University of New Hampshire School of Law

Inter Partes Practice before the USPTO Trademark Trial and Appeal Board

Final Examination April 12, 2012

You may use whatever materials you would like, including but not limited to your class notes, text book and laptop computers to access online manuals for this exam. **You may not communicate with anyone, electronically or otherwise, during this exam.**

Please use only your exam number on this exam. Do not write your name anywhere on the exam.

If you believe any question is ambiguous, please answer to the best of your ability and explain in the margin what you believe the ambiguity to be. If your explanation shows that you understand the concept involved and that the question is ambiguous, you will receive full or partial credit for your answer. If you answer correctly, you will receive full credit regardless of your explanation.

There are ten (10) true/false questions. Each of these is worth two (2) points.

There are twenty (20) multiple choice questions. Each of these is worth four (4) points. A fully correct answer is worth four (4) points. One (1) to three (3) points will be given for partially correct answers.
### TRUE-FALSE (worth 2 points each)

<table>
<thead>
<tr>
<th>True</th>
<th>False</th>
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<td>1)</td>
<td>If the plaintiff in a cancellation proceeding based on likelihood of confusion prevails, the defendant is required to stop using the mark that was the subject of cancelled registration.</td>
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<td>2)</td>
<td>The TTAB will grant a motion to extend the discovery period filed before the end of the discovery period in an opposition if an acceptable showing of good cause is made.</td>
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<td>3)</td>
<td>Non-dispositive motions can be decided by a single board member or an interlocutory attorney.</td>
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<td>4)</td>
<td>If a party petitions the Director of the USPTO for review of a TTAB procedural order, the Director may only reverse in cases of clear error or abuse of discretion.</td>
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<td>5)</td>
<td>The plaintiff’s brief is due thirty (30) days after the end of the final testimony period</td>
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<td>6)</td>
<td>If a party appeals a TTAB decision to the Federal Circuit, the other party has the right to elect that the proceeding be conducted by a District Court instead.</td>
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<td>7)</td>
<td>A party can obtain an initial sixty (60) day extension of time to oppose without cause.</td>
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<td>8)</td>
<td>The parties must file their disclosure and discovery plan with the TTAB following their discovery conference.</td>
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<td>9)</td>
<td>Exhibits submitted with briefs on motions are included when calculating the page count in the brief.</td>
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<td>10)</td>
<td>It is not mandatory for the defendant to file a brief in an inter partes proceeding.</td>
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Multiple Choice

Identify all correct answers – each question may have numerous correct answers. Each fully correct answer is worth 4 points. Each partially correct answer is worth 1-3 points.

1) Which of the following may be entered into evidence via Notice of Reliance?
   a. U.S. trademark registrations that are not the subject of the proceeding
   b. Interrogatory responses provided by the other side (i.e., provided by the party not introducing them into evidence)
   c. A party’s own testimony deposition transcripts
   d. Testimony from another proceeding

2) A federal registration owned by the plaintiff in an inter partes proceeding may be entered into the record as evidence by:
   a. Submitting a TARR printout along with relevant information from the PTO Assignment database as part of the complaint
   b. Stipulation of the parties
   c. Including it as an exhibit to the plaintiff’s brief
   d. Notice of Reliance

3) In an oral hearing before the TTAB:
   a. Each side has sixty (60) minutes to argue
   b. No new evidence may be submitted
   c. Both parties must appear
   d. At least three (3) Board members are present
4) Grounds that may form the basis for cancellation even after a registration becomes incontestable are:
   a. Likelihood of confusion
   b. Descriptiveness
   c. Genericness
   d. Abandonment

5) Which of the following must be included in a party’s initial disclosures?
   a. Name, address and telephone number, if known, of each individual likely to have discoverable information and the subject of that information
   b. Names and contact information for all employees and nonemployees of a party that may be called as witnesses
   c. Copies or descriptions of all documents that the disclosing party may use to support its claims and defenses.
   d. Name, address and telephone number of each individual who will provide expert testimony.

