

# Navigating Trademark Practice Before the PTO 2009

## From Filing Through the TTAB Hearing

New York City,\* February 19-20, 2009

Live Webcast, February 19-20, 2009 — [www.pli.edu](http://www.pli.edu)

- The New TTAB Rules: Hear from the TTAB and Practitioners One Year Later
- Master TTAB Practice: From Pleadings Through Trial
- Earn MCLE Ethics Credit and Explore Ethical Issues in PTO and TTAB Practice
- *New*: Learn About the Costs and Practicalities of Trademark Enforcement

### Special Features:

- View a Live Oral Argument in a Contested TTAB Proceeding
- Participate in a Q&A with the TTAB Judges

*\*This is an approved transitional program*

# Navigating Trademark Practice Before the PTO 2009

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### Why You Should Attend

A federal trademark or service mark registration can be a very valuable business asset. The Patent and Trademark Office considers applications for registrations. The Trademark Trial and Appeal Board hears appeals when the Patent and Trademark Office refuses to register a mark and conducts contested proceedings between parties litigating the right to register a mark. Because these issues are often part of larger disputes regarding the right to use marks in both the conventional marketplace, as well as in e-commerce, a basic understanding of TTAB practice and procedure is an important part of the skills required of intellectual property lawyers in the new economy.

### What You Will Learn

- One year later: Impact of new TTAB rules
- Practicalities and costs of trademark enforcement
- PTO and TTAB structure, jurisdiction and powers
- Practical tips for trademark searching, clearance and opinions
- Grounds for refusal of registration
- Importance of product configurations and functionality
- Importance of non-traditional marks
- Acquired distinctiveness issues
- Likelihood of confusion
- Challenges to registrability versus challenges to use
- Strategy for discovery
- Pleadings and related motions
- Nature of a TTAB Trial
- Earn ethics credit—learn about fraud on the PTO

### Special Features

- Observe the Live Oral Argument in a pending TTAB case heard by Administrative Trademark Judges

### Who Should Attend

This program is designed for attorneys who practice trademark law and who are interested in learning about PTO and TTAB practice.

### PLI's Nationally Acclaimed Course Handbooks

All program attendees will receive a copy of the Course Handbook. This bound volume is prepared specifically for this program and also stands alone as a permanent reference. PLI's Course Handbooks represent the definitive thinking of the nation's finest legal minds, and are considered the standard reference in the field. *Please note: Webcast attendees will have access to a downloadable version of the Handbook one business day prior to the program.*

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Pillsbury Winthrop Shaw Pittman LLP  
San Francisco  
Author, *Likelihood of Confusion in Trademark Law* (PLI)



**Helen Hill Minsker**  
Banner & Witcoff, Ltd.  
Chicago

### **Hon. Marc A. Bergsman**

Administrative Trademark Judge  
Trademark Trial and Appeal Board  
Alexandria, Virginia

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### **Linda K. McLeod**

Finnegan, Henderson, Farabow, Garrett,  
& Dunner, LLP  
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### **Hon. Gerard F. Rogers**

Administrative Trademark Judge  
Trademark Trial and Appeal Board  
Alexandria, Virginia

### **Hon. Ellen J. Seeherman**

Administrative Trademark Judge  
Trademark Trial and Appeal Board  
Alexandria, Virginia

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**Program Attorney: Tamara C. Kiwi**

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# PROGRAM SCHEDULE

Please plan to arrive with enough time to register before the conference begins. A continental breakfast will be available upon your arrival.

## DAY ONE: 9:00 A.M. – 5:00 P.M.

Morning Session: 9:00 a.m. – 12:30 p.m.

