

1997

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Recommended Citation

David W. Ehrlich, Richard A. Friedman, Donna L. Mirman, and T. Jeffrey Quinn, *Trademark Prosecution in the Patent and Trademark Office and Litigation in the Trademark Trial and Appeal Board*, 8 Fordham Intell. Prop. Media & Ent. L.J. 451 (1997).

Available at: <https://ir.lawnet.fordham.edu/iplj/vol8/iss2/4>

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DISCUSSION

Trademark Prosecution in the Patent and Trademark Office and Litigation in the Trademark Trial and Appeal Board

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Participants: David W. Ehrlich, Esq.**
Richard A. Friedman, Esq.***
Donna L. Mirman, Esq.****
Hon. T. Jeffrey Quinn*****

MR. SLOANE: On behalf of myself and my co-chair Mark Lieberstein, I welcome everyone here to the first annual panel discussion on issues in trademark law,¹ sponsored jointly by the New York State Bar Association and the *Fordham Intellectual Property, Media & Entertainment Law Journal*.

Our topic this evening concerns practice in an agency that is

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1. This discussion was held on December 2, 1997, in the McNally Amphitheater at Fordham University School of Law. Footnotes were provided by the *Fordham Intellectual Property, Media & Entertainment Law Journal*.

very important to business in the United States: the United States Patent and Trademark Office (“PTO”). Specifically, our panel will address trademark practice in the PTO and the Trademark Trial and Appeal Board (“TTAB”).

As we continue to move toward a service-based economy, trademarks will continue to grow in importance. The major export of the United States today is no longer manufacturing equipment; it is entertainment.² Today’s service providers want to quantify and protect their intellectual properties, which oftentimes are their most valuable assets.³ Trademark registration helps accomplish that goal, and the ability to maneuver through the PTO is often essential in helping clients avoid long delays and added costs while obtaining registration.

This evening, we should take a step back for a moment and review the past year’s practice at the PTO during 1997. It should come as no surprise to anyone that filings are up, as are administrative delays in processing those applications.

During 1998, the PTO is set to begin its program in electronic filing: a pilot project that will allow selected applicants to file applications electronically over the Internet.⁴ It should be interesting to see whether this helps to increase efficiency at the PTO.

We have with us two former PTO examiners, Donna Mirman of the New York law firm of Gottlieb, Rackman & Reisman, and Richard Friedman of NBA Properties, Inc., to help us navigate through prosecution practice.

Nineteen ninety-seven also was an exciting year at the Trademark Trial and Appeal Board, due to the circulation of proposed

2. See Rosanna Tamburri, *Canada Considers New Stand Against American Culture*, WALL ST. J., Feb. 4, 1998, at A18.

3. See Anthony Carey, *The Real Value of Hidden Assets*, FIN. TIMES, Nov. 6, 1997, at 14.

4. See Sabra Chartrand, *The Process of Filing an Application is Slowly Catching Up With the Technology Available*, N.Y. TIMES, Jan. 26, 1998, at D1; see also Wendy R. Leibowitz, *At Year’s End, Tech Cases Show Ties That Bind are Hyperlinked*, NAT’L L.J., Dec. 22, 1997, at B17.

amendments to the TTAB Rules.⁵ Those changes represent a sweeping overhaul of practice before the TTAB, affecting everything from discovery to summary judgment and even trial practice. The TTAB has reopened the comment period on the proposed rules and will hold an open hearing in Washington.

Like prosecution, litigation before the TTAB has its own intricacies. Here to help give us some helpful guidelines are Jeffrey Quinn, a member of the Trademark Trial and Appeal Board, and David Ehrlich of the New York law firm of Fross Zelnick Lehrman & Zissu.

On the subject of prosecution in the PTO, we begin with Donna Mirman, an associate with Gottlieb, Rackman & Reisman in New York. She is a graduate of the University of Pennsylvania and Cardozo School of Law and was an examining attorney with the PTO for five and one-half years. Since joining Gottlieb, Rackman & Reisman last year, her focus has been on trademark and copyright litigation and prosecution.

MS. MIRMAN: Thank you, Peter. Good evening.

Knowing how to maneuver through the PTO is very important in accomplishing your clients' goals. My firm was very pleased to hire someone with experience at the PTO—someone who knew the ins and outs of the PTO. They had never before employed a former examining attorney, and my experience was a big selling point for me.

As I was leaving my office to participate in this presentation, one of the partners at my firm found out that I was on this panel. He said, "What kind of expertise do you have?" He was kidding of course.

I said, "Well, if I don't have this expertise, why did you save four seemingly insurmountable trademark applications for me to handle my first day at the firm?" I subsequently managed to obtain registrations for those applications, and I will give you some tips about how those registrations were achieved.

5. See *PTO Proposes Changes to TTAB Rules*, 9 J. PROPRIETARY RTS. 16 (1997).

First, let me tell you a little bit about the way in which trademark examining attorneys initially examine applications and conduct searches.⁶ Examining attorneys may pull as many as twenty applications per day to reach their daily production quota of ten applications; that is 1.2 applications per hour. The examining attorneys may be forced to pull many extra applications before satisfying the production quota because they are required to turn over pending applications to another examining attorney if that other examining attorney is handling an application by the same applicant, an application with a confusingly similar mark, or an application with a similar identification problem to the application at hand. Well, that is good for practitioners because when one examining attorney handles all of the applications dealing with one applicant, it opens communications between the examining attorney and the practitioner, and that is what we all want. We all should try to bridge the gap between the examining attorney, who makes decisions in the PTO, and the realities of the marketplace.

At times you may get a refusal from an examining attorney and ask yourself, "What was this person thinking? This refusal does not take into account channels of trade or anything else out there on the market. What is going on?" So it may be difficult for examining attorneys in the PTO to see other factors which are not under consideration.

At the PTO, my fellow panelist Richard Friedman and I worked for three years in neighboring offices, and we would search our applications right next to each other in an area called the "bullpen." About ten examining attorneys would sit with their applications and ask each other, "Do you think this is confusing to that? Do you think this is descriptive?" In that way, the examining attorneys became part of the law office collective, which prompted them to lose their subjectivity and take on an objective approach.

After I left last year, however, I learned that examining attor-

6. See generally *In re ECCS, Inc.*, 94 F.3d 1578 (Fed. Cir. 1996) (describing the role of the examining attorney).

neys now have search databases on the computers in their offices, so decisions are now made more on a personal level rather than on the collective of the law office. So, at times, when the examining attorney first looks at the application and it is a borderline case, the examining attorney errs on the side of rejection, even though that seems contrary to the PTO's goal of facilitating the prosecution and the registration of trademarks.

But when an initial rejection is made, the examining attorney is usually thinking, "Well, you know, I'm not quite sure about this mark. Let's put the burden on the applicant's attorney and see what he comes back and argues." Well, of course, when we get it back from the PTO, we are befuddled how such a rejection could have been made. We want to get declarations and want to call our clients in a panic.

First thing, take a deep breath. Call the examining attorney and find out the basis for the decision, establish a little rapport, and possibly things can be resolved right then and there. Most of the time the examining attorney will say, "You know, you have a point, but send something to me in writing." At that time, you can put in a persuasive argument and overcome the rejection.

The rejections that I dealt with on my first day at Gottlieb, Rackman & Reisman, unfortunately for me, were not that easy. They already had been tried unsuccessfully by some of the partners handling the various applications.

