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801 Briefs on the Case

801.01 In General

After the close of all testimony periods in an inter partes proceeding before the Board, the parties are allowed time in which to file briefs on the case. The brief is a party's "opportunity to present, in a systematic and coherent manner, and in a form which is permanent and can be referred to, a discussion of the facts in light of the law," its strongest affirmative arguments, and a rebuttal of its adversary's arguments.¹

Subject to Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. However, the facts and arguments presented in the brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence.²

For information concerning briefs and oral hearings in ex parte appeals, see TBMP §§ 1203.01 and 1216, respectively.

801.02 Time for Filing

37 CFR § 2.128(a)

(1) The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.

(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response

¹ See David J. Kera, *TIPS FROM THE TTAB: Preparing and Filing Briefs With the Trademark Trial and Appeal Board*, 66 Trademark Rep. 141, 141 (1976).

² See TBMP §§ 704.05(b) (Exhibits to Briefs) and 704.06(b) (Statements in Briefs) and authorities cited therein.

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to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

801.02(a) Plaintiff's Main Brief

The main brief of the party in the position of plaintiff is due not later than 60 days after the date set for the close of the rebuttal testimony period.³

If a party in the position of plaintiff fails to file a main brief, the Board may issue an order allowing plaintiff until a set time, not less than 15 days, in which to show cause why its failure to file a main brief should not be treated as a concession of the case. If the plaintiff fails to file a response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff.⁴ The purpose of this order to show cause procedure is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board, or where the plaintiff has lost interest in the case. It is the policy of the Board not to enter judgment against a plaintiff, for failure to file a main brief on the case, where the plaintiff, in its response to the show cause order, indicates that it has not lost interest in the case.⁵

For further information concerning the 37 CFR § 2.128(a)(3) order to show cause procedure, see TBMP § 536.

801.02(b) Defendant's Main Brief

The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant.⁶

However, if a party in the position of defendant wishes to file a brief on the case, the brief is due not later than 30 days after the due date of the plaintiff's main brief.⁷

³ 37 CFR § 2.128(a)(1).

⁴ 37 CFR § 2.128(a)(3). *See CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (opposer's failure to respond to order to show cause under Rule 2.128 resulted in entry of judgment).

⁵ *See* TBMP § 536 (Motion for Order to Show Cause Under Rule 2.128(a)(3)) and authorities cited therein.

⁶ 37 CFR § 2.128(a)(1). *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

⁷ 37 CFR § 2.128(a)(1). *See Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250, 250 (TTAB 1972) (uncontested motion to strike brief filed three weeks after due date granted). *For information on extensions of time, see* TBMP § 509.

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801.02(c) Plaintiff's Reply Brief

The filing of a reply brief is optional for a party in the position of plaintiff.⁸

However, if a party in the position of plaintiff wishes to file a reply brief, the brief is due not later than 15 days after the due date of the defendant's main brief.⁹

801.02(d) Reply Brief for Defendant Not Permitted

There is no provision for filing a reply brief, rebuttal brief, rejoinder brief, etc. by a party in the position of defendant. If a party in the position of defendant files such a brief, it may be stricken, or given no consideration, by the Board.¹⁰

However, if a defendant has counterclaimed to cancel a registration owned by the plaintiff, the defendant, as plaintiff in the counterclaim, may file a reply brief directed to the counterclaim.¹¹

801.02(e) Special Situations

In certain special situations, the Board will set, by written action, the due dates for the filing of briefs on the case. This occurs when (1) there is a counterclaim, (2) proceedings have been consolidated, and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or (3) there is an interference or a concurrent use registration proceeding involving more than two parties.¹²

For example, if there is a counterclaim, the Board will issue an order setting the due dates for plaintiff's main brief in the original proceeding (due the 60th day after the date set for the close of rebuttal testimony); defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim (due the 30th day after the due date of the plaintiff's main brief); plaintiff's combined reply brief in the original proceeding and its brief as defendant in the counterclaim (due the 30th day after the due date of defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim); and defendant's

⁸ See 37 CFR § 2.128(a)(1), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

⁹ See 37 CFR § 2.128(a)(1).

