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PLEADINGS**

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### 301 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 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, under Section 12(a) of the Act, 15 U.S.C. § 1062(a), in the *Official Gazette* of the Patent and Trademark Office ("USPTO").<sup>1</sup>

#### **Mark on Supplemental Register Not Subject to Opposition:**

*15 U.S.C. § 1092 [Section 24 of the Trademark Act] Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. ...*

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not.<sup>2</sup>

Accordingly, the Board must reject any opposition filed with respect to the mark in an application for registration on the Supplemental Register. The opposition papers will be returned to the person who filed them, and any opposition fee submitted will be refunded. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued.<sup>3</sup>

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a trademark. The proceeding may only be filed after the issuance of the

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<sup>1</sup> See Section 13 of the Act of 1946, 15 U.S.C. § 1063.

<sup>2</sup> See Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§ 1062(a), 1063(a), and 1092. See also TBMP § 205 (Mark on Supplemental Register).

<sup>3</sup> See Section 24 of the Act, 15 U.S.C. § 1092.

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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.<sup>4</sup>

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.<sup>5</sup> The proceeding is declared by the USPTO only on petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference.<sup>6</sup>

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, ordinarily as to the geographic scope of the applicant's mark or the goods and/or services on or in connection with which the mark is used.<sup>7</sup>

### 302 Commencement of Proceeding

**37 CFR § 2.101(a)** *An opposition proceeding is commenced by the filing of an opposition in the Patent and Trademark Office.*

**37 CFR § 2.111(a)** *A cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the Patent and Trademark Office.*

**37 CFR § 2.116(b)** *The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

**37 CFR § 2.116(c)** *The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

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<sup>4</sup> See Sections 14 and 24 of the Act of 1946, 15 U.S.C. §§ 1064 and 1092.

<sup>5</sup> See Section 18 of the Act, 15 U.S.C. § 1068.

<sup>6</sup> See Section 16 of the Act of 1946, 15 U.S.C. § 1066; 37 CFR § 2.91; and TBMP § 1002 (Declaration of Interference).

<sup>7</sup> See *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 n.9 (TTAB 1995) and TBMP § 1101.01 (Nature of Concurrent Use Proceeding) and authorities cited therein.

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An opposition proceeding is commenced by the timely filing of a notice of opposition in the USPTO.<sup>8</sup> Similarly, a cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the USPTO.<sup>9</sup>

The notice of opposition, or the petition for cancellation, and the answer thereto correspond to the complaint and answer in a court proceeding.<sup>10</sup> The opposer in an opposition proceeding, or the petitioner in a cancellation proceeding, is in the position of plaintiff, and the applicant in an opposition proceeding, or the respondent in a cancellation proceeding, is in the position of defendant.<sup>11</sup>

An interference proceeding commences when the Board mails a notice of interference to each of the parties to the proceeding, as described in 37 CFR § 2.93.<sup>12</sup>

A concurrent use proceeding commences when the Board mails a notice of the proceeding to each of the parties thereto, as described in 37 CFR §§ 2.99(c) and 2.99(d)(1).

*For further information concerning interference and concurrent use proceedings, see TBMP chapters 1000 and 1100, respectively.*

### 303 Who May Oppose or Petition to Cancel

#### 303.01 In General

**15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act]** *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. ...*

**15 U.S.C. § 1064 [Section 14 of the Trademark Act]** *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of*

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<sup>8</sup> See 37 CFR § 2.101(a). See also *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). Cf. Fed. R. Civ. P. 3.

<sup>9</sup> See 37 CFR § 2.111(a).

<sup>10</sup> See 37 CFR § 2.116(c).

<sup>11</sup> See 37 CFR § 2.116(b). See also *Yamaha International Corp. v. Hoshino Gakki Co.*, *supra*.

<sup>12</sup> See 37 CFR § 2.93.

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*dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....*

**15 U.S.C. § 1092 [Section 24 of the Trademark Act]** *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. ...*

**15 U.S.C. § 1127 [Section 45 of the Trademark Act: Construction and Definitions]** *In the construction of this Act, unless the contrary is plainly apparent from the context--*

\* \* \* \*

**Person; Juristic Person.** *The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.*

*The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.*

*The term "person" also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.*

\* \* \* \*

**37 CFR § 2.2(b) Entity** *as used in this part includes both natural and juristic persons.*

**37 CFR § 2.101(b)** *Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. ...*

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**37 CFR § 2.111(b)** Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. ...

### 303.02 Meaning of the Term "Person"

The term "person," as used in the Act, includes both natural and juristic persons.<sup>13</sup> A juristic person is a "firm, corporation, union, association, or other organization capable of suing and being sued in a court of law."<sup>14</sup>

If an operating division of a corporation is not itself incorporated or is not otherwise a legal entity which can sue and be sued, it does not have legal standing to own a mark or to file an application for registration, an opposition, or a petition for cancellation.<sup>15</sup> In such a case, the application, opposition, or petition for cancellation should be filed in the name of the corporation of which the division is a part. If an opposition or a petition for cancellation is filed in the name of a division, and there is no indication that the division is incorporated, the Board will make written inquiry as to whether the division is incorporated or is otherwise a legal entity that can sue and be sued. If the opposer or petitioner responds in the negative, the opposition or petition for cancellation will go forward in the name of the corporation of which the division is a part.<sup>16</sup>

The term "person" as used in the Act also includes the United States, any agency and instrumentality thereof, or any individual, firm or corporation which acts for the United States and with the authorization and consent of the United States, as well as any state, any instrumentality of a state, and any officer or employee of a state or instrumentality of a state acting in his or her official capacity.

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<sup>13</sup> See Section 45 of the Act, 15 U.S.C. § 1127. Cf. 37 CFR § 2.2(b).

<sup>14</sup> Section 45 of the Act, 15 U.S.C. § 1127. See *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992) (a "person" may be a corporation or other entity); *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 720-21 (CCPA 1969) (a corporation, is a "person" within the meaning of Section 45 of the Act, and can base an opposition on Section 2(a) of the Act, 15 U.S.C. §1052(a)); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685, 1686 n.2 (TTAB 1987) (Commonwealth of Aruba is a "person" within the meaning of Sections 13 and 45 of the Act); *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254, 1257 (TTAB 1987) (U.S. Navy is a juristic person within the meaning of Section 45 of the Act); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 410 n.6 (TTAB 1986) (Alabama Board of Trustees, a corporate body, may be considered either a "person" or an "institution" within the meaning of Section 2(a) of the Act); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 n.2 (TTAB 1985) (corporations as well as individuals are "persons" for purposes of Section 2(a) of the Act); and *In re Mohawk Air Services Inc.*, 196 USPQ 851, 855 (TTAB 1977) (a government agency is a juristic person and as such may file an application for registration, an opposition, or a petition for cancellation).

<sup>15</sup> See *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986), and TMEP § 1201.02(d).

<sup>16</sup> Cf. *In re Cambridge Digital Systems*, *supra*, and TMEP § 1201.02(d).

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### 303.03 Meaning of the Term "Damage"

The term "damage," as used in Sections 13 and 14 of the Act, 15 U.S.C. §§ 1063 and 1064, concerns specifically a party's standing to file an opposition or a petition to cancel, respectively. A party may establish its standing to oppose or to petition to cancel by showing that it has a "real interest" in the case, that is, a personal interest in the outcome of the proceeding and a reasonable basis for its belief in damage.<sup>17</sup> There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding.<sup>18</sup>

### 303.04 Federal Trade Commission

*15 U.S.C. § 1064* Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required.

The proviso at the end of Section 14 of the Lanham Act, 15 U.S.C. § 1064, provides statutory standing for the Federal Trade Commission to cancel a registration on the Principal Register on the grounds specified in paragraphs (3) and (5) of the section.<sup>19</sup>

*For information concerning the grounds for cancellation specified in paragraphs (3) and (5) of Section 14 of the Act, see TBMP § 307.01.*

### 303.05 Opposition Filed During Extension of Time to Oppose

*37 CFR § 2.102(b)* The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through

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<sup>17</sup> See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) and TBMP § 309.03(b) (Standing).

<sup>18</sup> See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *Universal Oil Products Co. v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 1124, 174 USPQ 458, 459-60 (CCPA 1972). For additional case cites see the Appendix of Cases. For a discussion of standing, see TBMP § 309.03(b).

<sup>19</sup> See also *Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 647 (CCPA 1979), and *Federal Trade Commission v. Formica Corp.*, 200 USPQ 182, 191 (TTAB 1978).

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*mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.*

### **303.05(a) General Rule**

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party.<sup>20</sup> For this reason, an opposition filed during an extension of time to oppose ordinarily must be filed in the name of the party to which the extension was granted.<sup>21</sup> An opposition filed in a different name will be accepted only if the opposition is filed by a person in privity with the person granted the extension of time or if the person that requested the extension was misidentified through mistake.

### **303.05(b) Opposition Filed by Privity**

A party in privity with a potential opposer may step into the potential opposer's shoes and file a notice of opposition or may join with the potential opposer as a joint opposer.<sup>22</sup> Thus, an opposition filed during an extension of time to oppose may be filed by a party other than the party to which the extension was granted, if it is shown to the satisfaction of the Board that the differing party is in privity with the party granted the extension.<sup>23</sup> If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the opposition will not be accepted as to any different party that fails to make a satisfactory showing of privity.

The "showing" of privity should be in the form of a recitation of the facts on which the claim of privity is based, and must be submitted either with the opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more differing parties, an explanation will be requested as to each

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<sup>20</sup> See *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (a party cannot claim the benefit of an extension granted to another, unrelated party).

<sup>21</sup> See 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). Cf. TBMP § 206.02.

<sup>22</sup> See *SDT Inc. v. Patterson Dental Co.*, *supra* (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose); Trademark Rule 2.102(b); and *In re Cooper*, *supra*.

<sup>23</sup> See 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, *supra*; and *In re Cooper*, *supra* (fact that two entities share same objection is not a basis for finding privity). Cf. TBMP § 206.02.

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differing party, and the opposition will not be accepted as to any differing party that fails to make a satisfactory showing of privity.

Once a timely notice of opposition has been filed, and the time for opposing has expired, the right to pursue the filed case is a right individual to the timely filer. While this right may be transferred to another party, as by an assignment of the mark with the associated goodwill, it may not be shared.<sup>24</sup>

*For information concerning the meaning of the term "privity" see TBMP § 206.02.*

### **303.05(c) Misidentification of Opposer**

If the name of the opposer, in an opposition filed during an extension of time to oppose, differs from the name of the party to which the extension was granted, the opposition will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake.<sup>25</sup>

The phrase "misidentification by mistake," as used in 37 CFR § 2.102(b), means a mistake in the form of the opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named.<sup>26</sup>

The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts on which the claim of misidentification by mistake

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<sup>24</sup> *SDT, Inc. v. Patterson Dental Co.*, *supra* at 1709; and *In re Cooper*, *supra* at 671 (licensee, having failed to join opposer in filing opposition during extension of time to oppose, may not be joined after opposition is filed).

<sup>25</sup> *See* 37 CFR § 2.102(b), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

<sup>26</sup> *See Cass Logistics Inc. v. McKesson Corp.*, *supra* at 1077 (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). *See also* TMEP § 1503.04.

*Cf. William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870 (TTAB 1994) (motion to substitute party that acquired mark from opposer prior to commencement of proceeding granted where opposition had been mistakenly filed in name of original owner); *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a partner in a firm which no longer existed was not fatal); and TBMP § 512.04 (Misidentification). *Cf. also* TMEP §§ 803.03 and 1201.02(c); *In re Columbo Inc.*, 33 USPQ2d 1530, 1531 (Comm't 1994) (fact that statement of use was signed by officer of true owner was irrelevant where statement of use was filed in name of wrong party); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1640 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r 1974) (deletion of "company" was correctable mistake).

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is based, and must be submitted either with the opposition or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

### **303.06 Joint Opposers or Petitioners**

Two or more parties may file an opposition or a petition for cancellation jointly. However, the required fee must be submitted for each party joined as opposer or petitioner for each class in the application for which registration is opposed or for each class in the registration for which cancellation is sought.<sup>27</sup>

When parties file jointly, the notice of opposition or petition for cancellation must name each party joined as plaintiff. In addition, the notice of opposition or petition for cancellation should include allegations concerning the standing of each party plaintiff and the ground or grounds for opposition or cancellation.<sup>28</sup> If the case is ultimately determined on the merits, rather than by default, withdrawal, stipulation, etc., any joint plaintiff whose standing has not been proved cannot prevail, even though a ground for opposition or cancellation has been proved.<sup>29</sup>

On the other hand, the fact that two or more parties may have an interest in a mark to be pleaded in a notice of opposition, or a petition for cancellation does not mean that each such party must be joined as opposer, or petitioner. Joint filing is elective, not mandatory.<sup>30</sup>

### **304 Proceeding Against Multiple Class Application or Registration**

When an opposition is filed with respect to an application which contains goods and/or services in multiple classes (*see* 37 CFR § 2.86(b)), or a petition for cancellation is filed with respect to a registration which contains goods and/or services in multiple classes, the class or classes

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<sup>27</sup> *See* 37 CFR §§ 2.101(d)(1) and 2.111(c)(1); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee was not permitted to join as co-opposer after notice of opposition was filed, but even if permitted, would have had to submit fee); and TBMP § 308. *For information concerning the filing of an opposition by two or more parties jointly where the opposition is filed during an extension of time obtained by only one of the parties see* TBMP § 303.05.

<sup>28</sup> *See* TBMP § 309.03(b) and (c) *for a discussion of standing and grounds for oppositions and cancellations.*

<sup>29</sup> *See Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (of three joint opposers, owner of registration and its licensee as user of marks had real interest in proceeding, but opposer who only held software copyright had no standing and was given no further consideration). *See also Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (Board found that one of the two opposers did not prove standing).

<sup>30</sup> *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992) (respondent's motion to dismiss and its alternative motion to join petitioner's parent as owner of pleaded registrations and real party in interest denied since issue concerned what rights petitioner has in pleaded marks vis a vis defendant, not anyone else).

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opposed, or sought to be cancelled, should be specified in the plaintiff's pleading. In addition, the required opposition or cancellation fee must be submitted for each party joined as plaintiff for each class sought to be opposed or cancelled.<sup>31</sup>

### **305 Consolidated and Combined Complaints**

*37 CFR § 2.104(b) Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.*

*37 CFR § 2.112(b) Petitions to cancel different registrations owned by the same party may be joined in a consolidated petition when appropriate, but the required fee must be included for each party joined as petitioner for each class sought to be cancelled in each registration against which the petition to cancel is filed.*

When appropriate, a party may oppose, in a single (i.e., "consolidated") notice of opposition, different applications owned by the same defendant. However, the required fee must be submitted for each party joined as opposer, for each class in which registration is opposed, in each application against which the opposition is filed.<sup>32</sup> When such a pleading is filed, the Board sets up a single opposition file, identified by a single opposition proceeding number, but bearing on its front, in the place where the number of the opposed application is written, the number of each application opposed in the consolidated notice of opposition.

Similarly, when appropriate, a party may seek to cancel, in a single ("consolidated") petition for cancellation, different registrations owned by the same defendant. Again, the required fee must be submitted for each party joined as petitioner, for each class sought to be cancelled, in each registration against which the petition for cancellation is filed.<sup>33</sup> When such a pleading is filed, the Board sets up a single cancellation file, identified by a single cancellation proceeding number, but bearing on its front the number of each registration sought to be cancelled in the consolidated petition to cancel.

In addition, a party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations,

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<sup>31</sup> See 37 CFR §§ 2.101(d) and 2.111(c), and TBMP § 308.04.

<sup>32</sup> See 37 CFR § 2.104(b) and TBMP § 308.05.

<sup>33</sup> See 37 CFR § 2.112(b) and TBMP § 308.05.

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provided that each subject application and registration is owned by the same defendant.<sup>34</sup> However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the pleading is filed.<sup>35</sup> When such a pleading (referred to as a "combined" opposition and petition to cancel) is filed, the Board sets up both an opposition and a cancellation proceeding file, each with its own identifying number, and each marked "Combined with \_\_\_\_\_" followed by the number of the other proceeding. The opposition is treated as the "parent" case, and both proceeding numbers are placed on all papers relating to the combined proceedings.<sup>36</sup>

A consolidated notice of opposition, or petition to cancel, or a combined notice of opposition and petition to cancel, is appropriate if the plaintiff's claims against each of the defendant's subject applications, and/or registrations, involve common (i.e., similar) questions of law or fact.<sup>37</sup>

### 306 Time for Filing Opposition

#### 306.01 In General

*15 U.S.C. § 1062(a) [Section 12(a) of the Trademark Act] Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1(d) of this Act, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office....*

*15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act] Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result*

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<sup>34</sup> See, e.g., *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993) (combined opposition and cancellation).

<sup>35</sup> See TBMP § 308 (Filing Fees). Cf. 37 CFR §§ 2.104(b) and 2.112(b).

<sup>36</sup> Cf. TBMP § 511.

<sup>37</sup> See *Nabisco Brands Inc. v. Keebler Co.*, *supra* at 1238 n.2 (defendant who believes marks and issues are sufficiently different such that combined proceeding is not appropriate may file motion to separate proceedings). Cf. Fed. R. Civ. P. 42(a); TBMP § 511 (motions to consolidate); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (oppositions involving similar marks and similar issues consolidated); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441 (TTAB 1973) (applicant's motion to consolidate denied in view of extent of differences in the involved issues). Cf. also *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (joint motion to consolidate granted in view of identity of parties and issues), and *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985) (consolidation permitted; issues of fact and law substantially similar).

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*of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. ...*

**37 CFR § 2.101(c)** *The opposition must be filed within thirty days after publication (§2.80) of the application being opposed or within an extension of time (§2.102) for filing an opposition.*

An opposition to the registration of a mark on the Principal Register must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette* for opposition, or within an extension of time to oppose granted to the opposer or its privy.<sup>38</sup> The certificate of mailing by first-class mail procedure described in 37 CFR § 1.8 and the "Express Mail" procedure described in 37 CFR § 1.10 are both available for the filing of a notice of opposition; the certificate of (fax) transmission procedure described in 37 CFR § 1.8 is not.<sup>39</sup>

*For information concerning the effect of such matters as restoration of jurisdiction, republication, amendment, letter of protest, petition to the Director, abandonment, or the inadvertent issuance of a registration, on the filing of an oppositions or a request to extend time to oppose, see generally, TBMP chapter 200.*

### **306.02 Date of Publication of Mark**

The date of publication of a mark is the issue date of the issue of the *Official Gazette* in which the mark appears, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for purposes of opposition.

