

**EX PARTE APPEAL PRACTICE**  
**For PLI Navigating Trademark Trial and Appeal Board Practice**  
**San Francisco, February 2001**

© 2000 Anne Hiaring, Esq.  
Law Offices of Anne Hiaring  
San Anselmo, California

**I. INTRODUCTION**

This paper discusses ex parte appeals from refusals to register. 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. Sections 2.61 to 2.64) govern the examination of applications. Trademark Rules. 2.141 – 2.142 ( 37 C.F.R. Sections 2.41 and 2.42) and the Trademark Trial and Appeal Board Manual of Procedure ( (TBMP) Sections 1201- 1219, filing motions for reconsideration and appeal and the appellate process. TBMP Sections 1201-1219 are attached to this paper.

There are many possible grounds for refusal to register, ranging from refusals on substantive grounds to refusals based on indefinite descriptions of goods or services. Generally it is not worth a client's while to appeal refusals based on mere technicalities. It is better, if an application is rather hopelessly technically flawed, to re-file ( although the priority of the filing date may be lost). Therefore this paper and my remarks will focus on preparing for an appeal because of a substantive refusal. Note that Petitions to the Commissioner of Trademarks may be filed to correct improper requirements on formalities and similar technical matters.

The process gives the applicant three bites at the apple if there is a substantive refusal: 1) in the Response to the Office Action with the refusal 2) in the Motion for Reconsideration and 3) in the Appeal. Because of the nature of the appellate process, all the evidence must be in the record BEFORE the appeal stage. Therefore with the first two bites, additional evidence in support of the application can be submitted.

The first step in considering whether an appeal of a refusal to register should be made should be taken when a mark is searched. In the course of searching, frequently possibly conflicting marks, or possible bases for refusal of registration such as descriptiveness become apparent. When advice is given as to a mark's registrability, the client should be made aware of such conflicts. Furthermore, the possibility of refusal should inform the description of goods and services. An inartfully drafted application can result in providing the Trademark Office the perfect argument for refusal based on descriptiveness. Similarly, if a search reveals possibly conflicting marks, the application should be drafted around them. Do not plug in stock descriptions of goods and services regardless of what the search results show. Do not accept uncritically a client's own description of goods and services. Such description may fit well within their own conception of what they do, but could create problems with prosecution.

When and if the trademark Examining Attorney refuses registration, thoughts about overcoming the refusal should already be in place.

When a refusal issues, it can be handled by a Response by telephone or in writing. However, the purpose of a telephone response to a substantive refusal should be primarily to sound out the Trademark Attorney as to possible means of overcoming the refusal. No such phone call should be made until a complete factual and legal investigation has been made, so that the attorney is prepared to speak in a fully informed manner about all the issues with the Examining Attorney. Bear in mind that the Examining Attorney is not exactly like a judge, but is in the

position of disposing favorably or unfavorably over your client's application. Ex parte communications with a Trademark Attorney, unlike with a judge, are encouraged. But like communications with a court, they should be deferential, well-informed and completely accurate. With every communication with the Trademark Office examining staff, an attorney is establishing his or her reputation for reliability and good advocacy. Do not treat the facts or the law cavalierly. Remember also that the Examining Attorney is doing the best job he or she can and wishes to see that all appropriate marks are registered. If you can help find a creative solution to overcoming a refusal – such as limiting the description of goods, providing more evidence of use to more fully explain the client's activities to clarify lack of descriptiveness and so forth – do it.

As to the form of written Response, you will observe that many practitioners simply put oral remarks into a written Response format without any evidentiary or case law support. I do not recommend this practice. While Responses do not necessarily need to be as complete as briefs filed in court, and knowledge of the applicable case law by the Examining Attorney can be presumed, the better practice is to treat a Response like a short brief. Take the refusal seriously. Lay out the bases for refusal, why the refusal is wrong and both factual and legal support for this. Do not be merely conclusory. It is important, particularly with the facts, to provide something for the Examining Attorney to hang his or her hat on. Remember that Examining Attorneys are required to process a certain number of applications – it is in their interest to move cases forward, not keep them in their dockets on technicalities. So establish a relationship of mutual support – it is in both of your interests to pass the application on to publication

Only if a refusal is made final should a motion for reconsideration or an appeal be considered.