Although I had examined rejections and responses for five years at the PTO, I had never drafted responses to applications under section 2(d)⁷ or section 2(e)⁸ of the Lanham Act. So with about two months left at the PTO, I started saving the best responses to such applications. I kept them in my file and pulled them out, including declarations from seminars I attended as an examining attorney and from the *Qualitex*⁹ decision, in which the Court found color to be registerable under acquired distinctive-

7. 15 U.S.C.A. § 1052(d) (West 1994).

8. *Id.* § 1052(e).

9. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

ness.¹⁰ I based my responses on what I had collected and I was successful. I also had a series of conversations with examining attorneys during the course of the prosecution.

Another problematic thing, as our moderator Peter Sloane mentioned, is the desire to avoid long delays in registering the trademarks because of the importance of our clients' interest in commerce. I do not know how many of you encounter suspension actions;¹¹ that is when an application falls into the black hole of oblivion and could disappear for as long as three years while the application goes through a series of extensions providing time to file the statement of use.¹²

When I saw that happening with one of my client's famous marks—it was suspended based on some unknown mark—I quickly put together a letter of consent,¹³ another response that I had saved as an examining attorney. Letters of consent are almost always taken into account now, which is a lot more liberal than it was five or six years ago. The government is very liberal in saying, "The parties have consented. We will abide by their decision

10. *Id.* at 163; *see also* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:44 at 7-82 (1997); Michael B. Landau, *Reconciling Qualitex with Two Pesos: Ambiguity and Inconsistency from the Supreme Court*, 3 U.C.L.A. ENT. L. REV. 219, 248 (1996). Secondary meaning or acquired distinctiveness is achieved when the use of a word, symbol, or device that is not inherently distinctive allows prospective purchasers to identify the goods or services by that designation. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13(b) (1995).

11. "An application in which the examining attorney has formally delayed action beyond the time such action would have been due in normal order is referred to as being 'suspended' or 'under suspension.'" UNITED STATES PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 405 (2d ed., rev.1997). "The term 'suspension of action' refers to the suspending of an action which is due to be taken by an examining attorney. It does not mean suspending an applicant's response or extending an applicant's time to respond." *Id.* § 1108.

12. A statement of use is required when an application for a mark is based on an intent to use a trademark in commerce, which may be lawfully regulated by Congress. *See* 15 U.S.C. § 1051(d).

13. A letter of consent is useful in overcoming a refusal under section 2(d) of the Lanham Act. *Id.* § 1052(d). A refusal under section 2(d) results when the applicant's mark is confusingly similar to a mark previously registered or used by another in the United States. *Id.*

that there is no confusion in the marketplace.”

While my application was pending suspension, I sent a letter of consent, which I was able to negotiate, and my application was removed from suspension, went along to publication, and is now registered. I find letters of consent to be very helpful in avoiding the delays that are associated with suspensions.

I should talk a little bit about sound,¹⁴ smell,¹⁵ color,¹⁶ and trade dress.¹⁷ Those fall under the rubric of non-traditional trademarks.¹⁸ What is most important to remember about smell and sound is that you do not have notes or anything to send in. On the drawing page of the application, however, is a description of the sound and the smell. It is very important to describe exactly what the smell is. For instance, the drawing page of an application for the lemon scent of a toner said “a lemony scent,” and that was sufficient identification.

In configuration and trade dress applications, which after *Two Pesos v. Taco Cabana*¹⁹ can be inherently distinctive and do not

14. See *In re* General Electric Broadcasting Co., 199 U.S.P.Q. 560, 563 (T.T.A.B. 1978), for a discussion of the criteria for registration of sound marks.

15. A fragrance or scent mark that identifies a certain product may be registered if the fragrance is not an inherent attribute or natural characteristic of the product. See *In re* Clarke, 17 U.S.P.Q. 2d 1238 (T.T.A.B. 1990).

16. Color can function as a trademark when used on the goods in the manner of a trademark and is perceived by the purchasing public as distinguishing the goods and indicating their source. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (finding the color green-gold for dry cleaning press pads to be a protectable trademark); *In re* Owens-Corning Fiberglas Corp., 227 U.S.P.Q. 417 (Fed. Cir. 1985) (finding the color pink for fiberglass insulation to be a protectable trademark); *In re* Eagle Fence Rentals, Inc., 231 U.S.P.Q. 228 (T.T.A.B. 1986) (finding that the arrangement of alternately colored strands of wire functioned as a mark for renting chain-link fences).

17. Trade dress is “the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (citing *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)).

18. See Marcia B. Paul & Anthony F. Lo Cicero, *Litigating Trademark and Unfair Competition Cases*, 463 PLI/PAT. 83, 127-28 (1996) (categorizing non-functional aspects of products, such as trade dress, color, shape, sound, and scent, as non-traditional trademarks).

19. 505 U.S. 763 (1992).

necessarily have to be registered under acquired distinctiveness,²⁰ I have never seen an application go through based on an examining attorney's finding that the trade dress or the configuration was inherently distinctive. In cases like that, you should get as much promotion, advertising, and declarations as possible. It is important to keep in mind, of course, that in drafting the declaration for your client and its customers you must focus on that part of the configuration that you are claiming is distinctive.

I do not know how many of you are familiar with *In re Sandberg & Sikorski Diamond*,²¹ which involved a client of Gottlieb, Rackman & Reisman in a case prosecuted prior to my arrival at the firm. In that case, the TTAB found that the declarations were insufficient to show acquired distinctiveness because the declarations did not specifically talk about the ring design that we were seeking to register.²² Instead, it said, "Everybody knows the ring is from Sandberg Sikorski," without showing the consumers the actual configuration.²³ So it is very important to attach in your application either a description of the smell, the sound, or a drawing of the exact configuration.

One of my final points is to advise you to read as many TTAB decisions as possible.²⁴ It helps me tremendously. Almost monthly I find a case right on point to something that I have been dealing with in advising my clients.

20. *Id.*; see also Landau, *supra* note 10, at 234 (maintaining that, because the *Two Pesos* decision held that "[s]econdary meaning is required only for the protection of descriptive marks," it is not necessary to establish secondary meaning "in order to protect any other kind of mark—including trade dress").

21. *In re Sandberg & Sikorski Diamond Corp.*, 42 U.S.P.Q. 2d 1544 (T.T.A.B. 1997).

22. *See id.* at 1549.

23. *See id.* at 1548-49.

24. The TTAB is comprised of a chairperson, eight other members, and six interlocutory attorneys who assist the members. See Jeffrey M. Samuels, *U.S. Patent and Trademark Office (PTO) Practice*, 413 PLI/PAT. 163, 166 (1995). The United States Patents Quarterly ("USPQ") publishes TTAB decisions and petition decisions. *See id.* at 167. "Also published in the USPQ are decisions of the U.S. Court of Appeals for the Federal Circuit, which handles appeals from final decisions of the TTAB and decisions of the Commissioner disposing of petitions." *Id.*

I am going to end with a small anecdote about something that happened to me upon leaving the office. I had a client who had been represented by an attorney who left my firm a few months ago. His applications landed in my office with a status that read, "A response to Office action is due in four days." So I told the client how we needed to amend the drawing. He had tried to bring in a different drawing that didn't match the specimens. I told him what kind of drawing we needed.

He said, "You know, I feel confident that this application is going to go through. It is almost like you are anticipating what the examining attorney is going to say."