6) The responding party must supply to the inquiring party a privilege log providing information concerning documents withheld on the following grounds:
   a. Relevance
   b. Attorney-client privilege
   c. Premature disclosure of expert opinion
   d. Work-product doctrine

7) The following objections to testimonial evidence must be made in a timely manner, or will be deemed waived:
   a. Inadequate notice
   b. Objection to form of question
   c. Testimony taken after testimony period has ended
   d. Failure to sign transcript
8) A Request to take discovery in response to a Motion for Summary Judgment (“MSJ”):
   a. Must be made within 30 (thirty) days of the filing of the MSJ
   b. Should be filed along with the responding party’s response to the MSJ
   c. Must be limited to the information required to respond to the MSJ
   d. Must be supported by an affidavit or declaration giving a specific explanation of the necessary facts the additional discovery is intended to uncover

9) Which of the following types of evidence must be entered during a party’s testimony period?
   a. Copies of the Opposer/Petitioner’s registrations
   b. Written disclosures of the non-disclosing party
   c. File wrapper for each application/registration that is the target of the proceeding
   d. Documents produced by the other side during discovery

10) Which of the following statements are true of interrogatories?
    a. The TTAB’s rules allow for the service of 75 interrogatories, including subparts.
    b. They may be served on the last day of the discovery period.
    c. Unless an extension of time is obtained, responses must be served within 30 days after the date of service of the interrogatories.
    d. They may be served on a non-party.

11) The TTAB’s standard protective order:
    a. May not be modified
    b. Is intended to avoid delays from negotiating a protective order
    c. Is automatically in place from the beginning of the proceeding
    d. Must be signed by the parties
12) Which of the following are true with regard to the discovery period and discovery requests?
   a. Discovery requests must be directly served to the other party’s address of record, even if they are represented by an attorney (i.e., delivered to the party, not the attorney).
   b. The parties may agree to the electronic service of discovery requests and responses.
   c. Five (5) additional days are added to the discovery response period of the discovery requests are hand-delivered.
   d. Parties should commence discovery early in the discovery period so there is sufficient time for response and follow up.

13) Which of the following statements concerning motions practice before the TTAB are true?
   a. Parties should request extension of outstanding trial dates while a motion is pending.
   b. The TTAB may award damages if a party’s motion is granted.
   c. The TTAB or the parties may request a telephone conference to discuss a motion and the Board’s decision on the motion may be issued verbally during the conference without the issuance of a written decision.
   d. Consented motions generally are granted with few exceptions.
14) Which of the following statements concerning amendment of pleadings in a TTAB matter are true?
   a. A party may amend its pleading once as a matter of course within thirty (30) days of service.
   b. A Notice of Opposition cannot be amended to add additional goods or services to the list of goods or services being opposed.
   c. The amended pleading should be filed along with the motion to amend.
   d. If necessary, the discovery period may be reopened to allow the parties to take discovery concerning the amendment.

15) When considering whether to grant a Motion to Reopen Time (e.g., if a filing has not been timely filed), the TTAB will consider:
   a. The danger of prejudice to the non-movant
   b. Whether the reason for the delay was in the reasonable control of the movant
   c. The length of delay and impact on proceedings
   d. Whether the delay was the fault of the movant’s attorney, rather than the fault of the movant

16) Valid reasons for suspension of a TTAB proceeding include:
   a. Withdrawal of counsel
   b. Ongoing settlement negotiations
   c. Civil litigation in federal court that will have a bearing on the issues in the TTAB proceeding
   d. Pending motion to compel

17) Printed publications are useful as evidence of:
   a. Advertising of a mark in connection with the goods listed in an application or registration
   b. Descriptive or generic use of a mark
   c. The truth of the information therein
   d. The public’s knowledge of the mark in question
18) Which of the following are true in relation to evidence obtained via the Internet?
   a. The best person to obtain internet evidence is the attorney handling the matter, as he is most likely to know what evidence is relevant.
   b. The parties may stipulate to introduction of internet evidence via Notice of Reliance.
   c. Improperly submitted internet evidence must be objected to, or the TTAB will allow its entry into the record.
   d. Internet evidence need not be authenticated.

19) Which of the following are true in relation to testimony depositions?
   a. A witness need not answer a question if his attorney objects for any reason.
   b. A testimony deposition may be taken via video tape.
   c. The party taking the deposition must serve a copy of the transcript and exhibits on adverse party within fifteen (15) days of the deposition.
   d. The witness must review and correct the deposition before the transcript is filed.

20) Which of the following are included in the length or page count of a brief?
   a. Index of Cases
   b. Exhibits
   c. Argument
   d. Table of Contents