeal brief prior to filing the request for remand, it should not do so until the Board has acted on the remand request. If the request is denied, the Board will allow applicant time in which to file its appeal brief. If the request for remand is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the Examining Attorney for consideration of the request for remand. The Board's order granting the

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[210] *See* TBMP § 1204 (Effect of Request for Reconsideration of Final Action).

[211] *See In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002) (request for remand filed after notice of appeal in view of recent ruling by Federal Circuit Court of Appeals).

[212] *See* TBMP § 1207.02 for examples of circumstances that have been found to constitute good cause for a remand for the purpose of submitting additional evidence. *See* TBMP § 1205 for examples of what constitutes good cause for the purpose of amending an application.

remand and the directions to the Examining Attorney contained therein will depend on the nature of the remand request and the circumstances.[213]

1210 Approval for Publication During Appeal

The Trademark Examining Attorney may withdraw an appealed refusal to register, and approve the involved application for publication (or for registration, in the case of a Supplemental Register application), at any time prior to issuance of the Board's decision in the case.[214] When the Examining Attorney does so, the appeal becomes moot.

However, the Examining Attorney should notify the applicant by telephone that the application is being approved for publication (or registration).[215]

1211 Abandonment During Appeal

37 CFR § 2.68 Express abandonment (withdrawal) of application.
An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

During an ex parte appeal to the Board, the applicant may expressly abandon its involved application by filing in the USPTO a written statement of abandonment or withdrawal of the application. The abandonment or withdrawal must be signed by the applicant or its attorney or other authorized representative.[216]

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[213] If the request for remand is for the purpose of submitting additional evidence, *see generally,* TBMP § 1207.02. If the request for remand is for the purpose of submitting an amendment to the application, *see generally,* TBMP § 1205.

[214] *See* TMEP § 1501.03. *See also, for example*, TBMP §§ 1203.02(b), 1203.02(c), 1204, 1205, and 1207.02.

[215] *See* TMEP § 1501.03.

[216] *See* 37 CFR § 2.68.

The express abandonment, during an ex parte appeal to the Board, of the applicant's involved application will not, in any proceeding in the USPTO affect any rights that the applicant may have in the mark which is the subject of the abandoned application.[217]

In contrast, after the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of its involved application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant.[218]

1212 Cancellation or Assignment of Cited Registration

Often, in an ex parte appeal to the Board, the asserted ground (or one of the asserted grounds) for refusal of registration is the Section 2(d), 15 U.S.C. § 1052(d), ground that applicant's mark so resembles a mark registered in the USPTO as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive.

If, during the pendency of an ex parte appeal involving a refusal to register under Section 2(d) of the Act, the cited registration is cancelled, or is assigned to the applicant, the appeal will be moot insofar as that issue is concerned. If the refusal to register on the basis of the cancelled or assigned registration is the only issue involved in the appeal, the Board will dismiss the appeal as moot, and the application will be sent to the Trademark Examining Attorney for approval for publication (or for registration, in the case of a Supplemental Register application). If the appeal involves additional issues, it will go forward solely on the additional issues.

When an application has been rejected under Section 2(d) of the Act, and the refusal to register has been appealed to the Board, it is recommended that the applicant periodically check the status of the cited registration.[219] If the applicant learns that the registration has expired or been cancelled, the applicant should immediately notify the Board thereof. Similarly, if the registration is assigned to applicant, the applicant should immediately notify the Board thereof.

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[217] *See* 37 CFR § 2.68. *See also Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ2d 1264, 1267 (1st Cir. 1987). *Cf. (re preclusive effect of prior final judgment arising out of an ex parte case) In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987); and *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299 (TTAB 1986), *aff'd, Vesper Corp. v. Lukens Inc.*, 831 F.2d 306 (Fed. Cir. 1987).

[218] *See* 37 CFR § 2.135, and TBMP §§ 602.01 (Withdrawal by Applicant) and 603 (Withdrawal by Interference or Concurrent Use Applicant).

[219] *See* TBMP § 1203 (Appeal Briefs).

1213 Suspension of Appeal

Prior to the issuance of the Board's decision in an ex parte appeal, proceedings with respect to the appeal may be suspended by the Board upon written request by applicant showing good cause for the requested suspension.[220] Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, are listed below:

(1) Applicant is involved in a civil action, or a Board inter partes proceeding, which may be dispositive of the issue(s) involved in the appeal--Board may suspend pending final determination of the civil action or Board inter partes proceeding.

(2) Another application that involves the same issue is also on appeal to the Board--Board may suspend pending final determination of the appeal in the other application.

(3) A registration cited as a reference, under Section 2(d) of the Act, 15 U.S.C. § 1052(d), against applicant's mark is due, or will soon be due, for an affidavit of continued use (or excusable nonuse) under Section 8 of the Act, 15 U.S.C. § 1058, or for an application for renewal under Section 9 of the Act, 15 U.S.C. § 1059. The Board may suspend pending determination of whether registration will continue in existence or will, instead, be cancelled under Section 8 or expire under Section 9. If an applicant requests suspension based on the possibility that the cited registration may be cancelled for failure to file a Section 8 affidavit, the Board will grant such request if the Board acts on the request after the 5th anniversary of the issue date of the registration. If an applicant requests suspension based on the possibility that the cited registration may have expired for failure to renew it, the Board will grant such request if the Board acts on the request after the 9th anniversary of the issue date for ten-year term registrations (registrations which issued or were renewed on or after November 16, 1989), or after the 19th anniversary of the issue date for twenty-year registrations (registrations which issued prior to November 16, 1989 and which have not yet been renewed).

If it comes to the attention of the Examining Attorney, in the case of a refusal based on likelihood of confusion with a registered mark (Section 2(d) of the Trademark Act), that the grace period for filing an affidavit under Section 8 or an application for renewal under Section 9 for the cited registration has passed, and Office records do not indicate that such paper has been submitted, the Examining Attorney may request remand so the application can be suspended pending final disposition of the cited registration.[221] In that situation, the Board will issue an order suspending the appeal and remanding the case to the Examining Attorney. If the cited registration is cancelled or expires, and that registration forms the only basis for refusal, the

[220] *Cf.* 37 CFR § 2.117, and TBMP § 510 (Motion to Suspend; Motion to Resume).

[221] *See* TMEP § 716.02(e).