I said, "It's funny you should say that. A little bit about my background is that I was at the PTO for five and one-half years. That is why I was hired, so I can help you maneuver through the PTO." And I added, "Thank you for providing me with material as I head off for a talk on this subject."

I hope that all of you can take the painstaking efforts to anticipate what the examining attorney will do upon examining your application. If you have any questions, you can call me at the firm.

MR. SLOANE: Thank you, Donna.

Our next speaker is Richard Friedman, associate counsel with NBA Properties, Inc., in New York. He is a graduate of Duke University and The George Washington University National Law Center. After law school, he worked as an examining attorney with the PTO for three years. While at the PTO he had the opportunity to clerk with the Trademark Trial and Appeal Board. In his new position, he is responsible for the worldwide prosecution and enforcement of the intellectual property rights of NBA Properties, the twenty-nine member teams of the National Basketball Association ("NBA"), and the recently formed Women's National Basketball Association ("WNBA").

MR. FRIEDMAN: Thank you. We also do the licensing and marketing for USA Basketball, which many of you know as the Dream Team. It keeps me very busy.

I want to step back and try to give you some tips regarding

prosecution at the PTO, some things that I have learned while I was there and now since I have left, which I think will be helpful.

When my fellow panelist Donna Mirman said we worked together side-by-side, sitting next to each other at times, she touched on some major points. Let me extrapolate a little more and see if I can add something to what she said.

The way to make your life easier when prosecuting trademarks at the PTO is to make the examining attorneys' lives easier. One thing that I have noticed, from being there and now outside, is that a lot of examining attorneys feel like they are outsiders to the private bar; that private practitioners place a stigma on the examining attorneys, as though they or their jobs are inferior to those who are in private practice. So one of the most important things to do when you are dealing with trademark examining attorneys is to show respect. A little respect will go a long way.

One of the things that you can and should do in your conversations and written correspondence with them is to refer to them as "examining attorneys." I was listening to Donna, and every time she referred to them it was "examining attorneys," not "examiners." Examiners are the people on the patent side and they are not attorneys. It sounds like a small thing, but trust me, when you are on the phone and practitioners in the private sector start calling you "examiner," it eats at you. I see Donna is laughing.

MS. MIRMAN: My firm still calls everybody "examiners," and I am always correcting them.

MR. FRIEDMAN: So a little respect goes a long way.

Donna also mentioned the quota system. It is really too detailed to get into here, but I wanted to go into it just a little bit so you can understand how the examining attorneys accumulate points. Basically, their work is based on a point system, so that their bonuses, and in fact their yearly pay, is based on the number of points that they acquire over the course of the year. When an examining attorney writes a first action or anything regarding a first action, that is, when he or she pulls a file and sends something out, that is one point and that is good. When the examining attor-

ney passes something to publication, that gains him or her one point and that is good.

So based on that, if an examining attorney pulls an application that is in perfect order and can be passed right to publication, that is two points for the attorney. The examining attorneys love that. They are already thinking ahead to their bonus at the end of the year when they do something like that.

So your job should be to concentrate on making an application two-points perfect. You can do that by getting all the informalities right. Make sure the application is accurate. If there is an easy disclaimer, like a geographic term, put it in the application. Do not wait for them to ask you for it. Make sure the person who signs the application is authorized and that all the little things in the application papers are proper.

This is why when filing trademark applications you must pay attention to all the details. Let's say some kind of substantive refusal area comes up, but it is a gray area—not the easy section 2(d) case²⁵ or the easy descriptiveness refusal.²⁶ Let's say the examining attorney pulls an application that is in a gray area, but everything else is okay. The examining attorney is apt to say, "All right, I am going to take my chance and not send the refusal so I can get those two points for that first-action publication."

If, however, there are other things wrong in the application papers, little stuff, and they are going to have to send you a letter anyway, then they might as well put in the substantive refusal to cover themselves. That is the way things work, whether we on the outside like it or not. So it is very important that the application papers are in proper order.

25. 15 U.S.C. § 1052(d) (West 1994). Section 2(d) of the Lanham Act bars from registration marks that resembles a registered mark or a mark or trade name previously used by another which has not been abandoned. *Id.* A thorough inquiry into whether the proposed mark is likely to cause confusion as to the source of a product is required before refusing to grant a trademark request. *See In re Wella A.G.*, 787 F.2d 1549 (1986).

26. Under the Lanham Act, a mark that is merely descriptive cannot be granted trademark protection. *See* 15 U.S.C. § 1052(e).

I just want to reiterate that as far as easy substantive refusals go, if it is a clear-cut case, I would like to think that they are not letting those go and passing them to publication. But for the gray areas, you want to get everything right and maybe you can persuade them not to throw that substantive refusal in there.

As Donna Mirman mentioned, different managing attorneys have different views and, as a result, the examining attorneys under them have different views. Some managers take the position that if you include a substantive refusal in the first action, then you should be ready and prepared to take it up to the TTAB if it is appealed. That is one view. Another view is to throw in a substantive refusal, see what the applicant has to say about it, and then drop it. Let the applicant make a record.

Unfortunately, you do not know which type of examining attorney you are getting, or which type of manager he or she has. So that is when you call them and try to figure it out; you try to feel your way as to what it is going to take to overcome the refusal. Examining attorneys like to talk on the phone because they get points for phone actions and for examiner amendments or priority actions. So don't be afraid to call and discuss something and to feel out whether this is going to be an insurmountable task or whether you just need to build a record for them to pass it on to publication.

Finally, the last bit of advice regarding this is not to be afraid to ask for the manager's opinion or to get a second opinion. Again, it is important to do this in a respectful manner. Ask the examining attorney if he minds you going over his head to discuss your problem with the manager. It is funny, but when I was an examining attorney, I was in a conference where I heard someone lecture about this subject, and it really annoyed me because I did not want anyone going over my head. But now, on the outside, I have been able to get some marks passed on to publication and registered because I went over the heads of examining attorneys. Obviously, the most important thing is to support the interests of your client. So even if you annoy an examining attorney here and there, if you can do it in a way that is respectful and still get your mark passed,

then I think that is the way to do it.

Life at the NBA is not like life at the PTO. Life at the PTO was kind of like a flat line; pretty much every day is the same as the day before. After a while, you do not see too many new issues arise. At the NBA, I liken my job to one of those heart monitors that jumps up and down because every day is completely different. I never can anticipate what is going to happen. When I sit down at my desk in the morning, rarely do I end up doing what I expected to do that day.

I would like to discuss a few things that I do at the NBA, because I think they are directly related to what I have learned at the PTO. It is important to understand that registering trademarks is not the end of the road; it is the beginning of the road in many respects. It is a means to an end, rather than the end itself.

The majority of my work now is protecting the rights of the NBA, the WNBA, etc., through enforcement actions. We do a lot of anti-counterfeiting work.²⁷ To me, the main reason for getting the NBA's marks registered is to use those marks against counterfeiters. In that regard, I work with local law enforcement officials and private investigators. In fact, last week I conducted a training seminar for the New York City Police Department on how to identify counterfeit NBA products. I also work with the United States Customs Service ("Customs") helping them look out for counterfeits. Customs recordation is also a big part of the work of our intellectual property group.

The second phase of my job deals with advising inside the NBA: the consumer products group, the marketing people, the teams. I also deal with player right of publicity issues. We are responsible for marketing our players under the terms of our group license agreement with them.

