



TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE

**TRADEMARK TRIAL
AND
APPEAL BOARD
MANUAL OF
PROCEDURE
(TBMP)**

June 2014

United States Patent and Trademark Office

United States Patent and Trademark Office
PREFACE TO THE JUNE 2014 REVISION

This June 2014 revision incorporates amendments to the Trademark Act, the Trademark Rules of Practice, and the Federal Rules, where applicable, and further updates references to Board, Federal Circuit and other federal court cases. Content additions and revisions reflect the evolution and refinement of Board practice as experienced and articulated between March 1, 2013 and February 28, 2014.

The title of the manual is abbreviated as “TBMP.” A citation to a section of the manual may be written as “TBMP § ____ (2014).”

As with previous editions, this edition is available online at the Board home page of the USPTO web site in a searchable, printable format. A link to archived editions of the TBMP is also available at the Board’s home page.

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INTRODUCTION

The primary purpose of this manual is to provide stakeholders with basic information generally useful for litigating trial cases before the Trademark Trial and Appeal Board. The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board, its reviewing tribunals, the Director, or the USPTO. *Cf., In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989). Rather, the manual describes current practice and procedure under the applicable authority and incorporates amendments to the Trademark Rules of Practice, Trademark Act and Federal Rules, and updates in case law, where applicable, as of February 28, 2014. The guidelines set forth in the manual do not have the force and effect of law. They have been developed as a matter of internal office management and are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the office.

The manual is devoted primarily to opposition and cancellation proceedings, the two most common types of inter partes proceedings before the Board. Nonetheless, the manual includes a chapter of general information useful for all proceedings and chapters on interference proceedings, concurrent use proceedings, and ex parte appeals to the Board.

The manual will be updated periodically.

The Board welcomes suggestions for improving the content of the manual. Suggestions and comments should be addressed as follows:

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The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. [Note 1.] The Board's determination of registrability does not require in every instance decision on every pleaded claim, and the Board uses its discretion to decide only those claims necessary to enter judgment and dispose of the case. [Note 2.]

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. [Note 3.]

Similarly, the Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional. [Note 4.]

NOTES:

1. Trademark Act § 17, Trademark Act § 18, Trademark Act § 20, Trademark Act § 24, 15 U.S.C. § 1067, 15 U.S.C. § 1068, 15 U.S.C. § 1070, 15 U.S.C. § 1092.

2. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

3. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (quoting TBMP); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 300 F.3d 1333, 66 USPQ2d 1811, 1819-20 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws), *aff'd* 62 USPQ2d 1857, 1858 (TTAB 2002); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *Board of Trustees of University of Alabama v. Pitts*, 107 USPQ2d 2001, 2022 (TTAB 2013) (no jurisdiction to consider questions of infringement or unfair competition); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) ("[T]he Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings."), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den'd*, 552 U.S. 1109 (2008); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149, 1151-52 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer's claim that applicant neither owns nor is entitled to use mark was not separable from opposer's copyright claim); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Kelly Services Inc. v. Greene's Temps. Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431,

432 n.5 (TTAB 1985) (may not entertain any claim based on Trademark Act § 43(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Trademark Act § 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board's authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction); *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1326 (TTAB 2007) (Board has jurisdiction over assertion of priority under Article 7 of the Pan American Convention because it pertains expressly to the registrability of marks and priority rights based on use); *M-5 Steel Manufacturing Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1094-95 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Trademark Act § 43(c) in opposition and cancellation proceedings); *British-American Tobacco Co. v. Philip Morris Inc.*, 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board because it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

See also The Scotch Whiskey Association v. United States Distilled Products Co., 13 USPQ2d 1711, 1715 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240, 1243 (TTAB 1990) (Board cannot consider claims of unfair competition standing alone, but can consider such claims in determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation), *dismissed*, 18 USPQ2d 1391, 1394 (TTAB 1991) (where petitioner did not plead a separate ground on which to base the petition to cancel, petitioner's claims under Articles 10 and 10bis of the Paris Convention could not be considered), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