Examining Attorney may approve the application for publication (or for registration in the case of a Supplemental Register application), and the appeal will be moot. The Examining Attorney should so notify the applicant by telephone. If the Section 2(d) refusal is only one of the issues of appeal, the Examining Attorney should notify the Board of the status of the cited registration, and return the file to the Board, which will resume proceedings in the appeal. If an appropriate affidavit or renewal application is filed for the cited registration, the Examining Attorney should notify the Board, and return the file to the Board. The Board will then resume proceedings in the appeal. If the grace period for filing the appropriate affidavit or renewal application for the cited registration has not yet expired, the Examining Attorney may request that the Board suspend proceedings in the appeal. In that case, the Board will issue an action advising the applicant the Board is suspending proceedings in the appeal, and giving the applicant the opportunity to inform the Board if it wishes the appeal to proceed without waiting for a determination as to whether the cited registration will be cancelled or will expire. If the applicant wishes the appeal to proceed, the cited registration will be treated as existing and valid.

The Examining Attorney may also request suspension if it comes to his or her attention that another application that involves the same issue is on appeal to the Board. In that circumstance, the Examining Attorney may also request that the appeals be consolidated.[222]

A request for suspension of proceedings before the Board in an ex parte appeal must be filed prior to the issuance of the Board's final decision in the case. For example, an applicant which has appealed a refusal to register under Section 2(d) of the Act (i.e., a refusal to register on the ground that applicant's mark so resembles a registered mark as to be likely to cause confusion) may not wait until it receives the Board's decision on appeal and then, if the decision is adverse, file a petition to cancel the cited registration and request suspension of proceedings in the appeal pending the final determination of the cancellation proceeding.[223]

When proceedings have been suspended, at the request of the applicant, in an ex parte appeal to the Board, and the event for which proceedings have been suspended occurs, as, for example, when a civil action for which proceedings have been suspended has been finally determined, the applicant should file a paper notifying the Board thereof as soon as that knowledge comes to applicant’s attention. When an appeal has been suspended pending a determination of whether a cited registration will be cancelled pursuant to Section 8 or will expire, applicant should monitor the status of the cited registration on a monthly basis and should advise the Board as soon as it ascertains either that the registration has been cancelled or has expired, or that the required Section 8 or Section 9 document has been accepted by the USPTO.

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[222] *See* TBMP § 1214 (Consolidation).

[223] *See In re Vycom Electronics Ltd.*, 21 USPQ2d 1799, 1800 (Comm'r 1986).

The Board will then resume proceedings and take further appropriate action in the appeal. If the cited registration has been cancelled or has expired, and it was the only bar to registration, the appeal will be dismissed as moot. If the cited registration formed only one basis of the refusals on appeal, the Board will resume proceedings in the appeal with respect to the remaining issues.

In addition, when the refusal of registration, or one of the grounds of refusal, is based on Section 2(d), and it appears that the cited registration will be cancelled for failure to file a Section 8 affidavit or will expire for failure to renew, the Board will sua sponte suspend action in the following circumstance. When an ex parte appeal has been assigned to an Administrative Trademark Judge for final decision, the case will be suspended if the due date for filing a Section 8 affidavit or application for renewal of the cited registration falls on or before the date the case is assigned for decision. The due date is the anniversary date of the registration, and does not include the grace period. In this situation, the applicant will be advised that the Board is suspending proceedings in the appeal, and be given the opportunity to inform the Board if it wishes the Board to render a decision without waiting to determine whether the cited registration will be cancelled or will expire. In that case, the cited registration will be treated as existing and valid.

Proceedings in an ex parte appeal may also be suspended by the Board during remand to the Examining Attorney, as, for example, during remand for (1) consideration of an amendment to the application, or (2) consideration of a request for reconsideration of a final action, or (3) assertion of a new ground of refusal, or (4) submission of additional evidence.[224]

1214 Consolidation

When an applicant has filed an ex parte appeal to the Board in two or more copending applications, and the cases involve common issues of law or fact, the Board, upon request by the applicant or Trademark Examining Attorney or upon its own initiative, may order the consolidation of the cases for purposes of briefing, oral hearing, and/or final decision.[225] The Board may also consider two or more cases in one opinion even if they have not been consolidated.[226] Even if the Board renders its decisions on two appeals in a single opinion, the appeals will not necessarily be consolidated.[227]

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[224] *See* TBMP §§ 1202.02; 1203.02(a); 1203.02(b); 1204; 1205; 1206.01; 1207.02; 1207.06; and 1209.

[225] *See, for example, In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997). *See also In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991); *In re Del E. Webb Corp.*, 16 USPQ2d 1232 (TTAB 1990); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987); and *In re Petersen Manufacturing Co.*, 2 USPQ2d 2032 (TTAB 1987). *Cf.* FRCP 42(a), and TBMP § 511 (Motion to Consolidate). *For additional cases see the Appendix of Cases.*

[226] *In re Orange Communications Inc.*, 41 USPQ2d 1036, 1037-39 (TTAB 1996); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 (TTAB 1996) (because issues and record in each case essentially identical,

Although cases consolidated prior to briefing may be presented on the same brief, they do not have to be. The applicant (and/or the Examining Attorney) may file a different brief in each case, if the applicant (and/or the Examining Attorney) so desires. When consolidated cases are to be presented on the same brief, the brief should bear the serial number of each consolidated application, and a copy of the brief should be submitted for each application.

1215 Alternative Positions

Just as the Trademark Examining Attorney may refuse registration on alternative grounds (such as, that applicant's mark, as applied to its goods and/or services, is either merely descriptive or deceptively misdescriptive of them within the meaning of Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1)), so, too, the applicant may, in appropriate cases, take alternative positions with respect to a refusal to register. For example, where registration has been refused on the ground that applicant's mark, as applied to its goods and/or services, is merely descriptive of them, applicant may take the position that its mark is not merely descriptive, and, alternatively, assert a claim, under the provisions of Section 2(f) of the Act, 15 U.S.C. § 1052(f), that its mark has become distinctive of its goods and/or services in commerce.[228] However, it is applicant's responsibility to make clear that it is taking alternative positions.[229]

Board rendered decision as to two applications in a single opinion, noting that applicant and Examining Attorney treated the cases as consolidated for purposes of briefs and oral hearing).

[227] *In re Hudson News Co.*, 39 USPQ2d 1914, 1915 n. 5 (TTAB 1996), *aff'd without published opinion* (Fed. Cir. 1997) (Board issued a single opinion in interest of judicial economy, but each appeal stands on its own merits).

[228] *See, for example, In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Seaman & Associates Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Professional Learning Centers, Inc.*, 230 USPQ 70 (TTAB 1986); *In re American Home Products Corp.*, 226 USPQ 327 (TTAB 1985); and TMEP § 1212.02(c).