Finally, there is trademark prosecution. For the NBA teams, we register our marks in more than eighty countries, and the NBA

27. See William Green & Katherine Bruce, *Riskless Crime? (Product Counterfeiting)*, FORBES, Aug. 11, 1997, at 100.

logo is registered in more than 170 countries in many different classes. In addition, we have a strong copyright program. A trademark registration program should not be a substitute for a copyright registration program, especially if it is available and possible for the type of intellectual property you are dealing with.

Before finishing, I want to touch on the differences between clearing marks at the PTO and the NBA. Obviously, at the PTO when you review for likelihood of confusion issues, it is only with respect to the Federal Trademark Register. At the NBA, however, when we review search reports the Federal Trademark Register is very important, but it is equally important to review common law and state cites because oftentimes the little guys look at the NBA as a big pocket in litigation. So we spend a lot of time in search reports going over the common law cites, looking for people who might, if we adopt a certain trademark, look at us as a deep pocket in a litigation.

It is very important when looking at search reports not to look at just the Federal Register and think, "All right, it does not look like there is going to be a problem getting the mark registered." Well, there may not be, but there may be a problem using the mark. You may be looking down the barrel of a lawsuit.

Anyway, that is basically what I had. If one application passes to publication because of the tips that I have given you, then I guess I have done my job. Thanks, Peter.

MR. SLOANE: Thank you, Richard.

Now, to shift gears for a moment and talk about the Trademark Trial and Appeal Board. In essence, we still are talking about the same subject matter: trademark registration. We have Jeffrey Quinn, who has been a TTAB member since 1988. He is a graduate of Tulane University and Tulane University School of Law. After graduating from law school, he joined the PTO as an examining attorney, and in 1983 moved to the TTAB where he was an interlocutory attorney, until becoming an administrative trademark judge.

MR. QUINN: Thank you, Peter.

I just spent a couple of hours this afternoon walking around New York, and it appears that business is booming. I am here to report that the same holds true for the Trademark Trial and Appeal Board in Washington; business is booming.

Let me give you some numbers. In the last twelve months, we have had more than 8,000 filings at the TTAB, which represents a 33% increase over filings just two years ago, and a 60% increase in filings from five years ago. We currently have more than 10,000 active files, and extensions of time to oppose are approaching the 35,000-per-year figure. So business is very good. And with folks trying to push the outside of the envelope, as I like to say, in trying to get things registered, such as scents, trade dress, configurations, et cetera, there is a lot of work to be done.

Unfortunately, the down side to that, from our perspective and probably from your perspective as well, is that it takes longer to issue decisions. On average now, we issue opinions eight to nine months after a case is ready to be decided.

We have had some recent staff increases. We are up to ten judges. One just took senior status. We have ten judges and ten staff attorneys. Hopefully, some further staff increase is on the way, but in this economy of downsizing government, a dramatic increase is not going to happen overnight.

With our workload, we at the TTAB always look for ways to reduce our headaches. Hopefully, I might be able to give you just a few pointers to reduce your own headaches and, in turn, reduce our headaches at the TTAB.

The first pointer may be stating the obvious, but I am going to state it anyway; know the extent of the TTAB's jurisdiction. The only thing over which the Trademark Trial and Appeal Board has jurisdiction is the federal registration of trademarks.²⁸ By keeping

28. See 15 U.S.C.A. § 1070 (West, WESTLAW through Pub. L. 105-165, approved Mar. 20, 1998) (authorizing an appeal 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); cf. *The Driving Force, Inc., v. Manpower, Inc.*, 498 F. Supp. 21 (E. D. Pa.). In *Driving Force*, the court stated that:

this in mind in your pleadings, in your discovery, and in submission of your trial evidence, you can avoid some pitfalls.

When practitioners lose focus of the TTAB's limited jurisdiction, problems can arise. A typical example is discovery. If you lose focus of the TTAB's very narrow jurisdiction and request some over-broad, burdensome discovery, your opponent will refuse to answer it, and you might have to resort to a motion to compel²⁹—a filing with a low likelihood of success. It is brief, but it is one of those nasty, early disputes that could be avoided if you keep in mind the limited issues before the TTAB and tailor your pleadings, especially your discovery, accordingly. So know the extent of the TTAB's jurisdiction.

Another item that seems obvious but requires restating is that you should know the TTAB Rules of Practice³⁰ and the relevant case law. Again, I think you would be amazed at how many practitioners before us seem to be somewhat unfamiliar with the TTAB Rules of Practice. Many are unfamiliar with the slight nuances in practicing before the TTAB and the case law that has gone through the TTAB.

For example, the TTAB does not entertain motions for directed verdicts. Nevertheless, we still see those kinds of motions all the time, including motions under the Federal Rules of Civil Procedure to dismiss for failure to state a claim.³¹ We see those motions, but they are couched in terms of the merits of the case, rather than suf-

The Patent and Trademark Office is invested by Congress with broad authority to regulate the registration of trademarks. Included within the statutory mandate of the Lanham Act is the power to resolve inter-party disputes concerning registration of particular marks. The Trademark Trial and Appeal Board has been created especially to hear such disputes.

Id. at 25. See generally *Amalgamated Bank of New York v. Amalgamated Trust & Sav. Bank*, 842 F.2d 1270, 1272 (Fed. Cir. 1988) (“The TTAB’s June decision reinforced the TTAB’s March decision, emphasizing that the right to determine whether a mark was registerable fell within the jurisdiction of the TTAB.”).

29. See 37 C.F.R. § 2.120 (West, WESTLAW through 63 Fed. Reg. 28453, May 22, 1998 (setting forth the rules governing discovery in appeals before the TTAB)).

30. 37 C.F.R. pt. 2 (1995).

31. FED. R. CIV. P. 12(b)(6).

iciency of the pleadings. So it is important to know the TTAB's Rules of Practice and the case law.

The bigger point that I am trying to make here is that if you know the TTAB's jurisdiction and you know the case law and you know the TTAB Rules of Practice, the litigation before us becomes more efficient and less costly. That means fewer headaches for you and fewer headaches for us.

To the extent you have a question about any of that, namely, the jurisdiction, the case law, and the TTAB Rules of Practice, pick up the phone. I would like to think that the TTAB is very receptive to phone inquiries. I know I am. If I can avoid more papers being filed, a useless motion, or parties getting worked up early on in the case, I would much prefer that someone pick up the phone and say, "I am thinking about filing this motion. What do you think? What are my options here?" The more knowledgeable you are about the rules and the case law, the better you will be at examining the strengths and weaknesses of your case. That is true for your opponent's case as well. Ultimately, I hope you will be in a better position to gauge settlement.

With regard to those statistics I gave you earlier, I cannot imagine having to conduct more than eight thousand trials each year. We just could not do it. Luckily, about ninety-five percent of our cases settle out. So I think, again, some of those pointers might put you in a better position to gauge the possibility of settlement.

Now, for your list of do's and don'ts, here are a couple of do's for practicing before the TTAB. First, we see a ton of motions at the TTAB. These are decided by our interlocutory staff attorneys. When a case is filed before the TTAB, it is assigned to one of the ten interlocutory attorneys, who then handles that case through the interlocutory stage. So they become very familiar with the cases from early on.

In fact, as an interlocutory attorney, you get a quick sense of which case is going to be trouble because the motions start coming in very early and you see that the attorneys are not getting along. But remember, the attorney who is going to look at your motions is

familiar with the case. Indeed, as time goes on, the attorney probably will become very familiar with the good guy or the bad guy in the case, if there is a good guy or bad guy.

