

TRADEMARK TRIAL AND APPEAL BOARD PROCEEDINGS

TOP TIPS FOR TTAB ADVOCACY

2011 MIDWEST INTELLECTUAL PROPERTY INSTITUTE

Panel

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BEST PRACTICES

FIND THE RIGHT FORUM FOR YOUR DISPUTE

FIND THE RIGHT FORUM

- When You Must Appear Before the Board:
When Civil Court Lacks Jurisdiction Over Defendant
 - Intent-to-use trademark applications
 - Registrations based on foreign registrations
 - No geographic overlap in parties' territories
 - Special cases such as Native American tribes or foreign governments

FIND THE RIGHT FORUM

- When You May Want to Appear Before the Board
 - Want more flexible litigation schedule
 - Want to proceed against opponent without counsel
 - Want to proceed with less evidence and fewer types of evidence
 - Want to litigate remotely

FIND THE RIGHT FORUM

- When You May Want to Appear Before the Board (cont'd)
 - Want to keep costs down
 - Want to keep the federal register clear
 - Willing to coexist

FIND THE RIGHT FORUM

- When You Must Appear Before a Court
 - Dispute involves mark in use but not published or registered
 - Need to include non-trademark claims
 - Need for injunctive relief other than registration/non-registration of trademark
 - Need for monetary relief

FIND THE RIGHT FORUM

- When You May Want to Appear Before a Court
 - Need for judicial control (including sanctions and contempt)
 - Ability to select location of litigation
 - Importance of dispute/costs
 - Ability to outspend opponent
 - Dispute involves numerous trademarks

FIND THE RIGHT FORUM

- Letter of Protest Instead of Opposition
 - Informal way to keep mark from registering or to impose condition on registration
 - Process: see Section 1715 of Trademark Manual of Examining Procedure
 - Standard of Review:
 - Before publication: relevant evidence
 - After publication: clear error
 - LOP does not suspend opposition deadline

FIND THE RIGHT FORUM

- When to file a Letter of Protest
 - Descriptiveness or genericness
 - Own prior US registrations or pending applications
- Beauty of LOP, even if it does not work:
 - Can still oppose or petition to cancel
 - Evidence from rejected LOP not in application record
 - Can use evidence in Board proceeding

FIND THE RIGHT FORUM

- When not to file a Letter of Protest
 - When lack independent third-party evidence to support claim
 - When nature of evidence is not type to support examiner's refusal
 - When claim is subjective dispute with another trademark owner

BEST PRACTICES

PLEADING

PLEADING TIPS

- NOTICE PLEADING
 - Board's narrow scope of jurisdiction
 - Determining the right to federal registration of mark
 - Specialized knowledge and experience of the Board's judges and attorneys
 - Available claims, counterclaims, and affirmative defense
 - Elements necessary to proof

PLEADING TIPS

- COMPLAINT
 - Focus on available claims for which there is a reasonable belief that grounds exist
 - Reassess if the complaint has a high number of paragraphs (40-60-80)
 - Headings are preferable where several claims are asserted

PLEADING TIPS

- COMPLAINT
 - Use references to statutory provisions when pleading a claim—Avoids ambiguity
 - Some claims have particular pleading requirements, e.g., Section 43(c) Dilution, Section 2(a) False Suggestion of a Connection, and Fraud

PLEADING TIPS

- COMPLAINT
 - If in doubt, leave it out
 - Damages credibility of pleader
 - Adds expense without corresponding benefit
 - Fraud
 - Can typically amend later with right facts, and should amend when theory of case changes

PLEADING TIPS

- COMPLAINT – Filed by ESTTA
 - The ESTTA filing form is part of the complete pleading, *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008); *PPG Industries, Inc. v. Guardian Industries, Corp.*, 73 USPQ2d 1926 (TTAB 2005)
 - Inputting of pleaded registration in the available ESTTA field is insufficient to make the registration of record, *Prakash Melwani v. Allegiance Corp.*, 97 USPQ2d 1537 (TTAB 2010)

