



Training Academy Session # 30

Mastering Trademark Trial and Appeal Board (TTAB) Proceedings

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February 13, 2025

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What is the Trademark Trial and Appeal Board

The Board

The TTAB

The Trademark Trial and Appeal Board handles appeals involving applications to register marks, appeals from expungement or reexamination proceedings involving registrations, and trial cases of various types involving applications or registrations.

What is the Trademark Trial and Appeal Board

The Board

The TTAB

The TTAB comprises thirty (30) Administrative Trademark Judges. They have the authority to allow or cancel a federal trademark registration.

How Do You Get to the TTAB

Ex Parte Appeals

1. File an application with the USPTO
2. Get a substantive refusal from a USPTO Examiner
3. File an appeal to the TTAB to attempt to overturn the Examiner's decision

Parties: You (the applicant) and the Examiner

How Do You Get to the TTAB

Inter Partes Proceedings

- File a Petition to Cancel against a registration
- File a Notice of Opposition against a pending application
- Concurrent Use
- Expungements/Reexaminations

Parties: You (the opposer or petitioner) and the Owner of the Application or Registration

What Happens in the TTAB?

Ex Parte Appeal

The Board reviews the record of the application prosecution history related to an examining attorney's refusal to register a trademark.

The Board hears arguments from the applicant and the examining attorney.

No new evidence can be presented other than the record of the application prosecution history.

The Board makes a decision about whether or not the refusal should be upheld, and the mark should be registered.

What Happens in the TTAB

Notice of Opposition

The Board hears an opposer's argument that a trademark should not be registered.

The Board hears arguments from the opposer and from the owner of the application (The applicant).

The Board can entertain any evidence relevant to whether the registered trademark should be registered.

The Board makes a decision about whether or not the opposed trademark should be registered.

What Happens in the TTAB

Petition to Cancel

The Board hears a petitioner's argument that a registered trademark should be cancelled.

The Board hears arguments from the petitioner and from the owner of the registration (The respondent).

The Board can entertain any evidence relevant to whether the registered trademark should be cancelled.

The Board makes a decision about whether or not the trademark registration should be cancelled.

What Happens in the TTAB

Concurrent Use Proceeding

The Board determines whether multiple parties can use and register the same trademark simultaneously.

The Board hears arguments from an applicant and a registrant regarding whether the same trademark can be used simultaneously by two separate parties.

The Board makes a decision about whether the applicant can use the trademark simultaneously with the existing trademark registration owner without causing consumer confusion.

The Board makes a decision about whether the applicant can receive a concurrent use registration, permitting it to coexist with the registration owner.

What Happens in the TTAB

Expungement / Reexamination Proceedings

The Board hears a petitioner's argument that a registered trademark should be cancelled.

The Board hears arguments from the petitioner and from the owner of the registration (The respondent).

The Board can entertain relevant evidence that the trademark was never used, so that the registration should be cancelled.

The Board makes a decision about whether or not the trademark registration should be cancelled.

What do to before you get to the TTAB

- Watch Services
 - A “smoke detector”
 - Gives a trademark owner early warning about problematic applications.
- Contacting the Applicant
 - Cease and Desist
 - Gives a cost-effective way to handle a problematic application or registration.
- Letters of Protest
 - When a party detects a problematic application, this gives a party the ability to bring to an examining attorney evidence that the application should be refused registration.
 - If accepted, the examining attorney can refuse registration based on the information in the letter.

What do to before you get to the TTAB

- Expungements – Cancellation in whole or in part
 - Available if a trademark was never used in connection with any of the goods or services in a registration.
 - No “standing” requirement.
- Reexaminations – Cancellation in whole or in part
 - Available if a trademark was not used in connection with any of the goods or services in a registration by the relevant “use” date.
 - “Use” date is the application date, or the allegation of use date, or the statement of use deadline.
 - No “standing” requirement.
- District Court Lawsuits
 - Jurisdiction is over registration, and also use of a mark, and damages.
 - If you need an injunction or have a damages claim
- Alternative Dispute Resolution

Extensions of Time to Oppose

- First Extension
 - 30 days
 - No official fee
- Second Extension
 - 60 days
 - Can be combined with First Extension for 90 days.
 - \$200 fee
- Third Extension with Consent
 - 60 days
 - \$400 fee
- Can be a useful tool for negotiating settlement.