Cf. Fed. R. Civ. P. 8(e)(2), and TBMP §§ 309.03 (Substance of Complaint) and 311.02(b) (Affirmative Defenses). *For additional case cites see Appendix of Cases.*

[229] *See In re A La Vielle Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001) (applicant did not assert Section 2(f) claim in the alternative); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 n.2 (TTAB 1997) (Board found that applicant had abandoned its claim that its mark was inherently distinctive early in the prosecution and therefore Board refused to consider claim of inherent distinctiveness made in reply brief, or to view the claim of acquired distinctiveness as an alternative claim); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 n.2 (TTAB 1996) (applicant did not pursue its contention that the marks were inherently distinctive during prosecution, and Board found this claim to have been waived).

But see In re Central Sprinkler Co., 49 USPQ2d 1194, 1195 n.3 (TTAB 1998) (Board *considered* registrability on both Principal and Supplemental Registers even though applicant's amendment to the Supplemental Register was originally not made in the alternative, noting that Examining Attorney continued to refuse registration on both registers, and subsequent papers of both applicant and Examining Attorney, including request for reconsideration and decision on that request, discussed the amendment as being in the alternative).

When an applicant asserts alternative positions, and is not willing to accept registration on the basis of its "fallback" position unless the Board determines, on appeal, that applicant's primary position is not well taken, the applicant should make its wishes clear both to the Examining Attorney and to the Board. For example, when applicant, in response to a refusal on the ground of mere descriptiveness, has asserted alternatively that its mark is not merely descriptive and that the mark has become distinctive in commerce, but applicant is not willing to accept a registration issued under Section 2(f) on the basis of the claim of distinctiveness unless the Board holds, on appeal from the refusal to register, that the mark is merely descriptive, applicant should clearly so state. Otherwise, if the Examining Attorney finds applicant's claim of distinctiveness to be persuasive (and there is no other outstanding ground for refusal to register), the Examining Attorney will approve the application for publication on that basis, and any registration issued to applicant will be issued under the provisions of Section 2(f) of the Act.

If, in an application which is the subject of an ex parte appeal to the Board, the applicant has asserted alternative positions (such as, that its mark is not merely descriptive of its goods and/or services, and that the mark has, in any event, become distinctive of its goods and/or services in commerce; or that its mark has become distinctive of its goods and/or services in commerce, and that the mark is, in any event, registrable on the Supplemental Register), the Examining Attorney should clearly state his or her position with respect to each of applicant's alternative claims.[230]

1216 Oral Hearing

37 CFR § 2.142(e)(1) *If the appellant desires an oral hearing, a request therefor should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or his attorney or other authorized representative.*

(2) If the appellant requests an oral argument, the examiner who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examiner from the same examining division as designated by the supervisory attorney thereof, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.

(3) Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examiner. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.

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[230] *See* TMEP § 1212.02(c).

Chapter 1200
EX PARTE APPEALS

For general information concerning oral hearings in proceedings before the Board, see TBMP § 802. What follows below is information pertaining specifically to oral hearings in ex parte appeals to the Board.

An oral hearing is not mandatory in an ex parte appeal to the Board, but will be scheduled if a timely request therefor is filed by the applicant.[231] If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs.[232] An Examining Attorney may not request an oral hearing. An oral hearing is particularly useful in ex parte cases involving complex issues or where the goods or services identified in applicant's application (or a cited registration) are technical or unfamiliar, or where an issue on appeal is not clearly defined. In addition, the oral hearing sometimes provides an opportunity for the applicant and Trademark Examining Attorney to work out an agreement that results in approval of the application for publication (or for registration, in the case of a Supplemental Register application).

If the applicant desires an oral hearing in an ex parte appeal to the Board, the applicant should file a written request, by separate paper, not later than 10 days after the due date for applicant's reply brief. Only one copy of such request should be submitted. When the applicant has filed a timely request for an oral hearing, the Board sets the date and time for the hearing, and sends the applicant a notice of hearing specifying the date, time, and location of the hearing. Ordinarily, hearings are scheduled on Tuesdays, Wednesdays and Thursdays. In setting the oral hearing, it is the normal practice of the Board to set a time that is convenient for both the applicant and the Examining Attorney. Hearings are almost exclusively held at the offices of the Board.[233]

An oral hearing is held before a panel of at least three members of the Board (i.e., its statutory members, generally administrative trademark judges). The time for oral hearing may be reset if the Board is prevented from holding the hearing at the specified time, or, so far as is convenient and proper, to meet the wishes of the applicant (or the applicant's attorney or other authorized representative) or the Examining Attorney.[234] Board practice in such a situation is to reschedule an oral hearing, either by postponing the date or by moving it forward, but, absent compelling circumstances, not to change a hearing date if the request for rescheduling is made within two weeks of the scheduled hearing date, unless both the applicant and the Examining Attorney agree to the change. Therefore, if applicant requires a rescheduling of the oral hearing, it should inform the Board by telephoning the secretary to the Chief Judge, and by a follow-up facsimile transmission, not later than two weeks prior to the scheduled hearing date. If circumstances arise

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[231] *See* 37 CFR § 2.142(e)(1).

[232] *See* 37 CFR § 2.142(e)(2).

[233] Videoconferences are available in California and Michigan. *For information on requesting a videoconference, see* TBMP § 802.03.

[234] *See* 37 CFR § 2.142(e)(1).

which prevent applicant from providing such notice, applicant should inform the Board as soon as the circumstances become known. Although the Board will allow the cancellation of the oral hearing by the applicant at any point, the Board will consider the circumstances in determining whether it will grant a request by applicant to reschedule the oral hearing, or whether it will decide the case on briefs without oral hearing.[235]

If the applicant requests an oral hearing, the Examining Attorney who issued the Office action from which the appeal was taken, or another Examining Attorney from the same USPTO law office who has been designated for the purpose by the managing attorney of that law office, must appear at the hearing and present an oral argument.[236] If the Examining Attorney requires a rescheduling of the oral hearing, he should advise the secretary to the Chief Judge of the Board, by telephone and e-mail, not later than two weeks prior to the scheduled hearing date. If circumstances arise which prevent the Examining Attorney from providing such notice, another Examining Attorney should be designated by the managing attorney of the law office to appear at the oral hearing. In the rare instances in which the applicant appears but the Examining Attorney does not, the oral hearing will be held without the Examining Attorney; only the applicant will present its oral argument.

The applicant is allowed 20 minutes for its oral argument, and the Examining Attorney is allowed 10 minutes. If the applicant so desires, it may reserve a portion of its 20 minutes to use for rebuttal argument.[237] There is no requirement that the applicant and the Examining Attorney use all of their allotted time. Often, an ex parte appeal to the Board is of such nature that oral arguments thereon may be presented in considerably less than the allotted time. On the other hand, if, because of the complexity or novelty of the issues, an applicant feels that it needs more than 20 minutes for oral argument, it should file a written request with the Board for additional time.[238] If the request is granted, the Examining Attorney will also be allowed additional time.