### **306.03 Premature Opposition**

Section 13 of the Act, 15 U.S.C. § 1063(a), requires that an opposition to the registration of a mark on the Principal Register be filed within a specified time *after* the publication of the mark in the *Official Gazette*.

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<sup>38</sup> See Section 13(a) of the Act, 15 U.S.C. § 1063(a); 37 CFR §§ 2.102(b) and (c); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and TBMP § 303 (Who May Oppose or Petition to Cancel).

<sup>39</sup> See 37 CFR §§ 1.8(a) and 1.10(a). See also TBMP §§ 110 (Certificate of Mailing or Transmission) and 111 ("Express Mail" Procedure).

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Thus, any opposition filed prior to the publication of the mark sought to be opposed, is premature, and will be rejected by the Board, even if the mark has been published by the time of the Board's action. No proceeding will be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded.<sup>40</sup>

### 306.04 Late Opposition

Because the timeliness requirements of Section 13(a) of the Act, 15 U.S.C. § 1063(a), for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Director on petition.<sup>41</sup>

Accordingly, an opposition filed after the expiration of the would-be opposer's time for opposing must be denied by the Board as late. No proceeding will be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded. The would-be opposer's remedy lies in the filing of a petition for cancellation, pursuant to Section 14 of the Act, 15 U.S.C. § 1064, when and if a registration is issued.

## 307 Time for Filing Petition to Cancel

**15 U.S.C. § 1064 [Section 14 of the Trademark Act]** *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(a), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:*

- (1) Within five years from the date of the registration of the mark under this Act.*
- (2) Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.*
- (3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such*

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<sup>40</sup> Cf. TBMP §§ 119.03 (Papers and Fees) and 202.03 (Premature Request).

<sup>41</sup> See *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of Rule 1.8 would effectively waive Section 13 and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of Rule 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

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*Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.*

*(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act.*

*(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:*

*Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required.*

**15 U.S.C. § 1092 [Section 24 of the Trademark Act]** *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. The Director shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be cancelled by the Director. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).*

**37 CFR § 2.111(b)** *Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel*

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*the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases the petition and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.*

### **307.01 Petition That May Be Filed At Any Time After Registration**

A petition to cancel a registration may be filed at any time in the case of a registration issued on the Supplemental Register under the Act of 1946, 15 U.S.C. §1051 *et seq.*, or under the Act of 1920, or a registration issued under the Act of 1881 or the Act of 1905 which has not been published under Section 12(c) of the Act of 1946, 15 U.S.C. § 1062(c).<sup>42</sup>

In addition, a petition to cancel any registration may be filed at any time on any ground specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. § 1064(3) or 1064(5).<sup>43</sup> As permitted by Section 14(3), a petition to cancel may be filed at any time on grounds that, for example, the mark has been abandoned; the registration was obtained by fraud; the mark is generic; the mark is geographically deceptive,<sup>44</sup> or disparaging, or falsely suggests a connection with a person's name or identity;<sup>45</sup> the mark comprises matter that, as a whole, is functional;<sup>46</sup> or the mark comprises the flag of the United States<sup>47</sup> or the name of a living individual without the individual's consent.<sup>48</sup>

*For additional information on selected grounds for opposition and cancellation, see TBMP § 309.03(c).*

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<sup>42</sup> See Sections 14 and 24 of the Act, 15 U.S.C. §§ 1064 and 1092, and 37 CFR § 2.111(b).

<sup>43</sup> See Sections 14 and 24 of the Act, 15 U.S.C. §§ 1064 and 1092, and 37 CFR § 2.111(b).

<sup>44</sup> See Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). *Cf., for example, Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (registration over five years old may not be challenged on ground that mark is geographically descriptive under Section 2(e)(2)).

<sup>45</sup> See Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

<sup>46</sup> See Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5).

<sup>47</sup> See Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b).

<sup>48</sup> See Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c).

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### 307.02 Petition That Must Be Filed Within Five Years from the Date of Registration

#### 307.02(a) In General

A petition to cancel a registration issued on the Principal Register under the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. § 1064(3) or 1064(5), must be filed within five years from the date of the registration of the mark.<sup>49</sup> Similarly, a petition to cancel a registration issued on the Principal Register under the Act of 1881 or the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c), 15 U.S.C. 1062(c).<sup>50</sup>

Although a petition to cancel filed after the expiration of the five-year period, in the case of such a Principal Register registration, must recite one of the grounds specified in Section 14(3) or 14(5) of the Act, a petition to cancel filed prior to the expiration of the five-year period may be based on any ground which could have prevented registration initially.<sup>51</sup> The grounds for cancellation which are thus available in these cases for a petition filed within the five-year period, but not thereafter, include all of the grounds specified in Sections 14(3) and (5) as well as likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d);<sup>52</sup> all of the grounds specified in Section 2(e) of the Act, 15 U.S.C. § 1052(e), including a claim that respondent's mark is merely descriptive or deceptively misdescriptive, that respondent's mark is geographically descriptive or deceptively misdescriptive, or that respondent's mark is primarily merely a surname; that respondent is not the owner of the registered mark; and that there was no bona fide use of respondent's mark in commerce to support the original registration.

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<sup>49</sup> See *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (the filing date of the petition is the operative date, not the date that the notice of the proceeding is mailed to the parties). Cf. *British-American Tobacco Co. Limited v. Philip Morris Inc.*, 55 USPQ2d 1585 (TTAB 2000) (Section 14 does not limit Board's authority to entertain an action under Article 8 of the Pan American Convention against a registration over five years old).

<sup>50</sup> See Sections 14(1) and 14(2) of the Act, 15 U.S.C. §§ 1064(1) and 1064(2), and 37 CFR § 2.111(b).

<sup>51</sup> See *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142, 142 (Fed. Cir. 1986); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

<sup>52</sup> Cf. *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983) (claim of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment). For a discussion of standing to file a petition to cancel or a notice of opposition, see TBMP § 309.03(b).

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*For additional information on selected grounds for opposition and cancellation, see TBMP § 309.03.*

A petitioner may not seek to cancel a registration over five years old on the *ground* of likelihood of confusion. However, under Section 18 of the Trademark Act, 15 U.S.C. § 1068, a petitioner may seek to partially cancel a registration over five years old by restricting the goods or services therein in order to avoid a likelihood of confusion. *For a discussion of a petition to partially cancel a registration under Section 18 of the Trademark Act, see TBMP § 309.03(d).*

The five-year period specified in Section 14(1), 15 U.S.C. § 1064(1), (i.e., "Within five years from the date of the registration of the mark under this Act") includes the fifth anniversary date of the registration.<sup>53</sup> Similarly, the five-year period specified in Section 14(2), 15 U.S.C. § 1064(2), ("Within five years from the date of publication under Section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905"), includes the fifth anniversary date of the publication under Section 12(c).<sup>54</sup>

The filing date of the petition is the date of receipt in the USPTO of the petition with the required fee.<sup>55</sup> The Certificate of Mailing procedure described in 37 CFR § 1.8 and the "Express Mail" procedure described in 37 CFR § 1.10 are available for the filing of a petition to cancel.<sup>56</sup>

### **307.02(b) Sec. 14 Limitation Is Independent of Section 15 Affidavit**

The five-year time limit specified in Section 14, 15 U.S.C. § 1064, barring certain attacks on a Principal Register *registration*, "is not dependent on the filing of a declaration under Section 15 which provides incontestable rights of *use* to a limited extent (15 U.S.C. §1065)."<sup>57</sup>

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<sup>53</sup> *See Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 199) (fifth-year anniversary falling on a weekend or holiday). *Cf.* TMEP §§ 1605.05 and 1606.03.

<sup>54</sup> *Cf. Strang Corp. v. Stouffer Corp.*, *supra*, and TMEP §§ 1605.05 and 1606.03.

<sup>55</sup> 37 CFR § 2.111(c)(3).

<sup>56</sup> *See* 37 CFR §§ 1.8(a) and 1.10(a).

<sup>57</sup> *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1392 n.5 (Fed. Cir. 1990) (emphasis in original). *See also Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990), and *Strang Corp. v. Stouffer Corp.*, *supra* at 1311 (concept of incontestability of a registration is irrelevant to a cancellation proceeding under Section 14).

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### 307.02(c) Factors Affecting the Five-Year Period

#### 307.02(c)(1) Reliance on Registration By Plaintiff

If an opposer relies on a Principal Register registration of its pleaded mark, and the five-year period has not yet expired when the opposition is filed, the limitation does not apply to any counterclaim filed in response to the petition for cancellation of that registration. This is so even if the five-year period has expired by the time the counterclaim is filed. In such cases, the filing of the opposition tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds on which a counterclaim may be based.<sup>58</sup>

Similarly, the limitation would not apply to a counterclaim to cancel such a Principal Register registration relied on by the petitioner in a cancellation proceeding, if the five-year period had not yet expired with respect to the registration at the time of the filing of the petition to cancel.

#### 307.02(c)(2) Amendment of Registration

When a Principal Register registration has been amended, the registration is subject to attack under Section 14 of the Act, 15 U.S.C. § 1064, to the extent that the amendment of the registration has in any way enlarged registrant's rights, as though the registration had issued on the date of the amendment. That is, even though the Section 14 five-year period following issuance of the registration, or publication under Section 12(c), 15 U.S.C. § 1062(c), may have expired, if a petition to cancel the registration is filed within the five years following the amendment of the registration, the petition is not limited to Section 14(3) or 14(5) (15 U.S.C. § 1064(3) or 1064(5)) grounds, to the extent that the amendment has in any way enlarged the registrant's rights. Rather, during the five years after the amendment, "the modified registration, not having been in existence for five

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<sup>58</sup> See e.g., *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 862 n.3 (TTAB 1980); *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan*, 165 USPQ 597, 598 n.4 (TTAB 1970) (grounds were not limited where, although petition to cancel was not properly filed until after fifth anniversary date of registration, opposition wherein opposer relied on said registration was filed before anniversary date); and *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385, 386 (Comm'r 1955). See also J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:67 (4th ed. 2001).

*Cf.*, regarding concurrent use proceedings, *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (5-year period tolled where applicant, prior to expiration of 5-year period files a proper concurrent application or an amendment converting an unrestricted application to one seeking concurrent use naming registrant as exception to applicant's right to exclusive use).

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years, may be challenged in a cancellation proceeding as long as petitioner states grounds [not limited to Section 14(3) or 14(5) grounds] for the cancellation indicating how he believes he is or will be damaged by the modified registration."<sup>59</sup>

### **307.03 Premature Petition to Cancel**

Sections 14 and 24 of the Act, 15 U.S.C. §§ 1064 and 1092, provide for the filing of a petition to cancel "a registration of a mark." Until a registration actually issues, there is no registration.

Thus, if a petition to cancel a registration is filed prior to the issuance of the registration, it is premature, and will be rejected by the Board, even if the registration has issued by the time of the Board's action. No proceeding will be instituted; rather, the petition papers will be returned, and any submitted petition fee will be refunded. Petitioner's remedy lies in the filing of a new petition to cancel after the registration has issued.

### **307.04 Late Petition to Cancel**

A petition to cancel a registration issued on the Principal Register under the Act of 1946 on a ground not specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. § 1064(3) or 1064(5), must be filed within five years from the date of the registration of the mark. Similarly, a petition to cancel a registration issued on the Principal Register under the Act of 1881 or the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, 15 U.S.C. § 1062(c), on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c).<sup>60</sup>

If a petition to cancel one of these Principal Register registrations is filed after the expiration of the five-year period and does not plead one or more of the grounds specified in Section 14(3) or 14(5) of the Act, the petition is late, and will be rejected by the Board. No proceeding will be instituted; rather, the petition papers will be returned, and any submitted petition fee will be refunded. However, the rejection of the petition is without prejudice to petitioner's right to file, at any time thereafter, a new petition to cancel the registration, and to plead therein one or more of the grounds specified in Section 14(3) or 14(5).

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<sup>59</sup> *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 423 (CCPA 1976). See *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 824-25 (TTAB 1984) (counterclaim would be proper where defendant pleads that the amendment to the mark in the subject registration resulted in a mark materially different from originally registered mark, representing enlargement of rights conferred by original certificate of registration; that defendant used its mark prior to opposer's first use of amended mark; and that confusion with amended mark is likely).

<sup>60</sup> See Section 14 of the Act, 15 U.S.C. § 1064, and 37 CFR § 2.111(b).

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*For information concerning the effect of signature and fee requirements on the timing of a petition to cancel, see TBMP §§ 308.02(d) (Insufficient Fee) and 309.02(b) (Signature).*

### 308 Filing Fees

#### 308.01 Fee for Filing Opposition

##### 308.01(a) In General

*15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act] Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office....*

*37 CFR §2.101(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6). If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.*

*(2) If the fees submitted are sufficient to pay for one person to oppose registration in at least one class but are insufficient for an opposition against all of the classes in the application, and the particular class or classes against which the opposition is filed are not specified, the Office will issue a written notice allowing opposer until a set time in which to submit the required fee(s) or to specify the class or classes opposed. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the opposition will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which the fees submitted are sufficient to pay the fee due for each class.*

*(3) If persons are joined as party opposers, and the fees submitted are sufficient to pay for one person to oppose registration in at least one class but are insufficient for each named party opposer, the Office will issue a written notice allowing the named party opposers until a set time in which to submit the required fee(s) or to specify the opposer(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party opposer and additional parties will be deemed to be party opposers to the extent that the fees submitted are sufficient to pay the fee due for each*

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*party opposer. If persons are joined as party opposers against the registration of a mark in more than one class, the fees submitted are insufficient, and no specification of opposers and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending order.*

The rules governing opposition fees are specified in 37 CFR §§ 2.101(d)(1)-(d)(3). The amount of the required filing fee is specified in 37 CFR § 2.6(a)(17).

*For information on how to pay fees, see 37 CFR §§ 1.22-1.25, and TBMP § 118. For information on fee refunds, see 37 CFR § 1.26, and TBMP § 119.*

### **308.01(b) Insufficient Fee**

The required fee for filing an opposition should be submitted with the opposition. However, if no fee, or an insufficient fee, is submitted within thirty days after publication of the mark to be opposed, or within an extension of time to oppose, the defect may be cured as specified in 37 CFR §§ 2.101(d)(1)-(d)(3), set forth above.

## **308.02 Fee for Filing Petition to Cancel**

### **308.02(a) In General**

*15 U.S.C. § 1064 [Section 14 of the Trademark Act] A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....*

*15 U.S.C. § 1092 [Section 24 of the Trademark Act] Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. ...*

*37 CFR § 2.111(c)(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see § 2.6). If the fee submitted*

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*is insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.*

*(2) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are insufficient for each named party petitioner, the Office will issue a written notice allowing the named party petitioners until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the petitioner(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party petitioner and additional parties will be deemed to be party petitioners to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a registration sought to be cancelled in more than one class, the fees submitted are insufficient, and no specification of parties and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the petition against the classes in the registration in ascending order.*

*(3) The filing date of the petition is the date of receipt in the Patent and Trademark Office of the petition together with the required fee. If the amount of the fee filed with the petition is sufficient to pay for at least one person to petition to cancel one class of goods or services but is less than the required amount because multiple party petitioners and/or multiple classes in the registration for which cancellation is sought are involved, and the required additional amount of the fee is filed within the time limit set in the notification of the defect by the Office, the filing date of the petition with respect to the additional party petitioners and/or classes is the date of receipt in the Patent and Trademark Office of the additional fees.*

The rules governing cancellation fees are specified in 37 CFR §§ 2.111(c)(1)-(c)(3). The amount of the required fee is specified in 37 CFR § 2.6(a)(16). The required fee for a petition to cancel must be submitted with the petition; the effective filing date of a

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petition to cancel (and, hence, the date of commencement of the cancellation proceeding) is the date of receipt in the USPTO of both the petition to cancel and the required fee.<sup>61</sup>

*For information on how to pay fees, see 37 CFR §§ 1.22-1.25, and TBMP § 118. For information on fee refunds, see 37 CFR § 1.26, and TBMP § 119.*

### **308.02(b) Insufficient Fee**

The required fee for a petition to cancel must be submitted with the petition.<sup>62</sup> The filing date of a petition to cancel is the date of receipt in the PTO of the petition and the required fee.<sup>63</sup> Moreover, Section 14 of the Act, 15 U.S.C. § 1064, limits, after a specified five-year period, the grounds on which a Principal Register registration issued under the Act of 1946, 15 U.S.C. § 1051 *et seq.*, or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. § 1062(c), may be cancelled.<sup>64</sup> If a petition to cancel such a registration is submitted to the USPTO prior to the expiration of the five-year period, but the required fee is not submitted until after the expiration thereof, the filing date of the petition is the date of receipt in the USPTO of the required fee, and the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after expiration of the five-year period.<sup>65</sup>

Except to the extent that the five-year period of Section 14 is applicable in a particular case, there is no time limit for the filing of a petition to cancel an issued registration. Thus, if no fee, or an insufficient fee, is submitted with a petition to cancel, the defect may be cured as specified in 37 CFR §§ 2.111(c)(1)-(c)(3), *provided that the five-year period, if applicable, has not expired, or, if expired, that the petition recites a ground permitted after the expiration of the five-year period.* The petition will not be rejected (except to the extent that it is barred by the five-year limit) if the required fee is submitted to the USPTO within the time limit set in the Board's written notification of the defect. The responsibility for filing proper documents and fees rests with the party filing them. Although the Board makes every effort to notify plaintiffs of insufficiencies in fees

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<sup>61</sup> See 37 CFR §§ 2.111(a), 2.111(c)(1), and 2.111(c)(3); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966); and TBMP § 308.02(b) (Insufficient Fee).

