

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Navigating the Trademark Trial and Appeals Board (TTAB): Deep dive into *ex parte* appeals

Peter Cataldo and Angela Lykos

Administrative Trademark Judges,  
Trademark Trial and Appeal Board (TTAB)

June 27, 2023



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# Building a record

- Build an effective factual record during prosecution.
- Be purposeful in building your record.
- Strategize during the prosecution phase.

# Building a record (cont'd)

- Common pitfalls
  - Waiting until filing a request for reconsideration to make of record your strongest evidence.
  - Waiting until after the notice of appeal and request for reconsideration deadline has lapsed to attempt to introduce critical evidence by remand after the Board has jurisdiction.

# Building a record (cont'd)

- A more effective tactic in response to the first office action refusing registration make your strongest arguments supported by ample evidence. This may prompt the examining attorney to withdraw the refusal.

# Internet evidence – common pitfalls

- Failing to include the full URL address and access date on the web pages
- Truncated search results from search engines (i.e. Google) are of limited utility
- Submitting foreign websites with no U.S. exposure
- Submitting blurry or illegible printouts

# Internet evidence – social media

- Consider using social media evidence (i.e. number of followers on Facebook, Instagram, Twitter, YouTube and number hits on applicant websites) to show, for example, acquired distinctiveness under Trademark Act Section 2(f).

# Internet evidence – probative value

- Consider the source of the evidence because this affects its probative weight.
- For example, the probative value of a blog post depends on U.S. consumer exposure and credentials of the blogger.

# Internet evidence – probative value (cont'd)

- Do not simply rely on open source websites such as Wikipedia or the Urban Dictionary.
- Consider which online websites, articles and publications carry the most authority and are relevant to the particular goods or services and industry.

# Third-party registrations

- Do not submit expired registrations or registrations lacking a demonstration of use.
- Do not submit applications.
- Listings are unacceptable and not probative.
- A full printout of the registration from the USPTO electronic records (e.g. Trademark Status and Document Retrieval (TSDR) showing the current status and title is acceptable.



# Trademark Act Section 2(d) refusal

- One common pitfall is that applicants fail to make of record probative evidence of commercial and/or conceptual weakness of the cited registration.
- *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength ... and its marketplace strength ....").

# Trademark Act Section 2(d) refusal (cont'd)

"[T]he strength of a mark is not a binary factor" and "varies along a spectrum from very strong to very weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015).

# Trademark Act Section 2(d) refusal (cont'd)

- Evidence of commercial weakness consists of third-party marketplace use such as third-party website evidence.
- Carefully review website evidence to ensure that it involves or is related to the registrant's goods or services and submit a sufficient quantity of evidence.

## Trademark Act Section 2(d) refusal (cont'd)

- Evidence of conceptual weakness consists of third-party registrations and dictionary definitions.
- Make sure to submit a sufficient number of third-party registrations for the involved goods or services.

# Addressing examining attorney's evidence

- *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1673-74 (TTAB 2018). Applicant submitted probative evidence of third party use and registration of the term common to its mark and the mark in the cited registration in successfully traversing Section 2(d) refusal of registration.
- *In re Lizzo LLC*, 2023 USPQ2d 139 \*33-\*38 (TTAB 2023). In failure to function case, Applicant demonstrated that majority of examining attorney's evidence that Applicant's designation is a common expression in such widespread use that it fails to function as a mark actually points to Applicant as an indicator of source.
- Point out weaknesses in the examining attorney's own evidence and introduce countervailing evidence.

# Declarations and affidavits to prove acquired distinctiveness

- To show acquired distinctiveness under Trademark Act Section 2(f), submit an affidavit or declaration from the appropriate witness to verify sales and advertising data and do not rely on attorney argument.
- Make sure that the statements cover the relevant time periods.
- Consider presenting data in chart format.

# Form declarations to prove acquired distinctiveness

- Usually arises in the context of customer declarations to show consumer recognition of a proposed mark as a source indicator to prove acquired distinctiveness.
- Administrative Trademark Judges (ATJs) carefully scrutinize this type of evidence.
- The probative value of form declarations depends on the specific statements made and identity of the declarants.

# Form declarations to prove acquired distinctiveness (cont'd)

- Choose your declarants wisely.
- Avoid declarants with an inherent bias or self serving (i.e. employees of the applicant).
- Who are the members of the largest customer base?
- Geographic and customer diversity carries more probative weight.

# Form declarations to prove acquired distinctiveness (cont'd)

- Form declarations with mere conclusory statements are unconvincing.
- Form declarations using a true/false format carry little probative weight.
- Include some individualized statements within the form declaration to explain consumer recognition and basis for knowledge of mark and product or service.

# Surveys

- Surveys can be persuasive if correctly used.
- Consider hiring an expert.
- Scrutinize the methodology.
- What is the survey universe? Screened for qualified respondents? Any potential bias?
- Are the survey questions correctly framed?

# Surveys (cont'd)

- Consider the methodology. "Teflon" type survey to show consumer recognition of the mark COUNTRY MUSIC ASSOCIATION was successful in overcoming genericness refusal and registering under Section 2(f). *In re Country Music Association, Inc.*, 100 USPQ2d 1824 (TTAB 2011).