As should be apparent from the above, at the point a motion for

reconsideration or appeal is needed, as much work as possible should already have been done. The main task, if appeal appears unavoidable, is to prepare the record for appeal by gathering and submitting into the application record the facts you will need to win the appeal.

## **II. PREPARING THE RECORD FOR APPEAL**

The Lanham Act Section 2(f) sets forth the substantive bases for refusal. See 15 U.S.C. Section 1052. The two major bases for substantive refusal are 1) likelihood of confusion with an already registered or pending mark or 2) descriptiveness. It is beyond the scope of this paper to discuss the factors and cases on likelihood of confusion (or lack thereof) or descriptiveness. However, following are some practical tips on entering evidence into the ex parte record on these issues.

### **A. The First Bite: In Response to a Refusal to Register**

As noted in the introduction, the first chance an applicant has to “appeal” a refusal is to argue in a Response that the refusal was improper. Depending upon several factors, including how strong the basis of refusal seems to be and the importance of registration to the client, consideration should be given to submitting additional evidence in support of registration with the Response. Note that with every Office Action, the applicant has six months to respond. It is only when the refusal is made final that a motion for reconsideration or notice of appeal is appropriate. Thus potentially there will be more than one six-month period in which to gather and submit evidence. However, watch carefully the language with respect to whether the action is “final” or not.

The Examining Attorney has typically submitted evidence in support of refusal. The Applicant therefore should, wherever possible, submit rebuttal evidence in support of registration. For example, if an application to register “

mens shoes” is refused based on a registration for “women’s t-shirts and casual clothes”, various items of evidence could be developed and submitted with the Response. The point is to show no likelihood of confusion. Affidavits by the client, purchasers of mens’ shoes in the retail environment, clothing analysts and like witnesses that can state that mens’ shoes are not sold in the same channels of trade as women’s t-shirts would be helpful. Limitation of the description of goods may also be in order, to specify that the goods are mens’ dress shoes sold only in certain channels of trade. With respect to the channels of trade, if the women’s clothing application is unrestricted, this may not be determinative, but may help sway the decision of the Examining Attorney.

In some cases, it can be very helpful to demonstrate that the common terms in the applicant’s mark and the cited mark are very widely used and therefore the use of the common terms in both marks is not likely to lead to confusion. Search results showing registered and pending marks are helpful as a quick measure of how widespread terms are. Note that such evidence is NOT dispositive of use of the marks so cited. However, again, the purpose here is to provide some evidence, relatively inexpensively, that the trademark Examining Attorney can use to find in the applicant’s favor.

Another good source is the web. For example, if the common term in two marks is “turbo” for a type of software, it is helpful to find listings of many different types of software with the “turbo” feature, which demonstrates descriptiveness of the term. The web is also useful to prove that a term is not primarily geographically descriptive or merely a surname. For example, if the mark FAIRBANKS were refused on the ground of either geographic or surname significance, the number of place names and surnames and other uses of the term would tend to prove that it is not *primarily* merely geographically descriptive or *primarily* merely a surname.

Other common forms of evidence are client brochures or advertising, most

commonly web sites. These often contain information which clarifies that a mark that may seem descriptive is actually not because the products and services are different from the common understanding of the mark. An easy conceptual example is “GROCERY STORE”. As a type of retail store service, the mark is descriptive. As a brand of clothing, it is not. More commonly, such refusals come up in with new technology marks, for example FAST BUS may not be registrable for “fast” data transmission circuits, but may be registrable for DSL services. Client documents and client affidavits could help dispel the impression of descriptiveness.

