



## TRADEMARK OPPOSITIONS IN THE UNITED STATES OF AMERICA

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### **I. Introduction to U.S. Trademark Oppositions**

1. This paper is intended to provide an overview of trademark oppositions in the United States. Practical considerations for deciding whether to file and how to litigate an opposition are also discussed.
2. In the United States, oppositions are filed with and heard by the Trademark Trial and Appeal Board (“TTAB”) of the United States Patent and Trademark Office (“USPTO”). The USPTO, an agency of the United States Department of Commerce, administers the national trademark registry of the United States, also known as the “federal” registry. (Each of the 50 individual states in the U.S., plus the U.S. territory of the Commonwealth of Puerto Rico, maintain their own “state” trademark registries. Except for Puerto Rico, none of the states currently offers the ability to oppose a state trademark application.)
3. A trademark opposition is defined as an objection by a third party to a pending federal application after publication, and before a registration has been granted. Oppositions in the United States are therefore categorized as pre-grant, rather than post-grant, proceedings.
4. The parties to an opposition are known as the “Opposer” or “Opponent” (the objecting party) and the “Applicant” (owner of the opposed application).

### **II. TTAB Jurisdiction for Oppositions**

#### **A. The TTAB**

1. The TTAB is an administrative adjudicatory body residing within the USPTO, authorized by the U.S. Trademark Law (also known as the “Lanham Act”) to hear and decide trademark oppositions. The TTAB has exclusive jurisdiction to hear and decide oppositions to federal applications. An opposition cannot be filed in the federal or state trial courts, even as a companion claim to a larger related dispute, such as a trademark infringement complaint.
2. The TTAB also hears and decides petitions to cancel federal registrations (trademark cancellation proceedings), appeals from final USPTO decisions on applications (typically where the application has received a final refusal), and certain other proceedings under the Lanham Act.

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## **B. The TTAB Judges**

1. Oppositions are decided by administrative trademark judges. A panel of three judges hears each opposition and issues a written decision (also known as an “opinion”). TTAB decisions are either unanimous or by majority (2-1) vote. Dissenting judges can and occasionally do file their own opinions.
2. The administrative judges are very knowledgeable in trademark law, and are appointed by the U.S. Secretary of Commerce, in consultation with the Director of the USPTO. Once appointed the judges serve full-time for the TTAB. Prior to their appointments, judges often have acquired substantial trademark experience in private practice, at the USPTO, or in academia.
3. As of March 2014, the TTAB had 21 sitting judges.

## **III. Time Period to Oppose and Extensions of Time**

### **A. Publication for Opposition**

1. Applications are published for opposition in the weekly USPTO Trademark Gazette, available electronically or for download via the USPTO website.
2. Once the USPTO publishes an application for opposition, a potential Opposer initially has thirty (30) calendar days within which to file a Notice of Opposition, or a request to extend the time to file a Notice of Opposition.

### **B. Extensions of Time to Oppose**

1. The United States permits extensions of time to oppose published applications.
2. The initial thirty (30) day opposition period may be extended if the potential Opposer files an extension request with the TTAB.
3. However, note that any request for extension of time is communicated by the TTAB to the Applicant or Applicant’s designated representative by the TTAB. Thus even requesting an extension of time puts the Applicant on notice that the potential Opposer has some concerns about the application.
4. Without needing to contact Applicant or to obtain Applicant’s consent, the potential Opposer may extend the opposition deadline for a total of ninety (90) additional days, yielding a total opposition period of one hundred twenty (120) days from the date of publication.
5. The potential Opposer may file a request for a thirty (30) day extension as a matter of right (without cause and without Applicant’s consent).



6. If necessary or desired, the potential Opposer may then file a second request for an additional sixty (60) day extension, again without Applicant's consent, but this time showing some basis for "cause" for the additional extension request (for example, the potential Opposer's need to further investigate the matter, to confer with counsel, or to engage or continue in settlement discussions).
7. Alternatively, Opposer may file a single extension request, within the initial thirty (30) day period, without Applicant's consent, but showing a basis for cause, for a ninety (90) day extension.
8. Once the potential Opposer has obtained extensions of time totaling ninety (90) days, Opposer can only extend the opposition deadline with Applicant's consent absent extraordinary circumstances. The TTAB normally permits only one final consented-to extension, for a period of sixty (60) additional days.

#### **C. TTAB Deadlines That Do Not Fall on Normal Business Days**

1. An opposition deadline (or any other deadline in an opposition proceeding) that does not fall on a normal business day (Monday through Friday), or that falls on a national public holiday, a local public holiday in Virginia if the USPTO is closed for that holiday, or on any other officially excluded days (for example when the USPTO is closed due to inclement weather), may be met by the appropriate action on the next business day.

