

**PLEADINGS AND MOTIONS IN CONTESTED  
PROCEEDINGS**  
**For PLI Navigating Trademark Trial and Appeal Board  
Practice**  
**San Francisco, February 2003**

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**I INTRODUCTION**

This paper discusses pleadings in contested cases, the compulsory counterclaim rule and substantive motions attacking the pleadings. Representative samples of pleadings and substantive motions are attached for reference.

**II Pleadings – Notices of Opposition and Petitions to Cancel.**

Sections 13 and 14 of the Lanham Act provide for the filing in the Trademark Trial and Appeal Board of Oppositions and Petitions to Cancel, which are the equivalents of complaints in civil litigation. The subject matter of such actions is limited only to the registrability of the mark challenged; the Board has no jurisdiction to award damages or injunctive relief.

The Lanham Act itself has bare-bones requirements only – the “grounds” must be stated, the fee must be filed and, in the case of oppositions, they must be filed timely within thirty days after publication (unless there have been appropriate extensions). The Code

of Federal Regulations expands on those provisions. CFR Section 2.101(b), 2.111(b) and 2.116(c) and 2.119(e) have more detailed guidelines on forms of pleadings.

The Federal Rules of Civil Procedure also apply in all TTAB proceedings. Note, in particular, Rules 8, 9 and 11.

However, it is hazardous to rely only on the Federal Rules of Civil Procedure and cases construing them. The Board has its own rules and cases interpreting them. Extensive rules on the forms of pleading are set forth in the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Sections 312 – 314. The TBMP also provides sample forms of pleading.

A. Timing

A word of caution on oppositions and extensions of time to file oppositions. It can be fatal to file a request for extension of time in the name of the wrong party. Check your forms to make sure you didn’t forget to change the name of the client on whose behalf you have filed the extension. While such a mistake may seem innocuous and correctable – it may not be. See 37 CFR Section 2.102(b), Trademark Manual of Examining Procedure (“TBMP”) 206.01 – 206.03; *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

Similarly fatal are the time deadlines. The Lanham Act establishes *statutory* deadlines on the extent of time that can be granted to file oppositions and the total amount of time that can be granted in the absence of agreement or showing of “extraordinary circumstances” TBMP 207.03. First extensions of thirty days can be

granted without cause; extensions for up to 120 days can be granted for cause. To ensure that you remember to allege “cause”, regardless of where you are in the extension process, *always* allege “cause”. If you should omit grounds for “cause” after the first 30 day extension – it *cannot* be granted by the Board. You must notice the mistake of omission of cause within the first 30 day extension and correct it then – or you have forfeited the right to file opposition. TBMP 207.02. *See Lotus Development Corp. v Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm’r of Patents 1991).

Check the dates for deadlines carefully – good calendaring systems are essential – use fingers if necessary. Should you request a certain number of days for an extension, but the expiration of those days falls outside the statutory period, with no consent or extraordinary circumstances, you will forfeit the opportunity to oppose. There are 120 days from publication to file an opposition ; *expiration* is 120 days from publication - if expiration is on the weekend or a federal holiday, you may file the next day. TBMP 209.04.

Faulty requests for extensions of time can also be bases to dismiss claims, akin to motions to dismiss. See *Cass Logistics*, supra.

Note that over 25 thousand requests for extensions of time are processed each year. You must keep track of your extensions and request new extensions even if you have not yet been granted prior requests. For status, refer to uspto.gov BISX, the home page for all TTAB status questions.

Electronic filing (possibly mandatory electronic filing) will be implemented in 2003, starting with requests for extensions of time.

B. Keep It Simple in Drafting Complaints and Responses to Them

When drafting Notices of Opposition or Petitions to Cancel keep it simple – even simple-minded. All that must be stated are “grounds”, or in the words of the Federal Rules of Civil Procedures, a “short and plain statements of the facts”.

This is not a time to be in love with your prose. Do not give the other party any facts to which it is not entitled. When drafting your complaints, leave out extraneous matters and histrionics. “Wonton use” of applicant’s mark in a “manner calculated to cause confusion” will not get you any further than “the mark sought to be registered is likely to lead to confusion with Opposer’s mark”. In fact such florid pleadings may only create the impression that you do not know how limited the issues are in a TTAB proceeding and that you usually practice in other courts.