¹⁰ See TBMP § 539 (Motion to Strike Brief on Case) and cases cited therein.

¹¹ See TBMP § 801.02(e) (Time for Filing – Special Situations).

¹² See 37 CFR § 2.128(a)(2).

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reply brief as plaintiff in the counterclaim (due the 15th day after the due date of plaintiff's combined reply brief in the original proceeding and brief as defendant in the counterclaim).¹³

In an interference or concurrent use registration proceeding, the Board will schedule briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief in which it may meet the brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief.¹⁴

801.03 Form and Contents of Brief

37 CFR § 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. A paper submission, including exhibits and depositions, must meet the following requirements:

- (1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*
- (2) A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*
- (3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*
- (4) A paper submission must not be stapled or bound;*
- (5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in §2.123(g)(2);*
- (6) Exhibits pertaining to a paper submission must be filed on paper or CD-ROM concurrently with the paper submission, and comply with the requirements for a paper or CD-ROM submission.*

(b) Submissions may be made to the Trademark Trial and Appeal Board on CD-ROM where the rules in this part or Board practice permit. A CD-ROM submission must identify the parties and case number and contain a list that clearly identifies the documents and exhibits contained thereon. This information must appear in the data contained in the CD-ROM itself, on a label affixed to the CD-ROM, and on the packaging for the CD-ROM. Text in a CD-ROM submission must be in at least 11-point type and double-spaced. A brief filed on CD-ROM must be accompanied by a single paper copy of the brief. A CD-ROM submission must be accompanied

¹³ See the Appendix of Forms for a sample briefing schedule.

¹⁴ See TBMP § 1007 (example of a briefing schedule in an interference proceeding), and TBMP § 1109 (example of a briefing schedule in a concurrent use proceeding). Cf. 37 CFR § 2.121(b)(2).

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by a transmittal letter on paper that identifies the parties, the case number and the contents of the CD-ROM.

(c) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.

(d) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to §2.125(e) must be submitted under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must be submitted.

37 CFR § 2.128(b) *Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cases cited. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety.*

A brief on the case must be submitted in written form and must meet the general requirements for submissions to the Board specified in 37 CFR § 2.126. A party may file a brief on the case on paper, CD-ROM, or electronically through ESTTA.¹⁵ The requirements for each form of submission are set out in 37 CFR § 2.126(a), (b) and (c), respectively. If the brief is submitted on CD-ROM, a paper copy of the brief must be submitted at the same time.¹⁶

In addition to the general requirements for submissions to the Board, briefs at final hearing are also subject to the page limitations specified in 37 CFR § 2.128(b).¹⁷

As provided in 37 CFR § 2.128(b), without prior leave of the Board, a main brief on the case may not exceed 55 pages in length in its entirety, and a reply brief may not exceed 25 pages in its entirety. The parts of the brief that fall within the length limit include the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary. Extensive single-spaced footnotes may not be used as a subterfuge to avoid the page

¹⁵ See also TBMP § 106.03 (Form of Submissions).

¹⁶ See 37 CFR § 2.126(b).

¹⁷ See also, with respect to briefs on the case, David J. Kera, *TIPS FROM THE TTAB: Preparing and Filing Briefs With the trademark Trial and Appeal Board*, 66 Trademark Rep. 141 (1976).

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limit.¹⁸ Exhibits or appendices to a brief, not being part of the brief itself, are not included within the page limit.¹⁹ In addition, evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit.²⁰

For information concerning motions for leave to file a brief exceeding the page limit, see 37 CFR § 2.128(b) and TBMP § 537.

The brief must contain an alphabetic index of all cited cases. When cases are cited in a brief, the case citation should include a citation to *The United States Patent Quarterly* (USPQ), if the case has appeared in that publication.

The description of the record should comprise a list of the evidence properly introduced by the parties, such as, "The evidence of record consists of opposer's Registration No. 1,234,567; applicant's answers to opposer's interrogatories; the discovery deposition of Mr. X; and the testimony depositions of opposer's witnesses, Mr. Y and Ms. Z." For each significant fact recited, the recitation of facts should include, a citation to the portion of the evidentiary record where supporting evidence may be found.