4. *In re District of Columbia*, 101 USPQ2d 1588, 1602 (TTAB 2012) (no authority to declare provisions of the Trademark Act unconstitutional), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (no authority to rule on the constitutionality of the Trademark Act on its face or as applied); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) (no authority to declare provisions of the Trademark Act unconstitutional nor to determine whether Trademark Act § 2(a) is overbroad or vague), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003); *Zirco Corp. v. American Tel. and Tel. Co.*, 21 USPQ2d 1542,

1544 (TTAB 1991) (no jurisdiction to determine whether Trademark Act § 7(c), the constructive use provision, violates the commerce clause of the constitution); *Hawaiian Host, Inc. v. Rowntree MacKintosh PLC*, 225 USPQ 628, 630 (TTAB 1985) (no authority to declare Trademark Act § 44(e) unconstitutional); *Electric Storage Battery Co. v. Mine Safety Appliances Co.*, 143 USPQ 163, 167 (TTAB 1964) (no authority to find Trademark Act § 23 unconstitutional). *Cf. Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (no authority to determine whether private activities rendered to members of private club constitute “commerce”).

102.02 Types of Board Proceedings

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration, in whole or in part, of a mark on the Principal Register. “Any person who believes that he would be damaged by the registration of a mark” may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, in the Official Gazette of the United States Patent and Trademark Office. [Note 1.] See TBMP § 303 (Who May Oppose or Petition to Cancel).

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration, in whole or in part, of a trademark on the Principal Register or the Supplemental Register. A petition for cancellation may only be filed after the issuance of the registration. A petition for cancellation may be filed by “any person who believes that he is or will be damaged by the registration” of the mark. [Note 2.] See TBMP § 303 (Who May Oppose or Petition to Cancel).

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict), is entitled to registration. [Note 3.] The proceeding is declared by the Office only upon petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference. [Note 4.] See TBMP § 1002 (Declaration of Interference). Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. [Note 5.] An interference that has been declared by the Director is not instituted by the Board until after all of the marks that are to be involved in the proceeding have been published in the Official Gazette for opposition. See TBMP § 1003. For further information, see TBMP Chapter 1000 (Interferences).

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration on the Principal Register, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers). See TBMP § 1101.01. The proceeding may be initiated only through the filing of an application for

2. See, e.g., *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).
3. 37 CFR § 2.127(e)(1). See e.g., *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had not yet made and served initial disclosures). See also *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (“Because the Board does not allow a party to file a motion for summary judgment prior to the moving party's service of initial disclosures on the adverse party, the Board generally will no longer exercise its discretion to convert motions to dismiss that refer to matters outside the pleadings into motions for summary judgment, if such motions are filed before the moving party serves its initial disclosures.”).
4. *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010). But see *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).
5. 37 CFR § 2.120(a)(3) (“a party must make its initial disclosures prior to seeking discovery”). See *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to compel denied where moving party failed to make initial disclosures).

402 Scope of Discovery

402.01 In General

Fed. R. Civ. P. 26(b)(1) Scope in General. Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense — including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons who know of any discoverable matter. For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action. Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. All discovery is subject to the limitations imposed by Rule 26(b)(2)(C).

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

(1) Signature Required; Effect of Signature. Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name — or by the party personally, if unrepresented — and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:

- (A) with respect to a disclosure, it is complete and correct as of the time it is made; and
- (B) with respect to a discovery request, response, or objection, it is:

(i) consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;

(ii) not interposed for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation; and

(iii) neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.

(2) Failure to Sign. *Other parties have no duty to act on an unsigned disclosure, request, response, or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is called to the attorney's or party's attention.*

The general scope of discovery that may be obtained in inter partes proceedings before the Board is governed by Fed. R. Civ. P. 26(b)(1), which provides, in part, as follows: [Note 1.]

Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense -- including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons having knowledge of any discoverable matter. ... Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.

A party may take discovery not only as to matters specifically raised in the pleadings, [Note 2] but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. [Note 3.] While the scope of discovery is therefore somewhat broad, parties may not engage in “fishing expeditions” and must act reasonably in framing discovery requests. [Note 4.] The parties are expected to take into account the principles of proportionality with regard to certain types of discovery. [Note 5.] The scope of discovery in Board proceedings, though, is generally narrower than in court proceedings, especially those involving infringement and/or where both parties have made extensive use of the marks. [Note 6.] The guidelines set forth in Fed. R. Civ. P. 26(a)(1) also apply to the discovery of information stored in digital or electronic form. A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way. [Note 7.] However, parties are free to discuss agreed limits on discovery as a means of reducing the time and cost associated with discovery. [Note 8.]

Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. [Note 9.]

In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of Fed. R. Civ. P. 26(g), a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request

for discovery is proper when propounded by the party itself but improper when propounded by its adversary. [Note 10.] A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. [Note 11.] For a further discussion regarding discovery guidelines, see TBMP § 408.01 and TBMP § 414.

For a discussion of the scope of required disclosures intended to obviate the need for some basic discovery, see TBMP § 401.

NOTES:

1. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (“[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence.”). See also *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 856-66 (TTAB 1979); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (relevancy construed liberally).
2. See *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (discussing general scope of discovery); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition).
3. See *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information concerning possible abandonment, if revealed, may provide basis for counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (the mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, cannot be construed as a collateral attack on the registration); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) (“applicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for an affirmative defense or for a counterclaim.”).
4. Fed. R. Civ. P. 26(b). See *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987).
5. See, e.g., *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (discussing principles of proportionality with respect to requests for admissions); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908-10 (TTAB 2011) (Board applied proportionality principles to electronically- stored information).
6. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011).
7. See *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (scope of discovery limited only by restrictions in Fed. R. Civ. P. 26).

8. 37 CFR § 2.120(a)(2) (“[t]he parties may stipulate to a shortening of the discovery period.”).
9. Fed. R. Civ. P. 26(g). *See The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (parties are entitled to seek discovery as they may deem necessary to help them prepare for trial, but it is not the practice of the Board to permit unlimited discovery to the point of harassment and oppressiveness); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (“each party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case.”); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984). *Cf. Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (opposer's failure “to conduct an attorney-supervised ESI retrieval, research and review” does not necessarily mean the discovery efforts were inadequate under the circumstances).
10. *See* Fed. R. Civ. P. 26(g). *See also Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (petitioner estopped to challenge respondent's interrogatories as excessive in number having served virtually identical set on respondent); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties who served identical discovery requests on each other in effect waived their right to object and must answer each request completely). *See also Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (applicant, having served 114 interrogatories, is estopped from challenging opposer's 122 interrogatories as excessive); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 623 (TTAB 1974); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477 (TTAB 1974). *Cf. Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (no estoppel where opposer served a different, albeit also excessive, set of interrogatories on applicant); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990) (opposer not estopped from arguing that applicant's interrogatories are excessive even though opposer also exceeded the limit because applicant waived its rights to complain because it did not file a motion for a protective order).
11. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (Board was persuaded that certain interrogatories would be burdensome).

402.02 Limitations on Right to Discovery and on Electronically Stored Information

Fed. R. Civ. P. 26(b)(2)(A) When Permitted. By order, the court may alter the limits in these rules on the number of depositions and interrogatories or on the length of depositions under Rule 30. By order or local rule, the court may also limit the number of requests under Rule 36.

Fed. R. Civ. P. 26(b)(2)(B) Specific Limitations on Electronically Stored Information. A party need not provide discovery of electronically stored information from sources that the party identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the party from whom discovery is sought must show that the information is not reasonably accessible because of undue burden or cost. If that showing is

parties stipulate or otherwise treat the evidence as being of record, *see* TBMP § 702.02.

