

TRADEMARK TRIAL AND APPEAL BOARD PROCEEDINGS

TRENDS AND PLANNING AT THE TTAB

2011 MIDWEST INTELLECTUAL PROPERTY INSTITUTE

USPTO STRATEGIC PLAN

Available on USPTO web page:

www.uspto.gov/about/stratplan/index.jsp

- Five elements at pages 24-25 cover the Trademark Trial and Appeal Board
- Discussed with TPAC and stakeholder groups, before inclusion

PLAN ELEMENT

Providing Guidance to Practitioners:

- Issuance of Precedents
- Continuous Updating of TTAB manual of procedure (TBMP)

PRECEDENTIAL DECISIONS

Issuance of Precedents:

- FY 2006 – 55
- FY 2007 – 71
- FY 2008 – 51
- FY 2009 – 49
- FY 2010 – 54
- FY 2011 – (35-40)

REVISION OF TBMP

- Extensive changes in extension practice (Ch. 200)
- Advances in electronic filing
- Updated to reflect changes in Rules from August 1, 2007 Notice of Final Rulemaking
- Next revision planned for Spring 2012

PLAN ELEMENT

Settlement Conferencing:

- Notice of Inquiry (Request for Comments)
- Responses from 3 firms, 4 individuals, ABA-IP, AIPLA, INTA and IPO; posted on web page

SETTLEMENT CONFERENCING

- Existing settlement/discovery conference helpful
- Discovery often needed for fruitful discussions
- Any involvement by Board should be on consent of parties
- Consider only pilot projects

SETTLEMENT CONFERENCING

- Recusal of judge, attorney would be necessary; confidentiality paramount
- Some support for justifying extensions, suspensions for settlement talks
- Some support for second conference late in discovery or after discovery
- Use opportunities to promote ACR

PLAN ELEMENT

Increasing Efficiency in Trial Cases:

- Promotion of Accelerated Case Resolution (ACR)
- Promotion of alternatives to traditional discovery and/or trial models
- More active case management of trial cases

ACR

- As a summary bench trial, use at TTAB predates 2007 amended rules
See, e.g., Miller Brewing Co. v. Coy Int'l Corp., 230 USPQ 675 (TTAB 1986)
- Promoted under amended rules by requirement for discussion in conference
- Raise issue in conference; revisit after disclosures, some discovery
- Look for savings in time and resources

ACR

- Most attractive option when parties can stipulate to many facts, so that remaining evidence limited; must stipulate Board can resolve lingering issues of material fact
- Parties do not forfeit right to oral hearing
- Full appeal options retained
- Visit TTAB website for more information

ACR

- AIPLA proposed five alternatives
- Board will soon post four additional alternatives
- Will continue to promote its use and development of options
- Stakeholder roundtable in Spring 2012

STIPULATIONS

- *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007)
- Opposer used ULTIMATE POLO descriptively; applicant claimed acquired distinctiveness
- Entire record stipulated, including business records, government documents, marketing and internet materials

STIPULATIONS

- *Target Brands, cont'd*
- Stipulated to 13 paragraphs of facts; applicant's dates of use; extent and manner of applicant's use; channels of trade for applicant; recognition by others of applicant's use; and dates, nature and extent of descriptive use by opposer's parent

STIPULATIONS

- *Golding Farms Foods, Inc. v. Raymond Jaquez* (91194024; August 18, 2010) (agreed to limits on discovery)
- *Hachette Filipacchi Presse v. EV International, LLC* (91174433; September 5, 2008) (stipulations of fact and as to accompanying exhibits)
- Raise issue in discovery conference and revisit periodically thereafter

CASE MANAGEMENT

Increasingly Large Records:

- *Lorillard Licensing Company, LLC*, 99 USPQ2d 1312 (TTAB 2011) (“applicant has made many thousands of pages of evidence of record”)
- *General Mills, Inc. and General Mills IP Holdings II, LLC v. Fage Dairy Processing Industry S.A.*, ___ USPQ2d ___ (TTAB 2011) (“The trial record is over 20,000 pages.”)

CASE MANAGEMENT

Board will be more active:

- *Amanda Blackhorse et al v. Pro Football, Inc.*, 98 USPQ2d 1633 (TTAB 2011)
(Board noted overzealous litigation in prior proceedings at Board and, on appeal, in District Court; ordered parties and counsel to appear at Board, under 37 CFR 2.120(i)(2), for conference to plan for completion of discovery and trial of case)

PLAN ELEMENT

Manage workload and pendency:

- Maintain appropriate staffing levels
- Dialogue with stakeholders on pendency measures
- Roundtable with stakeholder organization representatives
November 1, 2011 (will be webcast)

PLAN ELEMENT

Manage workload and pendency:

- What do existing metrics measure?
- Differences between Board and District Courts. Is flexibility an attribute for Board?
- Does the Board need more power?
- Should motion practices be changed?

QUESTIONS?

THANK YOU

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