<sup>62</sup> See 37 CFR § 2.111(c)(1).

<sup>63</sup> See 37 CFR § 2.111(c)(3) and *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966).

<sup>64</sup> See Section 14 of the Act, 15 U.S.C. § 1064, and TBMP § 307.02(a) (petition filed within 5 years).

<sup>65</sup> See Section 14 of the Act, 15 U.S.C. § 1064; *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, *supra*; and TBMP § 307.04 (Late Petition to Cancel).

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before the expiration of any applicable statutory deadline, so that the insufficiencies may be corrected prior to the deadline, the Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time.<sup>66</sup>

### **308.02(c) Petition Filed by Federal Trade Commission**

There is no fee for a petition filed by the Federal Trade Commission to cancel a registration on the Principal Register.<sup>67</sup>

### **308.02(d) Fee for Counterclaim**

*For information concerning fees for counterclaims, see TBMP § 313.02.*

### **308.03 Fees for Joint Opposers or Petitioners**

Two or more parties may file an opposition, or a petition for cancellation, jointly. However, the required fee must be submitted for each party joined as opposer, or petitioner, for each class in the application for which registration is opposed, or for each class in the registration for which cancellation is sought.<sup>68</sup>

### **308.04 Fees for Proceeding Against Multiple Class Application or Registration**

The required opposition or cancellation fee must be submitted for each party joined as plaintiff for each class sought to be opposed or cancelled.<sup>69</sup>

### **308.05 Fees for Consolidated and Combined Complaints**

When appropriate, a party may oppose, in a single (i.e., "consolidated") notice of opposition, different applications owned by the same defendant. However, the required fee must be

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<sup>66</sup> *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (regarding defective renewal application in sufficient time to permit refiling), and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

<sup>67</sup> *See* Section 14 of the Act, 15 U.S.C. § 1064. *Cf.* TBMP § 303.04 (Federal Trade Commission).

<sup>68</sup> *See* 37 CFR §§ 2.101(d)(1) and 2.111(c)(1); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and TBMP §§ 308.01 and 308.02 (Filing Fees). *See also* TBMP § 303 (Who May Oppose or Petition to Cancel).

<sup>69</sup> *See* 37 CFR §§ 2.101(d) and 2.111(c), and TBMP §§ 308.01 (Filing Fee for Opposition) and 308.02 (Filing Fee for Cancellation). *See also* TBMP § 304 (Multiple Classes).

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submitted for each party joined as opposer, for each class in which registration is opposed, in each application against which the opposition is filed.<sup>70</sup>

Similarly, when appropriate, a party may seek to cancel, in a single ("consolidated") petition for cancellation, different registrations owned by the same defendant. Again, the required fee must be submitted for each party joined as petitioner, for each class sought to be cancelled, in each registration against which the petition for cancellation is filed.<sup>71</sup>

In addition, a party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant.<sup>72</sup> However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the complaint is filed.<sup>73</sup>

### 309 Form and Content of Oppositions and Petitions to Cancel

#### 309.01 In General

*37 CFR § 2.101(b) Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, and may be signed by the opposer or the opposer's attorney or other authorized representative.*

*37 CFR § 2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. ...*

*37 CFR § 2.116(c) The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

*37 CFR § 2.119(e) Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused*

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<sup>70</sup> See 37 CFR § 2.104(b). See TBMP §§ 305 (Consolidated Complaints) and 308.01 (Filing Fee for Opposition).

<sup>71</sup> See 37 CFR § 2.112(b). See also TBMP §§ 305 and 308.02 (Filing Fee for Cancellation).

<sup>72</sup> See, e.g., *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993) (combined opposition and cancellation).

<sup>73</sup> Cf. 37 CFR §§ 2.104(b) and 2.112(b). See TBMP § 305 (Consolidated and Combined Complaints).

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*consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.*

The notice of opposition, or petition to cancel, corresponds to the complaint in a court proceeding.<sup>74</sup> For purposes of simplicity, the term "complaint" is often used hereafter to refer to a notice of opposition or a petition to cancel.

### 309.02 Form of Complaint

#### 309.02(a) Format for Complaint

The Board prefers that complaints be submitted in typewritten or printed form, double-spaced. A complaint may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended.<sup>75</sup>

The USPTO has no printed form for use in filing a notice of opposition or petition for cancellation. However, as an aid to litigants, the USPTO has prepared suggested formats for these complaints.<sup>76</sup> A complaint need not follow the suggested format, as long as it includes the necessary information. *For suggested formats for complaints, see Appendix of Forms.*

The complaint should include the following information:

**Heading:** The complaint should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD."

**Identification of subject application or registration:** The heading should be followed by information identifying the application or registration that is the subject of the complaint with the wording "Serial No. \_\_\_\_\_" for an opposition or "Registration No. \_\_\_\_\_" for a petition to cancel.

**Name of proceeding:** The application or registration number should be followed by the name of the proceeding (i.e., "ABC Corporation v. XYZ Company"), the wording

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<sup>74</sup> 37 CFR § 2.116(c).

<sup>75</sup> See TBMP § 106.03 (Form of Papers).

<sup>76</sup> See *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1223 n.2 (TTAB 2000) (the guide to the format of the opposition should not to be used as a form to be filled in and returned to the Board).

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"Opposition No. \_\_\_\_\_" or "Cancellation No. \_\_\_\_\_" (the Board will insert, in the blank space, the number assigned to the proceeding).

**Title of Paper:** The title should describe the nature of the paper (i.e., "Notice of Opposition" or "Petition to Cancel").

**Plaintiff information:** The complaint should also include plaintiff's name, entity type (i.e., individual, partnership, corporation, association, etc.), and business address; the names of the partners, if the plaintiff is a partnership, or the state or country of incorporation, if the plaintiff is a corporation.

**Registrant information in petition to cancel:** A petition to cancel should indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration.<sup>77</sup> Petitioner may comply with this requirement simply by furnishing the Board with whatever information it has concerning the name and address of the current owner of the registration; a special investigation made solely for purposes of complying with the rule is not necessary. The purpose of the requirement is to provide the Board with whatever information petitioner may have concerning the name and address of the current owner of the registration, so that the Board can notify that party of the filing of the petition.<sup>78</sup> If petitioner has no information concerning the name and address of the current owner of the registration, petitioner may simply use the name and address of registrant stated on the registration certificate.

**Substance of complaint:** The complaint must also include a pleading of the substance (i.e., standing and grounds) of the complaint.<sup>79</sup>

**Signature:** The complaint must be signed and include a description of the capacity in which the signing individual signs.<sup>80</sup>

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<sup>77</sup> See 37 CFR § 2.112(a). See also *Informix Software Inc. v. Oracle Corp.*, 40 USPQ2d 1153, 1155 (N.D. Cal. 1996) (the proper defendant in suit for cancellation of a registration is the owner of that registration, not an exclusive licensee).

<sup>78</sup> Cf. TBMP §§ 310.01 (Notification of Proceeding) and 310.02 (Defendant's Copy Returned).

<sup>79</sup> See TBMP § 309.03 (Substance of Complaint).

<sup>80</sup> See TBMP § 309.02 (Form of Complaint).

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### 309.02(b) Signature

The complaint need not be verified, and it may be signed by the plaintiff or by the plaintiff's attorney or other authorized representative.<sup>81</sup> If an attorney signs the complaint, it need not be accompanied by a written power of attorney, but if a written power of attorney is filed, the plaintiff must sign it. If a plaintiff signing for itself is a partnership, the signature must be made by a partner. If a plaintiff signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the plaintiff who has authority to sign for the plaintiff and whose title is given. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as plaintiff, if plaintiff is an individual; as counsel for plaintiff; as a partner of plaintiff, if plaintiff is a partnership; as an officer of plaintiff identified by title, if plaintiff is a corporation; etc.).

Although a complaint must be signed, an unsigned complaint will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the Board's letter notifying plaintiff of this defect.<sup>82</sup> However, Section 14 of the Act, 15 U.S.C. § 1064, limits, after a specified five-year period, the grounds on which certain Principal Register registrations may be cancelled.<sup>83</sup> If an unsigned petition to cancel such a registration is filed prior to the expiration of the five-year period, but a signed copy thereof is not filed until after the expiration of the period, the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after the expiration of the five-year period.<sup>84</sup> Although the Board makes every effort to notify petitioners of unsigned complaints before the expiration of any applicable statutory deadline, so that the informality may be corrected prior to the deadline, the

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<sup>81</sup> See 37 CFR §§ 2.101(b) and 2.111(b), and TBMP § 106.02 (Signature of Papers).

<sup>82</sup> See 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Papers).

<sup>83</sup> See Section 14 of the Act, 15 U.S.C. § 1064; 37 CFR § 2.111(b); and TBMP § 307.02(a) (Petition filed within 5 years).

<sup>84</sup> Cf., e.g., cases involving former requirement for verification, *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966) (the filing date of a petition to cancel is the date of receipt in the USPTO of the verified petition and filing fee); *Texas Instruments Inc. v. Conklin Instrument Corp.*, 161 USPQ 740, 741 (TTAB 1969) (unverified petition timely filed but ineffective; verified substitute petition untimely); TBMP § 308.02(b) (Insufficient Fee); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 329 (1985). Cf. also *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (timely payment of filing fee for statement of use is statutory and cannot be waived).

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Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time.<sup>85</sup>

### **309.02(c) Complaint Must Be Filed in Duplicate**

The complaint, and any exhibits thereto, must be filed in duplicate.<sup>86</sup> The complaint need not be served by the plaintiff on the defendant. Rather, the duplicate copy of the complaint, and any exhibits thereto, will be forwarded to the defendant by the Board itself.<sup>87</sup>

While a complaint must be filed "in duplicate," there is no requirement that one of the duplicates filed be the original. The duplicates may consist either of the original and one copy, or of two copies. However, all copies must be legible, and on good quality paper.<sup>88</sup>

### **309.03 Substance of Complaint**

*15 U.S.C. § 1068 [Section 18 of the Trademark Act] In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, ....*

*37 CFR § 2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. ...*

*37 CFR § 2.99(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

*37 CFR § 2.133(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

*37 CFR § 2.104(a) The opposition must set forth a short and plain statement showing why the opposer believes it would be damaged by the registration of the opposed mark and state the grounds for opposition. ...*

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<sup>85</sup> Cf. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (regarding rejection of renewal application); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (regarding rejection of statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

<sup>86</sup> See 37 CFR §§ 2.104(a) and 2.112(a).

<sup>87</sup> See 37 CFR §§ 2.105, 2.113, and 2.119(a).

<sup>88</sup> See TBMP § 106.03 (Form of Papers).

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**37 CFR § 2.112(a)** *The petition to cancel must set forth a short and plain statement showing why the petitioner believes it is or will be damaged by the registration, state the grounds for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration. ...*

### **309.03(a) In General**

#### **309.03(a)(1) Scope of Opposition and Petition to Cancel**

In an opposition, the registration sought by an applicant may be opposed in whole, or in part. Similarly, a petitioner may seek to cancel a registration in whole, or in part.<sup>89</sup> However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding.<sup>90</sup>

The Board is an administrative tribunal which is empowered to determine only the right to register; it may not determine the right to use, or broader questions of infringement or unfair competition (-- *see* TBMP § 102.01).

#### **309.03(a)(2) Elements of Complaint – In General**

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding (*see* TBMP §§ 303.03 and 309.03(b)), and (2) a short and plain statement of one or more grounds for opposition.<sup>91</sup>

Similarly, a petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing to maintain the proceeding -- *see*

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<sup>89</sup> *See* Section 18 of the Trademark Act, 15 U.S.C. § 1068. *See also* TBMP § 309.03(d).

<sup>90</sup> *See* 37 CFR §§ 2.99(h) and 2.133(c).

<sup>91</sup> *See* 37 CFR § 2.104(a); *Young v. AGB Corp.*, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) (standing and grounds are distinct inquiries; allegation of "economic damage" while relevant to standing does not constitute a ground); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985) (allegation of priority without direct or hypothetical pleading of likelihood of confusion is insufficient pleading of Section 2(d) ground). *Cf.* Fed. R. Civ. P. 8(a).

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TBMP §§ 303.03 and 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation.<sup>92</sup>

The elements of a claim should be stated simply, concisely, and directly.<sup>93</sup> However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim.<sup>94</sup>

All averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances.<sup>95</sup> Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded.<sup>96</sup> A paragraph may be referred to by number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint.<sup>97</sup>

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<sup>92</sup> See 37 CFR § 2.112(a); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992); and *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). Cf. Fed. R. Civ. P. 8(a).

For a discussion of the grounds for opposition and cancellation, see TBMP § 309.03(c) and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 20:13 et seq. (4<sup>th</sup> ed. 2001). For a discussion of the grounds upon which a Principal Register registration over five years old may be cancelled, see TBMP §§ 307.01 and 307.02. See also J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 20:52 et seq. (4<sup>th</sup> ed. 2001).

<sup>93</sup> See Fed. R. Civ. P. 8(e)(1).

<sup>94</sup> See *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985) (petitioner's Section 2(a) allegations were merely conclusory and unsupported by factual averments). See also *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (since purpose of pleadings is to give fair notice of claims Board may in its discretion decline to strike even objectionable pleadings where their inclusion will not prejudice adverse party but rather will provide fuller notice of basis for claim); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1471 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328, 1330 (TTAB 1994) (although pleading need not allege particular "magic words" pleading of mere descriptiveness in this case could not be logically interpreted as asserting that applicant is not the owner of the mark); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (since function of pleadings is to give fair notice of claim, a party is allowed reasonable latitude in its statement of its claims); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

<sup>95</sup> See Fed. R. Civ. P. 10(b) and *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 794 (TTAB 1974) (while paragraphs were numbered, none of the paragraphs were limited to a statement of a single set of circumstances).

<sup>96</sup> See Fed. R. Civ. P. 10(b).

<sup>97</sup> See Fed. R. Civ. P. 10(b) and (c).

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A plaintiff may state as many separate claims as it has, regardless of consistency; a plaintiff may also set forth two or more statements of a claim alternatively or hypothetically, either in one count or in separate counts.<sup>98</sup>

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient.<sup>99</sup>

Evidentiary matters (such as, for example, lists of publications or articles in which a term sought to be registered by an applicant is alleged to be used descriptively) should not be pleaded in a complaint. They are matters for proof, not for pleading.<sup>100</sup>

In inter partes proceedings before the Board, as in civil cases before the United States district courts, all pleadings are so construed as to do substantial justice.<sup>101</sup>

### 309.03(b) Standing

Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint.<sup>102</sup> At the pleading stage, all that is required is that a plaintiff allege

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<sup>98</sup> See Fed. R. Civ. P. 8(e)(2); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, notwithstanding that it is the senior user, because the subject registration has been cited as a reference by the Examining Attorney). See also, *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before Examining Attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as basis for standing).

<sup>99</sup> See Fed. R. Civ. P. 8(e)(2).

<sup>100</sup> See *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959). Cf. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (if evidentiary facts are pleaded, and they aid in giving a full understanding of the complaint as a whole, they need not be stricken).

<sup>101</sup> See 37 CFR § 2.116(a); Fed. R. Civ. P. 8(f); and *The Scotch Whiskey Association v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991).

<sup>102</sup> See Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, and TBMP § 303 (Who May Oppose or Petition).

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facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis for its belief of damage.”<sup>103</sup> To plead a “real interest,” plaintiff must allege a “direct and personal stake” in the outcome of the proceeding.<sup>104</sup> The allegations in support of plaintiff’s belief of damage must have a reasonable basis “in fact.”<sup>105</sup>

Allegations in support of standing which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial (or on summary judgment).<sup>106</sup>

However, there is no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in an opposition or cancellation proceeding.<sup>107</sup>

A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads (and later proves):

A claim of likelihood of confusion that is not wholly without merit;<sup>108</sup>

Plaintiff has been refused registration of its mark because of defendant’s registration, or has been advised that it will be refused registration when defendant’s application matures into a registration, or has a reasonable belief that registration of its application will be refused because of defendant’s registration;<sup>109</sup>

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<sup>103</sup> *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). See also *Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) and *International Order of Job’s Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984).

<sup>104</sup> *Ritchie v. Simpson*, *supra* at 1026. See also *Lipton Industries, Inc. v. Ralston Purina Co.*, *supra*.

<sup>105</sup> *Ritchie v. Simpson*, *supra* at 1027 (citing *Universal Oil Products v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972) and stating that the belief of damage alleged by plaintiff must be more than a subjective belief).

<sup>106</sup> See *Ritchie v. Simpson*, *supra* at 1029 citing *Lipton Industries, Inc. v. Ralston Purina Co.*, *supra*. See also, e.g., *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (at final decision, inquiry is not whether pleading of standing is sufficient but whether allegations have been proven).

<sup>107</sup> See TBMP § 303.03 (Meaning of “Damage”), and cases cited therein.

<sup>108</sup> See *Lipton Industries*, *supra*; *Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1209 (TTAB 1993); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 1326, 217 USPQ 641, 648 (Fed. Cir. 1983); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002); *The Nestle Company Inc. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1087 (TTAB 1987); and *Liberty Trousers Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983) (allegation of likelihood of confusion accepted as proper allegation of petitioner’s standing with respect to pleaded grounds of fraud and abandonment).

<sup>109</sup> See *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1300 (TTAB 2000) and *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990).

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Plaintiff has a bona fide intent to use the same mark for related goods, and is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of respondent's registration;<sup>110</sup>

Defendant has relied on its ownership of its application or registration in another proceeding between the parties, or defendant has asserted a likelihood of confusion in another proceeding between the parties involving the same marks.<sup>111</sup>

A counterclaimant's standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding.<sup>112</sup>

A plaintiff need not assert proprietary rights in a term in order to have standing.<sup>113</sup> For example, when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its standing by alleging that it is engaged in the sale or the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using the term descriptively in its business.<sup>114</sup>

### 309.03(c) Grounds

In addition to standing, a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition or cancellation.<sup>115</sup> A plaintiff may raise any available statutory

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<sup>110</sup> See *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

<sup>111</sup> See *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 859 (TTAB 1986) (petitioner has standing to cancel registration that has been asserted, even defensively, in a civil action) and *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984).