So because the attorney is familiar with the case, I think you really only need to put the bare essentials in your motion. State what you want. Again, that may be stating the obvious, but it is not as easy as it sounds. If you are looking to extend your time to respond to discovery requests, ask for that. But if you also want the discovery period extended, ask for that too. Many times parties just ask for the response time to be pushed back but they do not ask for the discovery time to be pushed back. State what you want. Ask for it.

Cite the rule and precedent. Again, a lot of times we do not see that. I think that the most egregious cases probably are the discovery disputes. The TTAB has a lot of case law about what is discoverable and what is not discoverable. It is great when such support is included in the motion because we can go right to it.

Provide the evidence. If you file a motion that needs a declaration, affidavit, or otherwise, put it in there. I do not, however, think there is any need to recount in detail the pleadings, the history of the case, et cetera, unless it is absolutely necessary.

Please do not file three copies of everything. With all the paper at the TTAB, we see a lot of copies. Some of the motions look incredibly nice, they have color-coded tabs and are beautiful. But we need only one copy. So save us some trouble and save yourself some trouble as well.

How about briefs on the case at final hearing? I think basically they should concentrate on your best arguments. Do not attempt to set forth every conceivable argument that you might have and recite every piece of evidence. I think it dilutes your most potent arguments. I would just stick to those. When you make your potent arguments first, I think you score some early points, and that is a good thing.

When you make a factual proposition in the brief, show where it is in the record, actually reference the evidence so that I can eas-

ily find it. I find that to be especially helpful. And again, you would be amazed at the people who do not do this. But I find it especially helpful in the really fact-intensive cases, such as abandonment and priority, to know who did what when. It is very helpful if the attorney, in his or her brief, will point me to the evidence where I can find who, what, and when.

When citing a precedent in a brief, it is most helpful if you cite Federal Circuit and TTAB decisions. I think the TTAB has less compunction to look closely at the district court cases. We do look at them, of course, and we do look at the other courts of appeal; but we are especially interested in knowing what we said in the past and certainly what our reviewing court said in the past.

Some more comments about briefs, which I think also are pertinent to oral hearings. Avoid dubious assertions. Every case, like it or not, has its weaknesses, and denying those weaknesses is an ineffective tactic. If you have a likelihood of confusion case and the case involves similar-but-not-identical marks and you have different goods, a bull-headed insistence that the marks are totally dissimilar is frankly annoying to the TTAB. For example—and this happens at an oral hearing—if one of the marks is “AB” and the other mark is “BC” and the attorney argues that there is absolutely nothing similar between the marks, I will ask counsel, “Just to get this straight, counsel, you mean there is nothing similar about these marks?”

Counsel will then look me right in the eye and say, “Mr. Quinn, that is exactly what I am saying.” I think it is important to avoid the dubious assertions. It is best to acknowledge the weaknesses in your case. Admit frankly when there is some similarity in the marks, but then proceed to your strongest argument. In the example I just gave you, the goods are different, so I think that is what you have to hammer on.

Admitting a weakness in a case makes the strong points of your case more compelling. In owning up to the weaknesses, you show you have made a fair assessment of the record. We all know that briefs and oral hearings are not necessarily the most objective exercises, but a frank admission tells me that you have looked at the

evidence and you have made a fair assessment. I think it gives you credibility on the close points in a case. If you are believable and you have conceded some of the weak points, the close points are more believable, and it adds credibility to the entire package that you present to the TTAB.

On my last points on briefs and oral hearings, stick to the record. Constantly we have to ask people at oral hearings, "Is it in the record?" Many times, the attorney frankly admits, "No, it is not." So stick to the record.

One thing in inter partes cases, and I am not quite sure why we do not see more of it, is greater use of requests for admissions and stipulated facts. Requests for admissions, without a doubt, are the least utilized discovery tool out there. In the proposed Rules package, one of the proposals we made was to limit the number of requests for admissions and production of documents. We have dropped that proposal, so there will be no limit on the requests for production of documents and requests for admissions. I really do not want to talk extensively about the Rules package or turn this into a gripe session, because we are having the public hearing next Wednesday. Nevertheless, I would like to see greater use of stipulated facts, just to see more cooperation between counsel here in developing a record.

As far as the record goes, build a record. If you argue in an inter partes case that your goods are purchased by sophisticated purchasers, put some evidence in the record to that effect. If you argue that your opponent's mark is weak because third party use is rampant, put support in the record: even if the mark is something like "Max" or "Star," that is, something like a lot of other marks out there.

What are some don'ts in TTAB cases? First, do not over-litigate a case before the TTAB. I will preface my remarks on this topic by saying that I have never experienced a day in private practice. When I preach this to some of my friends in private practice, they say, "Quinn, you just don't get it." Obviously, I know there is an ethical obligation to be a zealous advocate, but I think in fulfilling this obligation—and certainly in fulfilling the obligation at the

TTAB—attorneys need not behave in a way that obstructs the proceedings and detracts from the merits of the case. It wastes the TTAB's resources, it wastes your resources, and it wastes the client's resources. So in this regard, there are a couple of things that I would not do.

Do not oppose every extension of time. If it is reasonable under the circumstances, stipulate to it. Once, when I was an interlocutory attorney, I had a request to extend time. I thought there were pretty good reasons. One lawyer's apartment had been burglarized and she had been beaten up. She submitted a copy of the police report and a copy of her medical report. That drew an objection from opposing counsel. I do not know why. Maybe they just were not getting along, maybe the client for opposing counsel just told his lawyer to hold her feet to the fire. I don't know what happened in that particular situation, but I propose that you not oppose every motion to extend.

Do not file reply briefs. It just slows down a decision on the motion. Some of you may be familiar with the rules package. We are going to provide for the filing of reply briefs because we see them in so many cases. I still say do not file them, even though the rules are going to let you file them.

Regarding testimony depositions, do not make needless objections. I read deposition after deposition where there is just objection after objection after objection. It slows down the reading of the deposition.

Do not file requests for reconsideration. I know you probably have heard many judges say that. I am going to say it again. I do not want to say that reconsideration requests are *never* granted; let me say that they are *almost* never granted. Besides which, any reconsideration gives the TTAB a second look at a case: a chance to shore up any part of the opinion that is a little short and needs some bulletproofing against your possible appeal. The TTAB may take advantage of reconsideration as an opportunity to do that.

The most important don't that I propose here is do not resort to

invective and name-calling: the so-called “Rambo lawyering.”³² The late Judge Nies gave a very nice lecture at the American Bar Association meeting several years ago on “Rambo lawyering.”³³ We see plenty of it at the TTAB, and it is one reason why we have proposed the Rules package, that is, to try to cut down on some of the abuses. Really, that type of lawyering detracts from the merits of your argument; it annoys the TTAB, and it lessens the chance for settlement.

When I read a brief that contains personal criticism, trying to make opposing counsel out to be the villain, I tend to lose my concentration. I let the fit run its course and regain focus when the brief returns to the merits of the case.

Another don't is summary judgment. The TTAB used to be very enthused about summary judgments. Five years ago, we granted sixty percent of the summary judgment motions that were filed. There has been a recent series of cases, however, in the last two or three years by the Federal Circuit wherein we have been reversed.³⁴ That has truly dampened our enthusiasm for summary judgment, and now we are granting only about ten or fifteen percent of those motions. So unless it is a *res judicata* ground perhaps, or truly compelling undisputed facts in your favor, motions for summary judgment are not very successful these days.