For information concerning audiotaping, visual aids, videoconferencing and the nature of an oral hearing before the Board, see TBMP §§ 802.06, 802.07, 802.03 and 802.08, respectively.

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[235] *See In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule hearing received three hours before the scheduled hearing because of "a sudden conflict of time" was denied; Commissioner [now Director] denied petition stating that Board has wide discretion in scheduling or rescheduling oral hearings).

[236] *See* 37 CFR § 2.142(e)(2).

[237] *See* 37 CFR § 2.142(e)(3).

[238] *Cf.* 37 CFR § 2.129(a), and TBMP § 802.05 (Length of Oral Argument).

The oral hearing is not an opportunity to present new evidence to the Board. Documents offered at the hearing that were not properly made of record will not be considered.[239]

1217 Final Decision

For general information concerning final decisions in proceedings before the Board, *see* TBMP § 803. What follows below is information pertaining specifically to final decisions in ex parte appeals to the Board.

In determining an ex parte appeal, the Board reviews the appealed decision of the Trademark Examining Attorney to determine if it was correctly made. The Board need not find that the Examining Attorney's rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale.[240] Thus, while the Examining Attorney may not raise a new ground for refusal of registration during appeal, except upon remand by the Board for the purpose,[241] the Examining Attorney is not precluded from raising, during appeal, new arguments and/or additional case citations in support of a ground for refusal which was timely raised and is a subject of the appeal.[242]

When the Board has issued its final decision in an ex parte appeal, the Examining Attorney is without jurisdiction to take any further action therein.[243] Similarly, the Board has no authority, either in its final decision on appeal or thereafter, to remand the case to the Examining Attorney for further examination. A case which has been considered and decided on appeal to the Board may be reopened only as provided in 37 CFR § 2.142(g), as discussed below.[244] That is, while the Board, in its final decision in an opposition, concurrent use, or interference proceeding, may include a remand to the Examining Attorney for further examination with respect to a matter which appears to render the mark of an applicant unregistrable but which was not tried under the

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[239] *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (exhibits in booklet submitted at oral hearing which had not previously been made of record were not considered).

[240] *See In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); and *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 343 n.2 (TTAB 1985). *Cf. Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1009 (Fed. Cir. 1988); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485, 488 (CCPA 1976); and *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426, 428 (CCPA 1975).

[241] *See* TBMP § 1209 (Remand).

[242] *See In re D.B. Kaplan Delicatessen, supra*.

[243] *See, for example, In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 397 n.2 (TTAB 1982); and TMEP §1501.06.

[244] *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) and *In re Mercedes Slacks, Ltd., supra*.

pleadings in the case[245] the Board cannot include such a remand in its final decision in an ex parte appeal.

However, if, at final decision in an ex parte appeal, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may, without deciding the issue(s) on appeal, suspend the appeal and remand the application to the Examining Attorney for further examination.[246] Alternatively, if the issue not previously raised is an application defect which can easily be corrected by the applicant, the Board may elect to decide the issue(s) on appeal, and include in its decision a recommendation that applicant voluntarily correct the defect if it prevails on the appealed issue(s).[247]

1218 Reopening (Amendment, etc., After Final Decision)

37 CFR § 2.142(g) *An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under § 6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.*

Once an application has been considered and decided by the Board on appeal, applicant's course of action normally is limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom, either by way of an appeal to the Court of Appeals for the Federal Circuit, or by way of a civil action seeking review of the Board's decision.[248] An application may not be "reopened," that is, an applicant may not amend its application, or submit additional evidence, at this stage, except in two very limited situations.[249] They are as follows:

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[245] S*ee* 37 CFR § 2.131 and TBMP § 515 (Motion to Remand).

[246] *See* 37 CFR § 2.142(f)(1) and TBMP § 1209.01 (Remand Upon Board's Own Initiative).

[247] *See In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1545 n.1 (TTAB 1996) (in final decision, Board recommended that applicant, if it ultimately prevailed, amend description of mark to clearly set forth claim); *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing); *In re Lativ Systems, Inc.*, 223 USPQ 1037, 1037 n.1 (TTAB 1984); and *In re Wallyball, Inc.*, 222 USPQ 87, 88 n.2 (TTAB 1984).

[248] *See* TBMP § 1219 (Review of Final Decision).

[249] *See* 37 CFR § 2.142(g); *In re Hines*, 32 USPQ2d 1376, 1377 (TTAB 1994) (reconsideration); and *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 n.3 (TTAB 1986).

(1) The application may be reopened by the Board for entry of a disclaimer under Section 6 of the Act, 15 U.S.C. § 1056;[250] and

(2) The application may be reopened upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.[251]

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence.[252]

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[250] *See* 37 CFR § 2.142(g); *In re Petite Suites Inc.*, 21 USPQ2d 1708, 1710 (Comm'r 1991) (Board has authority to remand application, after decision by Board on appeal, for entry of a disclaimer); and *In re S. D. Fabrics, Inc.*, 223 USPQ 56, 57 n.1 (TTAB 1984) (Board accepts disclaimers after decision by Board on appeal where the disclaimer puts the application in condition for publication without the need for any further examination).

[251] *See* 37 CFR § 2.142(g); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1047 n.2 (TTAB 2002) (request in applicant's brief that if the refusals are maintained the application be amended to the Supplemental Register denied because application which has been decided on appeal will not be reopened); *In re Taverniti, SARL*, 228 USPQ 975, 976 (TTAB 1985) (since applicant's registration was not part of evidentiary record before Board when it decided case, registration can be given no consideration in the absence of a successful petition to the Commissioner [now Director] to reopen); *In re Taverniti, SARL*, 225 USPQ 1263, 1264 n.3 (TTAB 1985) (it has been practice of the Commissioner [now Director] to refuse to reopen, after final decision, for amendment to the Supplemental Register); *In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) (Board has no jurisdiction to remand an application, after final decision, for submission of new evidence; only the Commissioner [now Director] has authority, after final decision, to remand for the purpose of reopening the application; *In re S. D. Fabrics, Inc.*, 223 USPQ 56, 57 n.1 (TTAB 1984) (after a case has been decided on appeal, an amendment to the Supplemental Register may be accepted only by the Commissioner [now Director] upon petition, and Commissioner has in past denied petitions to reopen to amend to the Supplemental Register); *In re Dodd International, Inc.*, 222 USPQ 268, 270 (TTAB 1983) (Board denies request to reopen application, after final decision, for amendment to Supplemental Register, quoting 37 CFR § 2.142(g));); *In re Vesper Corp.*, 8 USPQ2d 1788, 1789 n.3 (Comm'r 1988) (petitions to reopen are granted only when proposed amendment would place application in condition for publication, subject to updating search, and no other examination by Examining Attorney would be required); *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799, 1800 (Comm'r 1986) (petition to reopen to allow applicant to file and litigate petition to cancel cited registration denied);*In re Mack Trucks, Inc.*, 189 USPQ 642, 643 (Comm'r 1976) (petition to reopen for letter of consent and for amendment of identification of goods denied; applicant, having elected to proceed, prior to Board's decision, without letter of consent assumed the risk of an adverse decision by Board and does not establish sufficient cause to reopen; also, both the letter of consent and amendment would require further examination beyond an updating search); and *Ex parte Simoniz Co.*, 161 USPQ 365, 366 (Comm'r 1969) (petition to reopen for amendment to Supplemental Register denied; applicant elected a course of action and had a hearing and an adjudication thereon); and TMEP § 1501.06.