For a further discussion regarding viewing and obtaining Board records, *see* TBMP § 121.

If the parties to a proceeding desire to obtain a final resolution of a proceeding prior to the scheduled trial period, they may consider Accelerated Case Resolution (“ACR”). For information on ACR, *see* TBMP § 528.05(a)(2), TBMP § 702.04 and TBMP § 705.

NOTES:

1. *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). For a discussion concerning the general nature of trials in proceedings before the Board, *see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 428, *recon. denied*, 190 USPQ 431 (TTAB 1976).

2. *See* 37 CFR § 2.191.

3. *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976).

4. *See* 37 CFR § 2.123(c).

5. *See* 37 CFR § 2.129(a).

6. *See* 37 CFR § 2.123(l).

702.04 Accelerated Case Resolution

702.04(a) In General

Accelerated Case Resolution (“ACR”) is an alternative to typical Board inter partes proceedings with full discovery, trial and briefing, in which parties to a Board proceeding can obtain a determination of the claims and defenses in their case in a shorter time period than contemplated in the typical Board proceeding. The form of ACR can vary, but the process generally approximates a summary bench trial or cross-motions for summary judgment and accompanying evidentiary submissions that the parties agree to submit in lieu of creating a traditional trial record [Note 1] and traditional briefs at final hearing. Other approaches to accelerating resolution of a case include simplifying proceedings through the use of fact stipulations and stipulations regarding the admissibility of certain evidence. [Note 2.] Oral hearings generally are available in ACR cases in accordance with 37 CFR § 2.129(a). *See* TBMP § 802. If parties agree to conduct the case as an ACR case and to utilize the bench trial or cross-motions for summary judgment model, and the Board approves trial of the case by ACR, the Board generally will render a final decision within fifty (50) days following the completion of briefing.

By reducing the complexity of a case and total time expended in litigating a case, ACR is a more efficient and economical alternative to the typical Board inter partes proceeding. Not all Board cases involve complicated or disputed facts or require the full discovery and trial periods set out by the Trademark Rules, to arrive at a final determination. Parties may thereby save time and expense by focusing only on those issues genuinely in dispute, and opting for ACR early in the proceeding. For example, if the parties stipulate to facts, no time need be spent proving those facts (although there may be some typical costs involved in preparing and exchanging documents and other materials that illustrate for the involved parties that facts are not genuinely in dispute and therefore can be stipulated). When the issues in a proceeding are limited, savings can be even greater, because all aspects of the proceeding, including discovery, trial and briefing, are focused on such limited matters.

The Board is willing to consider almost any claim under ACR unless the complexity or novelty of the facts and/or legal theory of the case requires a full trial. However, the most appropriate cases for ACR are those in which, for example, little discovery is necessary, the parties are able to stipulate to many facts, each party expects to rely on the testimony of one or two witnesses, or the overall record will not be extensive. [Note 3.] ACR may not be suited to cases that generate a large record, complicated factual or legal issues, or cases where the parties are unwilling to stipulate to any matters (i.e., limitations on discovery or trial schedules, the absence of any genuine dispute about particular facts, or entry of evidence into the record).

ACR presently can be implemented only by consent of the parties and agreement by a Board attorney or judge, and will not be approved by unilateral motion of one party. ACR can also be implemented by all parties accepting an invitation or suggestion from a Board attorney or judge to participate in the process. [Note 4.] The parties are required to discuss the possibility of using ACR in their discovery conference and may seek the assistance of the Board in structuring their case so that it qualifies for ACR and the Board's commitment to render a decision within fifty days from the completion of briefing. [Note 5.]

