

# MOSER TABOADA

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## Trademark Trial & Appeal Board: Adversarial Proceedings

United States trademark law provides that a qualified third party who believes that the registration of a trademark may harm its rights may file an adversarial proceeding with the United States Trademark Trial & Appeal Board (TTAB) to adjudicate the right to a U.S. trademark registration. The TTAB is an administrative tribunal of the United States Patent & Trademark Office that administers *ex parte* (between an applicant and the USPTO) and *inter partes* (between an applicant/registrant and a third party) adversarial proceedings.

**The TTAB has limited jurisdiction solely relating to registrability of a mark.** The TTAB cannot issue injunctions against a party's infringing use of a mark, nor can it award damages or legal fees, which may only be sought in U.S. District Court federal litigation.

Nevertheless, TTAB adversarial proceedings have certain benefits over U.S. District Court actions:

- (1) Lower costs;
- (2) A more streamlined and generally expeditious process; and,
- (3) All actions, including trial, are based solely upon a written record - no live testimony or court appearances are required (an oral hearing following submission of trial briefs is optional upon consent).

Types of TTAB adversarial proceedings:

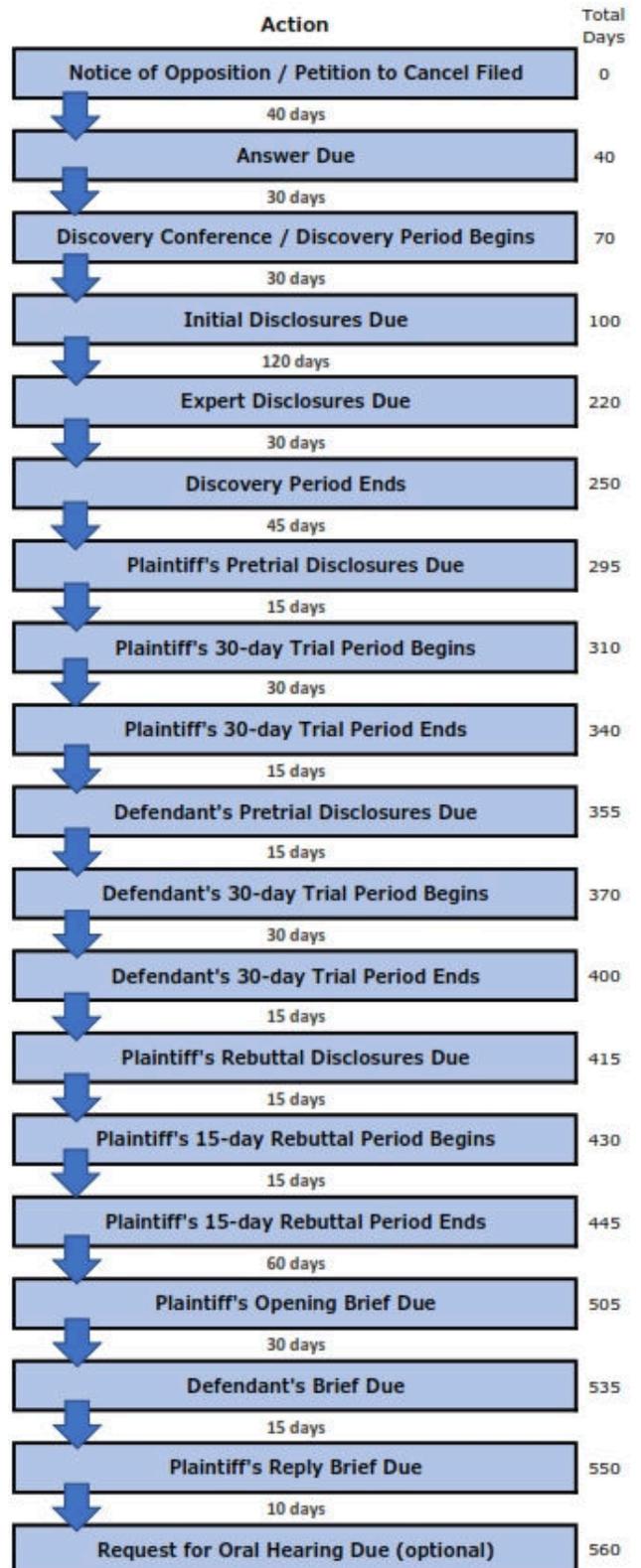
**Opposition** – to prevent registration of a pending trademark application

