Franklin Pierce Law Center

Inter Partes Practice in the USPTO – 1P0093

Final Examination April 24, 2008

This is an open examination . You may have in the room whatever materials you wish to have.

There are ten true or false questions. Each correct answer is worth 2 points.

There are twenty multiple choice questions, some of which may have more than one correct choice. A fully correct answer to a multiple choice question is worth 4 points. One to 3 points will be given for a partially correct answer.

The questions are based on the following hypothetical fact situation and the class lectures and discussions.

Showme Corporation filed an application to register CONDICAM for camcorders. The application was filed on July 1, 2007 on the basis of use of the mark in commerce and claims first use and first use in commerce on February 1, 2006. the description of goods in the application reads: "Camcorders; memory cards for camcorders; rechargeable battery packs; battery rechargers; tote bags for camcorders and accessories."

The application was published on April 22, 2008.

Photobug Corporation owns a registration of the trademark FONLICAM for the description of goods; "Digital portrait cameras , lenses, and tripods." The application was filed on January 3, 2006 on the basis of a bona fide intention to use the mark.

The mark was first used and first used in commerce on July 15, 2007 and a Statement of Use was filed. The registration was issued on August 15, 2007.

Photobug believes that the registration of CONDICAM would damage Photobug's rights in its trademark FONLICAM.

TRUE – FALSE (2 points for each correct answer)

TRUE	FALSE		
____	____	1.	If Photobug files an opposition based on likelihood of confusion, standing to oppose is presumed.
____	____	2.	If Photobug files an opposition based on alleged descriptiveness, Photobug must plead that it is using or is in a position to use CONDICAM as a descriptive word.
____	____	3.	In any opposition, the amended Rules of Practice in effect as of November 1, 2007 will control the timing of events in the proceeding.
____	____	4.	Pursuant to the Amended Rules, an Answer to a Notice of Opposition is due 40 days from the date when the Order instituting the opposition is issued by the Trademark Trial and Appeal Board.
____	____	5.	The TTAB prefers that a Notice of Opposition and all later papers filed at the TTAB be filed electronically using the ESTTA program of the TTAB.
____	____	6.	ESTTA must be used to request an extension of time to oppose a request for extension of protection of a Madrid Protocol International registration to the United States and for filing the Notice of Opposition and in all later proceedings.
____	____	7.	A Notice of Opposition may be amended to add new grounds except when the opposition is against a Madrid Protocol mark.
____	____	8.	The initial disclosures/discovery/settlement conference precedes the opening of discovery.
____	____	9.	Initial disclosures must be served before a party starts discovery.
____	____	10.	Each testimony period is preceded by pretrial disclosure.

MULTIPLE CHOICE (4 points for each completely correct answer. One to 3 points for each partially correct answer)

INDICATE ANSWERS BY CIRCLING LETTERS

1. A Notice of Opposition alleging likelihood of confusion must allege:

   A. Superior rights of the Opposer's mark resulting from: prior use; prior application; registration, or more than one of these bases.

   B. Confusing similarity of Applicant's mark and Opposer's mark.

   C. Competing goods of the Opposer and Applicant.

   D. Goods, or services related in some way likely to cause confusion.

   E. Likelihood of confusion.

2. During a discovery/disclosure/settlement conference

   A. An Administrative Trademark Judge may participate or an interlocutory attorney of the TTAB may participate

   B. Participation of an ATJ or interlocutory attorney must be requested by at least one party

   C. The parties must agree on a complete plan of discovery

   D. Settlement of the opposition is a topic for discussion

   E. Initial disclosures may be discussed

3. Initial disclosures must provide to the adverse party

   A. Name, address and telephone number of each person likely to have discoverable information that the disclosing party may use to support its claims or defenses

   B. Copies or descriptions by category and location of all documents and electronically stored information in the disclosing party's custody, possession, or control that may be used to support its claims or defenses

   C. Names, addresses, and subject matter of possible expert testimony

   D. Names and addresses of potential witnesses not affiliated with the disclosing party

4. A counterclaim to cancel an opposer's pleaded registration must be filed

   A. As part of, or at the same time as, the answer to the opposition if the grounds are known when the answer is filed

   B. Promptly after the grounds are learned if they are learned after the answer is filed

   C. At any time before the rebuttal testimony period for the opposer closes

5. The TTAB's standard protective order

   A. Is intended to keep confidential and commercially sensitive information out of the public record

   B. Is automatically in effect from the institution of a proceeding

   C. Has provisions to limit access to trade secrets and commercially sensitive information to the parties' outside counsel

