Overview of TTAB Oppositions

The following is a brief overview of U.S. trademark opposition proceedings. Oppositions before the Trademark Trial and Appeal Board ("TTAB" or "Board"), the judicial arm of the U.S. Patent and Trademark Office, are somewhat similar to a civil action in court. The party opposing registration ("Opposer") of a trademark application files a Notice of Opposition—analogous to a complaint—stating the bases for its opposition.[1] The Opposer must serve a copy of the opposition on the owner of the application ("Applicant") or its representative. Once filed and served, the TTAB issues an "institution order" to both parties detailing the discovery and trial schedule for the action along with the due date for the Answer. Applicant's Answer is due 40 days from the date of the institution order. The Answer is usually a short, plain denial of the allegations in the Notice of Opposition, sometimes followed by affirmative defenses. In some cases, Applicant may counterclaim to seek cancellation of the Opposer's registration(s).

The deadline for a discovery/settlement conference is 30 days from the date the Answer is due. The requirements for this discovery/disclosure conference are identified by Federal Rule Civil Procedure 26(f). The topics that the parties must discuss include: (i) settlement; (ii) modifications to the discovery/trial calendar; (iii) stipulation for declaration versus deposition testimony; (iv) expert testimony and scheduling; (v) preservation of discoverable information; (vi) development of a discovery plan; (vii) any issues about electronically stored information including form of document production proposed; and (viii) any changes to the TTAB's Standard Protective Order. The parties do not file the disclosure or discovery plan with the TTAB.

The parties are obligated to serve Initial Disclosures under FRCP 26(a)(1)(A) - (B) before they can serve any discovery requests. The deadline for making initial Disclosures is 30 days from the opening of the discovery period. Initial disclosures include: (i) the name, address, and telephone number of each individual likely to have discoverable information that the disclosing party may use in support of its claims or defenses; (ii) a description by category and location of all documents, electronically stored information, and tangible things that are in possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses. There is no obligation to disclose the name of every witness, document, or thing.[2]

The discovery period also opens 30 days after the Answer is filed. A party may not seek discovery until after it has made its Initial Disclosures. As in a federal court action, the discovery stage is the time during which each party asks the other questions about its case, demands production of documents and other evidence relevant to the claims and defenses of the opposition, and deposes witnesses. The discovery devices available in a civil action are all available in an opposition (e.g., document requests, interrogatories, requests for admissions, and depositions), and discovery in oppositions is governed by the Federal Rules of Civil Procedure unless modified by the Board rules. For example, the Board allows 75 interrogatories including subparts whereas the Federal Rules allow only 25. The Board provides a total of 180 days for the discovery period, which can be extended by agreement among counsel or motion granted by the Board. Unlike some courts, the Board will generally grant stipulated requests to extend discovery, even repeated requests. The motions available in a civil action are generally available in an opposition (e.g., motions to dismiss, motions to compel, motions for summary judgment).

Another difference between discovery in Board cases and civil actions is that depositions of foreign parties or their representatives may be taken only upon written questions unless: (1) the parties stipulate to an oral deposition, or (2) by order of the Board upon motion of the party seeking the oral deposition and a showing of good cause. It is generally difficult to obtain such a good-cause order. An example of where the Board found good cause is when a foreign applicant moved for summary judgment and submitted an affidavit of one of its officers. Under those circumstances, the Board held it would be unjust to deprive the Opposer of the opportunity to confront the witness by oral deposition. However, if the foreign party

or its representatives will be in the U.S. during the discovery period, they may be deposed by notice.[3]

The deadline for disclosure of expert testimony (namely, identification of experts who will testify at trial) is 30 days prior to the close of discovery (90 days prior to the opening of the Opposer's testimony period). FRCP 26(a)(2) governs the manner and sequence of disclosure of expert witnesses. If a party plans to use an expert solely to contradict or rebut the other party's expert, then disclosure is required within 30 days of the adverse party's disclosure. Any party disclosing plans to use an expert must notify the Board, following which the Board may suspend proceedings to allow for discovery limited to experts.

The Opposer's pretrial disclosures are due 15 days prior to the opening of each of its testimony periods. Specifically, each party must disclose the identity of witnesses from whom it intends to take testimony along with a general summary or list of subjects as to which each witness is expected to testify, and a general summary or list of the types of documents and things that may be introduced during the testimony of the witness.