**Cancellation** – to revoke an existing trademark registration

Grounds for Opposition or Cancellation include:

Likelihood of confusion  
 Deceptiveness  
 Descriptiveness  
 Dilution of a famous mark  
 Fraud  
 Abandonment  
 Functionality  
 Lack of a bona fide intent to use the mark in commerce

**The right column is a complete timeline of all phases of a TTAB Opposition or Cancellation proceeding**



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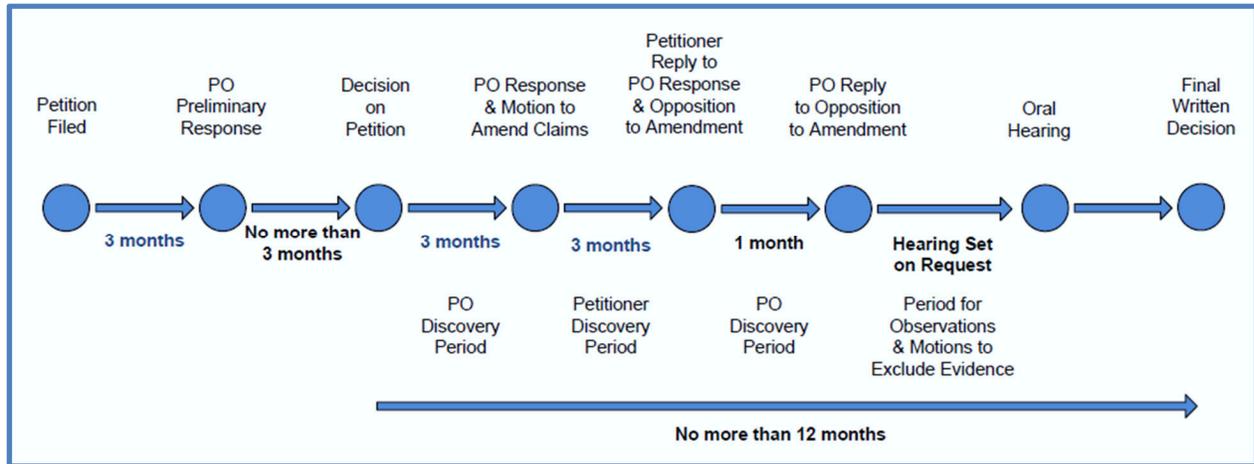
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## Patent Trial and Appeal Board (PTAB)

Tips for Filing Petitions with PTAB for *Inter Partes* Review (IPR), Post-Grant Review (PGR), and Covered Business Method Reviews (CBMR)

### Timeline to Decision

(PO = Patent Owner)



- Petition must carry the threshold burden that the Petitioner will prevail with respect to at least one challenged claim.
  - IPR: Reasonable likelihood of success.
  - PGR/CBMR: More likely than not.
- Every Petition must identify the Petitioner, real-parties-in-interest, counsel, etc.
  - CBMR requires additional analysis regarding why patent subject to CBMR review and showing that Petitioner has been charged with infringement.
- Must include a statement of the precise relief requested and a full statement of the reasons for the relief requested (i.e., detailed explanation of why the claims are invalid).
  - IPR/PGR/CBMR –prior art (i.e., patents/printed publication) analysis (102/103).
  - PGR/CBMR –analysis of additional grounds (101, 112).
- Must set forth any claim constructions needed to interpret the claims. NEW claim construction standard set forth in *Phillips v. AWH Corp.*: A claim term must be given “the meaning that the term would have to a person of ordinary skill in the part in question at the time of the invention.”