If a mark that is the subject of, or is pleaded in, a proceeding includes stylization or a design feature, a reproduction of the mark should be included in the brief on the case.

If a plaintiff files a reply brief, the brief must be confined to rebutting the defendant's main brief.

Confidential information. Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying.²¹ Therefore, only the particular portion of a brief that discloses

¹⁸ See *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 n.3 (TTAB 1992) (warned that single-spaced footnotes containing substantial discussion may be viewed as a subterfuge to avoid page limit).

¹⁹ See 37 CFR § 2.128(b); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (raising evidentiary objections in appendices was not viewed as subterfuge to avoid page limit); *United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1543 (TTAB 1994) (motion to file 30-page reply brief denied as unnecessary where main brief was 18 pages and responsive brief was 37 pages), and *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, *supra*.

²⁰ See *Harjo v. Pro-Football Inc.*, *supra* at 1792 (appropriate evidentiary objections may be raised in appendix or separate paper rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) and *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, *supra*.

²¹ See, e.g., *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of

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confidential information should be filed under seal pursuant to a protective order. If a party submits a brief containing confidential information under seal, the party must also submit for the public record a redacted version of the brief.²²

Confidential portions of the brief, if any, must be submitted in accordance with 37 CFR § 2.126(d). The requirements for confidential submissions are specified in part (d) of 37 CFR § 2.126. To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be filed under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must also be submitted.²³

Confidential materials filed in the absence of a protective order are not regarded as confidential and will not be kept confidential by the Board.²⁴

For further information regarding confidential materials, see TBMP §§ 120.02 and 412.

801.04 Amicus Briefs

The Board may, in its discretion, entertain an amicus brief.²⁵ An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. *For information concerning motions for leave to file an amicus brief, see TBMP § 538.*

801.05 Motion to Strike Brief on Case

A party may move to strike a brief on the case on a variety of grounds, including that the brief was untimely filed, exceeds the page limit for a brief on the case, violates the format requirements for such a brief, is a brief not provided for by the applicable rules (e.g., is a reply brief filed by the defendant). In addition, a party may move to strike evidentiary matter attached to a brief where the evidentiary matter was not properly made of record during the time for

such motion, the exhibits would be placed in the proceeding file), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003).

²² See 37 CFR §§ 2.27(d) and (e), and 2.126(d); *Duke University v. Haggard Clothing Inc.*, *supra* at 1445; and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

²³ See 37 CFR § 2.126(d). See also TBMP § 120.02 (Confidential Materials).

²⁴ See *Harjo v. Pro-Football, Inc.*, *supra* (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file).

²⁵ See TBMP § 538 (Motion for Leave to File Amicus Brief) and authorities cited therein.

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taking testimony. *For information concerning motions to strike a brief on the case, or matter attached to such a brief, see TBMP § 539 and cases cited therein.*

802 Oral Hearing

37 CFR § 2.129(a) If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives.

802.01 In General

The oral hearing on the case in an inter partes proceeding before the Board corresponds to the oral summation in court proceedings after all the evidence is in.²⁶

An oral hearing is optional and is scheduled only if a timely request therefor is filed by a party to the proceeding. The oral hearing provides a party with one last opportunity to emphasize its strongest arguments, and to refute its adversary's arguments. It is particularly useful in cases with complex issues or a complex record, or where the defendant needs to respond to arguments in the plaintiff's reply brief.²⁷

Subject to Fed. R. Civ. P. 11, a party is entitled to offer at oral hearing any argument it feels will be to its advantage. However, the facts recited and arguments made at oral hearing must be based on the evidence offered at trial. An oral hearing may not be used as a vehicle for the introduction of evidence.²⁸

²⁶ See 37 CFR § 2.116(f). *For information on oral hearings in ex parte cases, see TBMP § 1216.*

²⁷ *For information concerning situations in which it may be advisable to request an oral hearing on a case, see Saul Lefkowitz, TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board, 67 Trademark Rep. 283 (1977).*

²⁸ See 37 CFR § 2.123(1); TBMP § 704.06 (Statements in Pleadings or Briefs); and Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977). Cf. TBMP § 801.01 (Briefs on the Case – In General).