Parties seeking to optimize their chances for early determination of their case and savings in their resources are advised to opt for ACR early in the proceeding. To opt for ACR, the parties may jointly file a statement indicating their desire to proceed under ACR along with a proposed modified schedule which may include an abbreviated discovery period and/or briefing period under any form of ACR. The assigned attorney may, and likely will, then convene a conference by telephone to discuss the proceeding with the parties and explore how they wish to proceed under ACR. The parties may seek Board assistance when contemplating ACR to determine which form of ACR to follow and/or determine the discovery, trial and briefing schedule. Any modified discovery, trial and briefing schedule, including limits on discovery or discovery devices or trial, must be negotiated by the parties and approved by the Board. If, however, the parties choose to follow the traditional discovery and trial schedule, but merely wish to stipulate to particular facts or that particular items of evidence shall be considered by the Board, they may so agree and file their written agreement with the Board without need of a conference with a Board attorney. While this approach yields efficiency and savings, since prescribed discovery procedures and discovery and trial schedules are unchanged, a conference with a Board attorney typically would not be necessary.

The parties may limit discovery in a number of ways. For example, parties may limit the number of interrogatories, requests for production and requests for admissions as well as the number and duration of discovery depositions. They may exchange more extensive disclosures in lieu of formal discovery, or stipulate to facts and the exchange of certain documents, or propound interrogatory requests only on particular issues. If the parties are unable to agree on discovery limits, they will not have optimized any cost and time savings available through ACR. When discovery devices (e.g., number of depositions, document requests, or interrogatory requests) are limited, practice is necessarily more focused and cost efficient.

Parties which agree to conduct the proceeding under ACR and which have stipulated to limited discovery may still take testimonial depositions. By limiting the number or duration of testimonial depositions, they may realize additional savings in cost and time. They may also agree to use discovery depositions at trial or to introduce testimony by affidavit or declaration, with the non-offering party reserving the right to cross-examine the witness in a later testimonial deposition.

The standards of proof in an ACR proceeding are the same as the standards of proof in a traditional Board proceeding. In either an opposition or cancellation, the burden of proof remains with the plaintiff, who must establish its case by a preponderance of the evidence. [Note 6.]

A final decision rendered under ACR may be appealed in the same manner and under the same time frames as non-ACR decisions by the Board. [Note 7.]

Standard options for ACR are available on the Board's home page at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Such options include several possible ACR schedules suggested by the Board and options proposed by stakeholders. **Please Note:** some options do not allow for an oral argument.

The Board maintains a list of cases in which ACR has been used or other efficiencies have been agreed to, such as stipulations of fact, at http://www.uspto.gov/trademarks/process/appeal/acrcase_list.doc. Parties may review these cases in developing an ACR strategy.

NOTES:

1. See, e.g., *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1827-28 (TTAB 2012); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986). See also *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 47 USPQ2d 1953, 1954-55 (2d Cir. 1998).
2. See, e.g., *Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 (TTAB 2013) (parties stipulated under ACR that they could rely on the materials submitted in support of and against opposer's previously filed motion for summary judgment, that testimony could be submitted by declaration, that pretrial disclosures were not required, and that all evidence may be submitted through declarations or notices of reliance); *Edom Laboratories Inc.*

v. Lichter, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to the entire record: 13 paragraphs of facts, including applicant's dates of first use, channels of trade for applicant, extent and manner of applicant's use, recognition by others of applicant's use, as well as the dates, nature and extent of descriptive use by the opposer's parent company; the admissibility of business records, government documents, marketing materials and Internet printouts and to forgo trial).

3. See *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1828 (TTAB 2012); *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1226 n.9 (TTAB 2008) (on final decision noting that the "case would have been a good candidate for accelerated case resolution" because "there is no dispute about the operative facts; rather, the parties disagree about what the facts mean").

4. *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1634 n.6 (TTAB 2009) (in granting partial summary judgment, the Board suggested the parties may seek to use ACR on the remaining disputed issues without the need for a formal trial).

5. See *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829-30 n.9 (TTAB 2012) (although the parties crafted and proceeded with their own ACR approach, better practice is to contact the assigned Board attorney when the parties elect to pursue ACR); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

6. *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979).