[252] *See In re Lowrance Electronics Inc.*, 14 USPQ2d 1251, 1251 (TTAB 1989).

1219 Review of Final Decision

1219.01 By Request for Reconsideration

37 CFR § 2.144 Reconsideration of decision on ex parte appeal.
Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.

For general information concerning requests for rehearing, reconsideration, or modification of a final decision of the Board, see TBMP §§ 543 and 544. What follows below is information pertaining specifically to requests for rehearing, reconsideration, or modification of a final decision of the Board in an ex parte appeal.

An applicant that has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may file a request for rehearing, reconsideration, or modification of the decision. The applicant must file the request within one month from the date of the decision. The time for filing the request may be extended by the Board upon a showing of sufficient cause.[253]

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the Trademark Examining Attorney.[254] The Examining Attorney must file the request within one month of the date of the final decision, unless the time is extended by the Board upon a showing of sufficient cause.[255]
If a request for rehearing, reconsideration, or modification of the Board's final decision in an ex parte appeal is timely filed, applicant's time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire two months after action on the request.[256]

1219.02 By Appeal

An applicant which has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may have remedy by way of an appeal to

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[253] *See* 37 CFR § 2.144.

[254] *See In re Ferrero S.p.A.*, 22 USPQ2d 1800, 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992) (in the absence of statutory or regulatory prohibition, Board has inherent authority to entertain Examining Attorney's request for reconsideration); and TMEP § 1501.07

[255] *See In re Ferrero S.p.A.*, 24 USPQ2d 1061, 1062 n.1 (TTAB 1992).

[256] *See* 37 CFR § 2.145(d)(1).

the United States Court of Appeals for the Federal Circuit, or by way of a civil action for review of the decision of the Board.[257]

For information concerning the taking of an appeal from a final decision of the Board, see TBMP §§ 901-903.

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence.[258]

[257] Section 21 of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145.

[258] *See* TBMP § 1218 (Reopening).

APPENDIX OF CASES

Section 303.03 Meaning of the Term Damage

n.18 *Rosso & Mastracco, Inc. v. Giant food Inc.,* 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983); *Selva & Sons, Inc. v. Nina Footwear, Inc.,* 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 1100-01, 192 USPQ 24, 27 (CCPA 1976); *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); *Estate of Biro v. Bic Corp*., 18 USPQ2d 1382 (TTAB 1991); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); *Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685 (TTAB 1987); *Bankamerica Corp. v. Invest America,* 5 USPQ2d 1076 (TTAB 1987); *BRT Holdings Inc. v. Homeway, Inc.*, 4 USPQ2d 1952 (TTAB 1987); *American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984); and *Davco Inc. v. Chicago Rawhide Mfg. Co*., 224 USPQ 245 (TTAB 1984).

Section 314 Unpleaded Matters

n.262 *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815 (TTAB 1986); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *Alliance Manufacturing Co. v. ABH Diversified Products, Inc.*, 226 USPQ 348 (TTAB 1985); *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982); *Standard Brands Inc. v. Peters*, 191 USPQ 168 (TTAB 1975); *Dap, Inc. v. Litton Industries, Inc.*, 185 USPQ 177 (TTAB 1975); and *CCI Corp. v. Continental Communications, Inc.*, 184 USPQ 445 (TTAB 1974).

Section 404.08 Objections to Notice.

See also Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976*), petition to Commissioner denied*, 198 USPQ 485 (Comm'r 1977); *O.M. Scott & Sons Co. v. Ferry-Morse Seed Co*., 190 USPQ 352 (TTAB 1976); and *Allstate Life Insurance Co. v. Cuna International, Inc*., 169 USPQ 313 (TTAB 1971), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973).

Section 414 Discovery Guidelines (3)

See also Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.,* 183 USPQ 618 (TTAB 1974) and *American Optical Corp. v. Exomet, Inc*., 181 USPQ 120 (TTAB 1974).

Section 507.02 Amendments – General Rule—Fed. R. Civ. P. 15(a)

n.104 *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); *Estate of Biro v. Bic Corp*., 18 USPQ2d 1382 (TTAB 1991); *Huffy Corp. v. Geoffrey, Inc.,* 18 USPQ2d 1240 (Comm'r 1990); *Microsoft Corp. v. Qantel Business Systems Inc*., 16 USPQ2d 1732 (TTAB 1990); *Flatley v. Trump*, 11

USPQ2d 1284 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.,* 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986); *American Hygienic Labs, Inc. v. Tiffany & Co.,* 228 USPQ 855 (TTAB 1986); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Caron Corp. v. Helena Rubenstein, Inc*., 193 USPQ 113 (TTAB 1976); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.,* 183 USPQ 618 (TTAB 1974); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974); *Johnson & Johnson v. Cenco Medical Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973); and *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