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802.02 Request for Oral Hearing

A party that wishes to have an oral hearing on the case must file a request, by separate paper (not as part of its brief on the case), not later than 10 days after the due date for filing the last reply brief in the proceeding.²⁹ Any party to the proceeding may request a hearing.

If an oral hearing is not requested, the case will be decided in due course after the due date for filing the last reply brief on the case.

802.03 Time and Place of Hearing

When a timely request for an oral hearing on the case has been filed by a party to an inter partes proceeding before the Board, the Board sets the date and time for the hearing, and sends each party a written notice of hearing specifying the date, time, and location of the hearing.³⁰ Oral hearings are ordinarily scheduled on Tuesdays, Wednesdays and Thursdays. In setting an oral hearing it is the normal practice of the Board, to telephone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing. A written notice formally scheduling the hearing is mailed.

Oral hearings are almost exclusively held at the offices of the Board. However, there are two off-site video conference centers available for use for oral hearings. The two video conference centers are located in Sunnyvale, California and Detroit, Michigan. To request a hearing by video conference, a party must make the request in its written request for an oral hearing. When a request is received, the Board will contact the off-site video conference centers to obtain available times and dates, as well as the on-site video conference center for tentative scheduling options that coincide with the off-site video conference center. Once the information is obtained, counsel will be contacted and informed of the nearest center location, the available scheduling dates/times and the fee required by the off-site center. The requesting party is responsible for the fee for the off-site center. Once agreement is made on the conference, the Board will secure the hearing centers and provide written notice to the parties.

Attendance at a scheduled oral hearing is voluntary, not mandatory. If any party appears at the specified time, the party will be heard, whether or not the party that appears is the one that requested the hearing.³¹ If a party elects not to attend a scheduled hearing, the party should notify the Board, well in advance of the scheduled hearing date, that it will not attend the hearing.

²⁹ See 37 CFR § 2.129(a).

³⁰ See 37 CFR § 2.129(a).

³¹ See 37 CFR § 2.129(a).

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If a party that requested an oral hearing fails to appear at the appointed time, without giving prior notice to the Board of nonappearance, the failure to appear will be construed by the Board as a withdrawal of the request for an oral hearing. Any new request for an oral hearing will be granted only upon a showing that the failure to appear was occasioned by extraordinary circumstances.

If the Board is prevented from hearing the case at the time specified in the notice of hearing, a new hearing date will be set.³² The Board will reschedule an oral hearing, at the request of the parties, if there is a reasonable basis for the request. But, absent compelling circumstances, a hearing date will not be changed if the request for rescheduling is made within two weeks of the scheduled hearing date unless both parties agree to the change. When the parties agree to the resetting of an oral hearing, they should determine a new date and time convenient to every party and then contact the Chief Administrative Trademark Judge's secretary by telephone, well prior to the scheduled hearing date, to request that the hearing be reset for the new date and time. The parties should also file a written stipulation or consented motion confirming their agreement. If the parties agree to reset an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations. If agreement cannot be reached, the party that wishes to have the hearing reset should file a motion therefor.³³ However, parties should not file repeated requests to reset an oral hearing. *For information concerning requests to reset an oral hearing, see TBMP § 541.01*

802.04 Before Whom Held

An oral hearing is held before a panel of at least three members of the Board (i.e., its statutory members, generally administrative trademark judges).³⁴ Normally, an oral hearing panel consists of only three Board members. If for some reason a member of a panel of three that held the oral hearing is unable to participate in the final decision, another Board member may be substituted at final decision for the missing member, even though the substituted member was not present at the oral hearing; no new oral hearing is necessary.³⁵

³² See 37 CFR § 2.129(a).

³³ See 37 CFR § 2.129(b).

³⁴ See 37 CFR § 2.129(a). *Cf.* Section 17 of the Act, 15 U.S.C. § 1067; *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 420 n.8 (CCPA 1972) (where only one Board member signed decision, court presumed the proper number participated in decision) and 37 CFR § 2.142(e)(1).