<sup>112</sup> See *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1881 (TTAB 1990); and *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987); and *General Mills, Inc. v. Natures Way Products*, 202 USPQ 840, 841 (TTAB 1979) (counterclaimant's position as defendant in the opposition gives him a personal stake in the controversy). See also TBMP § 313.03 (Form of Counterclaim).

<sup>113</sup> See *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1496 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); and *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987) ("This is true irrespective of the grounds upon which the opposer relies in asserting the nonregistrability of applicant's mark").

<sup>114</sup> See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, *supra* at 2024; *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); and *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

<sup>115</sup> See *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

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ground for opposition or cancellation that negates the defendant's right to registration.<sup>116</sup> Grounds for petitions to cancel a Principal Register registration that is more than 5 years old are more limited and are specified in Sections 14(3) and (5) of the Act, 15 U.S.C. §§ 1064(3) and 1064(5).<sup>117</sup>

A plaintiff cannot rely upon an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.<sup>118</sup>

Examples of available grounds for opposition and for cancellation are listed below. [NOTE: The grounds identified in examples 3 and 4, and 12 through 14 are available for cancellation of a Principal Register registration over five years old.] This list is exemplary, not exhaustive.

(1) Section 2(d) of the Act, 15 U.S.C. § 1052(d): That defendant's mark so resembles a mark registered in the USPTO, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.<sup>119</sup>

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<sup>116</sup> See *Young v. AGB Corp.*, *supra* at 1754; *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 (TTAB 1991); *Marmark Ltd. v. Nutrexp S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); and *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, n.10 (TTAB 1984) (Board cannot decline to consider an issue because it is ex parte in nature). See also TBMP § 102.01 (Jurisdiction of Board) and cases cited therein.

*Cf. Young v. AGB Corp.*, *supra* at 1755 (Fed. Cir. 1998) ("economic damage" is not a ground for opposition although it is relevant to issue of opposer's standing); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (laches and acquiescence are affirmative defenses, not grounds for opposition); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (opposer's failure to submit copy of the foreign registration, which was the basis for issuance of opposer's pleaded registration, was an examination error and did not constitute a ground for counterclaim); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n.39 (TTAB 1994) (equitable defenses are not grounds for opposition); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, per se, does not constitute grounds for cancellation; the proper ground for cancellation is that the term has not been used as a mark) and *Century 21 Real Estate Corp. v. Century Life of America*, 11 USPQ2d 1355, 2035 (TTAB 1989) ("it is not the adequacy of the specimens, but the underlying question of service mark usage which would constitute a proper ground for opposition").

<sup>117</sup> See TBMP § 307.01 (Petition That May be Filed at Any Time).

<sup>118</sup> See TBMP § 314 (Unpleaded Matters).

<sup>119</sup> See, e.g., *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

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(2) The grounds specified in Section 2(e) of the Act, 15 U.S.C. § 1052(e); for example, that defendant's mark, when used on or in connection with the goods or services of the defendant, is merely descriptive or deceptively misdescriptive of them,<sup>120</sup> or that defendant's mark is primarily geographically descriptive<sup>121</sup> or primarily geographically deceptively misdescriptive of them,<sup>122</sup> and that defendant's mark is primarily merely a surname.<sup>123</sup>

(3) The grounds specified in Section 2(a) of the Act, 15 U.S.C. § 1052(a); for example, that defendant's mark is geographically deceptive,<sup>124</sup> that defendant's mark disparages members of a particular group,<sup>125</sup> or that defendant's mark falsely suggests a connection with plaintiff's name or identity.<sup>126</sup>

(4) That defendant's product design is de jure functional, and if not de jure functional, that the product design has not acquired distinctiveness.<sup>127</sup>

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<sup>120</sup> See Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). See also, e.g., *The Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (deceptive misdescriptiveness) and *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919 (TTAB 2002) (mere descriptiveness).

<sup>121</sup> See Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2). See also, e.g., *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ 1385 (TTAB 1994).

<sup>122</sup> See Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3). See also *In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003); *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); and *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

<sup>123</sup> See Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4). See also e.g., *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 391-92 (TTAB 1979); and *Food Specialty Co. v. Carnation Co.*, 170 USPQ 522, 523 (TTAB 1971).

<sup>124</sup> See, e.g., *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d 1894 (TTAB 1992) (mark's geographic deceptiveness must be established as of the time the registration issues). Cf. *K-Swiss Inc. v. Swiss Army Brands Inc.*, 58 USPQ2d 1540, 1543 (TTAB 2001) (can be cancelled if a registrant, through its own actions, causes its mark to become geographically deceptive subsequent to the issuance of the registration).

<sup>125</sup> See, e.g., *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (women in general and African American women in particular); *Order Sons of Italy in America v. The Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (members of plaintiff's Order and Italian-Americans in general); and *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Native Americans).

<sup>126</sup> See, e.g., *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) and *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

<sup>127</sup> See Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), and, e.g., *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001). See also, e.g., *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002).

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- (5) That there was no bona fide use of defendant's mark in commerce prior to the filing of the use-based application for its registration under Section 1(a) of the Act, 15 U.S.C. § 1051(a).<sup>128</sup>
- (6) That defendant did not have a bona fide intent to use the mark in connection with the identified goods/services as of the filing date of the application.<sup>129</sup>
- (7) That defendant's mark is a mere background design that does not function as a mark separate and apart from the words displayed thereon.<sup>130</sup>
- (8) That defendant is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark.<sup>131</sup>
- (9) That defendant's mark, consisting of a particular color combination applied to its goods, is ornamental and has not become distinctive as an indication of the source of defendant's goods.<sup>132</sup>
- (10) That the term for which registration is sought or for which registration has been obtained has not been used as a trademark or service mark.<sup>133</sup>

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<sup>128</sup> See, e.g., *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *Paramount Pictures Corp. v. White*, 31 USPQ 1768 (TTAB 1994) *aff'd (unpub'd)* 108 F.3d 1392 (Fed. Cir. 1997) ("use in commerce" involves the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542, 558 (TTAB 1983); and *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537, 543 (TTAB 1983).

<sup>129</sup> See, e.g., *Lane Ltd. V. Jackson International Trading Co.*, 33 USPQ2d 1351, 1352 (TTAB 1994) and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1504 (TTAB 1993).

<sup>130</sup> See, e.g., *General Foods Corp. v. Ito Yokado Co., Ltd.*, 219 USPQ 822, 825 (TTAB 1983).

<sup>131</sup> See, e.g., *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990); and *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327, 328 (TTAB 1976). Cf., e.g., *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) (where opposer was asserting that applicant's mark is a descriptive term which cannot be owned exclusively by anyone, rather than alleging that someone other than applicant is the owner of the term as a mark).

<sup>132</sup> See, e.g., *Goodyear Tire & Rubber Co. v. Vogue Tyre & Rubber Co.*, 47 USPQ2d 1748 (TTAB 1998) and *Kassnar Imports v. Plastilite Corp.*, 180 USPQ 156, 157 (TTAB 1973), *aff'd sub nom.*, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975).

<sup>133</sup> See, e.g., *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland, Inc.*, 29 USPQ2d 1146 (TTAB 1993) (allegation that slogan was used as mere advertising and not as a trademark) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989).

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- (11) That defendant's mark represents multiple marks in a single application (or registration) ("phantom mark").<sup>134</sup>
- (12) That defendant's mark has been abandoned due to nonuse;<sup>135</sup> or due to a course of conduct that has caused the mark to lose significance as an indication of source.<sup>136</sup>
- (13) That defendant's mark consists of or comprises the name of a particular living individual without the individual's consent.<sup>137</sup>
- (14) That defendant's product design is generic.<sup>138</sup>
- (15) That defendant's mark would dilute the distinctive quality of plaintiff's famous mark.<sup>139</sup>

The following is a brief discussion of the elements of a claim of likelihood of confusion, the most frequently encountered issue in Board inter partes proceedings.

Pursuant to Section 2(d) of the Act, 15 U.S.C. § 1052(d), plaintiff must assert, and then prove at trial, that defendant's mark, as applied to its goods or services, so resembles plaintiff's previously

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<sup>134</sup> See, e.g., *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres*, 56 USPQ2d 1538 (TTAB 2000). See also *In re International Flavors & Fragrances Inc.*, 47 USPQ2d 1314 (TTAB 1998) *aff'd* 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999).

<sup>135</sup> See, e.g., *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. V. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); and *Auburn Farms, Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1998).

<sup>136</sup> See, e.g., *Woodstock's Enterprises Inc. v. Woodstock's Enterprises Inc.*, 43 USPQ2d 1440 (TTAB 1997), *aff'd* (*unpub'd*), Appeal No. 97-1580 (Fed. Cir. Mar. 5, 1998).

<sup>137</sup> See Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c). See also *Ross v. Analytical Technology, Inc.*, 51 USPQ2d 1269 (TTAB 1999) (plaintiff must establish that the "name," as used on the goods or services, points uniquely to plaintiff as a "particular living individual") and *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (party asserting Section 2(c) ground must have cognizable or proprietary right in the name).

<sup>138</sup> See *Sunrise Jewelry Mfg. Corp. v. Fred, S.A.*, 175 F.3d 1322, 50 USPQ2d 1532 (Fed. Cir. 1999) (the term "generic name" as used in 15 U.S.C. § 1064(3) includes trade dress such as product design or configuration).

<sup>139</sup> See Sections 13(a) and 14 of the Trademark Act, as amended, 15 U.S.C. §§ 1063(a) and 1064, as amended, and *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). See also *Moseley v. Secret Catalogue Inc.*, 537 US 418, 65 USPQ2d 1801 (2003) and, for example, *Enterprise Rent-A-Car Company v. Advantage Rent-A-Car, Inc.*, 82 USPQ2d 1857 (TTAB 2002), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003).

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used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception.

### A. Priority

A plaintiff must plead (and later prove) priority of use. In order to properly assert priority, a plaintiff must allege facts showing proprietary rights in its pleaded mark that are prior to defendant's rights in the challenged mark.<sup>140</sup> Such rights may be shown by, for example, ownership of an application with a filing date (or a registration with an underlying application filing date) prior to any date of first use on which defendant can rely,<sup>141</sup> prior trademark or service mark use,<sup>142</sup> or prior use analogous to trademark or service mark use.<sup>143</sup>

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<sup>140</sup> See *Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 7 USPQ2d 1628, 1632 (Fed. Cir. 1988); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996); *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549 (TTAB 1994); *Jimlar Corporation v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216 (TTAB 1992); and *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352 (TTAB 1981) (proprietary right is a right residing in owner of mark and those in privity).

<sup>141</sup> See *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995) (owner of an intent-to-use application may rely on its application filing date as a constructive use date for purposes of priority); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991). See also *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (if the underlying application filing date of petitioner's pleaded registration was earlier than the filing date of respondent's underlying application, petitioner could take its chances and elect to make of record simply a copy of its registration as proof of first use as of the filing date of the underlying application); *American Standard Inc. v. AQM Corporation*, 208 USPQ 840, 842 (TTAB 1980); and *Gor-Ray Limited v. Garay & Co., Inc.*, 167 USPQ 694 (TTAB 1970) (a cancellation petitioner is entitled to rely on the filing date of its pleaded registration as prima facie evidence of its first use of the mark).

<sup>142</sup> See *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (interstate or intrastate commerce is sufficient) and *Jimlar Corporation v. The Army and Air Force Exchange Service*, 24 USPQ 1216, 1221 (TTAB 1992).

<sup>143</sup> See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996) (must show that the activities claimed to constitute analogous use have had "substantial impact" on the purchasing public); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993) (trade name use); *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) (trade name use); *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993) (priority of use against ITU application may be established with prior use analogous to trademark use) and *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, *supra* (owner of ITU application may rely on prior use analogous to trademark use).

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However, priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark,<sup>144</sup> provided that any counterclaim or separate petition to cancel the pleaded registration by the applicant is ultimately dismissed and the registration remains uncanceled.<sup>145</sup>

A plaintiff may be permitted to assert the proprietary rights or registration(s) of a third-party as a basis for a Section 2(d) ground if plaintiff can show a legitimate interest in preventing confusion between the pleaded mark(s) and the defendant's mark.<sup>146</sup>

### B. Likelihood of Confusion

The evidentiary factors the Board considers in determining likelihood of confusion are set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). These factors include the similarity of the marks, the relatedness of the goods and/or services, the channels of trade and classes of purchasers for the goods and/or services, the number and nature of similar marks in use on similar goods, the nature and

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<sup>144</sup> See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); ("Board must consider existing registrations of subsequent-user opposers because ... [Section 2(d) provides that] an applicant can register, unless his mark is likely to cause confusion with a mark 'registered in the Patent Office or \* \* \* previously used \* \* \*'..."); *SCOA Industries, Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 413 (TTAB 1975), appeal dismissed, 189 USPQ 15 (CCPA 1976); and *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280 (TTAB 1998).

*Cf.*, regarding cancellation proceedings, *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (in a cancellation proceeding the registrations of each party offset each other and petitioner must, in the first instance, establish prior rights); *SCOA Industries, Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 413 (TTAB 1975); and *American Standard Inc. v. AQM Corp.*, *supra* at 841 (priority must be proven in cancellation proceeding).

<sup>145</sup> See, e.g., *Contour Chair-Lounge Co., Inc. v. The Englander Company, Inc.*, 139 USPQ 285, 286 (CCPA 1963) (as long as a registration relied on by an opposer remains uncanceled, it will be treated as valid and entitled to all statutory presumptions; having dismissed petition to cancel pleaded registrations, and since no appeal was taken, Board was obligated to treat opposer's registrations as valid and as though no such petition had been filed). *Cf. Penguin Books Ltd. v. Eberhard, supra* (petition or counterclaim to restrict the scope of goods in registration under Section 18 of the Trademark Act was not a collateral attack on the validity of that registration).

*Note:* In cases where a plaintiff has relied on its ownership of a pleaded registration, any counterclaim or petition to cancel that registration is normally decided before the issues in the underlying opposition. See, for example, *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1328 (TTAB 1992) and *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1272 (TTAB 1992).

<sup>146</sup> See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1632 (Fed. Cir. 1988) (interest of trade association found sufficient); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) (petitioners failed to allege that they, or anyone else, possessed proprietary rights in the term); and *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549, 1552 (TTAB 1994) (no legitimate interest in preventing confusion alleged).

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extent of any actual confusion, and the fame of the prior mark.<sup>147</sup> The relevance and weight to be given the various factors may differ from case to case.<sup>148</sup>

**Direct or Hypothetical Pleading of Likelihood of Confusion:** A plaintiff may plead likelihood of confusion directly or hypothetically.<sup>149</sup> A hypothetical pleading may consist of assertions that if, as the Trademark Examining Attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then plaintiff will be damaged by the registration of defendant's mark.<sup>150</sup> Of course, in order to state a claim upon which relief can be granted, a hypothetical pleading of likelihood of confusion must be coupled with a pleading of one or more grounds for opposition or cancellation, such as, that defendant's mark has been abandoned; that plaintiff has priority of use (here, the hypothetical pleading of likelihood of confusion serves both as a pleading of plaintiff's standing and as part of the pleading of a ground under Section 2(d) of the Act, 15 U.S.C. §1052(d)); etc. Thus, a plaintiff wishing to plead likelihood of confusion hypothetically in a proceeding based upon Section 2(d) might assert, for example, that if, as the Trademark Examining Attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then the registration sought by defendant should be refused (or defendant's registration should be cancelled) because plaintiff has priority of use.<sup>151</sup>

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<sup>147</sup> See *In re E.I. du Pont de Nemours & Co.*, *supra* and, e.g., *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002).

<sup>148</sup> *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992). See *Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) and *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1800 (TTAB 2001).

<sup>149</sup> See Fed. R. Civ. P. 8(e)(2).

<sup>150</sup> See *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1978).

<sup>151</sup> See *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runclin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, notwithstanding that it is the senior user, because the subject registration has been cited as a reference by the Examining Attorney). See also, *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before Examining Attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

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**309.03(d) Remedy Under Section 18 (Partial Opposition or Partial Cancellation)**

*15 U.S.C. § 1068 [Section 18 of the Trademark Act] In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings....*

*37 CFR § 2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. ...*

*37 CFR § 2.133(b) If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party.*

*37 CFR § 2.99(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

*37 CFR § 2.133(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

Under Section 18 of the Trademark Act, 15 U.S.C. § 1068, the Board has the authority to cancel registrations in whole or in part, to restrict the goods or services identified in an application or registration, or to "otherwise restrict or rectify...the registration of a registered mark."<sup>152</sup> (However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding).<sup>153</sup>

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<sup>152</sup> See Section 18 of the Trademark Act, 15 U.S.C. § 1068; 37 CFR §§ 2.111(b) and 2.133(b); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 (TTAB 1998); and *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1994).

<sup>153</sup> See 37 CFR §§ 2.99(h) and 2.133(c), and *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

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For example, a plaintiff may seek to partially cancel a registration, or partially oppose registration only as to specific items in the identification of goods or services, or only to the extent of restricting the goods or services in a particular manner in terms of type, use, customers, trade channels, etc.<sup>154</sup>

A claim in which the plaintiff seeks to delete specific items on the grounds that the defendant is no longer using, and has no intent to resume use of its mark on those goods or services, is essentially a "straightforward" pleading of abandonment.<sup>155</sup>

A claim in which the plaintiff seeks to restrict or modify the goods or services in a particular manner, that is, by the addition of wording that identifies the goods or services with greater particularity in terms of type, use, channels of trade, etc., is in the nature of an equitable remedy under Section 18 and does not require pleading and proof of specific grounds for cancellation or opposition, such as abandonment.<sup>156</sup> However, the Board will not permit an action to restrict or modify the goods or services in this manner where such a claim is divorced from the question of likelihood of confusion.<sup>157</sup> Thus, a party seeking to restrict an opponent's broadly worded identification of goods or services, in a case involving likelihood of confusion, must plead and prove that (i) the entry of a proposed restriction to the goods or services in its opponent's application or registration will avoid a finding of likelihood of confusion and (ii) the opponent is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered.<sup>158</sup>

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<sup>154</sup> See *DAK Industries Inc. v. Daiichi Kosho*, 35 USPQ2d 1434, 1437 (TTAB 1995) and *Eurostar*, *supra* at 1270.