Section 507.03(b) [Amendments]To Add Issues Tried by Express or Implied Consent

n.119 *Plastic Fabricators Inc. v. Underwriters Laboratories Inc.,* 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini,* 570 F.2d 328, 1966 USPQ 801 (CCPA 1978); *Jockey International Inc. v. Mallory & Church Corp*., 25 USPQ2d 1233 (TTAB 1992); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd*., 3 USPQ2d 1600 (TTAB 1987); *Devries v. NCC Corp*., 227 USPQ 705 (TTAB 1985); *Medtronic, Inc. v. Pacesetter Systems, Inc*., 222 USPQ 80 (TTAB 1984); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936 (TTAB 1983); *ABC Moving Co. v. Brown*, 218 USPQ 336 (TTAB 1983); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co*., 216 USPQ 168 (TTAB 1982); *Marcal Paper Mills, Inc. v. American Can Co*., 212 USPQ 852 (TTAB 1981); *Trans Union Corp. v. Trans Leasing International, Inc*., 200 USPQ 748 (TTAB 1978); *Intermed Communications, Inc. v. Chaney,* 197 USPQ 501 (TTAB 1977); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977); *Bekaert Steel Wire Corp. v. S.p.A. Officine Maccaferri Gia' Raffaele Maccaferri & Figli,* 196 USPQ 558 (TTAB 1977*); Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc.*, 190 USPQ 158 (TTAB 1976); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); *Dap, Inc. v. Litton Industries, Inc.,* 185 USPQ 177 (TTAB 1975); *Downtowner Corp. v. Uptowner Inns, Inc.,* 178 USPQ 105 (TTAB 1973), *aff'd without opinion, Uptowner Inns, Inc. v. Downtowner Corp.,* 508 F.2d 847, 183 USPQ 427 (CCPA 1974); *Smith Kline & French Laboratories v. USV Pharmaceutical Corp*., 175 USPQ 666 (TTAB 1972); and *Conwood Corp. v. Loew's Theatres, Inc*., 173 USPQ 829 (TTAB 1972).

n.120 *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini,* 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Color Key Corp. v. Color 1 Associates, Inc.,* 219 USPQ 936 (TTAB 1983); *ABC Moving Co. v. Brown*, 218 USPQ 336 (TTAB 1983); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982); *Marcal Paper Mills, Inc. v. American Can Co*., 212 USPQ 852 (TTAB 1981); *Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc.,* 190 USPQ 158 (TTAB 1976); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); and *Downtowner Corp. v. Uptowner Inns, Inc*., 178 USPQ 105 (TTAB 1973), *aff'd without opinion, Uptowner Inns, Inc. v. Downtowner Corp.*, 508 F.2d 847, 183 USPQ 427 (CCPA 1974).

Section 509.01(a) Motion to Extend Time

n.131 *Chesebrough-Pond's Inc. v. Faberge, Inc*., 618 F.2d 776, 205 USPQ 888 (CCPA 1980); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 10 USPQ2d 1671, 1676 (TTAB 1988); *Consolidated Foods Corp. v. Ferro Corp*., 189 USPQ 582 (TTAB 1976*); Neville Chemical Co. v. Lubrizol Corp*., 184 USPQ 689 (TTAB 1975); and *Ortho Pharmaceutical Corp. v. Schattner,* 184 USPQ 556 (TTAB 1975).

APPENDIX OF CASES

Section 511 Motion to Consolidate

n.192 *Helene Curtis Industries Inc. v. Suave Shoe Corp*., 13 USPQ2d 1618 (TTAB 1989); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.,* 226 USPQ 262 (TTAB 1985); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered,* 217 USPQ 464 (TTAB 1983).

Section 512.01 Assignment of Mark

n.204 *Huffy Corp. v. Geoffrey Inc.,* 18 USPQ2d 1240 (Comm'r 1990*). See also S & L Acquisition Co. v. Helene Arpels Inc.,* 9 USPQ2d 1221 (TTAB 1987); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.,* 225 USPQ 956 (TTAB 1985); *E.E. Dickinson Co. v. T.N. Dickinson Co.,* 221 USPQ 713 (TTAB 1984); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.,* 216 USPQ 802 (TTAB 1982).

n.205 *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984); *Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc*., 217 USPQ 810 (TTAB 1982); *Liberty & Co. v. Liberty Trouser Co*., 216 USPQ 65 (TTAB 1982); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976); and *Aloe Creme Laboratories, Inc. v. Aloe 99, Inc*., 188 USPQ 316 (TTAB 1975).

Section 527.01(e) Estoppel Sanction

n.320 *Sunkist Growers, Inc. v. Benjamin Ansehl Co.,* 229 USPQ 147 (TTAB 1985); *Era Corp. v. Electronic Realty Associates, Inc.,* 211 USPQ 734 (TTAB 1981); *Visual Information Institute, Inc. v. Vicon Industries Inc*., 209 USPQ 179 (TTAB 1980); *Shoe Factory Supplies Co. v. Thermal Engineering Co.,* 207 USPQ 517 (TTAB 1980); *Refreshment Machinery Inc. v. Reed Industries, Inc*., 196 USPQ 840 (TTAB 1977); *Autac Inc. v. Walco Systems, Inc.,* 195 USPQ 11 (TTAB 1977); and *Georgia-Pacific Corp. v. Great Plains Bag Co*., 190 USPQ 193 (TTAB 1976). *Cf. Nestle Foods Corp. v. Kellogg Co.*, 6 USPQ2d 1145 (TTAB 1988); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co*., 204 USPQ 76 (TTAB 1979); and *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.,* 191 USPQ 468 (TTAB 1976).

Section 528.01 [Summary Judgment] General Nature of Motion

n.331 *Octocom Systems Inc. v. Houston Computer Services Inc*., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc*., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986); *Bongrain International (American) Corp. v. Moquet Ltd.,* 230 USPQ 626 (TTAB 1986); and *Giant Food, Inc. v. Standard Terry Mills, Inc.,* 229 USPQ 955 (TTAB 1986).

APPENDIX OF CASES

Section 534.02 Motion for Judgment Under Rule 2.132(a)

n.444 *Allegro High Fidelity, Inc. v. Zenith Radio Corp*., 197 USPQ 550 (TTAB 1977) (civil action filed by plaintiff after close of its testimony period); *Tel-E-Gift Corp. v. Teleflora Inc.,* 193 USPQ 254 (TTAB 1976) (communication problem between plaintiff and its counsel); *Litton Business Systems, Inc. v. J. G. Furniture Co*., 190 USPQ 428 (TTAB 1976), *recon. denied*, 190 USPQ 431 (TTAB 1976) (inadequate docket system and heavy work load of plaintiff's counsel; request filed by plaintiff, after close of its testimony period, that Board take judicial notice of certain matters); *Litton Business Systems, Inc. v. JG Furniture Co*., 188 USPQ 509 (TTAB 1976) (answer to complaint contains certain admissions); *A.R.A. Manufacturing Co. v. Equipment Co.,* 183 USPQ 558 (TTAB 1974) (unfamiliarity with current rule governing introduction of plaintiff's registration); *Pierce Foods Corp. v. Mountain Mamma, Inc*., 183 USPQ 380 (TTAB 1974) (applicant assertedly guilty of unclean hands); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974) (during its testimony period, plaintiff had moved to suspend pending outcome of recently filed civil action); *W. R. Grace & Co. v. Red Owl Stores, Inc*., 181 USPQ 118 (TTAB 1973) (unfamiliarity with current rule governing introduction of plaintiff's registration); and *Perfect Film & Chemical Corp. v. Society Ordinastral,* 172 USPQ 696 (TTAB 1972) (allegations in pleading, and exhibits attached thereto, not evidence in plaintiff's behalf).