³⁵ See *In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1, 3-4 (Fed. Cir. 1985) (statutory requirement that a case be heard "means judicially heard not physically heard"), and *Jockey International, Inc. v. Bette Appel Unltd.*, 216 USPQ 359, 360 (TTAB 1982). *Cf. Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464, 464 (TTAB 1983) (final decision rendered by only two Board members vacated); *Ronson Corp. v. Ronco Teleproducts, Inc.*, 197 USPQ 492, 494 (Comm'r 1978) (final decision heard by three Board judges but rendered by only two, vacated and oral hearing

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The Board may, in its discretion, use an augmented panel to hear a case.³⁶ A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding.³⁷

For information concerning motions for an augmented panel hearing, see TBMP § 540. For further information concerning the constitution of Board panels, see In re Alappat, 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994).

802.05 Length of Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral argument. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal.³⁸ If there is a counterclaim, the defendant, as the plaintiff in the counterclaim, may also reserve part of its 30 minutes for rebuttal on the counterclaim.

There is no requirement that a party use all of its allotted 30 minutes for oral argument. Often, a case may be presented in considerably less than 30 minutes.

On the other hand, if a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time.³⁹ If the request is granted, each party will be allowed the same amount of time for oral argument. *For information concerning requests or motions for additional time for oral argument, see TBMP § 541.02.*

rescheduled); and *Ethicon, Inc. v. American Cyanamid Co.*, 193 USPQ 374, 377 (Comm'r 1977) (petition to vacate decision denied).

³⁶ See TBMP § 540 (Motion for Augmented Panel Hearing) and cases cited therein.

³⁷ See, for example, *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992) (augmented panel used to overrule previous decision barring examining attorneys from requesting reconsideration), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (in view of issues presented, oral hearing held before augmented panel of eight Board members); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986) (augmented five-member panel); and *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services). See also *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (augmented panel of eight members because of the importance of the issues).

Cf. Federal Circuit Rule 35. *Cf. also Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

³⁸ See 37 CFR § 2.129(a).

³⁹ See 37 CFR § 2.129(a); TBMP § 541.02 (Motion for Additional Time for Oral Argument) and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987) (additional time for arguments allowed in view of voluminous record).

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802.06 Audiotaping and Videotaping

Upon motion showing good cause and with prior arrangement, the Board will usually permit a party to make an audiotape recording of an oral hearing. The recording, when permitted by the Board, is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board). The motion should be filed well in advance of the date set for the oral hearing, so if an objection is raised, the Board will have time to rule on the matter. *For information concerning motions for leave to audiotape an oral hearing, see TBMP § 542.*

If permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audio taping equipment in an unobtrusive manner.

A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, *an oral hearing before the Board may not be videotaped.*⁴⁰

802.07 Visual Aids, etc.

The Board will generally allow certain types of materials, such as graphs, large depictions of marks, schedules, charts, etc., to be used at oral hearing, either for clarification or to eliminate the need for extended description, when such materials are based on evidence properly of record.⁴¹

A party may also bring to the oral hearing any materials introduced as exhibits at trial, including audiotapes or videotapes of commercials or demonstrations. A party that introduced an audiotape or videotape as an exhibit at trial, and wishes to play it at the oral hearing, should notify the Board in advance. In addition, a party that wishes to play such a tape at oral hearing is responsible for furnishing, operating, and removing the necessary equipment in an unobtrusive manner.

A party may not, however, use an oral hearing for the purpose of offering new evidence, whether in the form of charts, graphs, exhibits, or other such materials.⁴² Nor may a party submit in writing the text of its oral argument; to allow such a practice would be to permit a party, in effect, to file an additional brief on the case.⁴³

⁴⁰ See TBMP § 542.

⁴¹ See *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.5 (TTAB 1990).

⁴² See TBMP § 802.01 (Oral Hearing – In General) and authorities cited therein.

⁴³ See *Reflange Inc. v. R-Con International*, *supra*.

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802.08 Nature of Hearing

Prior to an oral hearing, the Board panel members read the briefs on the case and, if necessary, examine the case files. Thus, persons presenting oral arguments should not read from the briefs on the case, except to emphasize an admission contained in an adversary's brief.

Normally, an oral hearing case is not assigned to a particular Board member to draft a final decision until some time after the oral hearing. Thus, the Board member who sits in the middle of the panel of three is not necessarily the person to whom the case will be assigned for decision; rather, the middle panel member is usually (but not always) the senior panel member.