#### **IV. Possible Issues and Strategies Between Publication and the Opposition Deadline**

##### **A. The United States is a First-To-Use Jurisdiction**

1. The United States is a first-to-use jurisdiction. Thus, use-based trademark rights (also known as "common law" trademarks) are valid and enforceable if the use occurs within the United States. While use-based rights are limited territorially to where the trademark owner can demonstrate substantial and continuous commercial use, plus a reasonable zone of territorial expansion, the geographic scope of common law rights tends not to matter much for oppositions. Oppositions can be based purely on senior common law trademark rights. Owning a prior federal application or trademark registration is not required.
2. When considering the priority of two trademarks, an earlier use date prevails over a later filing date.
3. But where an application has been filed on the basis of Lanham Act Section 1(b) (Intent-To-Use), Section 44(e) (national registration), or Section 66(a) (Madrid Protocol), and applicant's use has not yet commenced in the United States, Applicant's earlier filing date (also known as Applicant's "constructive use date") will prevail against an Opposer who begins use after the filing date, even though the Opposer's use may occur before Applicant's actual date of first use of the mark in the United States.
4. This also means that a potential Opposer needs to be very careful to assure itself that it has senior rights before filing an opposition or even extending the time to oppose.



## **B. Investigation of Applicant and the Application File**

1. During the thirty (30) days between publication and the filing of even one extension of time to oppose, the potential Opposer is often well-advised to investigate the Applicant, the possible use of the mark in the application, any seniority of rights issues, and the history of the prosecution of the application, including whether any of the potential Opposer's marks were cited by the USPTO against the application, and if so, what arguments Applicant made to overcome the citations and achieve publication.
2. Applicant's history in other applications, and opposition and cancellation proceedings, is also readily available from the USPTO and TTAB websites, including (typically) all of the pleadings and documents. If Applicant is represented by counsel, then in addition to any website that counsel's firm maintains, the USPTO and TTAB records can be searched to see what other applications or TTAB proceedings counsel has been involved with, what arguments were made, and what outcomes obtained.
3. In addition, it is often worthwhile to investigate Applicant's overall business and its apparent legal and financial resources, to determine how important the mark in the application appears to be to Applicant, and to gauge Applicant's willingness and ability to defend against an opposition.
4. Beyond any investigation that the potential Opposer or its counsel may conduct, consideration should be given to utilizing an outside investigator, particularly if evidence of Applicant's use or non-use of the mark, or information on Applicant's financial condition, are difficult to obtain through self-action.

## **C. Demand Letter**

1. During the time between publication and either the expiration of the opposition deadline or the filing of a Notice of Opposition, the potential Opposer should consider whether to send a demand letter to Applicant stating Opposer's concerns about the application and what steps would resolve those concerns (for example, withdrawal/abandonment of the application, undertaking not to use the mark, or more limited changes to the application).
2. The opposition deadlines can be used to pressure Applicant for a response to the demand letter or, if a settlement has been reached, then to move forward quickly with the preparation and execution of an agreement.
3. Preparing and sending a demand letter is usually less costly than preparing and filing a Notice of Opposition. Therefore, if Opposer is able to accomplish its goals (for example, abandonment or amendment of the application) with a letter, then sending a letter at this time is a cost-effective approach.
4. However, sending a demand letter can escalate the seriousness of the dispute, even to the point of Applicant filing court litigation to "pre-empt" a possible trademark infringement claim. Moreover, sending a demand letter threatening an opposition is not generally advisable if the potential Opponent is not willing to follow through and make good on the threat.



5. Consider also whether there is any history of past collaboration or conflict between Applicant and the potential Opposer, and whether a “business-to-business” communication channel exists or could be established to reach a settlement even if Applicant’s counsel proves to be difficult.
6. This is also the best time to carefully assess the validity and strength of the rights on which the potential Opposer would rely if an opposition must be filed. For example, issues to be considered could include:
  - a. Possible vulnerability of Opposers rights to partial or complete cancellation for non-use (abandonment).
  - b. Possible vulnerability of Opposer’s rights to cancellation due to improper licensing (“naked license”) or improper assignments or other chain of title defects.
  - c. Possible infirmities in Opposer’s marks, such as descriptiveness / genericness issues, deceptiveness, geographic descriptiveness or deceptiveness, etc.
  - d. Other irregularities in the filing and prosecution of Opposer’s federal applications and/or filings to maintain/renew federal registrations.
  - e. Opposer’s prior knowledge of or acquiescence to Applicant’s use and/or applications for the same or similar marks.

## **V. Commencing the Opposition**

### **A. The Notice of Opposition**

1. An opposition is commenced by filing a written “Notice of Opposition” with the TTAB.
2. The Notice of Opposition uses similar format, structure, and language to a trademark infringement complaint filed in a federal court. Indeed, many of the TTAB rules that govern opposition proceedings are lifted directly from the comparable procedural rules governing federal court litigation.
3. Although a Notice of Opposition can be as lengthy as the Opponent wishes, all that is necessary is a short and plain statement identifying the parties, the opposed application, the marks or other reasons on which the opposition is based, and a request that the TTAB sustain the opposition and refuse registration to the application.
4. The TTAB now permits (and indeed encourages) oppositions to be filed electronically via the TTAB’s portion of the USPTO website. Note: Oppositions against applications based on extensions of protection under the Madrid Protocol (or requests for extensions of time to oppose such applications) must be filed electronically.