Some of that, frankly, is due to the Federal Circuit reversals of our decisions. There has been a subconscious chilling effect. To anybody who perhaps is accusing the TTAB of a knee-jerk denial of summary judgment cases, we always say, “Well, go read the Federal Circuit's opinion in *Olde Tyme Foods, Inc. v. Roundy's*,

32. Valerie P. Hans & Krista A. Sweigart, *Jurors' Views of Civil Lawyers: Implications for Courtroom Communication*, 68 IND. L.J. 1297, 1297 (1993) (discussing a speech by Robert Saylor regarding the misconception that juries want to see a “warrior or ‘Rambo’ attorney”).

33. Helen W. Nies, *Rambo Lawyering: The Need for Civility in Civil Litigation*, 32 IDEA 1, 12 (1991).

34. See, e.g., *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372 (Fed. Cir. 1996) (reversing the TTAB's summary judgment ruling).

Inc.”³⁵ In that case, involving identical bread products, we found there was a likelihood of confusion on summary judgment.³⁶ Our decision was reversed because the court found that there were genuine issues about the commercial impressions of the marks.³⁷

How about ex parte appeals? Just some quick statistics. I think people always are interested in the affirmance rates. Let me just give you a couple of our most recent affirmance rate figures. In likelihood of confusion cases, in ex parte appeals before the TTAB, our most recent figures show the affirmance rate to be 82%, that is, 82% of those TTAB decisions affirm the examining attorney’s final refusal. In descriptiveness cases, there is 67% affirmance of the examining attorney’s final refusal. In cases involving capability on the supplemental register, there is 33% affirmance. And in surname refusals, the affirmance rate is 57%. Overall, the affirmance rate in an average year is between 70% and 75%, and our most recent figures show it to be right at 76%.

The two best things you can do in an ex parte appeal are build a record and build it early. One of the most thoughtful practitioners once gave a speech in which he said there are three things you’ve got to do in an ex parte appeal or while prosecuting a case with an eye toward appeal. The first thing you do is build a record; the second thing you do is build a record, and the third thing you do is build a record. It is very important. If you want me to vote to reverse the examining attorney’s final refusal, show me the evidence. You’ve got to put it in the record. That is what I am going to examine when deciding whether to affirm or reverse a refusal. Again, you would be amazed at the practitioners who say that the customers are sophisticated when there is nothing in the record to support that proposition.

The other do is educate the TTAB. There has been an explosion of cases involving configuration, trade dress, high technology

35. 961 F.2d 200 (Fed. Cir. 1992).

36. *See Olde Tyme Foods, Inc. v. Roundy’s, Inc.*, 961 F.2d 200, 202 (Fed. Cir. 1992).

37. *See id.* at 203.

goods, and service industries. We need to be educated about those. I mean, we do not have science backgrounds at the TTAB; we are not engineers. Some of us do not even know how to program our VCRs, so we need to be brought up to speed on some of the technical products and services.

My last points involve some introspection at the TTAB, some do's and don'ts for us. I think we can publish more cases. The private sector has maintained that we don't publish enough cases. We are taking a hard look at that, and I think we will publish more in the future.

Another point I think is well taken; the TTAB needs to get a better handle on abuses. Whether we institute a phone conference procedure, akin to a magistrate in district court; have more creative sanctions short of entering judgment; or make quicker decisions, certainly the TTAB needs to cut out abuses.

Those are my fifteen minutes of thoughts. I am not saying that if you adopt those thoughts you are going to prevail in every case. It helps if you have a better case than your opponent does, but some of the points might help you in your practice before the TTAB, which would be a major advantage in your practice.

Thank you.

MR. SLOANE: Thank you, Jeffrey.

Our next speaker David Ehrlich is an attorney with Fross Zelnick Lehrman & Zissu in New York. He will give us the perspective of a private practitioner practicing before the TTAB. He is the head of the Fross Zelnick group that practices litigation before the TTAB. Since graduating Harvard Law School in 1977, his practice has focused exclusively on trademark prosecution and TTAB litigation.

MR. EHRLICH: Thank you, Peter.

It is hard to distill almost twenty years of practice. I do not want to give you lots of micro-tips on dealing with TTAB procedure in a fifteen-minute talk, beyond saying that TTAB procedure is full of traps for the unwary. For example, if you do not file a

Notice of Reliance³⁸ in the proper way or at the proper time, and you do not get documents properly identified, after they are produced by the other side, you will not get them into evidence.

It is very important in TTAB procedure to read the rules carefully. It is desirable to get a copy of the new *Trademark Trial and Appeal Board Manual of Procedure*,³⁹ which is abbreviated as the “TBMP.” It is forbiddingly thick, but it is not badly indexed, and it will be a great help in dealing with practice points—especially on motions, but also in making your record.

I would like to talk a little bit about how TTAB practice is different from court practice. You might think, if you look at the pertinent statutory law and case law, that there should not be many differences on issues of likelihood of confusion, which make up most of the litigated cases in front of the TTAB. You look at *In re E.I. DuPont DeNemours & Co.*,⁴⁰ which lists thirteen or so factors; you look at *Polaroid Corp. v. Polarad Electronics Corp.*⁴¹ in the Second Circuit, which has a rather similar list of factors; you look at section 32 of the Lanham Act,⁴² which talks about likelihood of

38. See generally Gerald R. Rogers, *Patent and Trademark Office Practice in Trademark Matters*, 559 PLI/LIT. 241, 244 (1997) (describing the “Notice of Reliance” procedure).

39. PATENT AND TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) (1995).

40. 476 F.2d 1357 (C.C.P.A. 1973).

41. 287 F.2d 492 (2d Cir. 1961).

42. 15 U.S.C.A. § 1114 (West Supp. 1997). Section 32 states, in relevant part:

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for

confusion, and you look at section 2(d) of the Lanham Act,⁴³ which talks about likelihood of confusion; and it is hard to see much difference. But in the real world, the TTAB is constrained severely both by case law and by the realities of its procedure, which make the results extremely different between a TTAB case on registration and a court case on infringement.

If you will keep the differences firmly in mind as you go into a case, you will avoid surprising, disappointing results and a lot of wheel spinning.

Because the TTAB's focus is on registration, the TTAB is obliged, under case law of the Court of Appeals for the Federal Circuit ("CAFC"),⁴⁴ to give full scope to the prior registered rights

the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

Id.

43. *Id.* § 1052(d). Section 2(d) states, in relevant part:

No trade-mark 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 Commissioner 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 chapter; (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.

Id.

44. See generally *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 568 F. Supp. 1229, 1231 (N.D. Ill. 1983) (noting that the Court of Appeals for the Federal Circuit "is a

of the opposer in an opposition.⁴⁵ That means that if the pleaded registration of the opposer covers goods *A*, *B*, and *C*, then the opposer is assumed to be using the mark on all those goods and selling the goods in all normal channels of trade to all normal purchasers. It does not do you any good to counter that by arguing the actual facts of the opposer's use to try to convince the TTAB that there is no likelihood of confusion. They are forbidden from considering that, and there are countless TTAB cases saying, "Too bad, sorry, it is irrelevant."⁴⁶ Similarly, if you are representing the applicant and your identification of goods covers goods *A*, *B*, and *C*, it does you no good to argue that you are only selling in certain narrow channels in certain unusual circumstances and that is why there is no likelihood of confusion. So the likelihood of confusion determination is, in large measure, theoretical.