The major difference between an opposition and a civil action is that the Board does not sit for a live trial. Instead, an opposition trial is conducted through "testimony periods" as follows: (1) the Opposer has a 30-day testimony period in which to submit its trial evidence; (2) the Applicant then has a 30-day testimony period to submit its evidence; and (3) the Opposer has a 15-day testimony period to submit rebuttal evidence.

Trial evidence generally takes two forms. First, a party may depose its own witness(es) during its respective testimony periods and introduce documents through the witness(es), i.e., the equivalent of direct testimony in a civil action trial. The adverse party has the opportunity to attend the deposition(s) and cross-examine the witness(es) much like in a civil action. To save resources, the parties can stipulate to submitting testimony by declarations (with or without the opportunity for cross examination). Parties can also depose the other party's witnesses or third parties during its own testimony period, but only through a subpoena issued by a district court (unless the other party consents to the deposition by notice).

Second, the parties can submit certain types of documentary evidence during their respective testimony periods through a "Notice of Reliance," a short paper identifying the evidence and briefly describing its relevance to the opposition. The types of documentary evidence that can be submitted through a Notice of Reliance include discovery depositions of an adversary's witnesses, the adversary's responses to interrogatories, document requests, and requests for admission, certain types of printed publications (e.g., books, newspaper and magazine articles, and dictionary entries), and official records such as court or Board decisions and third-party trademark registrations.

After the completion of the testimony periods and the parties' filing of their trial evidence with the Board, the next stage is trial briefing of the case. The trial brief is a party's opportunity to present a summary of the evidence of record, a discussion of the facts in light of the law, and its strongest arguments in support of its case. The Opposer files its main brief within 60 days after the close of its rebuttal testimony period, and the Applicant files its main brief within 30 days after Opposer's filing date. These main briefs have a 55-page limit. The Opposer's reply brief, which has a 15-page limit, is due 15 days after Applicant files its main brief.

The Board will decide the case based on the written record, i.e., the trial evidence submitted by the parties and the parties' trial briefs. However, either party may request an oral hearing before a panel of three Administrative Trademark Judges, who will decide the case. The oral argument before the Board is like an appellate argument. Each party has only 30 minutes. Opposer's counsel argues first and may reserve a portion of her time for rebuttal; Applicant's counsel argues second; and Opposer's counsel argues last if any time was saved for rebuttal. It typically takes the Board three to six months to issue a written decision.

Once the Board issues a final decision (on motion or after trial), the losing party has the right to file a request for reconsideration within one month of the Board's decision. The losing party also has the right to file an appeal of the

Board's final decision to either the U.S. Court of Appeals for the Federal Circuit (for a "traditional" appeal) or to a U.S. District Court (for a de novo review in which the parties can introduce new evidence and assert claims and counterclaims for infringement, dilution, etc.) within two months from the date of the final decision or within two months from the date of the Board's ruling on any request for reconsideration.

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[1] Proceedings before the TTAB to cancel a registration are essentially identical to oppositions. The main difference is that the proceeding is initiated with a Petition to Cancel instead of a Notice of Opposition, and the parties are referred to as the "Petitioner" and "Respondent" instead of "Opposer" and "Applicant."

[2] In its recent decision in *In-N-Out Burger, Inc. v. BB&R Spirits Ltd.*, Opposition No. 92048909 (TTAB July 21, 2008), the Board indicated that Initial Disclosures in TTAB actions must be sufficiently detailed and specific to address each of the parties' claims and defenses, as well as each of the individual factors that are used to evaluate each claim and defense. In dicta, the Board stated that Initial Disclosures must reflect a party's plans for defending the action at trial and suggested that "[t]he most efficient means of making initial disclosures is to actually exchange copies of disclosed documents, rather than merely identifying their location."

[3] There is a recent Fourth Circuit decision allowing the testimonial deposition of a foreign applicant by subpoena in an opposition. *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd*., 511 F.3d 437 (4th Cir. 2007). But this case may be limited to its particular set of facts and procedural history. The district court in the case (E.D. Va.) had issued two separate orders regarding the subpoena at issue. In the first, the district court determined that the subpoena was valid by denying the responding party's motion to quash. In the second, the district court refused to compel the appearance of the responding foreign party, because the court determined that the term "witness" in 35 USC § 24 only applied to natural persons. Because the responding party did not file a cross-appeal, the only issue on appeal was whether a corporation could qualify as a "witness" under 35 USC §24. Also important in this case was the fact that the trademark Applicant's attorney for its application was located in Virginia. The opposer served the subpoena on the applicant's attorney, as a person located in the district.