A person presenting oral arguments should be prepared to answer questions from Board panel members at any point in the arguments. If exhibits or visual aids have been brought to the oral hearing, they should be shown to the adversary before they are shown to the Board panel. Further, a person presenting oral arguments should never interrupt the oral arguments of the adversary.

For further information on how to argue a case before the Board, see Saul Lefkowitz, TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board, 67 Trademark Rep. 283 (1977).

803 Final Decision

After an oral hearing has been held in a Board inter partes proceeding, the case is set down for final decision. If no oral hearing is requested, the case is set down for final decision after the due date for filing the last reply brief.

A panel of at least three Board members renders the final decision.⁴⁴ When there has been an oral hearing in a case, the final decision normally is rendered by the panel before which the oral hearing was held. If a member of a panel of three before which an oral hearing was held is unable to participate in the final decision, another Board member may be substituted at final decision for the missing member.⁴⁵

The Board may use an augmented panel at final decision. *For information concerning the use of an augmented panel, see TBMP § 540. For further information concerning the constitution of Board panels, see In re Alappat, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).*

⁴⁴ See Section 17 of the Act, 15. U.S.C. § 1067. See also TBMP § 802.04 (Oral Hearing – Before Whom Held) and cases cited therein.

⁴⁵ See TBMP § 802.04 and cases cited therein.

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Every member of the panel assigned to decide the case does not read the evidentiary record in a case. Rather, one panel member is assigned to read the testimony and examine the other evidence of record, discuss the case with the other panel members, and then draft a decision and supporting opinion. The draft is circulated to the other panel members for their approval and signature. A panel member who does not agree with the decision may write a dissent. A panel member who agrees with the decision, but disagrees with the reasoning expressed in the opinion supporting the decision, or wishes to express additional reasons, may write a concurring opinion.

When the members of the panel rendering the decision have signed a final decision, a copy is mailed to every party to the proceeding. All final decisions are posted on the USPTO web site as final decisions of the TTAB. The decisions are grouped first by year decided and then by issues. Within the groupings of issues, the decisions are listed by proceeding number.

Section 21 of the Trademark Act, 15 U.S.C. § 1071, and 37 CFR § 2.145 govern any appeal from a final decision of the Board.⁴⁶

804 Request for Rehearing, Reconsideration, or Modification of Final Decision

A party may file a request for rehearing, reconsideration, or modification of a decision issued after final hearing.⁴⁷ The request must be filed within one month from the date of decision and a responsive brief, if any, is due within 15 days of the date of service of the request. *For information concerning requests for rehearing, reconsideration, or modification of a decision issued after final hearing, see TBMP § 543.*

805 Final Decision Remand to Examining Attorney

37 CFR § 2.131 Remand after decision in inter partes proceeding. *If, during an inter partes proceeding involving an application under Section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in the light of the reference by the Board. If, upon reexamination, the*

⁴⁶ See TBMP Chapter 900 regarding appeals.

⁴⁷ See 37 CFR § 2.129(c).

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trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

If, during the course of an opposition, concurrent use, or interference proceeding involving an application under Section 1 or 44 of the Trademark Act, facts are disclosed which appear to render the mark of the involved application unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to Fed. R. Civ. P. 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, remand the application to the trademark examining attorney for further examination in light of the disclosed facts. That is, the Board may include in its decision a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the examining attorney reexamine the application in light of the disclosed facts.⁴⁸ An application under Section 66(a) of the Act may not be remanded under 37 CFR § 2.131.

If a party to an opposition, concurrent use, or interference proceeding involving a Section 1 or 44 application believes that the facts disclosed therein appear to render the mark of the involved application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR § 2.131 remand to the examining attorney. The request may be made in the party's brief on the case, or by separate motion. A 66(a) application may not be remanded under 37 CFR § 2.131.

806 Termination of Proceeding

When an inter partes proceeding before the Board has been finally determined (that is, when the time for filing an appeal from a decision of the Board determining the case has expired, and no appeal has been filed, or when any appeals filed have been determined), the Board takes certain further steps, based on the judgment entered, to close out the proceeding file and give effect to the judgment.⁴⁹ The same is true when a proceeding ends by stipulation of the parties, or by a voluntary withdrawal or consent to judgment by one party.