Section 704.03(b)(1)(A) Registration Owned by a Party

n.119 *Vita-Pakt Citrus Products Co. v. Cerro*, 195 USPQ 78 (TTAB 1977); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498 (TTAB 1976); *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976); *Fort Howard Paper Co. v. Georgia-Pacific Corp.*, 189 USPQ 537 (TTAB 1975); *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647 (TTAB 1975); and *A.R.A. Manufacturing Co. v. Equipment Co.*, 183 USPQ 558 (TTAB 1974). *Cf. Hollister Inc. v. Downey*, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977).

n.120 *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); and *W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118 (TTAB 1973).

n.132 *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979); *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742 (TTAB 1978); *Groveton Papers Co. v. Anaconda Co.*, 197 USPQ 576 (TTAB 1977); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976).

n.136 *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *David Crystal, Inc. v. Glamorise Foundations, Inc.*, 189 USPQ 740 (TTAB 1975); *Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 USPQ 790 (TTAB 1974); and *Gates Rubber Co. v. Western Coupling Corp.*, 179 USPQ 186 (TTAB 1973).

n.137 *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *Aloe Creme Laboratories, Inc. v. Johnson Products Co.*, 183 USPQ 447 (TTAB 1974); *Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970).

n.138 *See also Borden, Inc. v. Kerr-McGee Chemical Corp.*, 179 USPQ 316 (TTAB 1973), *aff'd without opinion*, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); *Unitec Industries, Inc. v. Cumberland Corp.*, 176 USPQ 62 (TTAB 1972); and *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506 (TTAB 1972).

n.140 *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976); *Old Dutch Foods, Inc. v. Old Dutch Country House, Inc.*, 180 USPQ 659 (TTAB 1973); and *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240 (TTAB 1963).

Section 704.03(b)(1)(B) Third-Party Registration

n.149 *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976)*;*

Section 704.05(b) Exhibits to Briefs

n.171 *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *American Crucible Products Co. v. Kenco Engineering Co.*, 188 USPQ 529 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 61 (TTAB 1975), *aff'd,* 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

Section 704.10 Interrogatory Answers; Admissions

n.213 *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025, 1027 n.1 (TTAB 1979) ; *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978; *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.4 (TTAB 1978); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.6 (TTAB 1977) ; *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 660 n.2 (TTAB 1977) ; *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340 (TTAB 1976); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 309 n.6 (TTAB 1976) ; and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976).

n.216 *E. I. du Pont de Nemours & Co. v. G. C. Murphy Co.*, 199 USPQ 807, 808 n.2 (TTAB 1978); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977); *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439, 440 n.2 (TTAB 1976); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976); and *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340, 341 n.3 (TTAB 1976).

Section 704.11 Produced Documents

n.225 *BAF Industries v. Pro-Specialties, Inc.*, 206 USPQ 166, 168 n.1 (TTAB 1980); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196

USPQ 566, 568 n.1 (TTAB 1977); *Dow Corning Corp. v. Doric Corp.*, 192 USPQ 106, 108 n.1 (TTAB 1976); *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.3 (TTAB 1976); and *MRI Systems Corp. v. Wesley-Jessen Inc.*, 189 USPQ 214, 215 n.3 (TTAB 1975).

Section 1207.01 General Rule—Evidence Submitted after Appeal Untimely

n.129 *In re Pennzoil Products Co.*, 20 USPQ2d 1753 1756 n.9 (TTAB 1991); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1884 n.5 (TTAB 1988); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 n.2 (TTAB 1987); *In re Gold's Gym Enterprises Inc.*, 3 USPQ2d 1716, 1716 n.2 (TTAB 1987); *In re International Environmental Corp.*, 230 USPQ 688, 690 (TTAB 1986); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363, 363 n.3 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 46 n.1 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 n.1 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333, 336 n.3 (TTAB 1984); *In re Pierre Fabre S.A.*, 221 USPQ 1210, 1212 n.2 (TTAB 1984); *In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 n.2 (TTAB 1983); *In re Gagliardi Bros., Inc.*, 218 USPQ 181, 183 (TTAB 1983); and *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982).

Section 1207.03 Evidence Considered Due to Actions of Nonoffering Party

n.141 *In re Wells Fargo & Co.*, 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Weather Channel, Inc.*, 229 USPQ 854, 854 n.3 (TTAB 1985); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986); *In re Cotter & Co.*, 228 USPQ 202, 204 n.2 (TTAB 1985); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 946 n.6 (TTAB 1985); *In re Bee Pollen From England Ltd.*, 219 USPQ 163, 165 n.4 (TTAB 1983); and *In re Development Dimensions International, Inc.*, 219 USPQ 161,162 n.2 (TTAB 1983).

Section 1214 Consolidation

n.225 *In re Le Sorbet, Inc.*, 228 USPQ 27 (TTAB 1985); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983); *In re 1776, Inc.*, 223 USPQ 186 (TTAB 1984); *In re Canadian Pacific Ltd.*, 222 USPQ 533 (TTAB 1984), *aff'd*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984); and *In re Armour & Co.*, 220 USPQ 76 (TTAB 1983).

n.228 *In re Lillian Vernon Corp.*, 225 USPQ 213 (TTAB 1985); *In re Narwood Productions, Inc.*, 223 USPQ 1034 (TTAB 1984); *In re Anania Associates, Inc.*, 223 USPQ 740 (TTAB 1984); *In re Perfect Fit Industries, Inc.*, 223 USPQ 92 (TTAB 1984); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983); and *In re Harrington*, 219 USPQ 854 (TTAB 1983).

APPENDIX OF FORMS

Section 310.01 – Notification of Proceeding

Sample Trial Order

MAILING DATE	1/1/2003
DISCOVERY PERIOD TO OPEN	1/21/2003
DISCOVERY PERIOD TO CLOSE	7/20/2003
30-day testimony period for party in position of plaintiff to close	10/18/2003
30-day testimony period for party in position of defendant to close	12/17/2003
15-day rebuttal testimony period for plaintiff to close	1/31/2004

Briefs shall be due as follows:
[See Trademark Rule 2.128(a)(2)]:

Brief for plaintiff is due	4/1/2004
Brief for defendant is due	5/1/2004
Reply brief, if any, for plaintiff is due	5/16/2004

APPENDIX OF FORMS

Section 312 – Suggested Formats for Complaints

SUGGESTED FORMAT FOR NOTICE OF OPPOSITION

(This is a suggested format for preparing a Notice of Opposition. This document is not meant to be used as a form to be filled in and returned to the Board. Rather, it is a suggested format, which shows how the Notice of Opposition should be set up. Opposers may follow this format in preparing their own Notice of Opposition but need not copy those portions of the suggested format which are not relevant.)