<sup>155</sup> *DAK*, *supra* at 1437 (because applicant sought to strike from opposer's registration goods specifically listed therein, such as "open reel audio tape" it was proper to plead abandonment and applicant did not need to plead that a finding of likelihood of confusion will be avoided by the restriction it sought). See also *Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996) (respondent's counterclaim alleging that it may have prior use of the mark in the trade channels sought to be excluded in petitioner's registration, was legally insufficient pleading of either likelihood of confusion or abandonment because likelihood of confusion is not available ground for cancellation of registration over five years old and because a counterclaim to restrict an identification of goods, as opposed to a counterclaim to delete specific identified items, is not a proper claim of abandonment).

<sup>156</sup> See *Eurostar*, *supra* at 1271, and 1271 n.3. See also *DAK*, *supra* at 1437.

<sup>157</sup> See *DAK*, *supra* at 1437 and *Eurostar*, *supra* at 1270. [**Note:** To the extent that cases decided prior to *Eurostar* permitted a restriction petition in the absence of a pleading that the restriction sought will avoid a likelihood of confusion, and to the extent that those cases required the pleading and proof of a separate ground of nonuse or abandonment, those cases were expressly overruled by *Eurostar*.]

<sup>158</sup> See *Eurostar*, *supra* at 1270. See also, for example, *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (applicant's attempt to restrict opposer's registration for computer programs to "computer programs except computer programs for maintenance management" was rejected as it did not serve to avoid likelihood of confusion since proposed restriction failed to delineate different users or different channels of trade).

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In considering a restriction of a registration, the Board will look to the nature of the use made by registrant as of the time the restriction is sought, not as of the time registration was sought.<sup>159</sup>

A petition to partially cancel a registration by restricting the goods or services in a particular manner in terms of type, use, channels of trade, etc., in order to avoid a likelihood of confusion can be made against registrations over 5 years old as well as those less than 5 years old.<sup>160</sup> Such claim is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration.<sup>161</sup>

A petition to restrict or clarify the description of a mark in a registration would fall under the provision giving Board authority to "restrict or rectify" the register.<sup>162</sup> As in the case of a petition to restrict goods or services, a proper pleading to restrict the description of a mark could include allegations that, for example, the description of the mark in the registration is ambiguous or overly broad and not specific to the mark actually used by the defendant, and that the limitation would avoid a finding of a likelihood of confusion.<sup>163</sup>

That same provision, along with the authority to "register the mark...for the person...entitled thereto," allows the Board to correct, respectively, a registration or application, to identify the true owner, if such correction is warranted.<sup>164</sup>

As in the case of any other claim, a claim for partial opposition or partial cancellation ordinarily should be asserted prior to trial in order to give the defendant fair notice thereof.<sup>165</sup> In addition, the claim must be specific in nature so that the defendant has fair

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<sup>159</sup> See *Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996).

<sup>160</sup> See *Eurostar*, *supra* at 1271 n.3.

<sup>161</sup> See, for example, *Penguin Books Ltd. v. Eberhard*, *supra* at 1286 (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

<sup>162</sup> See *Wellcome Foundation Ltd*, *supra* at 1479.

<sup>163</sup> See *Wellcome Foundation Ltd.*, *supra* at 1479-80.

<sup>164</sup> See *8440 LLC v. Midnight Oil Company*, 59 USPQ2d 1541 (TTAB 2001) (Board where the record showed that plaintiff, rather than defendant, was the true owner of the marks in the challenged application and registration and where the parties filed a joint motion that registration be issued in the name of plaintiff and that the register be rectified to show plaintiff as the owner of the existing registration, Board exercised authority under Section 18 and granted motion).

<sup>165</sup> See *Penguin Books Ltd.*, *supra* (restriction proposed for first time in reply brief untimely); *Eurostar*, *supra*; and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 n.10 (TTAB 1990) (petitioner's request to restrict

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notice of the specific restriction being sought.<sup>166</sup> Any claim that is not pleaded in the complaint, as originally filed or as amended (or deemed amended) pursuant to Fed. R. Civ. P. 15(a) or 15(b), will not be entertained by the Board.<sup>167</sup>

A defense which seeks to restrict a plaintiff's pleaded registration will not be entertained in the absence of a timely counterclaim, or separate petition, to cancel the registration in whole or in part.<sup>168</sup>

*For information on a request by defendant to restrict its identification of goods or services under Section 18, see TBMP §§ 311.02(b); 507 (Motion to Amend Pleading) and 514 (Motion to Amend Application or Registration).*

*For information concerning the extent of default for failure to file an answer to a claim for partial opposition or cancellation, see TBMP § 312.01.*

### 309.04 Defects in Complaint That May Affect Institution of Proceeding

No proceeding will be instituted, the opposition papers will be returned, and any filing fee submitted therewith will be refunded in the following circumstances:

- (1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake, no proceeding will be

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channels of trade for respondent's goods denied when raised at end of rebuttal period). *See also* TBMP §§ 309.03 (Substance of Complaint), 314 (Unpleaded Matters) and 507 (Motion to Amend Pleading).

<sup>166</sup> *See Eurostar, supra* at 1272 (party that seeks to restrict a registration or application should state with as much precision as possible the restriction it seeks, so that the issue is properly framed for trial); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1749 (TTAB 1992) (counterclaim failed to specify the least restrictive language applicant would accept); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (counterclaim that opposer's registration should be amended "to accurately describe the services" was vague); and *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 (TTAB 1985).

<sup>167</sup> *See Eurostar, supra*, and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 n.10 (TTAB 1990) (petitioner's request to restrict channels of trade for respondent's goods denied when raised at end of rebuttal period). *See also* TBMP §§ 309.03 (Substance of Complaint), 314 (Unpleaded Matters) and 507 (Motion to Amend Pleading).

<sup>168</sup> *See* TBMP § 313.01 (Counterclaims).

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instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.<sup>169</sup>

(2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the *Official Gazette* for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively), no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.<sup>170</sup>

(3) If an opposition is filed after the time for opposing has expired; or is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee, and the fee is not submitted within the time allowed by the Board; or if the opposed application was abandoned before the opposition was filed.<sup>171</sup>

Proceedings will be instituted and the filing fee charged in the following circumstances:

(1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Section 14 of the Act of 1946, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Any fee submitted therewith will not be refunded.

(2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (e.g., the time for filing an affidavit of use under Section 8 of the Act of 1946, 15 U.S.C. § 1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding), the proceeding will be instituted, and then dismissed as moot. Any fee submitted with the petition for cancellation will not be refunded.

(3) If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request ordinarily will be denied, and the proceeding will be instituted, unless there is a

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<sup>169</sup> See TBMP § 303.05 (Opposition filed during Extension of Time to Oppose).

<sup>170</sup> See TBMP §§ 306.03 (Premature Opposition) and 307.03 (Premature Petition to Cancel).

<sup>171</sup> See TBMP §§ 218 (Abandonment of Application); 306.04 (Late Opposition); 309.02(b) (Signature); and 308 (Filing Fees).

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defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

When a proceeding is erroneously instituted, the proceeding will be dismissed as a nullity, rather than vacated, so as to maintain the integrity of the proceeding numbers. The Board will retain all papers.

### **310 Notification of Proceeding and Setting Time to Answer**

#### **310.01 Notification of Proceeding**

##### ***37 CFR § 2.105 Notification of opposition proceeding[s].***

*When an opposition in proper form has been filed and the correct fee(s) have been submitted, a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the opposer, if any, or to the opposer. The duplicate copy of the opposition and exhibits shall be forwarded with a copy of the notification to the attorney or other authorized representative of the applicant, if any, or to the applicant.*

##### ***37 CFR § 2.113 Notification of cancellation proceeding.***

*When a petition for cancellation has been filed in proper form (see §§ 2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the petitioner, if any, or to the petitioner. The duplicate copy of the petition for cancellation and exhibits shall be forwarded with a copy of the notification to the respondent (see § 2.118), who shall be the party shown by the records of the Patent and Trademark Office to be the current owner of the registration or registrations sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration or registrations. When the party identified by the petitioner, pursuant to § 2.112(a), as the current owner of the registration or registrations is not the record owner thereof, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner, which may file a motion to be joined or substituted as respondent. If the petition is found to be defective as to form, the party filing the petition shall be so advised and allowed a reasonable time for correcting the informality.*

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When a timely opposition in proper form has been filed, and the required fee has been submitted, the Board obtains the file of the opposed application and sets up an opposition proceeding file.<sup>172</sup> The defendant in the opposition is the party shown by the records of the USPTO to be the current owner of the opposed application, except that the Board, in its discretion, may join or substitute as defendant a party which makes a showing of a current ownership interest in the application.<sup>173</sup> When a timely petition to cancel in proper form, together with the required fee, has been filed (*see* 37 CFR §§ 2.111(a) and 2.113), the Board obtains the file of the registration sought to be cancelled and checks the assignment records of the USPTO to determine whether there is any recorded assignment of the registration, and, if so, the identity of the assignee. After the title search has been completed, the cancellation proceeding file is set up.<sup>174</sup> The defendant in the cancellation proceeding is the party shown by the records of the USPTO to be the current owner of the registration sought to be cancelled, except that the Board, in its discretion, may join or substitute as defendant a party which makes a showing of a current ownership interest in the registration.<sup>175</sup>

Next, the Board prepares a letter wherein it, *inter alia*, notifies the defendant of the filing of the complaint, and notifies both parties of the formal institution of the proceeding. The notification letter includes the identification information described in 37 CFR § 2.105, for an opposition, or in 37 CFR § 2.113, for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice and specifies the due date for the filing of defendant's answer to the complaint. The notice also includes a trial order specifying the opening and closing dates for the discovery period and assigning each party's time for taking testimony.<sup>176</sup>

One copy of the notification letter is mailed to the attorney or other authorized representative of the plaintiff, or, if the plaintiff is representing itself, to the plaintiff itself. In an opposition, a second copy of the letter is mailed, together with a copy of the notice of opposition and any exhibits thereto, to the attorney or other authorized representative of the applicant, or, if the applicant is representing itself, to the applicant itself.<sup>177</sup> In a cancellation, a second copy of the notification letter is mailed, together with a copy of the petition to cancel and any exhibits

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<sup>172</sup> *See* 37 CFR § 2.105.

<sup>173</sup> *See* TBMP § 512 (Motion to Join). *Cf.* 37 CFR § 2.113.

<sup>174</sup> *Cf.* TBMP § 124 (Action by Assignee).

<sup>175</sup> *See* 37 CFR § 2.113, and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976). *Cf.* TBMP § 512 (Motion to Join or Substitute).

<sup>176</sup> *See* 37 CFR § 2.120(a). *An example of a trial order can be found in the Appendix of Forms.*

<sup>177</sup> *See* 37 CFR § 2.105 and *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 (TTAB 1993).

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thereto, to the respondent itself (even if there is an attorney or other authorized representative of record in the application file after the mark has registered).<sup>178</sup>

The reason why the complaint and notification letter are sent to the defendant's attorney or other authorized representative, if any, in an opposition, but are always sent to the defendant itself in a cancellation, is that any appearance or power of attorney (or designation of other authorized representative) of record in an application file at the time of the commencement of an opposition is considered to be effective for purposes of the proceeding, whereas any representation which may be of record in an application file after the mark has registered at the time of the commencement of a cancellation is not considered to be effective for purposes of the proceeding. Typically, a power of attorney in an application appoints the named attorney "to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration." That is, the power extends only up to the issuance and receipt of a registration. As a practical matter, the representation in an application file usually is, of necessity, current and active, whereas often the attorney or other authorized representative of record in a registration file has not taken any action on behalf of the client registrant for some years, may no longer represent registrant, may not know where registrant is currently located or may no longer be in practice, etc. However, if the Board is unable to locate the registrant for purposes of serving a copy of the complaint and notification letter on it, and the registration file reflects that an attorney or other authorized representative has appeared therein on registrant's behalf within the last five years or so, the Board will, if necessary, contact the attorney or other authorized representative and ask for information concerning registrant's current address.<sup>179</sup>

In a cancellation proceeding, if the party identified by the petitioner pursuant to 37 CFR § 2.112(a) as the current owner of the registration sought to be cancelled is not the record owner thereof, the Board will send to the alleged current owner a courtesy copy of the notification letter, together with a copy of the petition to cancel and any exhibits thereto. If the alleged current owner believes that it is, in fact, the current owner of the registration and wishes to defend the registration against the petition to cancel, it may file a motion, supported by a showing of its current ownership interest in the registration, to be joined or substituted as respondent.<sup>180</sup>

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<sup>178</sup> See 37 CFR § 2.113.

<sup>179</sup> See the Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34891, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 30.

<sup>180</sup> See 37 CFR § 2.113 and TBMP § 512 (Motion to Join or Substitute).

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### 310.02 Defendant's Copy of Complaint Returned as Undeliverable

If an applicant in an opposition is not represented by an attorney or other authorized representative, and the applicant's copies of the notice of opposition and notification letter are returned to the Board as undeliverable, the Board will make all reasonable efforts to locate the applicant. It should be noted, however, that it is the responsibility of an applicant representing itself to keep the USPTO informed of its current address. If the applicant fails to do so, and the Board is unable to locate the applicant, the Board will continue to send correspondence relating to the opposition to applicant's last-known address, and when applicant fails to file an answer to the notice of opposition, the opposition may be decided as in case of default.

If, in a cancellation proceeding, the respondent's copies of the petition to cancel and notification letter are returned to the Board as undeliverable, the Board will send a letter to the petitioner asking the petitioner for information concerning respondent's current address. If the petitioner files a response indicating that the respondent is no longer in business, notice of the filing of the petition to cancel will be published in the *Official Gazette*, pursuant to 37 CFR § 2.118. If the petitioner fails to file a response to the Board's letter, or files a response indicating that it is unable to furnish respondent's current address, the Board will make all reasonable efforts to locate the respondent.<sup>181</sup> If the Board is unable to locate the respondent after reasonable investigation, notice of the filing of the petition to cancel will be published in the *Official Gazette*.<sup>182</sup>

When notice of the filing of a petition to cancel is published in the *Official Gazette*, the published notice allows the respondent thirty days from the publication date thereof in which to appear in the cancellation proceeding. If respondent fails to appear within the time allowed, default judgment may be entered against respondent.

*For information concerning the procedure followed by the Board in a concurrent use proceeding when a communication sent by the Board to a specified excepted user is returned as undeliverable, see TBMP § 1105.*

### 310.03 Setting Time for Filing Answer

#### 310.03(a) In General

#### *37 CFR § 2.105 Notification of opposition proceeding[s].*

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<sup>181</sup> See the Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34891, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 30.

<sup>182</sup> See 37 CFR § 2.118.

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*When an opposition in proper form has been filed and the correct fee(s) have been submitted, a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. ...*

### **37 CFR § 2.113 Notification of cancellation proceeding.**

*When a petition for cancellation has been filed in proper form (see §§ 2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. ...*

Trademark Rules 2.105 and 2.113, 37 CFR §§ 2.105 and 2.113, provide, in part, that the Board's letter notifying a defendant of the filing of an opposition or petition to cancel "shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed." A defendant is under no obligation to file an answer to the complaint in an opposition or cancellation proceeding until it receives the Board's notification letter setting the time for filing an answer.<sup>183</sup> It is the general practice of the Board to allow the defendant in an opposition or cancellation proceeding 40 days from the mailing date of the notification letter in which to file its answer.

*For information on the time for filing an answer to a counterclaim, see TBMP § 313.06.*

### **310.03(b) Trademark Rule 2.119(c) 5-Day Addition Not Applicable to Deadlines Set by Board**

Trademark Rule 2.119(c), 37 CFR § 2.119(c), provides, in part, that "[w]hen a party is required to take some action within a prescribed period after the service of a paper on the party by another party and the paper is served by first-class mail, 'Express Mail' or overnight courier, 5 days shall be added to the prescribed period." This provision, by its very terms, applies only when a party has to take some action within a prescribed period after the service of a paper on it by another party (and service of the paper was made in one of three specified ways). It does not apply to an action that must be taken by a party within a time set in a communication from the Board.

Thus, when a Board letter notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the mailing date of the notification letter in which to file an answer to the complaint, the answer is due on or before the 40th day, not

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<sup>183</sup> See *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 (TTAB 1993).

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on the 45th day. Similarly, when the Board allows a counterclaim defendant 30 days from the mailing date of the Board's letter in which to file an answer to the counterclaim, the answer is due on or before the 30th day, not on the 35th day.

### **310.03(c) Extension of Time to File Answer**

The time for filing an answer may be extended or reopened by stipulation of the parties, approved by the Board, or on motion granted by the Board, or by order of the Board.<sup>184</sup>

## **311 Form and Content of Answer**

### **311.01 Form of Answer**

An answer to a notice of opposition or petition to cancel corresponds to an answer to a complaint in a court proceeding.<sup>185</sup>

The form for an answer is similar to a complaint. An answer should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name of the proceeding (e.g., "ABC Corporation v. XYZ Company"), the proceeding number (e.g., "Opposition No. 56,789" or Cancellation No. 12,345"), and a title describing the nature of the paper (e.g., "ANSWER," "ANSWER AND COUNTERCLAIM," etc.).<sup>186</sup>

An answer need not be verified, but it must be signed. The signature may be made by the defendant or by the defendant's attorney or other authorized representative.<sup>187</sup> If a defendant signing for itself is an individual, the individual must make the signature. If a defendant signing for itself is a partnership, a partner must make the signature. If a defendant signing for itself is a corporation, association, or similar juristic entity, the signature must be made by an individual who is an officer of defendant and who is authorized to represent it. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as defendant, if defendant is an individual; as counsel for defendant; as a partner of defendant, if defendant is a partnership; as an officer of defendant identified by title, if defendant is a corporation; etc.).

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<sup>184</sup> See Fed. R. Civ. P. 6(b), and TBMP § 509 (Motion to Extend Time).

<sup>185</sup> See 37 CFR § 2.116(c).