5. An opposition can be filed against all or some of the goods and services covered by the application.
6. Unlike the opposition procedure in some other jurisdictions, the Opponent can file a single Notice of Opposition against multiple published applications by the same Applicant if the same mark is involved and if the issues as to each application are identical to or substantially overlap with the issues for the other applications.
7. Opponent can also base its opposition on multiple federal trademark registrations and applications, as well as on any common law rights or other grounds Opponent may have.
8. Although unusual, a joint opposition (a single opposition with two or more Opposers) can also be filed in appropriate circumstances.

## **B. Federal Applications That Can be Opposed**

1. An opposition is available against applications published by the USPTO for registration on the Lanham Act's Principal Register (the main register where most federal trademark applications and registrations reside).
2. If the application is filed for (or later amended to) the Lanham Act's Supplemental Register, then a Petition to Cancel must be filed with the TTAB after the Supplemental Registration has been granted. Although a detailed discussion of the differences between the Principal and Supplemental Registers is beyond the scope of this paper, in general marks on the Supplemental Register are considered descriptive and are deemed to be only capable of functioning as a trademark at some point in the future. For this reason, oppositions against applications for the Supplemental Register are not permitted. (There have been calls to allow for oppositions against Supplemental Register applications, or to do away with the Supplemental Register altogether, but for now the Supplemental Register remains.)
3. Oppositions can be filed against use-based applications under Lanham Act Section 1(a), or applications filed on an Intent-To-Use basis under Lanham Act Section 1(b).
4. If the opposition is to be filed against an Intent-To-Use application, then Opposer should first try to determine whether Applicant is also using the mark (filing an application on an Intent-To-Use basis is permitted even where use of the mark in the U.S. has already begun). If Applicant has established actual use, but such use is junior to Opposer's rights, then Opposer may also consider a lawsuit for infringement. Applicant's use information may also provide some guidance to Opposer as to how invested Applicant is with the application and the likelihood that Applicant will defend against the opposition.
5. Oppositions can also be filed against applications based on Lanham Act Section 44(e), which implements Paris Convention provisions allowing applications based on a national registration in the Applicant's home country.



6. Oppositions can also be filed against applications based on extensions of protection to the United States under the Madrid Protocol (Section 66(a) applications). Note that the United States is only a member of the Madrid Protocol, not the original Madrid Agreement.

## VI. Other Issues for the Notice of Opposition

### A. Standing

1. Opposer must have standing to oppose.
2. Standing extends to any “person” (which includes corporations, other business entities, and associations) who believes that he, she, or it will be damaged by the registration of the application.
3. The TTAB is generally liberal in finding standing to oppose.

### B. Grounds

The following are the most typical grounds asserted in U.S. oppositions. Note that USPTO examiners can also raise most of these as objections to the application during substantive examination. For example, the USPTO examines applications for conflicts with prior federal applications or registrations.

1. Immoral or scandalous matter – Lanham Act Section 2(a)
2. Deceptiveness – Lanham Act Section 2(a)
3. False suggestion of a connection – Lanham Act Section 2(a)
4. Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods – Uruguay Round Agreements Act (“UGAA”) Section 2(9)
5. The mark consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof – Lanham Act Section 2(b)
6. The mark consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased U.S. President without the written consent of the surviving spouse – Lanham Act section 2(c)
7. Priority of rights and likelihood of confusion – Lanham Act Section 2(d)
8. The mark is merely descriptive – Lanham Act Section 2(e)(1)
9. The mark is deceptively misdescriptive – Lanham Act Section 2(e)(1)



10. The mark is primarily geographically descriptive – Lanham Act Section 2(e)(2)
11. The mark is primarily geographically deceptively misdescriptive – Lanham Act Section 2(e)(3)
12. The mark is primarily merely a surname – Lanham Act Section 2(e)(4)
13. The mark comprises matter that, as a whole, is functional – Lanham Act Section 2(e)(5)
14. The mark is likely to cause trademark dilution – Lanham Act Section 43(c)
15. The Applicant has committed fraud on the USPTO – *In re Bose Corporation*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
16. Genericness – Lanham Act Section 23

#### **C. Amendment of the Notice of Opposition**

1. With the exception of oppositions against Madrid Protocol applications, Opposer can amend the Notice of Opposition after filing to include additional grounds on which the opposition may be granted.
2. Opposer may amend the Notice of Opposition once as of right after filing and before Applicant answers or otherwise responds to the opposition.
3. Opposer can amend the Notice of Opposition thereafter by consent/stipulation of the parties or upon a Motion to Amend filed with and granted by the TTAB.
4. Note, however, that oppositions against Madrid Protocol Extensions of Protection (Section 66(a) applications) cannot be amended after filing.