Oppositions

- Must be filed before end of the opposition period, and any extensions.
 - If the deadlines are missed and the application registers, then a cancellation proceeding can be filed. (“Second backstop”)
- Costs
 - Oppositions are similar to federal district court lawsuits. If settlement is not reached, costs can exceed \$500,000 if the opposition goes through trial and oral argument.
- Purpose – Likelihood of Confusion / Invasion of Corporate Persona/Fraud
- Jurisdiction of TTAB – Only Registration. Not Use.
 - If the application is based on use of the applied-for mark, then a district court lawsuit may be better if an injunction is needed or damages are claimed.

Oppositions

- Use Based Applications
 - Relevant evidence includes use of the trademarks at issue; sales of goods or services under the trademarks; advertising of goods or services under the trademarks.
- Intent-to-Use Applications
 - Evidence of use of the applied-for mark may not exist.
- Applications based upon Foreign Registrations
 - Evidence of use of the applied-for mark in the United States may not exist.
- Applications based upon the Madrid Protocol.
 - Evidence of use of the applied-for mark in the United States may not exist.

Cancellations

- Purpose – Non-use/Abandonment
 - Must do research and allege facts about abandonment, not only conclusory statements.
 - Respondent may default.
- Purpose – Fraud
 - Fraud must be proven “to the hilt”
 - Applicant knew or should have known that he/she was not entitled to register the trademark.
- Purpose – Improper Owner
 - If the registrant was not the owner of the trademark when the application was filed, then the application is void *ab initio*, and a full cancellation proceeding is not needed

Cancellations

- Expungements
 - A decision in an expungement proceeding can be appealed to the Board.
- Reexaminations
 - A decision in a reexamination proceeding can be appealed to the Board.
- *In re Locus Link USA*, 2024 USPQ2d 1181 (TTAB 2024)
 - Board affirmed the decisions to cancel the subject registrations.

Procedure

- Trademark Board Manual of Procedure (TBMP)
 - Federal Rules of Civil Procedure
 - Federal Rules of Evidence
- Pleadings
 - Must allege the relevant facts, e.g. priority of use, registration, likelihood of confusion, abandonment, etc.
- Answer
 - Compulsory Counterclaims
 - Grounds for the counterclaim exist when answer is filed.
 - A defense attacking the validity of any one or more of the registrations pleaded in the opposition/cancellation.
 - Permissive Counterclaims
 - Grounds to cancel a trademark registration that is owned, but not pleaded, by an adverse party.
- Discovery / Settlement Conference

Procedure

- Discovery
 - TBMP Section 414 “Selected Discovery Guidelines”
- Evidence and Testimony
 - Interrogatories, document requests, requests for admission, discovery depositions
 - Testimony depositions
 - Notice of Reliance
 - *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557 (TTAB 2022) [Unnecessarily large record of evidence. "Judges are not like pigs, hunting for truffles buried ... [in the record]"]
- Motion Practice
 - Motions for Summary Judgment
 - Motions in Limine
- Trial Brief and Notice of Reliance

Procedure

- Oral Argument
 - Optional.
 - Generally discouraged.
- Appeals to Federal Circuit
 - Reviews the decision of the Board
- Appeals to District Court
 - Reviews the decision of the Board
 - De novo suit.
 - District court can refuse to register or cancel registration.
 - District court can issue injunctions or award damages.
 - *B&B Hardware Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293 (2015)
 - The Supreme Court held that issue preclusion applies to holdings of the TTAB where the ordinary elements of issue preclusion are satisfied.

Ex Parte Appeals

- Application Prosecution Record
 - Board review is restricted to arguments and evidence during prosecution
- Notice of Appeal / Request for Reconsideration
 - When a refusal is made final by an examining attorney, a notice of appeal may be necessary to preserve rights.
- Applicant's Brief
 - Restricted to evidence during prosecution.
 - Can introduce arguments against the examiner's refusals.
- Examiner's Brief
 - Restricted to evidence during prosecution.
 - Can introduce arguments against the applicant's brief.

Speakers



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