

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# **Trademark Trial and Appeal Board (TTAB) Recent Developments and Best Pretrial Practices**

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# TTAB – general stats (FY20)

- Ex parte appeals 528 decided
- Inter partes cases 200 decided
- Precedents 43 decisions (35-40 target)
- Pendency (appeals) 11.7 weeks ( $\leq 12$  weeks goal)
- Pendency (trials) 17.7 weeks ( $\leq 15$  weeks goal)
- **FY21 Q1 – met both pendency goals**

# Recent developments

- **Failure to function as a mark**
  - Covers many refusals
  - Merely informational refusals the focus here
- **Internet domain names (gTLD cases)**
- **Pretrial practice**
- **Discussing only precedents**

# Merely informational “marks”

- **TMEP 1202.04 – Informational Matter**
  - “Merely informational matter fails to function as a mark to indicate source and thus is not registrable.”
- **Three general categories**
  - Conveys general information about goods or services
  - Common phrase or message
  - Religious text
- **Key is consumer perception!**

# Team Jesus

## 2020 USPQ2d 11489

- For clothing and religious educational/entertainment services
- Evidence of common use by third parties
  - Over 20 examples cited in decision
  - Single results page from Google shopping search showed 20 uses, none by applicant
- Board emphasized importance of consumer perception
- “The evidence as a whole shows that TEAM JESUS is a commonplace message of Christian affiliation.”

# Texas Love

## 2020 USPQ2d 11290

- For “hats, shirts”
- Evidence of use by others
  - 8 examples of uses on shirts
  - 3 examples of other uses
- Some uses involved designs + words
  - The message is what matters
- **“TEXAS LOVE is too commonly used in connection with a wide variety of goods that typically carry such messages for it to be perceived as a trademark, and applicant should not be able to deny potential competitors (who according to the record also use the phrase) the right to use it freely”**

# God Bless the USA

2020 USPQ2d 11439

- Lee Greenwood application – for home goods (pillows, wall art, etc.)
- Evidence showed many uses of same phrase on the goods
  - 12 examples provided in decision
  - More in the record
- “Consumers ordinarily take widely-used, commonplace messages at their ordinary meaning, and not as source indicators, absent evidence to the contrary.”
- Applicant focused on reaction of Lee Greenwood fans
  - Application contained no limits in the identification of goods
  - “the relevant consumers are members of the general public”
  - Applicant has registrations for Lee Greenwood Collection



# PAST PRESENT FUTURE

2020 USPQ2d 11298

- For “t-shirts”
- Guess what? Ample evidence of use by others
  - Seven general examples
  - Wikipedia page showing phrase in title of 2 books, 12 albums and 13 songs
  - Nine samples of third party t-shirts bearing the phrase
- “Ubiquitous third-party use of the phrase PAST PRESENT FUTURE to refer to the past, present and future of people, things, ideas and concepts”
- “PAST PRESENT FUTURE is not perceived as a mark when used in connection with t-shirts”

# Why the failure to function refusals?

- **Trademarks are defined by their function**
  - A trademark must “identify and distinguish” – 15 U.S.C. § 1127
  - A word or phrase that does not “identify and distinguish” does not function as a mark
- **Consumer perception is the key**
  - Our perceptions and memories are shaped by exposure
  - Exposure to widespread use of a word or phrase by many parties makes it unlikely the word or phrase will “identify and distinguish” a single party from all others
- **Protection would harm third parties**
  - Trademarks are protected to enhance competition, not to hinder it

# **Failure to function – why the questions and comments?**

- **Relies on combination of statutory sections**
- **Overlaps with Section 2(e)(1) – merely descriptive**
- **Acquired distinctiveness and Supplemental Register are not available**
- **Consistency is a challenge**

# gTLD cases

- Post Booking.com – pair of gTLD cases
- Over 1,200 gTLDs
- Two parties sought registrations for their gTLDs – both denied
  - .sucks – 2020 USPQ2d 11289
  - .cam – 2020 USPQ2d 11048
- Registering a gTLD alone is different from generic.gTLD