If a mark has been refused based on descriptiveness, and the mark has been used at least five years ( refer to Section 2(f) of the Lanham Act), affidavits of continued use for five years by the client can be submitted claiming secondary meaning and thus distinctiveness. Even more persuasive are affidavits of third parties who can testify as to the secondary meaning of the mark. Again, trade publishers, advertisers, retailers or wholesalers and others familiar with the goods and services and the meaning of the mark to the public are most probative. Refer to Section 2(f) and Trademark Rule 2.41, which sets forth the types of evidence that can be considered to prove secondary meaning. These include advertising expenditures, advertising of the mark, use of the mark on products, volume of sales and like information, all of which can be submitted by affidavit. All such affidavits can be submitted in Response to the Office Action.

#### **B. The Second Bite: In Support of a Request for Reconsideration**

If no actual evidence in support of registration was submitted in connection with the Response to the refusal Office Action, it most definitely should be developed and considered in support of a motion for reconsideration. Filing the motion gives the applicant another six months to respond. This is the last stage in the application that further evidence can be introduced into the record. If the client

seriously requires registration, the above forms of evidence, if not developed sooner, should be developed and submitted with the reconsideration request. If the mark is important enough, even surveys should be conducted which support registrability.

With respect to surveys, while very expensive in the normal course of prosecution, they can be persuasive of both no likelihood of confusion and no descriptiveness. Short form surveys can be developed at less than the cost of a full-blown inter-partes survey or survey of the type used in civil litigation.

If no proper legal argument was made in the Response to the initial refusal, it should be made now. Also check recent TTAB cases to see if possibly new cases can change the outcome. Note again, however, that most of the case law and principles are well-established. The question of registrability is unlikely to turn on legal issues – more likely meeting the burden of proof and the evidence developed in support of registration. Remember the lesson of the *Loew's* case – it does not matter if your legal argument is right or not if you do not meet your burden of proof. In re Loew's Theatres, Inc. (769 F. 2d 764 (CAFC 1985) (failure to rebut evidence of geographic meaning of DURGANGO for chewing tobacco).

As a practical matter, if the client is not willing to spend additional funds to develop evidence either at the Response stage or the Reconsideration stage, filing a Motion for Reconsideration with the same argument used in the Response may be beneficial. This is because it signals to the Examining Attorney that the applicant is serious about the application. Typically this triggers review of the application by a Managing Attorney and more thoughtful review by the Examining Attorney. There is a certain “squeaky wheel” advantage to filing a motion for Reconsideration even without additional evidence. However some additional evidence in support of the application is preferable. And remember that the client's and the attorney's credibility is also at stake. Too many motions for reconsideration with no additional support will eventually be discounted and not

considered at all.

### **III. THE MECHANICS OF FILING A REQUEST FOR RECONSIDERATION**

Once a final action has been issued, applicant has six months in which to file a request for reconsideration. The paper is similar in form to a Response. There is no filing fee. The Examining Attorney will try to consider the Request in a timely fashion. However, there is no guarantee that the Attorney's action on the reconsideration will occur within the six month period.

CONCURRENT WITH THE DEADLINE FOR FILING A REQUEST FOR RECONSIDERTION IS THE DEADLINE FOR FILING A NOTICE OF APPEAL.

### **IV. MECHANICS FOR FILING AN APPEAL**

The time period in which an appeal must be filed is the same as that for a request for reconsideration – filing the reconsideration request *does not* lengthen the time to file the notice of appeal.

An appeal must be initiated by filing a Notice of Appeal ( see form enclosed) AND paying the required filing fee, which is based on the number of classes in the application. Appeal filing fees are \$100.00 per class. If no fee is paid at the time the Notice of Appeal is filed, the appeal is not treated as properly filed.