Don’t throw in the kitchen sink. Even though dilution is now grounds for opposition, if that is tough to prove, leave it out. Claims for relief typically part of civil actions have no place in opposition or cancellation proceedings. You will damage your credibility if you add such claims in. TBMP 312.

When reviewing a complaint, ask yourself what you really know. Typical claims are that Opposer ( or Petitioner) owns certain registrations or uses the mark for certain products. Even if you know from your own research that a mark is registered or the subject of a pending application by Opposer, you do not need to “admit” such facts - they are properly denied on information and belief. Do not amplify your denial of the claims in the Petition with affirmative defenses that state the same thing. You do not add to your defense, but in the worst case, you may end up shifting the burden of proof.

### **III. The Compulsory Counterclaim Rule**

“Compulsory” counterclaims do not exist in the same fashion in TTAB proceedings as they do in civil litigation because the issues in such proceedings are limited. For example, if a party has opposed your client’s mark and the defense is that your client has prior use, the proceeding will only determine the *registrability* of your client’s mark but will not cancel the opposer’s prior registration ( if any). You may petition to cancel such a pleaded registration in a counterclaim based on prior use and you should raise such related claims. Remember to pay the filing fee if your counterclaim does involve a cancellation or partial cancellation petition. Any claims which could have been brought at the time of the answer should be brought in the counterclaim.

### **IV. Motions to Dismiss and Motions for Summary Judgment**

#### **A. In General**

Motions to Dismiss and for Summary Judgment are just two of the many types of motions that may be filed in inter partes TTAB proceedings. As such, the general rules governing all motions apply to these types of motions. See TBMP 502. If the TBMP does not provide a specific rule on a procedure, then the Federal Rules of Civil Procedure apply. See Federal Rules of Civil Procedure 10(b)(5) and 56.

Trademark Rule 1.127 and TBMP Rule 502.02 set forth the rules on forms of motions. The general procedures applicable in civil proceedings apply except that the Board provisions do *not* contemplate reply briefs. Unless really necessary, therefore, try to avoid them. Page limits are *strictly* adhered to – twenty five. Oral hearings typically are

not held on any motions whatsoever, including on motions to dismiss and summary judgment motions. It is rare for the Board to grant oral hearings on these motions. These are proceedings in the Trademark Trial and Appeal Board after the Trademark Office has finally refused a federal application to register. Section 20 of the Lanham Act, 15 U.S.C. Section 1070 provides for an appeal to the TTAB from a final refusal. Trademark Rules 2.61 to 2.64 (37 C.F.R.)

Bear in mind that all motions are heard by the interlocutory attorney assigned to your case. When oppositions or cancellations are initiated, they are assigned to an interlocutory attorney. There are currently 16 interlocutory attorneys on four teams. Each team has two paralegals and 8 legal assistants. Paralegal staff handle most of the extensions of time and so forth, but substantive motions are reviewed by the interlocutory attorney. Therefore if you bring baseless motions of whatever nature, or exaggerate or show an unwillingness to communicate with opposing counsel, such tactics will be noticed. Although it is not guaranteed that the assigned interlocutory attorney will read and consider substantive motions such as motions to dismiss or motions for summary judgment, it is preferred that the assigned attorney do so. Therefore take care in all your motions. You will establish your reputation for veracity and reliability with each one.

Note that interlocutory attorneys currently handle a case load of about 300 live cases; this figure is rising as more oppositions and cancellations are filed. 8,526 such proceedings were filed in FY 2001; 9700 are projected for FY 2002. This is as a result of increased application filings in past years. Each interlocutory attorney has on average one summary judgment and three other types of contested motions to consider each month. (Based on FY 2001 607 contested motions filed, 201 summary judgments filed.)

Pendency is about four months for all types of motions,

although the goal for summary judgment motions is three months. The TTAB uses the same mailroom – papers are delayed in processing 2-3 weeks. Look for electronic filing procedures for all papers in the TTAB. Electronic filing of requests for extensions of time are expected in 2003.

#### B. Motions to Dismiss

TBMP Section 503 governs motions to dismiss. As in civil proceedings, such motions must be filed before and at the same time as the answer. As a practical matter, as in civil litigation, unless the point of the motion is simply to add the cost of litigation, the result of such a motion is simply to educate the other party on pleading practices; leave to amend defective pleadings is readily granted. TBMP 503.03.