PLEADING TIPS

- COMPLAINT – Filed by ESTTA
 - Merely checking off an intended claim from among the options available in ESTTA is generally insufficient to assert such claim
 - When opposing a Madrid extension application, all grounds must be checked on the ESTTA form and scope of challenged goods/services must be identified. *CSC Holdings, LLC v. SAS Optimhome* (Opposition No. 91199973, August 12, 2011); *Hunt Control Systems, Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558 (TTAB 2011)

PLEADING TIPS

- ANSWER
 - Compulsory counterclaim
 - If grounds are known at time answer is filed, bring the counterclaim or risk being precluded from doing so later
 - If grounds are uncovered after the answer is filed, bring counterclaim promptly thereafter
 - Before answering, consider whether counterclaim for restriction of plaintiff's pleaded registration is appropriate. Trademark Act Section 18.

PLEADING TIPS

- ANSWER
 - Affirmative defenses
 - Assert only those available and applicable
 - Limitations on many affirmative defenses in Board proceedings
 - Do not include a boilerplate assertion that the complaint fails to state a claim upon which relief may be granted
 - If complaint lacking, bring a motion to dismiss
 - Opportunity for plaintiff to amend its pleading
 - Avoid motions to strike, instead request interlocutory attorney to participate in discovery conference

BEST PRACTICES

DISCOVERY CONFERENCES

DISCOVERY CONFERENCE

- Trademark Rules 2.120(a)(1), (a)(2)
- Fed. R. Civ. P. 26(f)
- *Notice of Final Rulemaking*, 72 Fed. Reg. 42242, 42245 (Aug. 1, 2007)
http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf
- Scope of discussion defined by FRCP 26, subjects listed in institution order.

DISCOVERY CONFERENCE

- Deadline is 30 days after the answer is filed
- Once an answer is filed, the parties may not obtain an extension or suspension for purposes of settlement
- Parties have “equal responsibility” to conference by the deadline. *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701 (TTAB 2008)

DISCOVERY CONFERENCE

- Statistics for Board involvement

Fiscal Year	Board involved	Pro Se involved	2(d) Claim
2008	64	N.A.	N.A.
2009	74	~50%	85-90%
2010	98	>50%	80%
2011*	91*	~60%	80%

DISCOVERY CONFERENCE

- Requesting Board participation
 - Either or both parties may request
 - By phone call
 - Online via ESTTA
 - Not by email or fax
 - No later than 10 days prior to the deadline
Trademark Rule 2.120(a)(2)

DISCOVERY CONFERENCE

- Board participation indispensable when opposing party/counsel will not cooperate in scheduling
 - Interlocutory attorney can order participation at set date and time. *Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759 (TTAB 2009)
 - Dismissal possible for failure to participate. See Trademark Rule 2.120(g)(1)

DISCOVERY CONFERENCE

- Board participation indispensable when *pro se* or attorney not familiar with trademark or Board practice
 - Point out insufficient or improper claims or defenses
 - Highlight issues related to burden of proof
 - Draw attention to applicable rules and authorities

DISCOVERY CONFERENCE

- Additional Benefits of Board participation:
 - Generally explain discovery and trial procedures
 - Discuss schedules and potential unavailability of parties or witnesses
 - Discuss expectations for and modifications to schedule

DISCOVERY CONFERENCE

- Benefits of Board participation (cont'd)
 - Ensures coverage of specified issues (e.g. Standard Protective Order)
 - Discuss procedural stipulations [e.g. service by email per Trademark Rule 2.119(b)(6)]
 - Discuss stipulations of fact
 - Discuss ACR
 - Any other matter brought up by the Board

BEST PRACTICES

ACR (ACCELERATED CASE RESOLUTION)

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.
- Standard options being developed, customized processes available.

BEST PRACTICES

DISCLOSURES / DISCOVERY

DISCLOSURES/DISCOVERY

- Initial disclosures
 - Due 30 days after conference but can be made earlier, even at conference, Trademark Rule 2.120(a)(2)
 - May NOT seek discovery from adversary or file MSJ until you have served initial disclosures. Trademark Rule. 2.120(a)(3); *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010); *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768 (TTAB 2010).