For example, when a decision of the Board dismissing an opposition becomes final (that is, the time for filing an appeal has expired, and no appeal has been filed), or the opposition is dismissed pursuant to a stipulation of the parties or as the result of a withdrawal by opposer, among other things, the Board normally takes the following steps:

⁴⁸ See 37 CFR § 2.131 and TBMP § 515 (Motion to Remand Application to Examining Attorney) and cases cited therein. Cf. TBMP § 1217 (Final Decision).

⁴⁹ See Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34896, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 34.

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- (1) The testimony depositions, any discovery depositions made of record in the case, and one copy of each brief on the case (that is, materials which, because of their bulkiness, would not have been kept by the Board in the proceeding file), are all placed in the proceeding file.
- (2) The word "TERMINATED" is stamped on the proceeding file.
- (3) The proceeding file is sent to the USPTO warehouse where terminated proceeding files are stored.
- (4) Exhibits, which, because of their size, were too bulky to put in the proceeding file, and therefore were stored separately by the Board, are returned to the party that filed them.
- (5) Confidential materials filed under protective order are returned to the party that filed them.
- (6) The applicant's subject application is sent to the appropriate section of the Office for further appropriate action, such as, issuance of a notice of allowance under 37 CFR § 2.81(b), in an intent-to-use application for which no amendment to allege use under 37 CFR § 2.76 has been submitted and accepted; issuance of a registration pursuant to 37 CFR § 2.81(a); republication, if necessary for some reason; or reexamination by the trademark examining attorney pursuant to a 37 CFR § 2.131 remand.⁵⁰ Alternatively, if the applicant has abandoned the subject application, the abandoned application is sent to the USPTO warehouse where newly abandoned applications are stored (pending their destruction approximately two years after abandonment).

When a decision of the Board granting a petition for cancellation becomes final, the first five steps listed above are taken, and the subject registration is cancelled by separate order of the Director. When a decision of the Board dismissing a petition for cancellation becomes final, the first five steps are taken, and the file of the registration is returned to the USPTO warehouse where "live" (subsisting) registrations are stored.

Because the Board will take the termination steps described above when a Board decision appears to be final, a party that commences a civil action, seeking review of the Board's decision pursuant to Section 21(b) of the Act, 15 U.S.C. § 1071(b), must file written notice thereof with the Board. Board practice requires that the written notice be filed within one month after the expiration of the time for appeal or civil action. If a party files a civil action, but fails to notify the Board, the Board, believing that its decision has become final, will terminate the proceeding.

⁵⁰ See TBMP § 805 (Final Decision Remand to Examining Attorney).

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As a result, a registration may be issued or cancelled prematurely, while the civil action seeking review of the Board's decision is still pending.

807 Status of Application After Proceeding

37 CFR § 2.136 Status of application on termination of proceeding. On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.

When an opposition, concurrent use or interference proceeding ends with a judgment which is not adverse to an involved applicant, the application returns to the status it had before commencement of the proceeding, unless the Board indicates in its decision that the application must be republished for some reason, or includes in its decision a 37 CFR § 2.131 remand to the trademark examining attorney.⁵¹

If the proceeding ends with a judgment that is adverse to the applicant, the application stands refused, the file thereof is stamped "ABANDONED," and all proceedings are considered terminated.⁵²

⁵¹ See TBMP § 805 (Final Decision Remand to Examining Attorney) and 37 CFR § 2.136.

⁵² See 37 CFR § 2.136; *Forest Laboratories Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1060 n.3 (TTAB 1999) (if opposition is sustained, application is deemed abandoned); and *In re Vesper Corp.*, 8 USPQ2d 1788, 1789 (Comm'r 1988) (there is no authority for the Commissioner to reopen an application for entry of an amendment after a successful opposition). See also *National Patent Development Corp. v. Hercules Inc.*, 192 USPQ 491, 492 (Comm'r 1976) (Commissioner refused to reopen application for motion to amend after adverse final judgment in opposition).