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

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

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

NOTICE OF OPPOSITION

State opposer's name, address, and entity information as follows:[1]

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

OR

_____
(Name of partnership as opposer; name of partners; Business address of partnership)

OR

_____
(Name of corporation as opposer; State or country of incorporation; business address of corporation)

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

The grounds for opposition are as follows:

[Please set forth, in separately numbered paragraphs, the allegations of opposer's standing and grounds for opposition.][3]

By _____(Signature)[4]_____ Date_____
(Identification of person signing)[5]

FOOTNOTES

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

[2] The required fee must be submitted for each party joined as opposer for each class opposed, and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified.

[3] Set forth a short and plain statement here showing why the opposer believes it/he/she would be damaged by the registration of the opposed mark, and state the grounds for opposing. Each numbered paragraph should be limited, as far as practicable, to a statement of a single set of circumstances. See Rules 8(a) and 10(b) of the Federal Rules of Civil Procedure.

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

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

REPRESENTATION INFORMATION

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

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

SUGGESTED FORMAT FOR PETITION TO CANCEL

This is a suggested format for preparing a Petition to Cancel a trademark registration. This document is not meant to be used as a form to be filled in and returned to the Board. Rather, it is a suggested format, which shows how the petition should be set up. Petitioners may follow this format in preparing their own petition but need not copy those portions of the suggested format which are not relevant.

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

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

(Name of petitioner)
v.
(Name of registrant)

PETITION TO CANCEL

State petitioner's name, address, and entity information as follows:[1]

_____
(Name of individual as petitioner, business trade name (if any); business address)

OR

_____
(Name of partnership as petitioner; names of partners; business address of partnership)

OR

_____
(Name of corporation as petitioner; State or country of incorporation; business address of corporation)

To the best of petitioner's knowledge, the name and address of the current owner of the registration are _____*(provide if known)*_____

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

The grounds for cancellation are as follows:

[Please set forth, in separately numbered paragraphs, the allegations of petitioner's standing and grounds for cancellation][3]

By ____Signature[4]_____ Date _____
(Identification of person signing)[5]

FOOTNOTES

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

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

[3] Set forth a short and plain statement here showing why the petitioner believes it/he/she would be damaged by the registration, and state the grounds for cancellation. Each numbered paragraph should be limited, as far as practicable, to a statement of a single set of circumstances. See Rules 8(a) and 10(b) of the Federal Rules of Civil Procedure.

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

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

REPRESENTATION INFORMATION

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

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

Section 313.06 – Answer to a Counterclaim

SAMPLE TRIAL ORDER WITH A COUNTERCLAIM

DISCOVERY PERIOD TO CLOSE	7/20/2003
30-day testimony period for plaintiff in the opposition to close	10/18/2003
30-day testimony period for defendant in the opposition and plaintiff in the counterclaim to close	12/17/2003
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff in the opposition to close	2/15/2004
15-day rebuttal testimony period for plaintiff in the counterclaim to close	4/1/2004

Briefs shall be due as follows:
[See Trademark Rule 2.128(a)(2)]:

Brief for plaintiff in the opposition is due	5/31/2004
Brief for defendant in the opposition and plaintiff In the counterclaim is due	7/1/2004
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff in the opposition is due	7/31/2004
Reply brief, if any, for plaintiff in the counterclaim is due	8/16/2004

412.02 Terms of suggested protective agreement upon stipulation:

Plaintiff
v. Opposition/Cancellation No.
Defendant

PROVISIONS FOR PROTECTING CONFIDENTIALITY OF INFORMATION REVEALED DURING BOARD PROCEEDING

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, either the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to

protect the confidentiality of information by employing one of the following designations.

Confidential—Material to be shielded by the Board from public access.

Highly Confidential—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

Parties are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.

Attorneys for parties are defined as including in-house counsel and outside counsel, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.

Independent experts or consultants include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.

Non-party witnesses include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to confidential or highly confidential information in accordance with the terms that follow in paragraph 4. Further, independent experts or consultants may have access to trade secret/commercially sensitive information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify

the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be affected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. Occasions when a whole document or brief must be submitted under seal should be very rare.

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that
are subject to a protective order or agreement. The
confidentiality of the material is to be maintained and
the envelope is not to be opened, or the contents
revealed to any individual, except by order of the Board.

13) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information, which the disclosing party intended to designate as protected, shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of

any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Agreement of the Following,
Effective:

_____
[insert signature date]

_____
[print or type name and title of
individual signing for plaintiff]

_____
[print or type name and title of
individual signing for defendant]

_____
[print or type name and law firm of
attorney for plaintiff]

_____
[print or type name and law firm of
attorney for defendant]

By Order of the Board, effective _____.

_____
[print or type name and title of Board attorney
or judge imposing order]

Section 801.02(e) Special Situations:

Sample briefing schedule for a case with a counterclaim.

THE PERIOD FOR DISCOVERY TO CLOSE:	2/19/2003
30-day testimony period for Plaintiff in the opposition to close:	5/20/2003
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	7/19/2003
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	9/17/2003
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	11/1/2003

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due:	12/31/2003
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	1/30/2004
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	2/29/2004
Reply brief (if any) for plaintiff in the	

counterclaim shall be due: 3/15/2004

If the parties stipulate to any extension of these dates, the papers should be filed in triplicate and should set forth the dates in the format shown in this order. See Trademark Rule 2.121(d).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Section 1202.03 Notice of Appeal – Suggested Format

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

.....
(Name of applicant)
.....
(Serial Number of application)
.....
(Filing date of application)
.....
(Mark)

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.[1]

By.....
(Signature)[2]
.....
(Identification of person signing)[3]

FOOTNOTES

[1] The required fee must be submitted for each class for which an appeal is taken. If an appeal is taken for fewer than the total number of classes in the application, the classes in which the appeal is taken should be specified.

[2] The notice of appeal may be signed by the applicant or by the applicant's attorney or other authorized representative. If an applicant signing for itself is a partnership, the signature must be made by a partner; if an applicant signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

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

TABLE OF AUTHORITIES

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