#### **D. Costs and Fees to File an Opposition**

1. In addition to the attorneys' fees, the USPTO/TTAB fee for filing an opposition is US\$300.00 per class of the application opposed.

#### **E. Burden of Proof**

1. Opposer has the burden of proof (on a more-likely-than-not, “preponderance of the evidence” standard) to support the allegations in the Notice of Opposition and demonstrate that the TTAB should sustain the opposition.

#### **F. Opposition Against a Section 66(a) Application**

1. As noted earlier, an opposition against a Section 66(a) (Madrid Protocol) application must be filed electronically, rather than by paper submission.



2. Once an opposition against a Section 66(a) application is filed, the Notice of Opposition may not be amended to change or add to the grounds for opposition, or to add to the goods or services opposed. (A Notice of Opposition against other types of applications may be amended in these ways.)

## **VII. Effect of the Opposition on the Application**

1. Even if the opposition is unsuccessful or is later withdrawn, the filing of a Notice of Opposition will delay the grant of a registration to Applicant.
2. A fully-litigated opposition proceeding to a decision on the merits (from the date a Notice of Opposition is filed to a decision by the TTAB) may take eighteen months to two years to complete. This is a significant delay to registration of the application.
3. The TTAB's procedural rules were modified in 2007 to more closely parallel the procedures applicable to federal district court litigation. Therefore, fully-litigating an opposition proceeding to a decision on the merits before the TTAB is an expensive and time-consuming undertaking for both Opposer and Applicant, with costs and attorneys' fees also similar to court litigation.

## **VIII. Remedies at the TTAB**

1. Remedies at the TTAB are limited to whether the opposition will be sustained (granted) or denied (rejected). If the opposition is sustained, then the application is refused, and the application becomes abandoned (assuming no appeal is taken). If the opposition is denied, then the application will be allowed to register (again assuming no appeal is taken). Occasionally oppositions are sustained in part or denied in part.
2. No injunctive relief can be granted by the TTAB.
3. Money damages, other monetary compensation, and injunctions are not available at the TTAB.
4. The TTAB cannot award costs or attorneys' fees to either Opposer or Applicant. Each party must bear its own costs and fees.
5. If the Opposer has a claim for trademark infringement based on use of the mark, then a lawsuit for trademark infringement must be filed in federal or state court seeking money damages and, if desired, injunctive relief.

## **IX. Answer**

### **A. Time to Answer**

1. Immediately upon the filing of an opposition, the TTAB issues a Scheduling Order that governs the entire schedule of the proceeding through trial to a decision on the merits.



2. The Scheduling Order includes a deadline for Applicant to file its Answer to the opposition.
3. Applicant has forty (40) days from the filing of the opposition in which to answer the Notice of Opposition. This deadline can be extended upon Applicant's motion with or without Opposer's consent, and subsequent TTAB order.
4. If Applicant does not answer, then the TTAB will issue a Notice of Default allowing Applicant thirty (30) days to show cause as to why it did not answer. Such cause must be a legitimate reason for missing the deadline.
5. If Applicant fails to respond to the Notice of Default, then the TTAB will issue a Default Judgment sustaining the opposition and refusing the registration of the opposed application(s).

## **B. Contents of Answer**

1. In the Answer, Applicant must admit or deny each of the allegations in the Notice of Opposition, based on Applicant's own knowledge of the factual background to the opposition. If Applicant is without sufficient knowledge to be able to admit or deny the allegation, then Applicant must so state and deny the allegation.
2. Applicant should raise any available Affirmative Defenses in the Answer. Such defenses may include, for example, Opposer's failure to state a claim, acquiescence, or laches. Applicant bears the burden of proof on its Affirmative Defenses.
3. If counterclaims are appropriate, then Applicant may raise counterclaims in the Answer. Where the opposition is based on one or more of Opposer's federal registrations, a typical counterclaim would seek cancellation of the registration(s) on any available grounds, such as abandonment for non-use, fraud, or priority and likelihood of confusion. Applicant bears the burden of proof on its counterclaims.

## **X. Discovery Conference**

### **A. TTAB Requirements**

1. The TTAB Scheduling Order requires the parties to hold a Discovery Conference within thirty (30) days after Applicant files its Answer. The Discovery Conference can be held in person, by telephone, or (by mutual consent) by email.
2. At the Discovery Conference, the parties or their counsel are, at a minimum, required to discuss the following topics:
  - a. The merits of the claims and defenses in the Notice of Opposition and the Answer.



- b. The possibility of settling the opposition, or if settlement does not seem feasible at the time, the possibility of at least narrowing the scope of the claims or defenses.
- c. Any arrangements to expedite or limit disclosures, pre-trial discovery, and the introduction of evidence at trial.