7. See 37 CFR § 2.145.

702.04(b) ACR using Summary Judgment Briefs

For a case prosecuted on the summary judgment model of ACR, the trial and briefing periods occur in one phase; the summary judgment briefs and accompanying evidentiary submissions encompass both the trial and briefing periods. Because the parties have, in essence, agreed to create the record for the case by their summary judgment submissions, testimony will be presented by affidavit or declaration, and any exhibits referenced by the affiants or declarants.

In addition to filing summary judgment briefs, the parties should file a joint stipulation of undisputed facts, and, as attachments or exhibits to their briefs, any materials that, in a typical trial, could be submitted by notice of reliance (the notice of reliance itself need not be filed). The parties are free to enter into other stipulations regarding the submission of evidence. For example, they may agree that documents and things produced in response to requests for production may be submitted as exhibits without the need for accompanying testimony. The stipulations regarding the submission of evidence remove any question about the admissibility of the evidence, but the parties may reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality, or the weight to be accorded particular items of evidence. A party may not raise objections to the admissibility of evidence that it has

stipulated into the record. [Note 1.]

ACR summary judgment briefs may be presented either as cross motions for summary judgment or as a single motion for summary judgment. If the parties stipulate to ACR and file cross motions for summary judgment, each party is entitled to file a response to the other's motion and a reply in support of its own motion. [Note 2.] If the parties stipulate to ACR and the summary judgment motion is in the form of a single motion by plaintiff, then defendant may file a brief in response and only plaintiff is entitled to file a reply. [Note 3.] In the absence of a stipulation to the contrary, the parties are limited to 25 pages for the ACR summary judgment briefs, inclusive of table of contents and cases, index of cases, description of the record, statement of the issues, recitation of facts, argument and summary. [Note 4.] Reply briefs are limited to 10 pages unless otherwise stipulated [Note 5] and arguments should be restricted to rebuttal of the adverse party's case in chief.

In using the summary judgment form of ACR, the parties must provide a stipulation that the Board may resolve any genuine issues of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing.

If the parties decide early in the case to use the ACR motion for summary judgment model, they should file a stipulation with the Board selecting the ACR summary judgment model and setting forth the negotiated schedule for discovery and any limitation on discovery, submission of stipulations, and briefing. [Note 6.]

For more information regarding ACR motions for summary judgment, see TBMP § 528.05(a)(2).

NOTES:

1. *See Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating to introduction of affidavit and its exhibits into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit). *aff'd* on other grounds, *Creative Arts by Calloway, LLC v. Brooks*, Civ. No. 7:09 10488 (SDNY December 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013).
2. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1).
3. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1).
4. 37 CFR § 2.127(a). *But see Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement provided that "the page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b).").
5. 37 CFR § 2.127(a). *But see Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement provided that "the page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b).").

6. See e.g., *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (pursuant to their ACR stipulation, parties agreed to forgo discovery and reliance on expert testimony).

702.04(c) ACR Conversion - Summary Judgment Briefs

In circumstances where the parties have already filed summary judgment briefs, the Board may, in appropriate cases, invite the parties to agree to the Board's treatment of the summary judgment briefs and evidence as the final records and briefs. Alternatively, the parties may stipulate to treating the summary judgment briefs and evidence as the record and final briefs on the case, even in the absence of an invitation to do so extended by the Board. [Note 1.]

In either case, the parties must stipulate that the Board may resolve any genuine issues of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing.

For more information regarding ACR motions for summary judgment, see TBMP § 528.05(a)(2).

NOTES:

1. See, e.g., *Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002) (parties stipulated that case would be decided on petitioner's motion for summary judgment and respondent's response); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986) (parties stipulated that cross motions for summary judgment would be treated as testimony, evidence and briefs at final hearing).