There is a way to make it less theoretical, and that is by appropriately limiting your identification of goods to reflect some of these unusual circumstances that avoid confusion. You can do this under section 18 of the Lanham Act⁴⁷ and under Trademark Rule 2.133.⁴⁸ You also can partially cancel the opposer's registration to add a limitation on trade channels or delete goods that are not sold under the mark. In its case law, however, the TTAB has not warmly embraced the possibilities of these limitations under section 18. In short, it is easier for an opposer to win an opposition under this theoretical standard than it is for a plaintiff to win a lawsuit under the real-world likelihood-of-confusion test, which considers all of the circumstances involved with the use of the marks

court of competent jurisdiction to determine the likelihood of confusion in an opposition proceeding").

45. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 1582 (Fed. Cir. 1983) (reversing a TTAB decision to grant registration because the "applicant's trademark, as applied to applicant's goods, so resembles opposer's registered mark that it is likely to cause confusion and should, therefore, be refused registration").

46. See, e.g., *Jim Beam Brands Co. v. Beamish & Crawford Ltd.*, 937 F.2d 729 (2d Cir. 1991) ("Thus, even if comparison of defendant's label would indicate a greater dissimilarity in appearance of the parties' marks than did the typewritten registration name, this fact would be immaterial to the Federal Circuit's decision.").

47. 15 U.S.C.A. § 1608.

48. 37 C.F.R. § 2.133(b) (1997).

by both parties. That includes trade dress differences and the presence or absence of secondary marks.

I can give you an example of the way the marks of the parties are used from a real-life case, dimly remembered. I think there was a very tertiary mark on Vaseline labels, “Gold Label” or “Gold Seal,” and they successfully opposed an application for a similar “Gold” variant mark. If you looked at the labels of the two products, you would never think there was a likelihood of confusion. But, under the TTAB’s practice, the TTAB could not consider the fact that the opposer’s mark was used in a very non-prominent tertiary way. So the opposer won. This happens all the time.

The TTAB is also required by its case law to resolve doubt on section 2(d) of the Lanham Act⁴⁹ likelihood of confusion issues in favor of the opposer.⁵⁰ This rule arguably applies in infringement cases, but courts feel free to ignore it where they are not sufficiently convinced by the evidence.

The TTAB’s orientation is toward owners of prior rights. One can speculate on the reasons for this. Part of it may be that most of the members of the TTAB came up through the ranks as examining attorneys and are used to applying the standard that resolves doubts against applicants. So when you have a fairly strong case of likely confusion on its face, it is difficult to convince the TTAB that there is no likelihood of confusion.

Although third party use weakens a mark and makes confusion less likely in theory, the TTAB is generally skeptical about third-party use.⁵¹ If you are going to rely on a lot of third-party use, prove it to the hilt. That is an exception to the rule against over-litigation.

The TTAB is generally skeptical of technical challenges to an

49. 15 U.S.C.A. § 1052(d).

50. See *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470 (Fed. Cir. 1997).

51. See generally *Charrette Corp. v. Bowater Comm. Papers Inc.*, 13 U.S.P.Q. 2d 2040, 2044 (T.T.A.B. 1989) (“It has long been settled that third party evidence . . . is of no probative value in connection with a question of likelihood of confusion in the absence of evidence of actual use of those marks.”).

opposer's rights where the TTAB sees a pretty strong likelihood of confusion. The TTAB is not very receptive to laches defenses. There are a number of case law rules that discourage so-called equitable defenses. Equitable defenses are not supposed to be considered at all when there is a strong likelihood of confusion.

The clock does not start ticking on laches until the application is published. So if you are the applicant and you may have been using a mark for twenty years, then you get an application published, and a prior party opposes, the long term use is irrelevant.⁵²

To prove an abandonment defense⁵³ is difficult. It is rarely granted. Even weak marks are still protected.

If you remember these rules, you will focus your case where it needs to be focused. One thing that you can do is remember that the TTAB is looking for the quality of on-point evidence, not the quantity of repetitive evidence. This may be related to the fact that the evidence is in the form of deposition transcripts; you do not have to put on five witnesses in court and hope that the jury finds one of them credible. Paper is more credible than witnesses are.

I had a pretty plain vanilla likelihood of confusion case that I

52. See *National Cable Television Ass'n v. American Cable Editors, Inc.*, 937 F.2d 1572, 1580 (Fed. Cir. 1991) (criticizing the TTAB for assessing the merits of the laches defense from the date of knowledge of another's use of a mark, rather than from the date when a trademark application was filed). In *National Cable*, the court noted that:

Appellant was clearly under no duty to attack appellee's right to use the mark if it did not choose to do so, on penalty of being deprived of the right to oppose an application to register. It could not take the latter action, of course, until after appellee applied for registration and the application was published for the purpose of opposition.

Id.

53. See 15 U.S.C.A. § 1127. A mark shall be deemed "abandoned" if either of the following occurs:

- (1) When its use has been discontinued with intent not to resume such use.
- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.

Id.; see also *Silverman v. CBS Inc.*, 870 F.2d 40, 45-47 (2d Cir. 1989) (citing 15 U.S.C.A. § 1127).

was very proud of because I litigated it with only one witness. It was a cosmetics case. I put on the brand manager. The brand manager testified from personal knowledge how the products of the parties were related, how she was personally familiar with the fact that these twelve other companies on a list made product A, which was the opposer's product, and product B, which was the applicant's product, under the same trademarks. It is perfectly admissible, and it was enough. Sure, I could have put on six other witnesses to say the same thing, and I could have had an investigator go out and buy the products and testify that he went to this place and he went to that place and he bought the product. But it was not necessary. So this sort of lapidary precision is a good thing in the TTAB.

It also is not necessary to use all the time provided by the testimonial deposition procedure. The TTAB welcomes procedures that save the litigants money. If the litigants can agree, instead of filing a testimonial deposition for your evidence, you can file an affidavit for your evidence and give the other party the right to cross-examine. It is not necessary for you to fly across the country to attend and cross-examine at another party's testimonial deposition. If the other party will agree, you can cross-examine by telephone based on pre-marked exhibits. If the other party will agree, you can do a deposition by video-conferencing. There are a lot of ways to make the procedure of having everything on paper less burdensome.

The TTAB likes creativity in procedure if it saves everybody time and money. To get around this summary judgment prohibition—an effective prohibition in arguable cases—we recently made a stipulation with another party in an opposition to litigate the case on cross-motions for judgment on the pleadings. We filed a Notice of Opposition.⁵⁴ We learned that the other party was not

54. After a trademark application is approved, it is published in a weekly publication entitled the *Official Gazette of the U.S. Patent and Trademark Office*. Publication of the trademark enables anyone who believes he will be damaged by the registration of the mark to oppose the application by filing a Notice of Opposition. See JANE C. GINSBERG ET AL., *TRADEMARK AND UNFAIR COMPETITION LAW* 225 (2d ed. 1996). If the opposition

really disputing our facts, so I suggested to the other party that he just file an answer admitting to the facts, and we stipulated that we would just cross-move for motion for judgment on the pleadings. We made it very clear in the stipulation that the losing party, if he appealed, would not have the right to appeal on grounds that there were issues of fact, which is reversal insurance for the TTAB. Thus, with a cooperative adversary you can do a lot to make proceedings less protracted and less expensive.