## **B. TTAB Participation**

1. Either party can request TTAB participation in the Discovery Conference to help facilitate the conference.
2. A request for such TTAB participation must be made at least ten (10) days prior to the deadline to hold the conference.
3. The TTAB representative will facilitate the conference, address any fundamental misconceptions regarding trademark law, and help facilitate Accelerated Case Review (“ACR”, discussed *infra*) should the parties agree to utilize that process.
4. TTAB participation is particularly helpful when Applicant is pro se or Applicant’s counsel is not a knowledgeable or experienced trademark attorney.

## **C. Other Issues to Address in the Early Stage of the Opposition**

1. Protective Order for Sensitive Commercial Information and Trade Secrets: The TTAB automatically enters a standard Protective Order in the opposition whereby each party may designate confidential materials that may be withheld from the public view.
  - a. The Protective Order allows parties to designate and produce confidential materials during discovery and to submit such confidential materials to the TTAB in pleadings, briefs, and as exhibits by submitting redacted documents for public viewing and unredacted documents under seal for review by the TTAB. This mechanism allows the parties to rely on relevant but confidential material during the opposition proceeding.
  - b. The parties may agree to amend that Protective Order to tailor the Protective Order to the specific needs of the parties. Each party may, however, challenge another party’s designation of documentation as confidential.
2. Service of Pleadings and Other Documents: If the parties agree, service of pleadings and other documents can be accomplished by electronic mail as opposed to regular mail, fax, or courier service. If service is made by U.S. First Class (regular) mail, then the receiving party has an additional five (5) days to respond beyond whatever the normal response period would be as provided in the Scheduling Order or TTAB rules. If service is via email, there is no additional time outside the response period.
3. Production of Documents and Other Evidence: The parties or their counsel should discuss how documents and other evidence will be produced, including the location of the production and whether production will occur electronically, on paper, or otherwise.



4. Protection of Attorney-Client Privilege: Counsel should discuss the creation of Privilege Logs, and whether documents dated after the Notice of Opposition was filed should be logged because such documents are presumably privileged.
5. Witness Deposition Procedures: Counsel should discuss any special concerns or issues related to witness depositions.

#### **D. Settlement Strategy**

1. Once Opposer commits the time and resources to prepare and to file the Notice of Opposition, there is less incentive to contact Applicant with a compromise settlement proposal because the pressure is on Applicant to file an answer or be defaulted, and the parties are required to discuss settlement at the Discovery Conference. If Opposer waits to make a compromise settlement proposal until the Discovery Conference or in the normal and required course of the litigation, Opposer is less likely to appear weak or overly eager to settle.

#### **XI. Pre-Trial Discovery**

##### **A. What is “Discovery”?**

1. The term “discovery” refers to the U.S litigation procedure whereby the parties disclose to each other the witnesses and evidence that the parties intend to rely on in the opposition proceeding.
2. This disclosure is mandatory and a party who fails or refuses to comply with discovery can be severely sanctioned, up to and including having judgment entered against that party.
3. The typical TTAB Scheduling Order allows the parties six months to complete their discovery.
4. Discovery techniques vary, and can be both formal and informal. The TTAB rules provide for the following formal types of discovery techniques, all of which are discussed in more detail below:
  - a. Initial Disclosures: Early exchanges of information relevant to the opposition.
  - b. Interrogatories: Written questions concerning the issues and allegations in the opposition, given to the other party to be answered under oath.
  - c. Requests for Production: Written requests to the other party to produce documents and other evidence relevant to the issues and allegations in the opposition.
  - d. Requests to Admit: Written requests to the other party to admit or deny specific allegations relevant to the opposition.



- e. **Witness Depositions:** Live examination of a party's witnesses, by either that party's counsel or opposing counsel, recorded by a stenographer, about that party's knowledge of the facts and evidence relevant to the opposition.

## **B. Initial Disclosures**

1. A party's written discovery requests cannot be served until that party's Initial Disclosures are served. Service of Initial Disclosures and written discovery requests can be simultaneous.
2. In the Initial Disclosures, the parties need to disclose their respective witnesses who likely have discoverable information to support the parties' claims and defenses. Such information can include, for example, Opposer's and Applicant's use, advertising, marketing, promotion efforts, sales, fame, channels or trade and expansion into additional channels of trade, and targeted consumers regarding the parties' respective marks, and the likelihood of confusion and/or dilution that Applicant's mark will cause.
3. In the Initial Disclosures, the parties also need to list the categories of documents on which they intend to rely to support their claims and defenses.