<sup>186</sup> See, for example, TBMP § 309.02(a) (Format for Complaint).

<sup>187</sup> See 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

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Although an answer must be signed, an unsigned answer will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the Board's letter notifying the defendant of this defect.<sup>188</sup>

The Board prefers that answers be submitted in typewritten or printed form, double-spaced. An answer should be submitted on letter-sized paper. While legal-sized paper is permitted, letter-size paper (the size preferred by many Federal district courts) is recommended.<sup>189</sup>

One copy of the answer, and any exhibits thereto, must be filed in the USPTO. Another copy of the answer, with any exhibits thereto, must be served by the defendant upon the attorney for the plaintiff, or on the plaintiff if there is no attorney. The answer must bear proof (e.g., a certificate of service, consisting of a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made) that such service has been made before the paper will be considered by the Board.<sup>190</sup>

*For information on the time for filing an answer, see TBMP § 310.03.*

### **311.02 Substance of Answer**

*37 CFR § 2.106(b)(1) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original notice of opposition or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.*

*(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer.*

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<sup>188</sup> See 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

<sup>189</sup> See TBMP § 106.03 (Form of Papers).

<sup>190</sup> See 37 CFR § 2.119(a), and TBMP § 113 (Service of Papers).

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*If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

*(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.*

**37 CFR § 2.114(b)(1)** *An answer shall state in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the respondent is without knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original petition for cancellation or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.*

*(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

*(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.*

**37 CFR § 2.133(d)** *A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.*

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### 311.02(a) Admissions and Denials

The defendant should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied.<sup>191</sup> If the defendant does not have sufficient information to admit or deny an allegation, the defendant may so state, and this statement will have the effect of a denial. If the complaint consists of numbered paragraphs setting forth the basis of plaintiff's claim of damage, the defendant's admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

A denial of an allegation should fairly meet the substance of the allegation denied, and may take any of the forms described in Fed. R. Civ. P. 8(b).<sup>192</sup> An answer that fails to deny a portion of an allegation may be deemed admitted as to that portion.<sup>193</sup> Thus, if a defendant intends in good faith to deny only a part or a qualification of an allegation, the defendant should admit so much of the allegation as is true and material and should deny only the remainder. If a defendant intends in good faith to controvert all of the allegations contained in a complaint, the defendant may do so by general denial, subject to the obligations set forth in Fed. R. Civ. P. 11 (for a discussion of Fed. R. Civ. P. 11 in relation to pleadings, see TBMP § 318). If a defendant does not intend in good faith to controvert all of the allegations contained in a complaint, the defendant may make its denials as specific denials of designated allegations or paragraphs, or may generally deny all the allegations except those designated allegations or paragraphs which are expressly admitted.

In the absence of a general denial of some or all of the allegations in a complaint, admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

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<sup>191</sup> See 37 CFR §§ 2.106(b)(1) and 2.114(b)(1); Fed. R. Civ. P. 8(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Turner Entertainment Co. v. Ken Nelson*, 38 USPQ2d 1942 (TTAB 1996) (applicant's answers were argumentative and nonresponsive and Board was ultimately forced to interpret the answer); *National Football League v. Jasper Alliance Corporation*, 16 USPQ2d 1212 (TTAB 1990) (applicant's answer was more in the nature of argument than answer); and *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 (TTAB 1985).

<sup>192</sup> See 37 CFR §§ 2.106(b)(1) and 2.114(b)(1). See also, for example, *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982) (regarding equivocal admissions or denials).

<sup>193</sup> See Fed. R. Civ. P. 8(d).

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### 311.02(b) Affirmative Defenses

An answer may also include a short and plain statement of any defenses that the defendant may have to the claim or claims asserted by the plaintiff.<sup>194</sup> These defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense.<sup>195</sup> They may also include a pleading that defendant is at least entitled to a registration with a particular restriction (described in the pleading in sufficient detail to give plaintiff fair notice of the basis for the defense);<sup>196</sup> except that geographic restrictions will be considered and determined by the Board only in the context of a concurrent use registration proceeding.<sup>197</sup> A request by defendant to restrict its identification of goods or services under Section 18 of the Trademark Act, 15 U.S.C. § 1068, must be made either by way of an affirmative pleading in the answer (as originally filed, or as amended, or deemed amended) or by way of motion under 37 CFR § 2.133, in order to be considered by the Board.<sup>198</sup>

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<sup>194</sup> See 37 CFR §§ 2.106(b)(1) and 2.114(b)(1), and Fed. R. Civ. P. 8(b).

<sup>195</sup> See 37 CFR §§ 2.106(b)(1) and 2.114(b)(1). See, for example, *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b) permits a defendant to assert in the answer the "defense" of failure to state a claim upon which relief can be granted).

See, e.g., with respect to estoppel, *Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (licensee estoppel); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (licensee estoppel); and *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel).

See, e.g., with respect to "Morehouse" defense, *Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969) (that defendant already owns a substantially similar registered mark for substantially similar goods and/or services such that the second registration (or second registration sought) causes no added injury to the plaintiff). See also *O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) (*Morehouse* defense).

See, e.g., with respect to prior judgment, *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492 (Fed. Cir. 2000) (res judicata); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000), (res judicata, claim preclusion); *Boston Chicken Inc. v. Boston Pizza International, Inc.*, 53 USPQ2d 1053 (TTAB 1999) (judicial estoppel); and *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990) (claim preclusion, issue preclusion).

Cf., e.g., *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001) (defendant not entitled to rely on asserted ownership of "family" of marks as defense to Section 2(d) claim).

<sup>196</sup> See 37 CFR § 2.133(a). Cf. 37 CFR §§ 2.133(b) and 2.133(c).

<sup>197</sup> See *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990). Cf. TBMP § 514 (Motion to Amend Application or Registration).

<sup>198</sup> See 37 CFR § 2.133(a) and (b). See also *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1125 (Fed. Cir. 1994) (Board had no duty to address defendant's offer to amend in final brief where defendant failed to file a motion or include as affirmative defense in pleading); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863, 1865 (TTAB 1991) (mere request by respondent in its trial brief to have its

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Equitable defenses may not be available against certain grounds for opposition or cancellation or under certain circumstances. For example, the availability of laches and acquiescence is severely limited in opposition and cancellation proceedings because these defenses, in Board proceedings, start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use.<sup>199</sup> Moreover, for public policy reasons, the defenses of laches and acquiescence cannot be asserted against such claims as genericness, descriptiveness, fraud, abandonment and functionality and, further, will not apply in a case of likelihood of confusion if it is determined in the case that confusion is inevitable.<sup>200</sup>

Similarly, the "prior registration" or *Morehouse* defense, an equitable defense in the nature of laches or acquiescence,<sup>201</sup> is not available in all cases.<sup>202</sup> In addition, the

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identification of goods amended rejected where petitioner was not put on notice before petitioner presented its case); and *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972 (TTAB 1991) (applicant's argument on summary judgment that parties' channels of trade were different not persuasive where applicant's claim of entitlement to narrower range of goods was not put in issue by motion or amendment to its pleading).

<sup>199</sup> See *National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11<sup>th</sup> Cir. 1991); and *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999). *But see Aquion Partners L.P. v. Envirogard Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1991) (laches defense in an opposition may be based on opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods).

<sup>200</sup> See *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (it is within the public interest to have certain registrations removed from the register and this interest, quoting *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 USPQ 313, 316 (TTAB 1965), *aff'd*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967), "cannot be waived by the inaction of any single person or concern no matter how long the delay persists."). See also, e.g., *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002) (equitable defenses of laches, acquiescence and estoppel cannot be asserted against claim of descriptiveness); *Turner v. Hops Grill & Bar Inc.*, *supra* at 1313 (laches will not prevent cancellation where it is determined that confusion is inevitable); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (same).

*Compare Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1463 (Fed. Cir. 2001) (laches is available defense against Section 2(a) claim of false suggestion of connection because rights protected under that provision "are not designed primarily to protect the public but to protect persons and institutions from exploitation of their persona"); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1294 (TTAB 1999) (estoppel not available against claims of mere descriptiveness or geographic descriptiveness); *Ross v. Analytical Technology, Inc.*, 51 USPQ2d 1269. (TTAB 1999) (laches, acquiescence and estoppel can be asserted against Section 2(c) claim that mark comprises name of opposer without his consent in view of personal nature of claim with no overriding public interest precluding assertion of equitable defenses); and *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990) (equitable defenses can be asserted against Section 2(a) claim of "false suggestion of a connection").

<sup>201</sup> *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989).

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*Morehouse* defense will not be applied where defendant's prior registration is on the Supplemental Register, or if the prior registration did not issue until after commencement of the proceeding in which it is asserted as basis for this defense, or if plaintiff has petitioned to cancel the prior registration.<sup>203</sup>

The elements of a defense should be stated simply, concisely, and directly.<sup>204</sup> However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.<sup>205</sup> When one of the special matters listed in Fed. R. Civ. P. 9 (including, *inter alia*, capacity, fraud, and judgment) is pleaded, the provisions of Fed. R. Civ. P. 9 governing the pleading of that special matter should be followed.<sup>206</sup>

A defendant may state as many separate defenses as it has, regardless of consistency; a defendant may also set forth two or more statements of a defense alternately or hypothetically, either in one count or in separate counts.<sup>207</sup> For example, an applicant whose application for registration has been opposed under Section 2(d) of the Act, 15 U.S.C. § 1052(d), on the ground of opposer's alleged prior use of its mark, coupled with an allegation of likelihood of confusion, might deny that there is any likelihood of confusion with respect to its mark and goods as set forth in the application. At the same time, the applicant might plead alternatively that it actually uses its mark only on a specific type (identified in the pleading) of the goods covered by the broad identification

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<sup>202</sup> See *TBC Corp. v. Grand Prix Ltd.*, *supra* (abandonment, descriptiveness, fraud) and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497 (TTAB 1986) (ornamentation, fraud).

<sup>203</sup> See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001). See also *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313-14 (TTAB 1989) (unavailable where issue is abandonment, descriptiveness or fraud).

<sup>204</sup> See Fed. R. Civ. P. 8(e)(1).

<sup>205</sup> Cf. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985) (bald allegations in the language of the statute, did not provide fair notice of basis of petitioner's Section 2(a) claim).

<sup>206</sup> See 37 CFR §§ 2.106(b)(1) and 2.114(b)(1).

<sup>207</sup> See Fed. R. Civ. P. 8(e)(2). Cf. *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runmlin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, albeit it is the senior user, because the subject registration has been cited as a reference by the Examining Attorney). Cf. also *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before Examining Attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

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in its application; that there is no likelihood of confusion with respect to applicant's actual goods; and that even if the Board ultimately finds that opposer is entitled to judgment with respect to applicant's goods as broadly identified, applicant would be entitled to a registration of its mark with a restricted identification reflecting the actual nature of its goods.<sup>208</sup>

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient.<sup>209</sup>

Evidentiary matters (such as, for example, lists of third-party registrations on which defendant intends to rely) should not be pleaded in an answer. They are matters for proof, not for pleading.<sup>210</sup>

The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration.<sup>211</sup> Moreover, a defense which seeks to restrict a plaintiff's pleaded registration as, for example, by limiting the goods or services therein, or by deleting some of the goods or services, will not be entertained in the absence of a timely counterclaim, or separate petition, to cancel the registration in whole or in part.<sup>212</sup> Geographic restrictions will be considered and determined by the Board only within the context of a concurrent use registration proceeding.<sup>213</sup>

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<sup>208</sup> Cf. 37 CFR § 2.133(b), and TBMP § 514 (Motion to Amend Application or Registration).

<sup>209</sup> See Fed. R. Civ. P. 8(e)(2).

<sup>210</sup> See *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959).

<sup>211</sup> See 37 CFR §§ 2.106(b) and 2.114(b); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) (allegedly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration); *Contour Chair-Lounge Co., Inc. v. The Englander Company, Inc.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition had been dismissed); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). See also *Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840 (TTAB 1977); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975) and TBMP § 313 (Counterclaims).

<sup>212</sup> See 37 CFR § 2.133(d) and *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1287 (TTAB 1998) (applicant's request raised in reply brief for a restriction of opposer's registration [beyond applicant's initial counterclaim to restrict] was untimely as it should have been raised by promptly moving to amend). See also TBMP §§ 309.03(d) (regarding claims for partial cancellation under Section 18) and 313 (regarding counterclaims).

<sup>213</sup> See 37 CFR §§ 2.99(h) and 2.133(c). See also *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990).

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Although Trademark Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii), 37 CFR §§2.106(b)(2)(ii) and 2.114(b)(2)(ii), specifically permit a defense attacking the validity of a plaintiff's pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim.<sup>214</sup> If the defense is raised as a separate petition to cancel, however, the petition itself and any covering letter filed therewith should include a reference to the original proceeding.<sup>215</sup>

When a defense is raised by way of a counterclaim, it should not also be pleaded as an affirmative defense, because the pleading of it as an affirmative defense is unnecessary and redundant.<sup>216</sup>

### 311.02(c) Unpleaded Affirmative Defenses

Except as provided in Fed. R. Civ. P. 12(b) and 12(h)(2) (which allow a defendant to raise certain specified defenses by motion), an unpleaded defense cannot be relied upon by the defendant unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter.<sup>217</sup>

*For additional information concerning unpleaded matters, see TBMP § 314.*

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<sup>214</sup> See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

<sup>215</sup> See *Vitaline Corp. v. General Mills Inc.*, *supra* at 1174. See also TBMP § 313 (Counterclaims).

<sup>216</sup> See *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (motion to strike affirmative defense predicated on same facts alleged in counterclaim granted as representing, in effect, a collateral attack on registration); and *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (motion to strike affirmative defense which allegations formed basis for counterclaim granted since, although Board did not find that applicant was attempting to collaterally attack registration, the affirmative defense was repetitious and unnecessary).

<sup>217</sup> See Fed. R. Civ. P. 8(b), 8(c), and 12(b); and Section 19 of the Trademark Act, 15 U.S.C. § 1069. See also *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense that opposer lacks proprietary rights in its common law mark raised for first time in final brief was neither pleaded nor tried); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 341 (TTAB 1984) (laches is an affirmative defense which must be specifically pleaded); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748, 754 (TTAB 1978) (defense of laches, which was raised by applicant in its final brief, was not pleaded in answer but was tried by implied consent of opposer); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 304 n.5 (TTAB 1977) (the equitable defenses set forth in Section 19 of the Trademark Act are affirmative defenses which must be affirmatively pleaded and in this case were neither pleaded nor tried); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 590 (TTAB 1977) (laches, while not affirmatively pleaded, was nevertheless tried and briefed by both parties without objection); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 251 (TTAB 1977) (laches and acquiescence were neither pleaded nor tried); and *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975) (laches is affirmative defense that must be pleaded in order to be considered).

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### 311.02(d) Other Affirmative Pleadings - Amplifying Denials

An answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant's denial of one or more of the allegations in the complaint. These amplifications of denials, whether referred to as "affirmative defenses," "avoidances," "affirmative pleadings," or "arguments," are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.<sup>218</sup>

### 311.03 Reply to Answer Should Not be Filed

Although Trademark Rules 2.106(b) and 2.114(b) require that an answer to a counterclaim be filed, within the time designated by the Board, they specifically provide that a reply to an affirmative defense need not be filed.<sup>219</sup> Similarly, Fed. R. Civ. P. 7(a) provides that there shall be a complaint and an answer and a reply to a counterclaim denominated as such; that certain other specified pleadings, not relevant to Board proceedings (and not including a reply to an answer), shall be allowed; but that "[n]o other pleading shall be allowed, except that the court may order a reply to an answer."

Thus, while a plaintiff must file an answer to a counterclaim, a reply to an answer need not, and should not, be filed.

## 312 Default

### 312.01 In General

**37 CFR § 2.106(a)** *If no answer is filed within the time set, the opposition may be decided as in case of default.*

**37 CFR § 2.114(a)** *If no answer is filed within the time set, the petition may be decided as in case of default.*

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<sup>218</sup> See *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986) (same); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (objection to certain paragraphs of answer as verbose and argumentative not well taken); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959) (allegation that registered mark is weak does not constitute a collateral attack on validity of opposer's registrations). Cf. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1572 (TTAB 1988).

<sup>219</sup> See 37 CFR §§ 2.106(b)(1) and (2)(iii), and 2.114(b)(1) and (2)(iii).

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If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board may issue a notice of default. The notice states that neither an answer nor any extension of time to answer has been filed; that notice of default under Fed. R. Civ. P. 55(a) is entered; and that defendant is allowed 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response that does not show good cause, default judgment may be entered against it.<sup>220</sup>

If the defendant fails to file a response to the notice, or files a response which does not show good cause in a case where the plaintiff is seeking to partially cancel a registration or partially oppose an application under Section 18 of the Trademark Act, 15 U.S.C. § 1068, default judgment will be entered only to the extent that the restriction requested by plaintiff will be entered.<sup>221</sup>

The issue of whether default judgment should be entered against a defendant for failure to file a timely answer to the complaint may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its late-filed answer be accepted.<sup>222</sup> However the issue is raised, the standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the Fed. R. Civ. P. 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it.<sup>223</sup>

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<sup>220</sup> See 37 CFR §§ 2.106(a) and 2.114(a); Fed. R. Civ. P. 55(a), 55(b) and 55(c); *DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990) and *Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977) Cf. TBMP § 508 (Motion for Default Judgment).

<sup>221</sup> See *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994) (*concurring opinion* at n.4). Compare *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997) (where registrant defaulted in case involving petition to partially cancel registration to delete certain items identified therein on ground of abandonment and registration was cancelled in its entirety, Board, while noting that it may have been error to order cancellation of registration in its entirety, declined to set aside order, finding that default was properly entered and therefore not "void" under Fed. R. Civ. P. 60(b)(4)).

<sup>222</sup> See, e.g., *DeLorme Publishing Co v. Eartha's Inc.*, *supra* (motion for default judgment); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990) (plaintiff's motion for default judgment and defendant's motion to accept late answer) and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (motion to accept late answer filed before notice of default issued). Cf. TBMP § 508 (Motion for Default Judgment).

