Franklin Pierce Law Center

Course: 1P-0093 Spring Term 2004

Inter Partes Practice Before The Trademark Trial and Appeal Board

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This examination consists of 10 True or False and 10 multiple choice questions. Each correct answer is worth 5 points. If more than one lettered subpart of a multiple choice question is correct, pro rata credit will be given for each correct subpart.

Books and notes may be used when taking this examination.

The Trademark Trial and Appeal Board is called TTAB. The Court ofAppeals for the Federal Circuit is called CAFC.

TRUE – FALSE Circle your answers.

T F 1. The TTAB is an administrative court with jurisdiction over issues dealing with the registrability of marks but no jurisdiction over issues of trademark infringement or unfair competition.

T F 2. There are four kinds of proceedings over which the TTAB has jurisdiction.

T F 3. The standing of a party in the position of plaintiff is always presumed to exist in a TTAB proceeding.

T F 4. In an opposition based on likelihood of confusion, the opposer must own a registered mark.

T F 5. Any person who feels personally offended by the mark of an application published in the PTO Official Gazette may file an opposition.

T F 6. There is an unlimited period of time after the publication of an application in the Official Gazette to file an opposition.

T F 7. The accession by the United States to the Madrid Protocol for the international registration of trademarks did not result in any change of practice before the TTAB.

T F 8. In a notice of opposition based on likelihood of confusion the opposer has to plead only that the marks are similar.

T F 9. If the mark of the application is similar to the mark of the opposer's registration, the TTAB requires no additional evidence to sustain the opposition.

T F 10. A descriptive word may be refused registration if an opposer proves that the word describes some attribute of the product or service.

MULTIPLE CHOICE Circle your answers.

1. After a notice of opposition is served, the applicant may:

(a) Serve an answer on the opposer and file a copy at the TTAB.
(b) Move to dismiss the opposition for failure to state a claim on which relief may be granted.
(c) Move to dismiss the opposition on the ground that it does not allege a claim within the jurisdiction of the TTAB.
(d) Each of the above actions is possible depending on the claim alleged.
(e) Defer filing an answer until discovery is completed.

2. A party may inquire about the facts known by the other party by:

(a) Making a telephone call and asking questions.
(b) Serving written interrogatories.
(c) Sending an investigator to interview the other party's employees.

3. Every written interrogatory requires:

(a) A factual answer.
(b) An objection based on irrelevance, attorney-client privilege, confidentiality of information, or some other reason allowed by the Federal Rules of Civil Procedure.
(c) Either a factual answer or an objection, depending on the question.
(d) No response if the question appears to be unreasonable.

4. Information may be obtained from the other side in an opposition by means of:

(a) Interrogatories.
(b) Requests for production of documents.
(c) Requests for admission.
(d) Discovery depositions.
(e) Depositions by written questions.

5. If a discovery deposition seeks to take the deposition of a corporation, the corporation:

(a) May refuse to be deposed.
(b) Must identify one or more persons with knowledge of each subject in the notice of deposition and authority to bind the corporation.

6. Written requests for admissions from the other party to an opposition may:

(a) Seek admissions that facts are true.
(b) Seek admission that specified documents are authentic.
(c) Both of the above.

7. Evidence in a TTAB proceeding:

(a) Is in the form of testimony before an administrative trademark judge.
(b) Is in the form of testimony before a court certified reporter who is a notary public.
(c) May include a notice of reliance from the fruits of discovery taken of the adverse party.
(d) May include a notice of reliance on copies of public records and publications circulating among the relevant public or available in libraries accessible by the relevant pubic.
(e) Must be relevant to the issues framed by the pleadings.

8. A motion for summary judgment:

(a) Must demonstrate that there is no controlling issue of fact in dispute.
(b) Must demonstrate that the moving party is entitled to judgment as a matter of law.
(c) Must be accompanied by a brief not exceeding 25 pages in length.
(d) Must be answered by the nonmoving party with a showing of facts sufficient to create an issue that could be decided in its favor.
(e) May use discovery depositions taken by either party, affidavits (or declarations) alleging facts, admissions, and answers to interrogatories from either party as support for the motion.

9. In an opposition proceeding in which the opposer alleges that the applicant's mark is likely to cause confusion, mistake, or deception, the TTAB may consider:

(a) Only the marks of the parties.
(b) The marks of the parties and the goods or services in the application.
(c) The marks of the parties and the goods or services on which the parties are using their marks.
(d) The marks of the parties and the goods or services in the application plus the goods or services in the opposer's registration plus the goods or services for which the opposer is using its mark.
(e) The marks of the parties and the goods or services in the application plus the goods or services in the opposer's registration plus the goods or services for which the opposer proves use from a date prior to the earliest date provable by the applicant.

10. In an opposition proceeding in which the opposer alleges that the applicant's mark is merely descriptive of the goods, the TTAB may consider evidence of the use of the contested word in:

(a) Dictionaries.
(b) Trade journals.
(c) Publications of general circulation or available in libraries.
(d) Information in publicly accessible computer databases.
(e) All of the above.