On the other hand, if you have an abusive adversary, I am sorry to say that, as presently constituted, TTAB procedure gives an abusive adversary enormous scope to make your life miserable. There are no meaningful sanctions. There are no money sanctions. Lesser sanctions are rarely awarded, and only in the most egregious cases of repeated abuse. Thus there is tremendous scope for delay. You can extend almost any deadline by filing a motion, and the TTAB may say months later, "We do not grant the motion; but on the other hand, we are going to give you another thirty days to do what you have to do." The proposed Rules changes, if they are approved, are trying to cut back on that, but with what success I cannot speculate.

Also keep in mind that, because it is an administrative tribunal very closely hemmed in by precedent and statute, the TTAB is not the place to expect to win on arguments based on policy that seek to get around clear statutory language or overturn a higher court precedent. Make your arguments and make your record, but do not expect to win at the TTAB level. Maybe the CAFC will help you out.

An example of that—in a case that is much criticized—is *Clorox v. Chemical Bank*,⁵⁵ where a security transaction caused an intent-to-use application to be transferred without the accompanying business,⁵⁶ which is a violation of the literal language of section 10

is filed, a proceeding will be conducted before the TTAB. *See id.*

55. 40 U.S.P.Q. 2d 1098 (T.T.A.B. 1996).

56. *See id.* at 1104-05.

of the Lanham Act.⁵⁷ It invalidates the application. The TTAB, probably rightly, declined to look at the policy behind that and simply said, “Look, it is a statutory violation. We cannot help you.”⁵⁸ The message was, “Take it up on appeal and maybe you will do better.” That happens quite a bit.

On *ex parte* appeals, my advice—apart from make your record, which is essential—is use all available procedural ways to make the record complete and helpful. Well, after you get a final refusal, you have an opportunity under the Rules to file a request for reconsideration.⁵⁹ You can dump into the record at that time all the good evidence you want for the appeal. Do not forget to do that. It is possible to re-open the record after you file an appeal, but difficult.

It is also possible to delay the hearing on an appeal, waiting for contingent events that will help you. If you think, for example, that you are going to get a consent from somebody, the owner of a blocking mark, but you need time to negotiate it, do not tear out your hair. Instead, file a motion to suspend the appeal.⁶⁰ The TTAB will grant it, and then you can try to get your consent.

On the merits of inherent registrability issues, the TTAB is moving back to the old rule that a rare surname is not really a surname, hence you can get it registered. It might take a few more cases to get there, but that seems to be the trend. You can go a long way on inherent registrability objections by putting in a lot of evidence about how ambiguous the mark is. For example, you can argue that the mark is not primarily a surname or is not primarily geographic because it has many possible meanings. On borderline descriptiveness/suggestiveness cases, take your appeal. You have a shot.

I have used up my fifteen minutes. Thank you very much.

57. 15 U.S.C. § 1060 (1994).

58. *See id.*

59. *See id.*

60. *See Midland Cooperatives, Inc. v. Midland Int'l, Corp.*, 421 F.2d 754 (C.C.P.A. 1970).

MR. SLOANE: Thank you, David.

We will now take a short question-and-answer session.

QUESTIONER: I have a question for our former examining attorneys. Are the examining attorneys docked points when an application is kicked back after being passed on to publication? You were talking about they get two points for passing it on to publication. If it gets kicked back because of an error, are they docked two points?

MR. FRIEDMAN: Yes, the points are taken back, and then when it is re-published they get the points back, which can be important. They are actually given reports as to how they are doing on a biweekly basis. So it can make a difference to them if something gets kicked back. I mean, if you get a bunch kicked back, then all of a sudden you have a lot fewer points. I used to focus on how many points I made every two weeks. If all of a sudden I do not have as many, I need more in the next biweekly cycle. But the answer to your question is yes, they take it back.

MS. MIRMAN: Richard was very good at calculating these things biweekly. I was okay. But you should see that office at the end of the fiscal year. During September people stay until eleven o'clock at night and come in on weekends to make up points. I am sure a lot of you could testify that in September you start getting a whole bunch of office actions at a far greater volume than you were all year.

MR. FRIEDMAN: And more phone calls because, like I said, they get points for making phone calls. So all of a sudden, even though you have never heard from an examining attorney all year, in September you receive phone calls every day.

QUESTIONER: On the same sort of idea, a lot of times I put preliminary limits in my cover letter when I file an application. But a lot of times I get calls about it anyway. Is there some way to put it into the record, better than putting it in the cover letter, so that it will get noticed?

MR. FRIEDMAN: The answer is do not put anything of any importance in the cover letter because the people who look at the

application before the examining attorneys are what are called R&A clerks—I think that is what they are called—and they are not attorneys. Their whole job is to put data into the computer and to identify material in the application. The bottom line is, they do not look at the cover letter. And, oftentimes, the cover letter gets stuffed in the back of the file and the examining attorney does not see it. So if you are putting a disclaimer in or if you are putting other information in, just stick it right in the application because then it should get picked up.

QUESTIONER: But if the applicant has already signed it, I cannot really add anything to the application?

MR. FRIEDMAN: Well, you should have it in there. It should be part of your application papers before the signature. I mean, just put in a separate paragraph for the disclaimer, or if there is a question as to the entity type, or if the person was authorized to sign it. If it is in the application papers, there is a ninety percent chance that the examining attorney will see it, whereas, like I said, the cover letter is usually lost.

MR. SLOANE: Are there any other questions?

QUESTIONER: This is a question for the former examiners.

MS. MIRMAN: Examining attorneys.

QUESTIONER: How does the examining attorney know that something is descriptive without the applicant telling the examining attorney? Applicants don't need to identify their marks as descriptive or generic. Do you use some sort of a red flag?

MS. MIRMAN: Examining attorneys use Lexis-Nexis searches to assist with the likelihood of confusion problem and to help determine whether a mark is descriptive or generic. I think, based upon the identification of goods and what the mark is, it is either obvious, because generic is generic, or the examining attorney will search Lexis-Nexis to determine if the trademark is a term of art in that field of goods and look for dictionary evidence. The applicant must make a good-faith statement but does not have to state, "Oh, I realize this is descriptive." There is no kind of duty like that.

QUESTIONER: Are examining attorneys required to conduct an inquiry before deciding that something is generic?

MR. FRIEDMAN: It is a good question. The answer is no. When I was there, I worked in the Food & Beverages category, so it was not that difficult. If the mark had the word "cracker" in it, I was pretty sure it was generic for crackers. But you make a good point, because if someone has a word that looks completely arbitrary and he or she does not go to Lexis-Nexis or does not check a dictionary, then that person really is not doing his job. He should check it out, but sometimes things slip through.

I should say that there is an obligation on the examining attorney to at least inquire and ask the applicant, "Does this have any meaning in the trade?" If the applicant says, "No," but the mark in fact does have a special meaning in the trade, which the applicant knew of, arguably there is an action, if someone was opposing based on descriptiveness, for fraud on the PTO.

MS. MIRMAN: I would like to add that, the senior attorney usually, upon review of what gets published, looks in the record and asks, "Does this mean anything? Did you bother to ask?" Typically, if the examining attorney did ask the applicant, the examining attorney would have written a note in the file stating, "I asked on such-and-such a date if it had any meaning." Sometimes that is put right in the examiner's amendment. The examining attorney will say, "This mark has no other meaning than trademark significance."

MR. SLOANE: Unfortunately, we are out of time. I would like to thank our distinguished panelists. I think they did a tremendous job. Thank you.