<sup>223</sup> See, for example, *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, *supra* at 1557 (motion to accept late answer filed before notice of default issued was treated as response to notice of default). See also *DeLorme Publishing Co v. Eartha's Inc.*, *supra* at 1224 and *Paolo's Associates Limited Partnership v. Paolo Bodo*, *supra*.

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When a defendant who has not yet filed an answer to a complaint files a response to a notice of default, or to a motion for default judgment, the late answer normally should be submitted with the response. However, in some cases it may not be necessary for the defendant to submit its answer with the response. Examples include cases where the defendant has not received the copies of the complaint and notification letter sent to it by the Board, or where the parties have settled the case or agreed to an extension of the defendant's time to file an answer.

### 312.02 Setting Aside Notice of Default

If a defendant who has failed to file a timely answer to the complaint responds to a notice of default by filing a satisfactory showing of good cause why default judgment should not be entered against it, the Board will set aside the notice of default.<sup>224</sup> Similarly, if the defendant files such a showing in response to a motion by the plaintiff for default judgment, or in support of its own motion asking that its late-filed answer be accepted, default judgment will not be entered against it.

Good cause why default judgment should not be entered against a defendant, for failure to file a timely answer to the complaint, is usually found when the defendant shows that (1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action.<sup>225</sup> The showing of a meritorious defense does not require an evaluation of the merits of the case. All that is required is a plausible response to the allegations in the complaint.<sup>226</sup>

The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board.<sup>227</sup> In exercising that discretion, the Board must be mindful of the

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<sup>224</sup> See Fed. R. Civ. P. 55(c).

<sup>225</sup> See *DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (willful conduct shown where although applicant may not have intended that proceedings be resolved by default, applicant admittedly intended not to answer for six months); *Paolo's Associates Limited Partnership v. Paolo Bodo*, *supra* at 1903-04 (no evidence that failure was willful; costs incurred in preparing and filing motion not sufficient to support finding of prejudice); and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, *supra* at 1557 (failure to answer due to inadvertence on part of applicant's counsel; answer had been prepared and reviewed by applicant but counsel inadvertently failed to file it; nine-day delay would cause minimal prejudice; by submission of answer which was not frivolous meritorious defense was shown). Cf., regarding a motion to set aside judgment under Fed. R. Civ. P. 60(b), *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (the two other factors having been shown, applicant was allowed time to show meritorious defense by submission of answer).

<sup>226</sup> See *DeLorme Publishing Co v. Eartha's Inc.*, *supra* at 1224.

<sup>227</sup> See, e.g., *Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977) (fact that in response to order to show cause applicant filed answer but no response to show cause order does not mandate entry of default judgment; applicant allowed time to show cause).

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fact that it is the policy of the law to decide cases on their merits. Accordingly, the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant. Nevertheless, entry of default judgment may be necessary in some cases.<sup>228</sup>

### 312.03 Setting Aside Default Judgment

The standard for setting aside default judgment is stricter than the standard for setting aside a notice of default.

A notice of default may be set aside on a showing of good cause.<sup>229</sup> However, once default judgment has actually been entered against a defendant pursuant to Fed. R. Civ. P. 55(b), the judgment may be set aside only in accordance with Fed. R. Civ. P. 60(b), which governs motions for relief from final judgment. The stricter standard reflects public policy favoring finality of judgments and termination of litigation.<sup>230</sup>

The factors considered in determining a motion to set aside notice of default are also considered in determining a motion for relief from a default judgment entered pursuant to Fed. R. Civ. P. 55.<sup>231</sup> Among the factors to be considered in determining a motion to vacate a default judgment for failure to answer the complaint are (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action.<sup>232</sup>

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<sup>228</sup> See *DeLorme Publishing Co v. Eartha's Inc.*, *supra* (although no specific prejudice to opposer, and while meritorious defense was shown, Board found applicant's conduct amounted to gross neglect and granted motion for default judgment where applicant filed its answer six months late, viewing the notice of opposition as "incomplete," instead of filing appropriate motion or taking other appropriate action).

<sup>229</sup> See Fed. R. Civ. P. 55(c) and TBMP § 312.02 (Setting Aside Notice of Default).

<sup>230</sup> See *Waiferson Ltd. Inc. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632, 1634 (6th Cir. 1992) and *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997).

<sup>231</sup> Compare, for example, *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990), and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (both of which involved the question whether default judgment should be entered against defendant), with *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991), and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991) (both involving relief from default judgment). See also Wright, Miller & Kane, *Federal Practice and Procedure: Civil 3d* § 2692 (1998) and *Waiferson Ltd. Inc. v. Classic Music Vending*, *supra*.

<sup>232</sup> See *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, *supra* (motion based on alleged failure to receive correspondence from the Board denied given presumption of receipt of correspondence, passage of 12 years and resulting hardship to third parties); *Djeredjian v. Kashi Co.*, *supra* at 1615 (motion granted pending showing of meritorious defense where other two elements were established) and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (motion granted; respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings).

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However, the showing submitted by the defendant is likely to be viewed with less leniency when defendant seeks relief from default judgment than when defendant seeks to show cause why default judgment should not be entered against it.<sup>233</sup>

Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are other motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments such as default judgments entered against plaintiffs for failure to prosecute the case.<sup>234</sup>

*For information concerning motions under Fed. R. Civ. P. 60(b) for relief from final judgment, see TBMP § 544.*

### 313 Counterclaims

#### 313.01 In General

*37 CFR § 2.106(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

*(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.*

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<sup>233</sup> See *Waiferson Ltd. Inc. v. Classic Music Vending, supra* (while the factors are similar, the methodology for considering the factors in deciding motion under 60(b)(1) and the weight to be accorded them differs); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co., supra* (a significant factor is the hardship that reopening a judgment may cause to others and whether other actions have been taken in reliance on the judgment); and Wright, Miller & Kane, *Federal Practice and Procedure: Civil 3d* § 2692 (1998).

<sup>234</sup> Compare, for example, *Djeredjian v. Kashi Co., supra* and *Regatta Sport Ltd. v. Telux-Pioneer Inc., supra* (both of which involved default judgments for failure to answer) with *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982) (motion to set aside judgment against opposer for failure to prosecute denied; incompetent attorney); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735, 736 (TTAB 1976) (motion to set aside judgment for failure to prosecute denied; inattention and carelessness not excusable); and *Williams v. Five Platters, Inc.*, 181 USPQ 409, 410 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (motion to set aside default judgment for failure to respond to motion for summary judgment denied; carelessness and inattention of counsel). See also Wright, Miller & Kane, *Federal Practice and Procedure: Civil 3d* § 2693 (1998).

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*(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

*(iv) The times for pleading, discovery, testimony, briefs or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

**37 CFR § 2.114(b)(2)(i)** *A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

*(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.*

*(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

*(iv) The times for pleading, discovery, testimony, briefs, or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

The Board cannot entertain an attack upon the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration.<sup>235</sup>

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<sup>235</sup> See 37 CFR §§ 2.106(b)(2)(ii) and 2.114(b)(2)(ii); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) (since no counterclaim had been filed, Court disregarded applicant's claims that opposer had admitted periods of nonuse); *Contour Chair-Lounge Co. v. The Englander Company, Inc.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition to cancel had been dismissed); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). See also *Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840 (TTAB 1977); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

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Although Trademark Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii) specifically permit a defense attacking the validity of a plaintiff's pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim.<sup>236</sup> If the defense is raised as a separate petition to cancel, however, the petition itself and any covering letter should include a reference to the original proceeding. Further, a defendant that fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel.<sup>237</sup>

The only type of counterclaim that may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party.<sup>238</sup>

As provided in Section 18 of the Trademark Act (15 U.S.C. § 1068) a counterclaim may seek to cancel a registration in whole or in part. In the latter case, the counterclaimant may seek to cancel the registration only, for example, as to some of the listed goods or services or only to the extent of restricting the goods or services in a particular manner (described in sufficient detail to give the respondent fair notice thereof).<sup>239</sup> However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding.<sup>240</sup> A counterclaim to partially cancel a registration by restricting the manner of use of the goods or services therein in order to avoid a likelihood of confusion is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration.<sup>241</sup>

A counterclaim is the legal equivalent of a petition to cancel. Thus, the provisions of 37 CFR §§ 2.111 through 2.115, governing petitions to cancel, are applicable to counterclaims.<sup>242</sup>

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<sup>236</sup> See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989).

<sup>237</sup> See *Vitaline Corp. v. General Mills Inc.*, *supra* at 1174. See also TBMP § 313.04 (Compulsory Counterclaims), and cases cited therein.

<sup>238</sup> See *Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 n.2 (TTAB 1990) (counterclaim to cancel "any registration which might issue in the future from pleaded application" was improper), and *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (counterclaim to "refuse any application filed by petitioner" was improper).

<sup>239</sup> See Section 18 of the Act, 15 U.S.C. § 1068; 37 CFR §§ 2.111(b) and 2.133(b); and TBMP § 309.03(d) (Remedy Under Section 18), and cases cited therein.

<sup>240</sup> See 37 CFR §§ 2.99(h) and 2.133(c), and *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

<sup>241</sup> See, e.g., *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

<sup>242</sup> See 37 CFR §§ 2.106(b)(2)(iii) and 2.114(b)(2)(iii).

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When necessary to enable a party fully to present or meet a counterclaim or separate petition to cancel a registration, the times for pleading, discovery, testimony, briefs and/or oral argument will be reset or extended. A party that believes that such a resetting or extension is necessary should file a motion therefor with the Board.<sup>243</sup>

### 313.02 Fee For Counterclaim

*37 CFR §§ 2.106(b)(2)(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

*37 CFR §§ 2.114(b)(2)(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

A counterclaim for cancellation of a plaintiff's registration is the legal equivalent of a separate petition to cancel. The required filing fee must be paid when a petition to cancel takes the form of a counterclaim, just as it must be paid when a petition to cancel takes the form of a separate proceeding.<sup>244</sup> That is, the required fee (*see* 37 CFR § 2.6) must be paid for each party joined as counterclaimant for each class sought to be cancelled in each registration against which the counterclaim is filed.<sup>245</sup>

If no fee or an insufficient fee is submitted, the Board will ordinarily prepare a letter noting the counterclaim, advising that the counterclaim cannot be entertained because the proper fee has not been paid and allowing the counterclaimant time to submit the appropriate fee.<sup>246</sup>

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<sup>243</sup> *See* 37 CFR §§ 2.106(b)(2)(iv) and 2.114(b)(2)(iv). *See also* TBMP § 509 (regarding motions to extend).

<sup>244</sup> *See* 37 CFR §§ 2.106(b)(2)(iii) and 2.114(b)(2)(iii); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966) (payment of fee is necessary to give Board jurisdiction); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1748 (TTAB 1992), *summ. judgment granted in part*, 26 USPQ2d 1926 (TTAB 1993) (same); and *Sunway Fruit Products, Inc. v. Productos Caseros, S. A.*, 130 USPQ 33, 33 (Comm'r 1960) (requirement for fee is statutory and cannot be waived).

<sup>245</sup> *See* 37 CFR §§ 2.111(c) and 2.112(b). *Cf.* TBMP § 308.02 (Fee for Filing Petition to Cancel).

<sup>246</sup> *See, e.g., Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998) (allowed time to submit fee); *Jet-Pak, Inc. v. United States Plywood Corp.*, 124 USPQ 385, 386 (TTAB 1960) (allowed time to submit fee failing which, counterclaim would be stricken); *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17-18 (TTAB 1959) (counterclaim not entertained until fee is paid) and *Jet-Pak, Inc. v. United States Plywood Corp.*, 125 USPQ 491, 492 (Comm'r 1960).

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### 313.03 Form and Substance of Counterclaim; Service of Counterclaim

A counterclaim should be generally similar in form to a petition to cancel (for information concerning the form of a petition to cancel, *see* TBMP § 309.02). However, a counterclaim filed as part of the counterclaimant's answer to the adverse party's complaint necessarily differs somewhat in format from a separate petition to cancel.

Moreover, a plaintiff filing a separate petition to cancel must file the petition (and any exhibits thereto) in duplicate, and need not serve a copy thereof on the defendant(s).<sup>247</sup> A counterclaimant, on the other hand, need file only one copy of its counterclaim (and any exhibits thereto) with the Board, but must serve a copy thereof (with any exhibits thereto) on every other party to the proceeding, and must make proof of such service before the Board will consider the counterclaim.<sup>248</sup>

The pleading of the substance of a counterclaim may also differ somewhat from the pleading of the substance of a separate petition to cancel. For example, a counterclaimant need not plead its standing to assert a counterclaim to cancel a registration pleaded by the plaintiff in its complaint. The counterclaimant's standing in such a case is inherent in its position as defendant to the complaint.<sup>249</sup>

In some instances, the grounds for cancellation available in the case of a counterclaim differ from those available in the case of a petition to cancel that are not in the nature of a counterclaim. Section 14 of the Act, 15 U.S.C. § 1064, limits, after a five-year period, the grounds upon which most Principal Register registrations may be cancelled. If the plaintiff in a proceeding before the Board relies on such a registration and the five-year period has not yet expired when the plaintiff's complaint is filed, the limitation does not apply to a counterclaim filed by the defendant therein for cancellation of that registration. This is so even if the five-year period has expired by the time the counterclaim is filed. In such cases, the filing of the plaintiff's

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<sup>247</sup> *See* 37 CFR §§ 2.112(a) and 2.119(a), and TBMP § 309.02(c) (Complaint filed in Duplicate).

<sup>248</sup> *See* 37 CFR § 2.119(a).

<sup>249</sup> *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (finding of no likelihood of confusion in the opposition did not remove defendant's standing to counterclaim for abandonment); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987) (defendant seeking to cancel pleaded registration on ground of descriptiveness or genericness in an opposition based on likelihood of confusion need not allege that it has an interest in using the term sought to be cancelled); *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 95 (TTAB 1984) (counterclaimant clearly has personal stake in the controversy); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 856 (TTAB 1981) (damage assumed, and with properly pleaded ground is sufficient to place validity of registration in issue); and *General Mills, Inc. v. Natures Way Products*, 202 USPQ 840, 841 (TTAB 1979).

## Chapter 300 PLEADINGS

complaint tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds on which a counterclaim may be based.<sup>250</sup>

### 313.04 Compulsory Counterclaims

*37 CFR § 2.106(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

*37 CFR § 2.114(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.*

Counterclaims for cancellation of pleaded registrations in Board proceedings are governed by 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).<sup>251</sup> If the defendant knows the grounds for a

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<sup>250</sup> See e.g., *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 862 n.3 (TTAB 1980); *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan*, 165 USPQ 597, 598 n.4 (TTAB 1970) (grounds were not limited where, although petition to cancel was not properly filed until after fifth anniversary date of registration, opposition wherein opposer relied on said registration was filed before anniversary date); and *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385, 386 (Comm'r 1955). See also J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:67 (4th ed. 2001).

*Cf.*, regarding concurrent use proceedings, *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (5-year period tolled where applicant, prior to expiration of 5-year period files a proper concurrent application or an amendment converting an unrestricted application to one seeking concurrent use naming registrant as exception to applicant's right to exclusive use).

<sup>251</sup> See 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i). See also *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by Trademark Rule 2.106(b)(2)(i)). *But see See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1397 (TTAB 1989) (Board applied 13(f) "when justice requires" standard where grounds for counterclaim filed as a separate petition to cancel were known at time of answer to opposition).

## Chapter 300 PLEADINGS

counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the answer.<sup>252</sup> If grounds are learned during the course of the proceeding, the counterclaim must be pleaded promptly after the grounds therefore are learned.<sup>253</sup>

A defendant who fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. In such a case, the separate petition will be dismissed, on motion, on the ground that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that it was not timely asserted.<sup>254</sup>

If a defendant confronted with a motion for summary judgment knows of grounds for a counterclaim that might serve to defeat the motion, the counterclaim should be asserted in response to the motion, even if no answer to the complaint has yet been filed.<sup>255</sup>

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<sup>252</sup> See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) (since it was unclear from applicant's submissions to amend whether counterclaim was timely, i.e., whether grounds were known by applicant at time original answer was filed, applicant was allowed time to explain why it was not pleaded with answer); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987) (motion to amend answer to add additional ground to existing counterclaim denied since such ground was available at time of original answer); and *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986) (petitioner cannot avoid effect of its failure to timely assert counterclaim at time it filed its answer as defendant in prior opposition since grounds existed and were known to petitioner at that time).

But see *See's Candy Shops Inc. v. Campbell Soup Co.*, *supra* (although counterclaim (filed as separate petition to cancel) was premised on facts known by applicant at time it filed its answer in the opposition, Board allowed the petition to go forward, notwithstanding that the petition was filed two weeks after answer was filed in the opposition).

<sup>253</sup> See *Vitaline supra*; *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992), *summ. judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) (counterclaim pleaded promptly after obtaining the information necessary to assert counterclaim during discovery and before discovery had closed); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); and *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984). See also *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (if applicant learns through discovery that grounds exist for counterclaim, applicant may move to amend answer to assert such counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975) (applicant would not be barred by the dismissal with prejudice of its counterclaim in prior proceeding thirteen years earlier from asserting new counterclaim on same ground, i.e., that registered mark has become common descriptive name of identified goods, provided new counterclaim is based solely on circumstances occurring subsequent to termination of prior proceeding); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) (same); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

<sup>254</sup> See *Vitaline, supra* and *Consolidated Foods Corp., supra*.

<sup>255</sup> See *Libertyville Saddle Shop, supra*.