   D. Requires the identification of confidential, highly confidential, and trade secret information

6. Discovery may be obtained by

   A. Serving up to 75 interrogatories unless a greater number is approved by the TTAB by granting a motion

   B. Serving requests for production, for which there is no numerical limit prescribed in the Rules

   C. Serving requests for admissions, for which there is no numerical limit prescribed in the Rules

   D. Taking depositions of officers, directors, or managing agents of the adverse party

7. Discovery by a party may

   A. Use one or more methods simultaneously or sequentially

   B. Does not have to be delayed until after a party responds to the other party's discovery if the other party starts discovery first

   C. May not be started by a party until after that party makes its initial disclosures

   D. Lasts 180 days but is extendible by stipulated (agreed) motion or a motion by a party that shows good cause

8. If a party does not respond to discovery, the inquiring party may

   A. Move for an order to compel responses to interrogatories and requests for production

   B. Move for an order that the facts for which admissions were requested are deemed admitted

   C. If the answering party failed to designate or to produce a deposition witness, the inquiring party may move for an order to compel the adverse party to produce a deposition witness

9. Documents and things produced in response to requests for production

   A. Are automatically admissible as evidence on behalf of the inquiring party

   B. Must be authenticated before being admissible as evidence

   C. May be authenticated by response to interrogatories, by responses to requests for admissions, or at a discovery deposition

10. Responses to interrogatories and requests for admissions and discovery deposition testimony

   A. May never be used as evidence by the responding party

   B. May be used by the inquiring party or by the responding party to support a motion for summary judgment or a response to a motion for summary judgment

   C. May be used by the inquiring party during its testimony by filing a notice of reliance

   D. If properly introduced in evidence, may be used by both parties to support claims or defenses

11. A material fact is a fact

   A. Which is essential to support an element of a claim or of a defense

   B. Which is interesting as background information

12. A motion for summary judgment

    A. May be filed by an Opposer to obtain a final judgment in a proceeding where there is no disagreement about any material fact necessary to support every element of a claim and the Opposer is entitled to judgment as a matter of law (the legal principles support the claim)

    B. May be filed by an Applicant to obtain a final judgment when there is no disagreement about a material fact which is sufficient to defeat a claim in the opposition

    C. When filed by an Opposer, must be supported by one or more declarations, answers to interrogatories, answers to requests for admissions, or discovery deposition testimony to prove undisputed facts to support every element of the claim

    D. When filed by an Applicant, must be supported by the same kind of evidence as described in (C) to prove by indisputed evidence that the Opposer's case lacks proof of at least one essential element of the claim or by pointing to an absence of factual support for an element necessary to prove the Opposer's claim

13. Each testimony period of a party

    A. Is preceded by pretrial disclosure

    B. If a party does not intend to take testimony, it should inform the adverse party

    C. Is in effect for 30 days except for rebuttal testimony, which period is for 15 days

14. Admissibility of testimony and; evidence is governed

    A. Solely by the Federal Rules of Evidence

    B. Subject to rules pertaining to authenticity

    C. Subject to rules pertaining to authenticity and hearsay

    D. By Federal Rules of Evidence and Rules of the PTO

15. Expert witness testimony

A. Is not required to be disclosed, prior to the expert's testimony

B. Is required to be disclosed by 220 days from institution of the proceeding

C. If not disclosed by 220 days from the institution of the proceeding, may be offered if the TTAB grants a motion to use the expert testimony

16. In the hypothetical stated above

A. Showme has priority resulting from its date of first use

B. Photobug has superiority of right resulting from its registration

C. Showme has a valid basis to counterclaim for cancellation of the FONLICAM registration because CONDICAM was in use prior to the earliest date of use in commerce that could be claimed for FONLICAM

17. A counterclaim or separate petition to cancel a registration on the basis of fraud

A. Can be based only on a claim that the registration (as a pending application) claimed use of the mark on goods for which the mark had not been used

B. Can be based on a claim that material misinformation (other than information on the use of the mark) was given to the Trademark Examiner

C. Can be based on both the claims described in (A) and the claim described in (B)

D. Can be based on the claim described in (A), the claim described in (B), or a claim that material information requested by the Examiner was intentionally withheld from the Examiner

18. Documents more than 20 years old on the date they are offered in evidence

A. Are deemed to be authentic

B. Are deemed authentic if in such condition as to create no suspicion concerning authenticity

C. Are deemed to be authentic if in such condition as to create no suspicion concerning authenticity and were in a place where, if authentic, they would likely be

19. Evidence is not excluded by the hearsay rule, even though the declarant is available as a witness if it is a

A. Pubic record

B. Recorded recollection

C. Market report

D. Print out of a page downloaded from the Internet

20. Briefs at final hearing

A. Are filed according to a schedule prescribed by the Rules

B. Have page limitations

C. May be of any reasonable length

D. Are considered only if the filing party attends the oral argument