9:00

### Introduction

*Richard L. Kirkpatrick, Helen Hill Minsker*

9:15

### Setting the Stage: The Nuts and Bolts of PTO and TTAB Practice

- The U.S. Trademark Registration System
- PTO and TTAB structure, jurisdiction and powers
- PTO/Court interface

*Helen Hill Minsker*

10:15

### Trademark Searching and Clearance

- Reasons to search
- Practical tips for searching, clearance and opinions
- Foreign searching

*Richard L. Kirkpatrick*

11:15 Break

11:30

### Prosecution Part 1: 2 (d) and 2 (e) Refusals and Substantive Issues in Ex Parte Appeals

- Likelihood of confusion
- Genericness/descriptiveness
- Other grounds for refusal of registration

*Christopher C. Larkin*

12:30 Lunch

Afternoon Session: 1:45 p.m. – 5:00 p.m.

1:45

### Prosecution Part 2: Other Substantive Refusals and Acquired Distinctiveness

- Geographic indicators
- Product configurations
- Non-traditional marks
- Acquired distinctiveness issues

*Philip G. Hampton, II*

2:45

### Costs and Practicalities of Trademark Enforcement

- Corporate counsel perspective
- Outside counsel perspective
- Watch services and investigations
- Strategy and tactics
- C&D letters, TTAB, courts

*Susan H. Frohling, William T. Gallagher, Anne Hiaring Hocking*

3:45 Break

4:00

### Ethical Issues in PTO and TTAB Practice

- Candor with the PTO in ex parte prosecution
- Fraud on the PTO
- Ethical issues in inter partes proceedings

*Linda K. McLeod*

5:00 Adjourn

## DAY TWO: 9:00 A.M. – 4:00 P.M.

Morning Session: 9:00 a.m. – 12:15 p.m.

9:00

### TTAB Part 1: Pleadings

- Challenges to registrability vs. challenges to use
- Standing
- Grounds for opposition
- The compulsory counterclaim rule

*Leslie J. Lott*

10:00

### TTAB Part 2: Discovery/Motions and Alternative Resolution

- Discovery strategy
- Mandatory disclosures
- Protective orders
- Written discovery
- Depositions
- Motions to compel
- Summary judgment motions
- Other types of TTAB motions
- Settlement strategies

*Carla C. Calcagno*

11:00 Break

11:15

### TTAB Part 3: Trial

- Nature of a TTAB trial
- Techniques of proof
- Briefs and oral argument

*Gary D. Krugman*

12:15 Lunch

Afternoon Session: 1:15 p.m. – 4:00 p.m.

1:15

### One Year Later: Living with the New TTAB Rules

- Impact of new rules on practice/procedure
- Practical tips for handling new procedures
- Pitfalls to avoid
- Recent decisions interpreting rules

*Beth A. Chapman, Administrative Trademark Judge  
Gerard F. Rogers*

2:15 Break

2:30

### Setting the Stage for Oral Argument

*Richard L. Kirkpatrick, Helen Hill Minsker*

2:45

### Live Oral Argument in a Contested TTAB Proceeding

*Administrative Trademark Judges:  
Marc A. Bergsman, Gerard F. Rogers, Ellen J. Seeherman*

3:45

### Q&A with TTAB Judges

*Administrative Trademark Judges:  
Marc A. Bergsman, Gerard F. Rogers, Ellen J. Seeherman*

4:00 Adjourn

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**Navigating Trademark Practice Before the PTO 2009: From Filing Through the TTAB Hearing**, \$199. The Course Handbook will be available on the first day of the program.

### Treatises

#### Kane on Trademark Law: A Practitioner's Guide, Fifth Edition

**Siegrun D. Kane** (*Morgan & Finnegan LLP, New York City*)

1 looseleaf volume, 990 pages, \$270 (Revised annually or as needed:  
No charge for revision issued within 3 months of purchase)

#### Likelihood of Confusion in Trademark Law

**Richard L. Kirkpatrick** (*Pillsbury Winthrop Shaw Pittman LLP, San Francisco*)

1 looseleaf volume, 491 pages, \$275 (Revised annually or as needed:  
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Live Webcast, February 19-20, 2009 — [www.pli.edu](http://www.pli.edu)

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- ☐ 13723 Kane on Trademark Law: A Practitioner's Guide, 5th Ed.,<sup>1</sup> 1 looseleaf volume, \$270
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