In the TTAB fiscal year ended September 30, 2001, 93 motions to dismiss were filed, most of which resulted in leave to amend the pleadings.<sup>1</sup> That figure is slightly up for 2002.

Bear in mind that the Board can and does use its power to award sanctions granted by Rule 11 in the case of unsupported allegations in any pleadings and the filing of pleadings for any improper purpose. See TBMP Rule 529. Thus a motion to dismiss filed for any improper purpose is likely to result in sanctions.

#### C. Summary Judgment Motions

Just as in civil litigation, summary judgment motions can be filed only after evidence has been adduced and can be granted *only* if

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<sup>1</sup> I gratefully acknowledge the assistance Honorable Gerard Rogers of the Trademark Trial and Appeal Board and Mary Frances Bruce, the supervisor of the interlocutory attorney staff at the Board for this and similar information presented in this paper.

there is no issue of material fact so that the movant is entitled to judgment as a matter of law. See Fed. Rule of Civil Procedure 56, TBMP 528.

Therefore by the time a proceeding is ripe for a summary judgment motion, it is probably also ripe for the testimony and briefing period. Summary judgments are most useful “where the material facts are clearly undisputed and are truly compelling, or where the motion is based on some theory of *res judicata*”<sup>2</sup> and can be a good way to avoid a useless trial, but probably only in limited situations.

Summary judgment motions are based on facts. Gather all the supporting evidence in support of your motion ( which you would do for the testimony period in any event).

In the TTAB fiscal year ending September 30, 2001, 201 motions for summary judgment were filed, or about 17 a month. That is about one summary judgment motion per interlocutory attorney each month. Exact figures are not kept, but estimates are that only between 25% and 30% of those were granted. Any order granting or denying summary judgment can of course, be appealed to the Court of Appeals of the Federal Circuit, which has not been reluctant to overturn the TTAB’s granting of summary judgment motions. There has been a relatively low chance of prevailing at the Board level, and a relatively low chance of maintaining the summary judgment award if it is appealed.

The TTAB generally assigns an interlocutory attorney to each case until it reaches the Board. However, because of the difficulty of reviewing summary judgment motions, these can be assigned centrally to all interlocutory attorneys. Therefore the attorney assigned to your

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<sup>2</sup> Honorable T. Jeffrey Quinn, “Trademark Trial and Appeal Board: Motion Practice” presented September 14, 2000 at the TTAB Practice For Novices Forum sponsored by the International Trademark Law Association.

proceeding may not be the reviewer on the summary judgment motion. The reviewing attorney's findings are then passed on to the Board. The goal currently for acting on summary judgment motions is three months, and as of the end of December, 2001, is about three and half months. This time from filing to decision is down considerably from a pendency of two years in the recent past.

This information suggests that the filing of summary judgment motions will not necessarily speed the result of the case ( in fact is guaranteed to suspend it for several months), and that the likelihood of winning a motion for summary judgment is two to one at the Board phase, and at best fifty-fifty thereafter. Furthermore, such a motion will do much to educate the other side on its case and ensure that the other party is as prepared as the moving party on the issues.

However, recent comments from the Board suggest that the Board may be more inclined to consider favorably well-taken motions for summary judgment. If the facts are well-developed through discovery and the summary judgment motion is not premature, it may be advisable.

Knee jerk summary judgment motions are not advisable. You will delay your case several months and educate your opponent on your strategies and their weaknesses and put the other side on notice as to the work ahead of them in the testimony phase and at trial.

## **PLI Navigating Trademark Trial and Appeal Board Practice**

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Memorandum in Support of Applicant's cross-Motion for Summary Judgment and in Opposition to Opposer's Motion for Summary Judgment (Valentino Garavani v. Mario Valentino)

Opposer's Reply Memorandum in Opposition to Applicant's Cross-Motion for Partial Summary Judgment and in Further Support of Opposer's Motion for Summary Judgment (Valentino Garavani v. Mario Valentino)

Applicant's Memorandum in Reply to Opposer's memorandum in Further Support of Opposer's Motion for Summary Judgment (Valentino Garavani v. Mario Valentino)