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## **US Customs and Border Protection: Securing Intellectual Property Rights Through Recordation of Trademarks and Copyrights**

US Customs and Border Protection (“CBP”), the federal agency primarily responsible for securing the borders of the United States, also plays an important role in guarding against the infringement of US copyrights and trademarks and securing intellectual property rights (IPR).

In furtherance of its goals of protecting the economy, as well as the security, health, and safety of US consumers, CBP is authorized to exclude, detain, and seize imported goods, including counterfeit and pirated goods, that infringe United States intellectual property law. CBP seizes over \$2B worth of infringing goods each year at United States borders, ports, and airports. As such, CBP enforcement offers copyright and trademark owners a valuable and strategic tool for enforcing their rights against infringing products that are being imported into the United States.

Customs Recordation is the essential first step in securing CBP assistance with IPR enforcement. Recordation is a straightforward and cost-effective process. The IPR owner must provide a few items of basic information: (1) the IPR owner’s name, address and citizenship; (2) the details of the trademark and/or copyright registrations to be recorded; (3) the manufacturing location(s) of the genuine goods; and (4) a list of authorized licensees, importers, and/or other distributors of the genuine goods.

Once the necessary information has been provided, an application can be prepared and filed with CBP. Processing of an application is usually completed within three (3) business days.

The official CBP fees for trademark recordation are \$190 USD per mark, per international class of goods; a trademark recordation may be renewed for \$80 USD per mark, per international class. The official CBP fees for copyright recordation are \$190 USD per copyright; a copyright recordation may be renewed for \$80 USD per copyright.

Customs recordation terms for a trademark is concurrent with the duration of the underlying trademark registration. Customs recordation terms for a copyright are 20 years or the expiration of the recordant’s rights, whichever comes first. Should the underlying trademark or copyright registration be cancelled or revoked, the customs recordation will cease to be in effect.

Once recorded, trademark and copyright information is uploaded to the CBP database and is thereafter available to CBP enforcement personnel at all US ports of entry. CBP will detain, seize, or exclude infringing goods, and notify the IPR owner that a suspect shipment has been discovered. The IPR owner is provided with the importation date, port of entry, goods quantity and description, country of origin, and the names and addresses of the manufacturer, exporter, and importer. In certain cases, it is possible to request photographs of the seized goods in order to verify the authenticity of the goods. Such information is highly valuable in preventing further infringement as well as to assist in the prosecution of enforcement actions.

Moser Taboada is a US-based law firm providing a full range of intellectual property legal services, including the preparation and filing of US CBP Customs Recordation applications and renewals. Please contact our Trademark and Copyright team for preferential flat rate pricing.

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## Trademark and Copyright: Dual Protection for Designs

Trademark and Copyright law are separate and independent bodies of law, each with its own criteria for eligibility and scope of protection. Pictures and logo designs used as trademarks are no less copyrightable as pictorial works simply because they are used in connection with product labels and marketing materials.



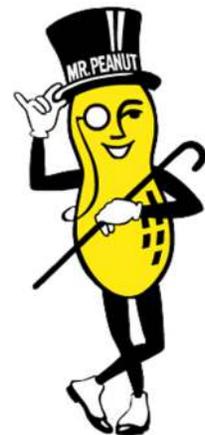
If an image identifies and distinguishes the source of goods or services (e.g. an image of Mickey Mouse on a watch face), copyright can protect against unauthorized copying of the artistic image of the famous mouse, while trademark law can prevent confusion and deception by protecting the role that the image plays in identifying the source of the goods, **thus providing dual IP protection.**

Given the long duration of U.S. copyright, this additional layer of protection may be a valuable, low-cost way of **extending an owner's intellectual property rights** even after the corresponding trademark is allowed to lapse due to abandonment or non-use.