Therefore there is six months from the final action both to request reconsideration and file and pay for the Notice of Appeal. As insurance, it can be worthwhile to file the Notice of Appeal at the same time as the reconsideration request. If the reconsideration request is at all close to the six-month deadline, filing the Notice of Appeal should be automatic, to preserve the client's rights. If the client is sensitive to the costs – advise the client in writing that the failure to

file the Notice of Appeal before a decision on the reconsideration could result in an abandonment. The appeal filing is therefore “insurance” to preserve the right to appeal, should the reconsideration not be successful.

As a practical matter, if both the reconsideration and appeal are filed simultaneously, the Board will defer to the Examining Attorney for decision on the reconsideration before taking up the appeal.

**A. “Good Cause” Showing to Complete Evidentiary Record**

In general, the record of the application must provide all the evidence to support the appeal. However, under limited circumstances, additional evidence can be filed. A request for suspension and to file additional evidence for good cause is available under Trademark Rule 2.142(d) 37 C.F.R. 2.142. Good cause can be shown if the evidence was not previously available, the Examiner has agreed with Applicant to the extension or there is a new firm representing applicant.

The Board does have discretion to consider untimely filed evidence if the Examining Attorney not not object to the new evidence and affirmatively treat is as being part of the record.

**B. The Mechanics of the Appeal**

Once an appeal is filed, as with the request for reconsideration, the case is forwarded to the managing attorney who then reviews the application with the Examining Attorney. This is a helpful process, which can result in the Attorney allowing registration.

Most the appeal will be handled on a written record, although oral argument is available, if specifically requested.

Opening briefs are due within sixty days from the date of the appeal. If an early notice of appeal was filed before the end of the six month period, and evidence is still being developed, this and other reasons can be good cause for an

extension on filing the brief. The Examining Attorney will draft a response, but reply briefs are discouraged.

Remember that, even more so than with the Examining Attorney, the TTAB knows the law. Do not brief background legal issues for the Board as you may do for a judge with a varied caseload, who cannot be expected to have any familiarity with the law of the particular case.

Instead, focus on the facts and the particular aspects of the legal bases that may support your client's application. Remember that at any time the Examining Attorney may allow the application for publication. Therefore you continue to educate the Examining Attorney as well as the Board with your papers.

Finally, remember in all your actions that you are dealing with a career trademark attorney. The Examining Attorney is not an adversary and should always be referred to respectfully. Although you may not agree with the Attorney's actions, you may be sure that they were taken in complete good faith; stick to the facts and legal issues without hyperbole or any personal comments. Never cite any evidence that is not in the record. This will serve only to undermine your credibility with the Board, as well as the Attorney.

## **V. CONCLUSION**

The best method to prepare for an appeal is to be conscious of the possible grounds for rejection when searching a mark and drafting the application to register. Appeal should not be automatic, or credibility will be lost; however all means of preparing a good evidentiary record to support an appeal should be taken – not just argument of counsel – to ensure the success of the appeal.

## PERTINENT STATUTES

The Lanham Act (Trademark Act of 1946), 15 U.S.C. Section 1051, *et seq.*

*The Trademark Trial and Appeal Board Manual of Procedure (TBMP) 1995*

*Uspto.gov*

## SELECTED BIBLIOGRAPHY

Krugman, Gary D. *Trademark Trial and Appeal Board Practice and Procedure* (2001, West)

McCarthy, J.T., McCarthy on Trademarks and Unfair Competition (3rd Ed. 1996) (5 vols.)

## EXAMPLES OF TRADEMARK SEARCH RESOURCES

### Trademark Databases and On-Line Services

**TRADEMARKSCAN™** data produced by Thomson & Thomson and available on CDs and on-line through DIALOG Information Services.

**Trademark Access** is produced by CCH Trademark Research Corporation and available by subscription on CDs updated monthly. On-line backup service is provided, for filings more recent than the CDs.

### Other Databases

DIALOG Electronic Yellow Pages, NEXIS news article database, various databases according to industry.