## **C. Other Discovery Techniques – Further Information**

1. **Interrogatories:** The TTAB rules allow the parties to propound up to seventy-five (75) interrogatories. The responding party must provide its written responses within thirty (30) days.
2. **Requests for Production:** The parties can make an unlimited number of requests for production of documents and evidence. Whether the requests are appropriate is governed by relevance.
3. The responding party must provide its written responses within thirty (30) days.
  - a. The document requests typically include requests for all electronic documents, as well as paper documents.
  - b. In some cases the parties will meet and confer regarding "electronic discovery" ("e-discovery" for short), and, specifically, what keywords the parties will use when searching for relevant and responsive electronic documents.
  - c. Because of the advent of electronic document storage and other data in electronic form, e-discovery and the production of electronic documents can become extremely time-consuming and expensive.
4. **Requests for Admissions:** The parties can make an unlimited number of requests for admission. The responding party must provide its written responses within thirty (30) days. If the responding party fails to respond, the requests are deemed admitted, cannot be challenged at trial, and may be used for all purposes in the opposition.



5. Witness Depositions: Depositions to obtain the oral testimony of witnesses are typically limited to one seven-hour day per witness. For a corporate party where it may be difficult for the opposing party to know the identity of the most knowledgeable witnesses, the opposing party may simply request that the corporate party make available the person or persons with the most knowledge of particular deposition topics.

#### **D. Motions to Compel**

1. If a party fails to respond to written discovery, fails to appear for a deposition, or fails to answer one or more questions at a deposition, the requesting party can file with the TTAB a "Motion to Compel" seeking an order that certain discovery be produced. If the ordered party continues to withhold discovery, then the TTAB can issue sanctions, up to and including default judgment against that party.

#### **E. Expert Witnesses**

1. Sometimes parties will engage expert witnesses to support a particular claim or defense. For example, expert witnesses are often involved where a party wishes to conduct and enter into evidence a consumer survey either supporting or refuting a likelihood of confusion between the respective marks of Opposer and Applicant.
2. Thirty (30) days prior to the close of discovery, expert witness reports are due. If a survey is contemplated, a party needs to decide early in the opposition proceeding whether or not it will retain an expert witness to allow the witness sufficient time to conduct the survey, analyze the information, and prepare a report.
3. Typically experts in opposition proceedings are retained to conduct a likelihood of confusion survey. If there is no evidence of actual confusion, then the next best evidence to actual confusion is survey evidence showing a likelihood of such confusion.
4. In addition to likelihood of confusion, experts can be retained to support other claims, such as a claim that a mark is famous, and/or to show a likelihood of dilution.

## **XII. Summary Judgment**

#### **A. What is Summary Judgment?**

1. Summary judgment is a faster way for the parties to obtain an opposition decision. It requires a motion to the TTAB requesting a decision on the merits in the Movant's favor without the necessity of a full trial.
2. Movant must demonstrate the absence of any genuine dispute of material fact, and that Movant is entitled to judgment as a matter of law.
3. Because trademark oppositions are so fact-intensive and the facts are often in dispute, summary judgment is difficult to obtain at the TTAB.



4. According to TTAB statistics, in Fiscal Year 2013, only 21 summary judgment motions were granted out of 153 summary judgment motion decided.
5. Summary judgment motions are expensive to prepare, file, and argue. Because of this expense and because it is so difficult to prevail on a summary judgment motion, the Movant should be as certain as possible that Movant has clear and undisputed facts and an uncomplicated legal argument as to why judgment should enter in Movant's favor.

## **B. When to File and When Not to File Summary Judgment Motions**

1. Claims most amenable to summary judgment include (a) issue or claim preclusion, and (b) genericness or descriptiveness.
2. Claims least amenable to summary judgment include (a) ownership disputes not based on contracts, (b) priority disputes, (c) likelihood of confusion claims where there are differences between the marks and/or goods, (d) dilution, and (e) fraud.

## **XIII. The Opposition "Trial" at the TTAB**

### **A. Witness Testimony and Documentary Evidence**

1. Each party must submit its Pretrial Disclosures fifteen (15) days before its trial period opens. The Pretrial Disclosures identify witnesses and documents that may be introduced at trial.
2. Opposer has the first thirty (30) day trial period to depose trial witnesses, submit the trial deposition transcripts to the TTAB, and to submit documents into evidence to the TTAB through Notices of Reliance.
3. Applicant then submits its Pretrial Disclosures, and has a thirty (30) trial period to take trial depositions and submit documents into evidence.
4. Opposer is then allowed a fifteen (15) day rebuttal period to address any issues raised by Applicant.

### **B. Introduction of Evidence**

1. During the testimony periods, a party may take a testimony deposition, on oral examination or written questions, and the written transcripts along with any exhibits introduced during the testimony deposition are then submitted to the TTAB.
2. A party may also submit a "Notice of Reliance" to the TTAB to introduce certain types of evidence, such as official records and printed publications. A Notice of Reliance is essentially a cover sheet for documentary materials sought to be introduced into evidence, and must include a description of the proffered materials and, in some instances, must indicate the relevance of those materials to the case.