702.04(d) ACR using Stipulated Record and Trial Briefs

Under the stipulated record and trial briefs ACR model, the case proceeds to final decision on an evidentiary record that has been stipulated to, in whole or in substantial part. Thus, the parties must be prepared to stipulate to the admissibility of most of the record. They may, however, reserve the right to object in trial briefs on substantive grounds to particular evidence such as on the grounds of competency, relevancy or materiality. Testimony periods may not be needed for cases prosecuted on the stipulated record model (with or without stipulated facts), if the evidentiary record has been stipulated to by the parties. [Note 1.] Essentially, the parties are agreeing to an abbreviated trial on the merits.

Just as with any non-ACR case, the Board will decide disputed facts as part of the final decision.

The Board has found that cases that proceed along the ACR stipulated record model, involving many stipulated facts and stipulated evidence, yield highly effective records because evidentiary submissions are focused on the disputed facts. Stipulations of fact are useful but are not required in an ACR case prosecuted on a stipulated record.

Parties which agree to conduct the proceeding under ACR and which have stipulated to limited discovery may still take testimonial depositions. However, by limiting the number or duration of testimonial depositions, they may realize additional savings in cost and time. They may also

agree to use discovery depositions at trial or to introduce testimony by affidavit or declaration, with the non-offering party reserving the right to cross-examine the witness in a later testimonial deposition.

Parties using this form of ACR and who agree to forgo the testimony period should file a stipulation indicating such an intention, along with their stipulations to the record with respect to facts, evidence and testimony (e.g., testimony by affidavit, using discovery depositions in lieu of testimonial depositions). [Note 2.]

The stipulations regarding the submission of evidence remove any question about the admissibility of the evidence, and the parties may reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality. [Note 3.] A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 4.]

The parties are limited to 55 pages for the ACR trial briefs under the stipulated record model, inclusive of table of contents, index of cases, description of the record, statement of issues, recitation of the facts, argument and summary. [Note 5.] Unless counterclaims are involved, only plaintiff is entitled to file a reply which is limited to 25 pages. [Note 6.] A reply brief is limited to a rebuttal of the adverse party's case in chief.

For additional information regarding stipulated evidence and ACR, see TBMP § 705.

NOTES:

1. See, e.g., *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties selected ACR and agreed to forgo trial by stipulating to use evidence submitted in support of opposer's motion for summary judgment as trial evidence and allowing for any additional evidence to be submitted with their trial briefs on the case); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entirety of the record and agreed to forgo trial).
2. See, e.g., *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts and a stipulation to seek a determination through ACR); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties agreed to forgo trial by stipulating to use evidence submitted in support of opposer's motion for summary judgment as trial evidence and allowing for any additional evidence to be submitted with their trial briefs on the case); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entirety of the record and stipulated to forgo trial); *Zimmerman v. National Association of Realtors*, 70 USPQ2d 1425, 1427 (TTAB 2004) (in addition to reliance on a discovery deposition of one of the parties, the parties stipulated that the evidentiary record from an earlier Board case would be considered); *Devries v. NCC Corp.*, 227 USPQ 705, 708 (TTAB 1985) (parties stipulated to waive trial periods and stipulated to the following: petitioner's pleaded registration; each party's responses to certain interrogatories and requests for production of documents served upon it by the other party; and stipulated facts and affidavit testimony, with attached exhibits).

But see Lebanon Seaboard Corp. v. R&R Turf Supply Inc., 101 USPQ2d 1826, 1830 (TTAB 2012) (parties who stipulated to certain facts and issues, yet also submitted evidence to prove these points, have gone to needless effort and expense and the Board unnecessarily must review this evidence).

3. *See Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties agreed to reserve the right to object to facts and documents on the bases of relevance, materiality and weight).

4. *See Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating affidavit and exhibits thereto into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds sub nom, Creative Arts by Calloway, LLC v. Brooks*, 09-cv- 10488 (CS) (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013).

5. 37 CFR § 2.128(b).