DISCLOSURES/DISCOVERY

- Initial disclosures may be waived by stipulation or motion approved by the Board. *Boston Red Sox Baseball Club Ltd. v. Chaveriat*, 87 USPQ2d 1767 (TTAB 2008).
- Can agree to make more use of disclosures of core information and less use of formal discovery. See NPRM at 71 FR 2498, 2501 (January 17, 2006).

DISCLOSURES/DISCOVERY

- Expert disclosures, Rule 2.120(a)(2)
 - Due 30 days before the end of discovery
 - Board contemplates situations where need for expert may become apparent after discovery closes
 - Work together to resolve issues before presenting to the Board
 - Many deficiencies in an expert disclosure may be curable. *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890 (TTAB 2011).

BEST PRACTICES

PHONE CONFERENCES WITH INTERLOCUTORY ATTORNEY

PHONE CONFERENCING

- Phone conferences on discovery matters
 - Authority
 - Trademark Rule 2.120(i)(1)
 - TBMP §§ 413 and 502.06(a) (3rd ed. 2011)
 - June 20, 2000 Official Gazette notice at <http://www.uspto.gov/trademarks/process/appeal/pattele.jsp> (“Policy & Procedure”)

PHONE CONFERENCING

- Requesting
 - Interlocutory attorney has discretion to grant or deny request
 - Denial of request is without prejudice to merits of the motion
 - Movant may request before filing motion; non-movant may request after receipt of service copy, for expedited consideration

PHONE CONFERENCING

- Requesting (cont'd)
 - May be convened *sua sponte* by an interlocutory attorney or judge
 - Written motion or agenda generally required
 - Call interlocutory attorney (no email unless interlocutory attorney instructs; never by fax)
 - State only the issues, not the merits
 - Impact: may save costs and speed up resolution of case

PHONE CONFERENCING

- Examples of suitable motions
 - Extend time, reopen time
 - Compel (discovery, disclosures, witnesses' attendance at depositions) where issues are narrow and directed
 - Suspension (settlement, pending civil action); resumption
 - Withdraw or amend admissions
 - Quash notice of deposition
 - Amend pleading

PHONE CONFERENCING

- Examples of motions not suitable for a conference
 - Dismiss (failure to state a claim, failure to prosecute)
 - Judgment on the pleadings
 - Summary judgment
 - Judgment as a sanction
 - A motion with a complicated fact pattern or novel issue

PHONE CONFERENCING

- Phone conferences
 - Stay on topic
 - Be prepared to answer questions from the Board
 - Be prepared for different experiences with different interlocutory attorneys
 - May not receive an immediate ruling; arguments taken under consideration; conference may be reconvened

BEST PRACTICES

PREPARATION FOR TRIAL AND THE INTRODUCTION OF EVIDENCE

Stipulations of Fact, Evidence

- Good opportunity to review pleadings for possible pretrial amendment.
- *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007)
- Raise issue in discovery conference; revisit after disclosures, some discovery.
- Can stipulate to record or portion thereof but may reserve right to object on bases of relevance, materiality, probative value, etc.

Procedural Stipulations

- Stipulate to telephone depositions.
- Stipulate to taking of testimony by affidavit or declaration (with or without reservation of right to in-person cross-examination).
- Stipulate to introduction of report of expert witness and necessary supporting materials by Notice of Reliance; and to introduction of same by any countervailing expert; may reserve right to live cross-exam if needed.

Pretrial Disclosures

- Due 15 days before each trial period. *Carl Karcher Enterprises, Inc. v. Carl's Bar & Delicatessen, Inc.*, 98 USPQ2d 1370 (TTAB 2011).
- Supplement discovery responses and initial disclosures to avoid pretrial problems. *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859 (TTAB 2009).

EVIDENCE

- Determine the facts you need to prove your case.
- Put in evidence to support those facts.
- Too often, parties waste time and resources on proof of facts that are not material to issues or have little probative value.
- Do not prove adversary's case.

BE SELECTIVE

- Judge reads all the evidence that is submitted, not just what is highlighted in brief. Do not burden record with cumulative or irrelevant testimony and exhibits. No Dumping!
- Focus on presentation of effective, persuasive testimony and exhibits.

QUESTIONS?

THANK YOU.