

Anatomy of a Typical TTAB Case



(Notice of Opposition or Petition to Cancel)

Phase 1: Initiation of the Case

A trademark opposition or trademark cancellation proceeding begins with the filing of a Notice of Opposition or a Petition to Cancel. Shortly after it is filed, the TTAB will set a deadline for the trademark owner to file its Answer. The Answer is mandatory, and the failure to file an Answer can result in the immediate loss of the trademark. The Answer should also include certain Affirmative Defenses, which may be deemed to have been waived if they are not raised in the Answer or early in the case.

After the Answer has been filed, the parties or their attorneys must conduct a mandatory case planning conference, during which the parties discuss case scheduling, issues related to discovery, the need for a protective order, and the possibility of settlement.

This initial phase lasts one to three months. Many cases are settled during the initial phase.

Phase 2: Discovery

The discovery phase is when the parties exchange information relevant to the case. Each party has the opportunity to provide the other party with written discovery requests, asking for information or the production of documents. Interrogatories request that the other party answer written questions, Requests for Production seek copies of relevant documents, and Requests for Admission ask the other party to admit or deny certain facts. The parties may also take Depositions of one another or of other people with information related to the case. A deposition is when a witness testifies under oath about issues and facts in the case, such as how a trademark was developed, the parties' marketing efforts, and other issues.

The discovery phase also often includes discovery related to expert witnesses. Depending on the issues in the case, many trademark opposition and trademark cancellation proceedings require the testimony of an expert witness to provide clarity on consumer or industry trends or other issues that have a bearing on the

facts of the case. Expert witnesses typically provide written reports of their opinions, and parties often want to take the depositions of the other party's expert witness to learn more about the basis for his or her opinions.

The discovery phase is crucial to gathering the information needed to take a trademark opposition or trademark cancellation case to trial. This phase is important to build a client's case for trial, and learning more about the facts of the case can often facilitate a settlement. The discovery phase typically takes six to nine months but can take longer in complex cases.

Phase 3: Trial

Unlike most court cases, there is no live trial in front of a judge or jury in TTAB cases. Instead, the parties submit evidence, deposition testimony, expert opinions for consideration, along with lengthy briefs containing their oral arguments. The parties may take additional trial testimony depositions in this phase, and they may submit their evidence and information over a period of time. The submission of evidence and arguments typically takes two to four months, and then the parties can expect to wait another few months for the TTAB to render a decision.

If you believe you need to initiate a trademark opposition or cancellation proceeding, or one has been filed against your trademark, contact one of our experienced TTAB attorneys to discuss the details of your case.