**Designs and logos must contain the requisite amount of creativity and originality to be protected under copyright law.** Thus, product labels consisting merely of words, letters, mere typographic ornamentation, or simple and common geometric shapes or designs are not sufficiently original to qualify for copyright protection under the U.S. Copyright Act. In contrast, trademarks incorporating detailed designs or images are likely to qualify for copyright.

Dual protection under copyright and trademark is **particularly appropriate for graphic representations of characters.** A character image is deemed an artistic creation deserving copyright protection, while also serving to identify the creator of the image as the source of certain goods or services, thereby meriting protection under trademark law. Indeed, because of their value in distinguishing goods and services, pictorial representations of characters are often registered as trademarks under the Lanham Act.

For example, the image of Mr. Peanut, a humanized peanut dressed in formal attire complete with top hat, cane, monocle, and spats is clearly eligible for copyright. That picture also qualifies, however, as a design trademark to identify and distinguish the source of peanuts and snacks - Planters.



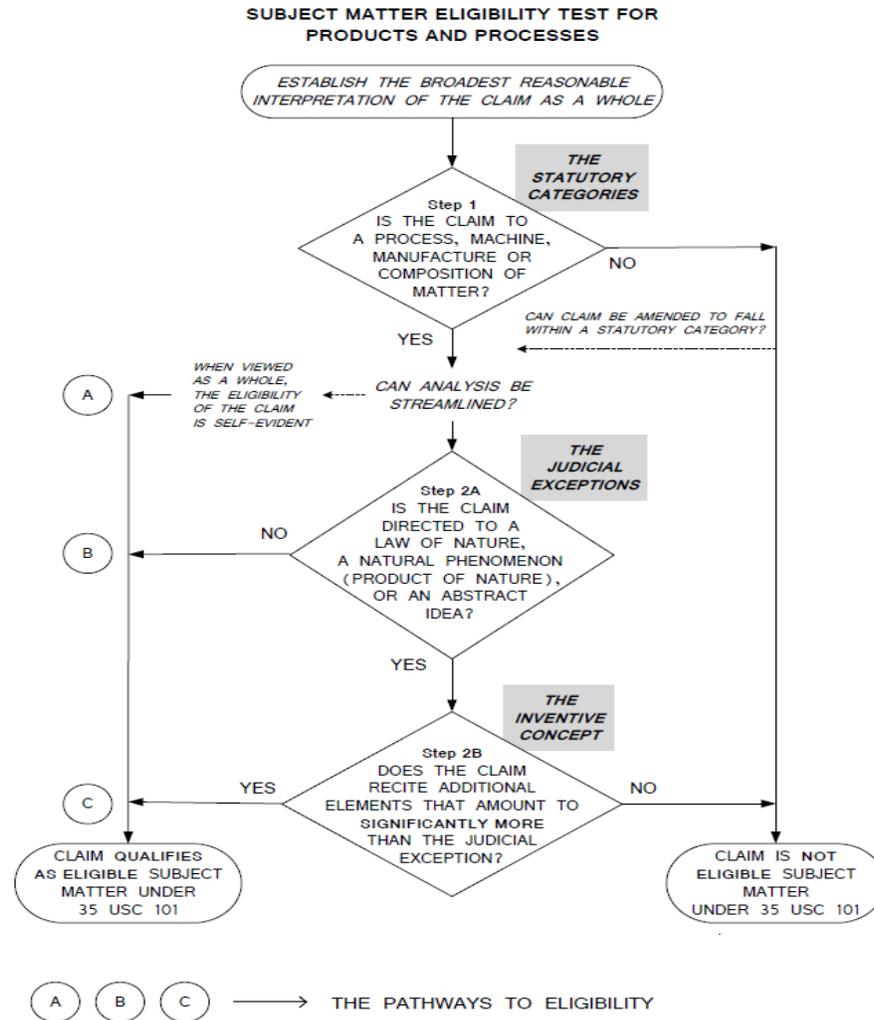
Outside the U.S., in countries where it is available, copyright registration offers a potentially **powerful tool for addressing third-party piracy of design and stylized trademarks.** The protection offered by copyright applies regardless of the goods or services covered by the pirated mark. Registering copyrights early in the product development process – before pirates file problematic trademark applications – may lead to significant savings in the context of potential oppositions and invalidation proceedings. At present, there are approximately 48 countries offering copyright registration systems, including China, South Korea, and Thailand.