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A plaintiff which fails to plead a registration, and later seeks to rely thereon, will not be heard to contend, if defendant then moves to amend its answer to assert a counterclaim to cancel the registration, or then files a separate petition to cancel the registration, that the counterclaim or separate petition is untimely because it was not pleaded when defendant filed its answer. A plaintiff may not, by failing to plead a registration on which it intends to rely, deprive a defendant of its right to petition to cancel the registration, either by counterclaim or by separate petition, at such time as opposer seeks to rely upon the registration. Even if the defendant knows grounds for cancellation of a plaintiff's unpleaded registration when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration unless and until the plaintiff pleads the registration.<sup>256</sup>

### 313.05 Permissive Counterclaims

A party may counterclaim to cancel a registration that is owned, but not pleaded, by an adverse party. A counterclaim to cancel a registration owned, but not pleaded, by an adverse party is a permissive counterclaim.<sup>257</sup>

### 313.06 Answer to Counterclaim

**37 CFR § 2.106(b)(2)(iii)** *The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

**37 CFR § 2.114(b)(2)(iii)** *The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.*

**37 CFR § 2.114(a)** *If no answer is filed within the time set, the petition may be decided as in case of default.*

When a counterclaim (together with the required cancellation fee) is filed, the Board prepares an order acknowledging its receipt and allowing the plaintiff (defendant to the counterclaim) a set time, not less than 30 days, within which to file an answer to the counterclaim.<sup>258</sup> In practice, the Board usually allows 30 days.<sup>259</sup> A copy of the order is sent to each party to the proceeding, or

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<sup>256</sup> See 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i), and *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93 (TTAB 1984). See also Notice of Final Rulemaking published in the *Federal Register* of January 22, 1981 at 46 FR 6940.

<sup>257</sup> See Fed. R. Civ. P. 13(b). Cf. 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).

<sup>258</sup> See 37 CFR §§ 2.106(b)(2)(iii) and 2.114(b)(2)(iii).

<sup>259</sup> See TBMP § 310.03(b) (five-day addition under 37 CFR § 2.119(c) does not apply to deadlines set by Board).

## Chapter 300 PLEADINGS

to each party's attorney or other authorized representative. The order will also include a trial schedule and briefing dates to accommodate the counterclaim.<sup>260</sup>

If no answer to the counterclaim is filed during the time allowed, the counterclaim may be decided as in case of default.<sup>261</sup>

An answer to a counterclaim should be in the same form as an answer to a complaint. *For information on the proper form for an answer to a complaint, see TBMP § 310.01.*

An answer to a counterclaim, like any other answer, may include a counterclaim for cancellation of a registration owned by the counterclaimant. A defense attacking the validity of any registration pleaded by the counterclaimant is a compulsory counterclaim if grounds for such counterclaim exist at the time when the plaintiff's answer to the defendant's counterclaim is filed. If the plaintiff knows grounds for a counterclaim when the plaintiff's answer to the defendant's counterclaim is filed, the counterclaim must be pleaded with or as part of the plaintiff's answer. If, during the course of the proceeding, the plaintiff learns, through discovery or otherwise, that grounds for a counterclaim exist, the counterclaim should be pleaded promptly after the grounds therefor are learned.<sup>262</sup>

A plaintiff's counterclaim to cancel a registration owned by the defendant, but not pleaded in the defendant's counterclaim, is a permissive counterclaim.<sup>263</sup>

*For information on the fee for a counterclaim, see 37 CFR § 2.6(a)(16) and TBMP § 313.02. For information on the form for a counterclaim, see TBMP § 313.03.*

### 314 Unpleaded Matters

A plaintiff may not rely on an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.<sup>264</sup>

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<sup>260</sup> *An example of a trial order for a proceeding with a counterclaim can be found in the Appendix of Forms.*

<sup>261</sup> *See 37 CFR §§ 2.114(a) and 2.114(b)(2)(iii). For information concerning default for failure to answer, see TBMP § 312.*

<sup>262</sup> *Cf. 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i), and TBMP § 313.04 (Compulsory Counterclaims).*

<sup>263</sup> *Cf. Fed. R. Civ. P. 13(b), and TBMP § 313.05 (Permissive Counterclaims).*

<sup>264</sup> *See P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801, 804 (CCPA 1978) (registrant did not have fair notice that petitioner was attempting to establish a two-year period of nonuse extending beyond two-year period alleged in petition); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1471 n.11 (TTAB 1993) (only ground pleaded and tried was descriptiveness, not likelihood of confusion); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1439-40 (TTAB 1993) (issue of abandonment argued in final brief was neither pleaded nor tried); *Riceland Foods*

## Chapter 300 PLEADINGS

Similarly, except as provided in Fed. R. Civ. P. 12(b) and (h)(2) (which allow a defendant to raise certain specified defenses by motion), the defendant may not rely on an unpleaded defense unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter.<sup>265</sup>

If, after the filing of its pleading, a party learns, through discovery or otherwise, of information which would serve as the basis for an additional claim (in the case of a plaintiff), or defense or counterclaim (in the case of a defendant), the party should move promptly to amend its pleading to assert the additional matter.<sup>266</sup>

A party may not obtain summary judgment on an unpleaded issue, nor may a party defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. However, a party that seeks to obtain, or to defend

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*Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (only mark pleaded by opposer and tried was registered design mark and applicant had no notice that opposer intended to rely on use of unregistered word mark appearing on opposer's packaging); *Micro Motion, Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1992) (motion to amend opposition filed with final brief denied where pleaded issue was genericness and applicant was not on notice of unpleaded issue of mere descriptiveness so that applicant could have put on defense of acquired distinctiveness); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1139 (TTAB 1992) (to have valid 2(d) claim in this case opposer was advised to amend pleading to state that its pleaded mark is merely descriptive and had acquired distinctiveness prior to any establishment by applicant of acquired distinctiveness of applicant's mark); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1128 (TTAB 1990). For additional case cites, see *Appendix of Cases*.

*Cf. The Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) (unpleaded issue will not be addressed for the first time on appeal).

<sup>265</sup> See Fed. R. Civ. P. 8(b), 8(c), and 12(b); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995) (applicant allowed time to amend pleading to allege acquisition of secondary meaning as an affirmative defense in the answer); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, *supra* (in defending against 2(d) claim where opposer's unregistered mark is merely descriptive, applicant was advised to amend pleading to affirmatively assert priority of acquired distinctiveness); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense raised for first time in final brief that opposer lacks proprietary rights in its common law mark was neither pleaded nor tried); and *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984). See also *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748 (TTAB 1978); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301 (TTAB 1977); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246 (TTAB 1977); and *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975).

<sup>266</sup> See Fed. R. Civ. P. 15(a); *Hilson Research Inc. supra*; *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748 (TTAB 1978); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974). See also 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).

## Chapter 300 PLEADINGS

against, summary judgment on the basis of an unpleaded issue may move to amend its pleading to assert the issue.<sup>267</sup>

### 315 Amendment of Pleadings

***37 CFR § 2.107 Amendment of pleadings in an opposition proceeding.***

*Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.*

***37 CFR § 2.115 Amendment of pleadings in a cancellation proceeding.***

*Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.*

Pleadings in inter partes proceedings before the Board may be amended in the same manner and to the same extent as pleadings in a civil action before a United States district court. *See* 37 CFR §§ 2.107 and 2.115. *For further information concerning the amendment of pleadings, see Fed. R. Civ. P. 15, and TBMP § 507. See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

### 316 Motions Relating to Pleadings

In opposition and cancellation proceedings, there is a wide range of motions relating to pleadings, including motions to dismiss, for a more definite statement, to strike, for judgment on the pleadings, to amend pleadings, etc. *For information concerning these motions, see* TBMP chapter 500.

### 317 Exhibits to Pleadings

***37 CFR § 2.122(c) Exhibits to pleadings.*** *Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.*

***37 CFR § 2.122(d) Registrations.*** *(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...*

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<sup>267</sup> *See, e.g., Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (opposer's pleading deemed amended where nonmoving party did not object to summary judgment motion as seeking judgment on unpleaded claim); and TBMP § 528.07 (Unpleaded Issue), and cases cited therein.

## Chapter 300 PLEADINGS

A plaintiff or defendant may attach exhibits to its pleading. However, with one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits.<sup>268</sup>

The one exception to the foregoing rule is a current status and title copy, prepared by the Patent and Trademark Office, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff.<sup>269</sup>

### 318 Fed. R. Civ. P. 11 Applicable

Rule 11 of the Federal Rules of Civil Procedure provides, in part, as follows:

***(b) Representations to Court.***

*By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances,--*

- (1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;*
- (2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*
- (3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.*

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<sup>268</sup> 37 CFR § 2.122(c). See *Republic Steel Co. v. M.P.H. Manufacturing Corp.*, 312 F.2d 940, 136 USPQ 447, 448 (CCPA 1963); *Hard Rock Café Intl (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000); *Home Juice Co. v. Runmlin Companies Inc.*, 231 USPQ 897, 898 (TTAB 1986); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 155 n.3 (TTAB 1985); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.5 (TTAB 1978); *A-1-A Corp. v. The Gillette Co.*, 199 USPQ 118, 119 n.2 (TTAB 1978); and *Permatex Co. v. California Tube Products, Inc.*, 175 USPQ 764, 765 n.2 (TTAB 1972).

<sup>269</sup> See 37 CFR §§ 2.122(c) and 2.122(d)(1), and TBMP § 704.03(b)(1)(A) (Registration Owned by Party).

## Chapter 300 PLEADINGS

### ***(c) Sanctions.***

*If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the attorneys, law firms, or parties that have violated subdivision (b) or are responsible for the violation.*

The quoted provisions are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board.<sup>270</sup>

### **319 Amendment to Allege Use; Statement of Use**

*For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application that is the subject of the opposition, see TBMP § 219.*

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<sup>270</sup> See 37 CFR § 2.116(a) and TBMP § 527.02 (Motion for Rule 11 Sanctions), and authorities cited therein. See also *Central Manufacturing, Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (the Board will also consider the conduct of a party relating to the requests to extend time to oppose).

## APPENDIX OF CASES

### Section 303.03 Meaning of the Term Damage

**n.18** *Rosso & Mastracco, Inc. v. Giant food Inc.*, 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1100-01, 192 USPQ 24, 27 (CCPA 1976); *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685 (TTAB 1987); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076 (TTAB 1987); *BRT Holdings Inc. v. Homeway, Inc.*, 4 USPQ2d 1952 (TTAB 1987); *American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984); and *Davco Inc. v. Chicago Rawhide Mfg. Co.*, 224 USPQ 245 (TTAB 1984).

### Section 314 Unpleaded Matters

**n.262** *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815 (TTAB 1986); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *Alliance Manufacturing Co. v. ABH Diversified Products, Inc.*, 226 USPQ 348 (TTAB 1985); *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982); *Standard Brands Inc. v. Peters*, 191 USPQ 168 (TTAB 1975); *Dap, Inc. v. Litton Industries, Inc.*, 185 USPQ 177 (TTAB 1975); and *CCI Corp. v. Continental Communications, Inc.*, 184 USPQ 445 (TTAB 1974).

## APPENDIX OF FORMS

### Section 310.01 – Notification of Proceeding

#### Sample Trial Order

|   |            |
|---|------------|
| MAILING DATE  | 1/1/2003   |
| <b>DISCOVERY PERIOD TO OPEN</b>   | 1/21/2003  |
| <b>DISCOVERY PERIOD TO CLOSE</b>  | 7/20/2003  |
| 30-day testimony period for party in position of plaintiff to close         | 10/18/2003 |
| 30-day testimony period for party in position of defendant to close         | 12/17/2003 |
| 15-day rebuttal testimony period for plaintiff to close                     | 1/31/2004  |
| <b>Briefs shall be due as follows:</b><br>[See Trademark Rule 2.128(a)(2)]: |            |
| Brief for plaintiff is due  | 4/1/2004   |
| Brief for defendant is due  | 5/1/2004   |
| Reply brief, if any, for plaintiff is due                                   | 5/16/2004  |

**APPENDIX OF FORMS**

**Section 312 – Suggested Formats for Complaints**

**SUGGESTED FORMAT FOR NOTICE OF OPPOSITION**

(This is a suggested format for preparing a Notice of Opposition. This document is not meant to be used as a form to be filled in and returned to the Board. Rather, it is a suggested format, which shows how the Notice of Opposition should be set up. Opposers may follow this format in preparing their own Notice of Opposition but need not copy those portions of the suggested format which are not relevant.)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.....  
For the mark.....  
Published in the Official Gazette on.....(Date).....

(Name of opposer)  
v.  
(Name of applicant)

**NOTICE OF OPPOSITION**

State opposer's name, address, and entity information as follows:<sup>(1)</sup>

\_\_\_\_\_  
(Name of individual as opposer and business trade name, if any, and business address)

**OR**

\_\_\_\_\_  
(Name of partnership as opposer; name of partners; Business address of partnership)

**OR**

\_\_\_\_\_  
(Name of corporation as opposer; State or country of incorporation; business address of corporation)

## APPENDIX OF FORMS

The above-identified opposer believes that it/he/she will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.<sup>(2)</sup>

The grounds for opposition are as follows:

[Please set forth, in separately numbered paragraphs, the allegations of opposer's standing and grounds for opposition.]<sup>(3)</sup>

By \_\_\_\_\_ (Signature)<sup>(4)</sup> Date \_\_\_\_\_  
(Identification of person signing)<sup>(5)</sup>

### FOOTNOTES

<sup>(1)</sup> If opposer is an individual, state the opposer's name, business trade name, if any, and business address. If opposer is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If opposer is a corporation, state the name of the corporation, the state (or country, if opposer is a foreign corporation) of incorporation, and the business address of the corporation. If opposer is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

<sup>(2)</sup> The required fee must be submitted for each party joined as opposer for each class opposed, and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified.

<sup>(3)</sup> Set forth a short and plain statement here showing why the opposer believes it/he/she would be damaged by the registration of the opposed mark, and state the grounds for opposing. Each numbered paragraph should be limited, as far as practicable, to a statement of a single set of circumstances. See Rules 8(a) and 10(b) of the Federal Rules of Civil Procedure.

<sup>(4)</sup> The opposition need not be verified, and may be signed by the opposer or by the opposer's attorney or other authorized representative. If an opposer signing for itself is a partnership, the signature must be made by a partner; if an opposer signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

<sup>(5)</sup> State the capacity in which the signing individual signs, e.g., attorney for opposer, opposer (if opposer is an individual), partner of opposer (if opposer is a partnership), officer of opposer identified by title (if opposer is a corporation), etc.

### REPRESENTATION INFORMATION

If the opposer is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative may be designated.

**APPENDIX OF FORMS**

If the opposer wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

**SUGGESTED FORMAT FOR PETITION TO CANCEL**

This is a suggested format for preparing a Petition to Cancel a trademark registration. This document is not meant to be used as a form to be filled in and returned to the Board. Rather, it is a suggested format, which shows how the petition should be set up. Petitioners may follow this format in preparing their own petition but need not copy those portions of the suggested format which are not relevant.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration No.....  
For the mark.....  
Date registered.....

(Name of petitioner)  
v.  
(Name of registrant)

**PETITION TO CANCEL**

**State petitioner's name, address, and entity information as follows:<sup>(1)</sup>**

\_\_\_\_\_  
(Name of individual as petitioner, business trade name (if any); business address)

OR

\_\_\_\_\_  
(Name of partnership as petitioner; names of partners; business address of partnership)

OR

\_\_\_\_\_  
(Name of corporation as petitioner; State or country of incorporation; business address of corporation)

## APPENDIX OF FORMS

To the best of petitioner's knowledge, the name and address of the current owner of the registration are \_\_\_\_\_ (*provide if known*) \_\_\_\_\_

The above-identified petitioner believes that it/he/she will be damaged by the above-identified registration, and hereby petitions to cancel the same.<sup>(2)</sup>

The grounds for cancellation are as follows:

[Please set forth, in separately numbered paragraphs, the allegations of petitioner's standing and grounds for cancellation]<sup>(3)</sup>

By \_\_\_\_\_ Signature<sup>(4)</sup> \_\_\_\_\_ Date \_\_\_\_\_  
(Identification of person signing)<sup>(5)</sup>

### FOOTNOTES

<sup>(1)</sup> If petitioner is an individual, state the petitioner's name, business trade name, if any, and business address. If petitioner is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If petitioner is a corporation, state the name of the corporation, the state (or country, if petitioner is a foreign corporation) of incorporation, and the business address of the corporation. If petitioner is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

<sup>(2)</sup> The required fee must be submitted for each party joined as petitioner for each class sought to be cancelled, and if cancellation is sought for fewer than the total number of classes in the registration, the classes sought to be cancelled should be specified.

<sup>(3)</sup> Set forth a short and plain statement here showing why the petitioner believes it/he/she would be damaged by the registration, and state the grounds for cancellation. Each numbered paragraph should be limited, as far as practicable, to a statement of a single set of circumstances. See Rules 8(a) and 10(b) of the Federal Rules of Civil Procedure.

<sup>(4)</sup> The petition need not be verified, and may be signed by the petitioner or by the petitioner's attorney or other authorized representative. If a petitioner signing for itself is a partnership, the signature must be made by a partner; if a petitioner signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

<sup>(5)</sup> State the capacity in which the signing individual signs, e.g., attorney for petitioner, petitioner (if petitioner is an individual), partner of petitioner (if petitioner is a partnership), officer of petitioner identified by title (if petitioner is a corporation), etc.

## **APPENDIX OF FORMS**

### **REPRESENTATION INFORMATION**

If the petitioner is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative may be designated.

If the petitioner wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power

## APPENDIX OF FORMS

### Section 313.06 – Answer to a Counterclaim

#### SAMPLE TRIAL ORDER WITH A COUNTERCLAIM

|   |            |
|---|------------|
| <b>DISCOVERY PERIOD TO CLOSE</b>  | 7/20/2003  |
| 30-day testimony period for plaintiff in the opposition to close  | 10/18/2003 |
| 30-day testimony period for defendant in the opposition and plaintiff in the counterclaim to close                        | 12/17/2003 |
| 30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff in the opposition to close | 2/15/2004  |
| 15-day rebuttal testimony period for plaintiff in the counterclaim to close   | 4/1/2004   |
| <b>Briefs shall be due as follows:</b><br>[See Trademark Rule 2.128(a)(2)]:   |            |
| Brief for plaintiff in the opposition is due  | 5/31/2004  |
| Brief for defendant in the opposition and plaintiff<br>In the counterclaim is due   | 7/1/2004   |
| Brief for defendant in the counterclaim and reply brief,<br>if any, for plaintiff in the opposition is due                | 7/31/2004  |
| Reply brief, if any, for plaintiff in the counterclaim is due   | 8/16/2004  |