# Surveys (cont'd)

*Compare In re Country Music Ass'n, Inc.*, 100 USPQ2d 1824, 1831 (TTAB 2011) (survey sample "based on a random digit probability sample of computer-generated phone numbers derived from all working telephones in the continental United States and based on a representative sample of the U.S. population.") *with In re Van Valkenburgh*, 97 USPQ2d 1757, 1767 (TTAB 2011) (finding "no basis on which to conclude that the survey is based on scientifically valid principles" where the survey consisted of questionnaires distributed to an unknown number of people who filled them out and mailed them back to applicant's counsel).

# Communication with the examining attorney

- Use the telephone! Communication with the examining attorney during prosecution is key.
- Examination is not intended to be adversarial.
- We strongly suggest working with the examining attorney.

# Communication with the examining attorney (cont'd)

- To obviate a Section 2(d) refusal consider amending the identification.
- We are constrained to consider the identifications and not extrinsic evidence except in limited situations (i.e. technical goods or services).
- The Trademark rules only permit amendments that limit the identification meaning that an expansion is impermissible.
- Discuss options with the examining attorney to achieve resolution via an examiner's amendment.

# Communication with the examining attorney (cont'd)

- When facing a Section 2(d) refusal, move to suspend if the grace period for filing a Trademark Act Section 8 affidavit or Trademark Act Section 9 renewal has passed.
- Check TTABVue to see if the cited registration is the subject of a petition to cancel brought by a third-party. If so, move to suspend.

# Communication with the examining attorney (cont'd)

- Investigate the owner of cited registration in order to ascertain whether the cited mark is in use. Consider filing a petition to cancel on ground of abandonment and then moving to suspend prosecution.
- Consider negotiating a consent agreement with the owner of the cited mark. Discuss with the examining attorney required elements of a consent agreement prior to filing for evaluation.

# Briefs - the realities of appeals

- Refusals under Section 2(d) and Trademark Act Section 2(e)(1) (mere descriptiveness) constitute the bulk of the TTAB's appellate docket.
- The vast majority of appeal briefs in Section 2(d) and 2(e)(1) cases are not winning ones; such refusals are consistently affirmed at a very high rate (85%+).
- Given these realities, ask yourself whether an appeal is in your client's best interest.

# Practical considerations on appeals

- Is it better to abandon the application and re-file in the future when conditions may be more favorable?
  - Cited registration may expire or be subject to cancellation, or to a consent agreement
  - Sufficient use to make Section 2(f) (acquired distinctiveness) claim
- Or risk an adverse TTAB decision that may have preclusive effect.



# Prior to briefing, have you:

- Created a sufficient record to support your arguments in favor of registration?
- Reviewed the examining attorney's evidence to determine its strengths and weaknesses?
- Investigated the status of any cited registration and its vulnerability to cancellation, or the possibility of obtaining a consent?

# Are you ready to brief?

- If research reveals new evidence, request remand.
- If a cited registration may be cancelled in the near future, request suspension pending its disposition.
- If the owner of a cited registration is amenable to a consent, request suspension.
- If all outstanding issues have not been addressed, (e.g., the examining attorney has not considered your Section 2(f) amendment), request remand for further examination.

# Applicable rules and law

- Trademark Rules of Practice govern appeals.
- Trademark Trial and Appeal Board Manual of Procedure (TBMP) and Trademark Manual of Procedure (TMEP) do not have the force of law, but are useful sources of case law and practical guidance.
- Federal Circuit and TTAB precedential decisions provide the applicable law.
- Other federal court decisions and non-precedential TTAB decisions do not bind the TTAB and are far less useful.

# Briefing strategies

- Address refusals and requirements in a clear and concise manner.
- Cite to evidentiary record in USPTO docketing systems – TSDR and TTABVUE.
- Cite to Federal Circuit and TTAB precedential decisions as legal support whenever possible.
- Be certain to address **all** outstanding refusals and requirements.



# Some briefing pitfalls

- Repeating verbatim your last response to the examining attorney during prosecution.
- Wasting space on string cites.
- Engaging in extensive discussion of legal standards, unless the standards themselves are in dispute.
- Attaching to the brief any evidentiary materials other than proper subjects for judicial notice.
- Advancing arguments that are unavailable under the statute or the case law (e.g., arguing that the registrant's actual use restricts the goods identified in the cited registration).
- Offering ad hominem commentary regarding the owner of cited registration, the examining attorney, the ATJs or the USPTO.



# Some briefing considerations:

- How can you refine (or change) the arguments that you made to the examining attorney to give you a better chance of success before the TTAB?
- Should you argue every aspect of a refusal or requirement?
- Should you file a reply brief and, if so, how can you rebut the examining attorney's arguments instead of simply restating your main arguments?
- Is it better to object to the examining attorney's evidence or to make arguments undercutting its probative value?



# Non-precedential decisions

- Non-precedential decisions do not bind the TTAB, but may be cited for whatever limited persuasive value they may have.
- If there is no precedential decision on point, explain why the analysis of the non-precedential decision that you cite should be applied by the TTAB to the facts and record of your case.
- Do recent non-precedential decisions suggest a trend by the TTAB in a particular direction? If so, request the TTAB make your decision precedential to make the asserted trend part of decisional law.

# Raising novel arguments

- Make it clear in your brief if your appeal raises an issue of first impression because there are no precedential decisions that have considered the issue.
- Explain why and how the TTAB should interpret the law to address the particular circumstances in your case.
- Make it clear in your brief if your argument requires the TTAB to overrule existing precedent and explain why the TTAB panel should do so.

# Questions?

- TTAB contact information for further queries
  - (800) 786-9199
  - (571) 272-8500