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## Don't Amend. Defend.

Responding to §101 rejections since *Alice Corp.*



From MPEP §2106

2-Step Analysis	The Office's <i>prima facie</i> rejection requires an examiner to walk through a two-step analysis identifying why the claim is directed to ineligible subject matter. In addition, the examiner is required to, based on MPEP §2106.07(a), cite "to an appropriated court decision that supports the identification of the subject matter recited in the claim language as an abstract idea." Instead, examiners are often making conclusory statements that the claims are abstract. If the examiner's analysis is incomplete or is clearly a generic boilerplate copy and paste rejection, responding that the Office has not met their burden for establishing a <i>prima facie</i> rejection is a good first step.
Cited Court Decision	If the examiner has provided a court decision, analyze the decision and argue that your invention is distinguishable from the cited decision or the reasons for the finding of the court decision.
Claim Characterization	The examiner typically characterizes the claim when formulating their rejection by stating what they believe the claim is directed to. This formulation tends to be painted in very broad brush strokes or addresses less than all of the elements of a claim. The examiner then dismisses the claim as "failing to provide significantly more" to the abstract idea. Respond by arguing the claim as a whole and point out the novelty in the claim based on the ordered combination of elements, without ignoring the requirements of the individual steps.

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## Proper Marking – U.S. Trademarks & Copyrights

Although marking is not required in the United States, it is best practice to do so, as it gives the public and competitors notice of your claimed rights in and to a trademark or copyright. Proper marking helps dissuade others from copying and/or using your mark without permission, particularly in connection with similar products and/or services. Below is a list of best practices:

TM	<p>The ™ symbol can and should be used once a trademark application has been filed in the U.S., whether the application is filed in a particular state or with the USPTO. The ™ symbol may also be used in connection with common law trademark rights; that is, a mark being used to denote the source of goods and/or services for which a formal application for registration has not been filed. Please note that U.S. state registrations and common law trademark rights are limited to the geographic area where the mark is used and does not afford any rights of protection to the user outside that area.</p> <p><b>Caution:</b> Only the ™ symbol may be used to mark a common law trademark or state trademark registration (e.g., Moser Taboada™).</p>
SM	<p>Use of the ™ symbol is the governed by the same rules as the ™ symbol; however, the ™ symbol is used in connection with services rather than goods (e.g., Moser Taboada™).</p>
®	<p>The right to use the ® symbol in the United States is limited to <b>federally registered</b> trademarks and only in connection with the goods/services listed in said registration. As a best practice, we recommend use of the mark with the ® symbol on the product itself where practical, as well as on the product packaging, tags, labels, and any print materials (such as manuals or guides) associated with same. Point of sale materials (such as product display stands), print materials, advertising materials, and webpages should use the ® symbol in connection with the most prominent display of the mark on each page, as well as the first use of the mark in paragraph text. “Registered in the U.S. Patent and Trademark Office” or “Reg. U.S. Pat. &amp; TM Off.” are also acceptable forms of marking. Unlike patents, the trademark registration number is not required to be used in connection with marking.</p> <p><b>Caution:</b> Improper use of the ® symbol with an unregistered mark is a ground for denying registration, if done with intent to deceive the public into believing that the mark is registered.</p>
©	<p>Use of the © symbol is not required to claim rights in the U.S. Copyright is automatically given as soon as the author publishes their work publicly and in tangible form. However, best practice is to include the © symbol on any work in the public domain over which you claim rights. This practice will make it easier to protect your work in court, should it become necessary. Proper marking makes it more difficult for the other party to claim ignorance. Note: Proper marking of a copyright should include the word Copyright or the © symbol, the year the work was first published, and then the name or the person or company/organization that holds the copyright (e.g., Copyright 2017 Moser Taboada or © 2017 Moser Taboada).</p>