6. 37 CFR § 2.128(b).

702.04(e) Utilizing Stipulations in Non-ACR Board cases

Parties may utilize stipulations of facts and evidence to realize cost efficiencies in non-ACR cases. They may stipulate to the entire record, to portions of the record, or to particular facts. [Note 1.] Parties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule.

A list of cases in which the parties have used stipulations to expedite discovery, trial and/or briefing is provided at the USPTO web site at

http://www.uspto.gov/trademarks/process/appeal/acrcase_list.doc. *See also TBMP § 705* regarding stipulated evidence.

NOTES:

1. *See, e.g., Miller v. Miller*, 105 USPQ2d 1615, 1617 n.6 (TTAB 2013) (parties stipulated to testimony by affidavit and provided a stipulation of undisputed facts); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (with specified exceptions, parties stipulated that all evidence submitted in a previous case by notice of reliance shall be admissible in instant proceeding by a notice of reliance; and that any documents could be submitted by notice of reliance without the other parties waiving its right to make substantive objections); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (parties stipulated to authenticity of produced documents and to the introduction of testimony in affidavit or declaration form, with certain guidelines); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1915 (TTAB 2011) (parties stipulated to authenticity of produced documents); *Brooks v. Creative Arts by Calloway, LLC*, 93 USPQ2d 1823, 1824-25 (TTAB 2010) (parties stipulated to admission of various testimony declarations and to facts), *aff'd on other grounds sub nom, Creative Arts by Calloway, LLC v. Brooks*, 09-cv-

10488 (CS) (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1044 (TTAB 2009) (parties stipulated to introduce testimony by declaration and to live cross-examination); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1585 (TTAB 2008) (parties stipulated to testimony by declaration, with exhibits); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1847 n.5 (TTAB 2008) (stipulation to use discovery depositions as trial testimony); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (stipulation to use evidence and exhibits submitted in connection with a motion for summary judgment at trial); *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1360 (TTAB 1988) (stipulations to facts by applicant, testimony by affidavit by opposer, and use of certain testimonial depositions taken in prior civil action); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1013 (TTAB 1984) (stipulated to the filing of facts and exhibits on behalf of each party during each party's testimony period); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 635 (TTAB 1983) (parties stipulated to facts, legal conclusions and testimony, including cross-examination and redirect examination with respect to stipulated testimony).

702.05 Overly Large Records

The Board notes that in recent years there has been a trend regarding the introduction of irrelevant and/or cumulative evidence at trial. [Note 1.] The Board views parties who engage in this practice with disfavor. [Note 2.] The introduction of such evidence impedes the orderly administration of the case, and obscures the impact of truly relevant evidence. In addition to diminishing the effectiveness of a party's evidentiary record, "papering" the Board causes delays in rendering a final decision. Parties should submit only relevant, non-cumulative evidence. [Note 3.] For instance, in lieu of filing discovery deposition transcripts in their entirety, it is preferable that parties file only those portions that are relevant to the pleaded claims and explain their relevance in the notice of reliance. [Note 4.] See TBMP § 704.09. For materials obtained from the Internet, parties should only submit relevant evidence, and should not submit duplicative and irrelevant materials. [Note 5.] For a detailed discussion of the relevancy requirements for Internet evidence, see TBMP § 704.08(b).

The Board may require the parties to take steps to assist with organizing the evidence such as preparing and filing tables summarizing testimony and other evidence and specifying 1) the probative value of particular facts or testimony and 2) the location in the record of such facts or testimony. [Note 6.]

Pursuant to 37 CFR § 2.120(i)(2), the Board may require the parties to appear for a pretrial conference where the Board has determined that the case has the potential to become overly contentious and/or involve the creation by the parties of excessive records. See TBMP § 502.06(b) for more information about pretrial conferences.

NOTES:

1. See, e.g., *Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013) ("While we commend the parties for agreeing to efficiencies intended to facilitate