# Pretrial practice cases

- Titomirov – 2019 USPQ2d 418666 – discovery misconduct
  - “these actions show a course and pattern of delay that evidence willful evasion of **Titomirov's** discovery obligations”
  - Lesser sanctions were not effective
  - Final judgment entered as a sanction
- **We take our rules seriously**

# Other pretrial precedents

- **DiMarzio** – trade dress case involving appearance of electric guitar pickups – 2020 USPQ2d 10671
  - Rule 30(b)(6) deposition dispute
  - Individual’s residence not controlling
- **Cloudworks** – 2020 USPQ2d 10019
  - U.S. Counsel Rule applies to Canadian parties

UTAH IP SUMMIT

***USPTO's Trademark Trial and Appeal Board:  
Tips and Tricks for Oppositions and  
Cancellations***

Jennifer L. Elgin, Interlocutory Attorney

February 19, 2021

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# TBMP

**TBMP** Trademark Trial and Appeal Board Manual of Procedure  
2020-06

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## United States Patent and Trademark Office

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PREFACE TO THE JUNE 2020 REVISION

The June 2020 revision is an update of the June 2019 edition. Primarily, this update incorporates relevant case law issued between March 1, 2019 and February 29, 2020. In addition, the update includes changes to the rules due to the requirement for foreign-domiciled applicants, registrants and parties to a proceeding to be represented by a U.S.-licensed attorney and changes to the rules due to mandatory electronic filing before the Trademark Examining Operation.

The title of the manual is abbreviated as "TBMP." A citation to a section of the manual may be written as "TBMP § \_\_\_\_ (2020)."

As with previous editions, this edition is available online at the TTAB home page of the USPTO web site in a searchable, printable format as well as in pdf. A link to archived editions of the TBMP is also available at the TTAB's home page.

*Cheryl Butler*  
*Senior Counsel and TBMP Editor*  
*Trademark Trial and Appeal Board*

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# Pleading (TBMP Ch. 300)

- Change in nomenclature – standing/entitlement to a statutory cause of action
- Notice pleading – **BUT**
  - Plead fraud claims with **particularity** (Rule 9(b))
  - No bald affirmative defenses
- Exhibits to pleadings not of record
  - Attach TSDR records of pleaded registrations

# Discovery (TBMP Ch. 400)

- Discovery & settlement conference
- What is acceptable
  - TBMP § 414
  - Trademark Rule 2.120(d) and (e) and *One Jeanswear Grp. Inc. v. YogaGlo, Inc.*, 127 USPQ2d 1793, 1796-97 (TTAB 2018).
- Extensions (good cause) and reopens (excusable neglect)
  - Settlement discussions
  - Docketing errors

# Motions (TBMP Ch. 500)

- General tips on drafting
- Watch the timing of motions – there are deadlines!
- Motions to Compel – TBMP § 523.02
  - Good faith effort required
  - Attach your discovery requests
- Summary Judgment – hard to get, consider ACR

# Accelerated Case Resolution (ACR)

- TBMP 528.05(a)(2) and 702.04(d)
- Stipulated record model
- Summary judgment model

# Settlement (TBMP Ch. 600)

- Get written consent for withdrawals, abandonments, surrenders to avoid judgment
- Amendments – TBMP § 514
  - File a redline
  - Application or registration subject to multiple proceedings
  - Withdraw contingent on acceptance

# General

- For more info: “Advanced Practice Tips from the TTAB” by Hon. Christen English and Interlocutory Attorney Mary Beth Myles
- Questions?
  - Phone: 571-272-8500, Monday - Friday 8:30 a.m. to 5 p.m. ET
  - Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov) (General Information about TTAB proceedings)
  - Email: [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov) (Technical assistance with ESTTA filings)