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## Proper Marking – U.S. Patents

- Under 35 U.S.C. §287, a patent owner can collect damages for an infringing product only if adequate notice is given of the patent(s) at issue.
- Two options for best practice for giving notice:
  - Physical marking: affixing a product with the word “patent” or “pat.” along with the patent number. (Ex: “Pat. 7,000,000).
  - Virtual marking: affixing a product with the word “patent” or “pat.” Followed by an internet address at which the patented article is associated with one or more patent numbers.
- Where to mark:
  - Patent owners may mark the packaging ONLY if marking the product “cannot be done.” For example, the packaging may be marked instead of the product if the size of the product itself renders marking unfeasible, or if the cost to mark the product is disproportionate to the cost of the product itself.
  - **CAUTION:** If a competitor with a similar size product or smaller product marks their product rather than the packaging, a court is likely not going to accept marking the packaging as “notice.”
- Every patent that applies to a product must be listed in any physical or virtual marking.
- There are no marking requirements for patents that contain only method claims, as there is no physical product that can be marked. However, if there is a “tangible item” embodying the method/process (e.g., software) it must be marked. For example, if there is a website that provides access to a program or downloadable software covered by the patent, the website should be marked. However, if the patent contains only method claims, there is no need to mark.
- Marking is required for design patents.
- “Patent Pending” is not required and does not entitle one to damages prior to the issuance of a patent.
- False marking: Marking an unpatented product with a patent number, the word “patent,” the abbreviation “pat.,” or other similar statements OR placing the words “patent pending” or similar terms on a product for which no patent application is actually pending. Any person, even uninterested parties, may sue for false marking. The penalty for false marking may be up to \$500 per item. A person or entity that suffers a “competitive injury” may bring a civil action against a false marker and receive compensation for that injury.
- If a patent expires, a mark on the corresponding product with that patent number does not amount to false marking.