## **C. Trial Briefs**

1. After the close of the rebuttal period, Opposer has two months to prepares and file its main trial brief summarizing the witness testimony, the documentary evidence, and the legal authority in support of Opposer's position.
2. Applicant then has thirty (30) days to prepare and file its trial brief.
3. Opposer then has thirty (30) days to prepare and file its rebuttal trial brief.

## **D. Oral Argument**

1. Either or both of the parties can request oral argument. Such a request must be filed with the TTAB within ten days after the due date for the filing of the Opposer's reply brief.
2. If either party files a timely request for an oral argument, the TTAB will schedule a hearing. If neither party requests a hearing, the opposition is decided on the evidence and testimony made of record during the trial phase.
3. The hearing normally lasts for one hour, with each party having 30 minutes to present their side (Opposer can reserve some of its time for rebuttal). This is an opportunity for each party to summarize its factual and legal position, emphasize its strongest arguments, refute the other party's arguments, and to respond to any questions from the TTAB panel. If a party believes that it needs more than 30 minutes for its argument, the party may file a request with the TTAB for a longer time, which if granted, will also be made available to the other party.
4. Normally the panel consists of three administrative trademark judges, although "augmented" panels of more than three judges can be designated by the USPTO Director or the TTAB to hear a particular case.
5. While hearings often occur with representatives of both parties physically present in the same room as the TTAB panel, the hearings can take place via videoconference with one or both parties. The TTAB is occasionally willing to hold hearings outside of the TTAB's offices at the USPTO in Alexandria, Virginia, but most hearings take place at the TTAB's offices.

## **XIV. Appeal of TTAB Decisions**

### **A. Request for Rehearing, Reconsideration, or Modification of Decision**

1. A party dissatisfied with a TTAB opposition decision may file with the TTAB a request for rehearing, reconsideration, or modification of that decision. The request must be filed within one month from the date of the decision.
2. The other party can respond to the request within 15 days of the date of service of the request (20 days if service is by first-class U.S. mail or courier service).



3. The TTAB in its discretion may permit the original requester to file a reply brief if the other party files a responsive brief. The same time periods apply as for the responsive brief.
4. However, such requests are rarely granted by the TTAB.

## **B. Availability of Appeal**

1. Any party who is dissatisfied with a TTAB opposition decision may seek relief via an appeal.
2. The deadline for filing an appeal is within two months of the date of the opposition decision.

## **C. Where to File the Appeal**

1. An appeal can be made to either (a) the United States Court of Appeals for the Federal Circuit; or (b) a United States district court (trial court). However, where a party has filed a notice of appeal to the Federal Circuit, the adversary, within 20 days, may file with the Commissioner for Trademarks a notice electing to proceed with a civil action in a United States district court, in which event the parties are required to proceed with the civil action.
2. Unlike in a Federal Circuit appeal, if a party appeals to a United States district court, the parties may assert new claims, e.g. trademark infringement, and submit additional evidence in a civil action seeking review of a TTAB decision.
3. Regardless of which appeal option is selected, the TTAB's factual findings in the opposition generally will be upheld unless they are found to be unsupported by substantial evidence.

## **XV. Accelerated Case Resolution (“ACR”)**

### **A. What is ACR?**

1. ACR is an alternative to a traditional TTAB opposition proceeding.
2. To utilize the TTAB ACR procedure, both parties must agree.
3. In ACR, the parties agree to arrangements and limitations regarding disclosures, discovery, and/or the introduction of evidence that tend to reduce or relax the discovery or evidentiary requirements under normal TTAB rules and procedures.
4. The discovery process and introduction of evidence to prove the case is therefore simpler, and the length of time spent litigating the case is shorter (with some phases eliminated), reducing the costs for both parties. For example, the parties could agree to limit the number of interrogatories to 10 instead of the 75 normally permitted under the TTAB rules.



5. If the parties agree to ACR, the TTAB will issue its decision within fifty (50) days of the final ACR brief being filed. This is a substantially shorter time to receive a decision than in a normal opposition.

## **B. What Types of Cases Are Appropriate for ACR?**

1. The most appropriate cases for ACR are those in which one or more of the following circumstances apply: (a) little discovery is necessary; (b) parties are able to stipulate to many facts; (c) each party expects to rely on the testimony of one or two witnesses and the overall record will not be extensive; (d) parties are prepared to make summary judgment submissions with exhibits and are prepared to stipulate that the TTAB panel deciding the case can resolve any lingering genuine disputes as to material facts; or (e) parties are prepared to stipulate to the admissibility of most of the record, and will merely reserve the right to object in trial briefs on the grounds of relevancy or the appropriate weight to be given to particular items of evidence.

## **C. When and How To Use ACR**

1. ACR can be selected at almost anytime in the opposition proceeding. However, to maximize the benefit of reduced time and cost, it is best to select ACR at the beginning of the opposition proceeding.
2. The parties can implement ACR in many ways, including (a) agree to the terms of ACR and file a stipulation with the TTAB, (b) call the TTAB staff attorney assigned to the opposition proceeding, or (c) discuss with the TTAB representative if the TTAB is participating in the Discovery Conference.

## **XVI. Opposition Costs**

### **A. Fully-Litigated Opposition to a Decision on the Merits**

1. As noted previously, although some of the pre-trial and trial procedures differ from those in a trial court, the typical costs are quite similar to federal court litigation.
2. It will likely cost each side at least several hundred thousand U.S. Dollars to fully litigate an opposition proceeding to a decision on the merits.
3. Note, however, that according to TTAB statistics, approximately two-thirds of opposition proceedings are resolved before the answer is filed.

### **B. Cost Variables**

1. Generally speaking, the actual cost of an opposition proceeding depends on how aggressively Applicant defends the opposition, how much discovery is taken, how many pre-trial motions are filed, and whether or not expert witnesses are retained.
2. Discovery requests to the other party, including interrogatories, requests for production of documents, and requests for admissions, can be prepared for a reasonable cost.

However, responding to discovery requests can be quite expensive, especially if there are a significant number of requests. In addition, when responding to each request, appropriate objections need to be raised, information and documents need to be gathered from the client, and the client needs to review counsel's draft responses. Documents need to be reviewed for possible protection under the attorney-client privilege and/or the "attorney work product" doctrine, with privileged documents withheld from production and logged on a "privilege log" to produce to the other side, and for confidentiality, with each document appropriately designated according to the TTAB Protective Order. If Opposer has been using the asserted mark for decades, if the Opposer is trying to assert unregistered common law rights, or if the Opposer is trying to claim its marks are famous, then the Opposer will likely have to produce a significant number of documents.

3. Counsel taking a deposition will need to review documents in advance, confer with the client on deposition strategy, and prepare questions for the deposition, and then likely travel to the deposition location to take the deposition. Counsel defending the deposition will also need to review documents in advance, prepare the witness, travel to the deposition location, and attend the deposition to protect the witness and lodge appropriate objections on the record. Each deposition can easily cost between US\$5,000 and US\$10,000. Therefore, if multiple depositions are taken during discovery, the discovery costs can mount up quickly over a short period of time.
4. Motions can be filed for various reasons throughout the opposition proceeding, including motions to compel discovery responses, to challenge evidence, or to assert objections. Individual minor motions typically cost US\$5,000 – US\$10,000 to prepare. However, more substantive motions, such as motions for summary judgment, can cost US\$25,000 – US\$50,000 or more.
5. An expert survey regarding issues such as fame, likelihood of confusion, or likelihood of dilution can cost US\$75,000 – US\$125,000 or more, including the conducting of the survey, analysis of the data, preparation of the expert witness report, and a subsequent deposition of the expert witness.
6. Depending on the number of trial witnesses and the amount of evidence to submit, testimony and briefing for trial can cost in the range of US\$50,000 – US\$150,000 or more.

## C. Typical Costs

1. Using the cost ranges discuss above, a typical fully-litigated opposition proceeding to a decision on the merits, and without expert witnesses, can cost US\$100,000 – US\$325,000. Including expert witnesses substantially increases this cost range.
2. An opposition proceeding litigated pursuant to the ACR process can reduce the expense by approximately one-half (50%) of the typical cost of a fully-litigated opposition.



## **XVII. Settlement / Withdrawal of An Opposition**

### **A. Settlement**

1. An opposition may be settled at any time prior to the TTAB's decision on the merits.
2. Depending on the terms of the parties' settlement agreement, termination of the opposition may be on a "with prejudice" or "without prejudice" basis, as described below.

### **B. Opposer's Withdrawal of Opposition**

1. Opposer's withdrawal of an opposition with or without Applicant's consent automatically terminates the proceedings.
2. Withdrawal of an opposition with Applicant's consent is on a "without prejudice" basis, allowing Opposer to bring the same claim against the same Applicant in the future, typically in the form of a cancellation action at the TTAB. Withdrawal of an opposition without Applicant's consent but before Applicant has filed its Answer to the opposition is also on a "without prejudice" basis.
3. Withdrawal of an opposition without Applicant's consent but after Applicant has already filed its Answer to the opposition results in a "with prejudice" dismissal of the opposition. A "with prejudice" withdrawal will prevent Opposer from later bringing the same claim against the same Applicant at the TTAB.
4. If Applicant asserted a counterclaim as part of its Answer, proceedings with respect to the counterclaim will continue despite Opposer's withdrawal of the opposition, unless Applicant also withdraws the counterclaim.

### **C. Applicant's Withdrawal of Application**

1. Withdrawal of an opposed application with or without Opposer's consent automatically terminates the proceedings.
2. Withdrawal of the application without Opposer's consent will result in an adverse judgment against Applicant. The entry of an adverse judgment should prevent Applicant from re-filing an application for the same mark covering the same goods/services, and prevents Applicant from later defending against the same claim brought by the same party in the TTAB.

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