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ATTORNEYS AT LAW

**Once your trademark application has been filed, this is what you may expect:**

<b>Use-Based Application</b>	<b>Intent-To-Use Application</b>	<b>Based on Foreign Registration</b>	<b>Based on Foreign Application</b>
<p><b><u>USPTO Reviews Application</u></b> (The application fee covers this step.)</p> <p>After determining that the minimum filing requirements have been met, the application is forwarded to an examining attorney, usually within 3-4 months of filing. The examining attorney reviews the application to determine whether it complies with all applicable statutes and rules, conducts a search for conflicting marks, and examines the written application and all submitted drawings and specimens. The examining attorney will determine whether the application may move forward, or if an Office Action must be issued.</p>	<p><b><u>USPTO Reviews Application</u></b> (The application fee covers this step. See first column.)</p>	<p><b><u>USPTO Reviews Application</u></b> (The application fee covers this step. See first column.)</p> <p>The foreign registration certificate with an English translation (if applicable) needs to be provided at the time of filing. A translation may be prepared through our vendor, if necessary (additional fees apply).</p>	<p><b><u>USPTO Reviews Application</u></b> (The application fee covers this step. See first column.)</p>
<p><b><u>USPTO Publishes Mark or Issues an Office Action</u></b> (A nominal fee is charged to review and report the Notice of Publication.) If the examining attorney raises no objections, a Notice of Publication issues and the mark is published in the Official Gazette. Any party who believes it may be damaged by registration of the mark has thirty (30) days from publication to file an opposition or a request an extension (up to 90 days) to oppose. If no opposition is filed the application moves forward to registration. Should an opposition be filed, we will advise you of same, along with an estimate of related costs before performing any work.</p> <p><b><u>USPTO Issues Office Action</u></b> (A nominal fee is charged to review and report an Office Action.) An estimate will be provided for preparing and filing a response, including any applicable USPTO fees, before any work is done in connection with a response. If the examining attorney decides that a mark should not be registered; an Office Action will issue providing any substantive reasons for refusal, as well as any technical or procedural deficiencies in the application. A response must be filed within six (6) months, or the application will be abandoned. If the applicant's response is sufficient, the mark will be published. If the applicant's response is insufficient, the examining attorney will issue a final refusal. To attempt to overcome a final refusal, the applicant may appeal to the Trademark Trial &amp; Appeal Board (TTAB), an administrative tribunal within the USPTO (additional fees apply).</p> <p><b><u>Registration Certificate Issues</u></b> (A nominal fee is charged to review and forward the registration certificate.)</p> <p><b><u>Maintenance Filings</u></b> After your trademark has registered, maintenance filings are required. A specimen showing that the mark is in use is required when filing maintenance documents.</p> <p><b>Between the 5<sup>th</sup>-6<sup>th</sup> years</b> - Section 8 &amp; 15 Renewal Declarations</p> <p><b>Between the 9<sup>th</sup>-10<sup>th</sup> year, and every ten years thereafter</b> - Section 8 &amp; 9 Renewal Declarations</p>	<p><b><u>USPTO Publishes Mark or Issues an Office Action</u></b> (A nominal fee is charged to review and report the Notice of Publication. See first column.)</p> <p><b><u>USPTO Issues Office Action</u></b> (A nominal fee is charged to review and report an Office Action.) An estimate will be provided for preparing and filing a response, including any applicable USPTO fees, before any work is done in connection with a response. See first column.</p> <p><b><u>USPTO Issues Notice of Allowance</u></b> (A nominal fee is charged to review and report the Notice of Allowance.) After receipt of the Notice of Allowance, the applicant has six (6) months to file a Statement of Use with supporting specimen(s) and the dates of first use (anywhere and in U.S. commerce). If the mark is still not in use at the expiration of the six-month period, the applicant may file a request for an Extension to Time for Statement of Use, which will provide an additional six (6) month period for the Statement of Use (additional fees apply). An applicant may request up to five (5) such extension requests (additional fees apply). The USPTO will review the Statement of Use and supporting specimen(s). If it is deemed acceptable, the mark will register in due course. If the Statement of Use is rejected, a Post-Allowance Office Action shall issue.</p> <p><b><u>Registration Certificate Issues</u></b> (A nominal fee is charged to review and forward the registration certificate.)</p> <p><b><u>Maintenance Filings</u></b> After your trademark has registered, maintenance filings are required. 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An estimate will be provided for preparing and filing a response, including any applicable USPTO fees, before any work is done in connection with a response. See first column.</p> <p><b><u>USPTO Issues a Suspension Notice</u></b> (A nominal fee is charged to review and report the Suspension Notice). Once the application is deemed complete, the USPTO will issue a Notice of Suspension pending registration of the mark in the country on which the US application is based. In order for the US application to proceed to registration, a copy of the foreign registration certificate with an English translation must be provided to the USPTO.</p> <p><b><u>USPTO Publishes Mark</u></b> (A nominal fee is charged to review and report the Notice of Publication. See first column.)</p> <p><b><u>Registration Certificate Issues</u></b> (A nominal fee is charged to review and forward the registration certificate.)</p> <p><b><u>Maintenance Filings</u></b> After your trademark has registered, maintenance filings are required. A specimen showing that the mark is in use is required when filing maintenance documents.</p> <p><b>Between the 5<sup>th</sup>-6<sup>th</sup> years</b> - Section 8 &amp; 15 Renewal Declarations</p> <p><b>Between the 9<sup>th</sup>-10<sup>th</sup> year, and every ten years thereafter</b> - Section 8 &amp; 9 Renewal Declarations</p>