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Navigating Trademark Practice Before the PTO 2006

From Filing Through the TTAB Hearing

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- A graphic showing the letters 'TM' and 'R' in a stylized, 3D font, with the 'R' inside a circle, set against a dark, textured background.
- Setting the Stage: The Nuts and Bolts of PTO and TTAB Practice
 - Trademark Searching and Clearance
 - Addressing Common Substantive Issues in Ex Parte Prosecution
 - Special Topics in Ex Parte Prosecution
 - Geographic Indicators
 - Product Configurations
 - Non-Traditional Marks
 - Acquired Distinctiveness
 - Ex Parte Appeal Practice
 - Ethical Issues in PTO and TTAB Practice

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Oral Argument in
a Contested TTAB
Proceeding

New York City, February 23-24, 2006

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Navigating Trademark Practice Before the PTO 2006

From Filing Through the TTAB Hearing

New York City, February 23-24, 2006

Why You Should Attend

A federal trademark or service mark registration can be a very valuable business asset. The Patent and Trademark Offices consider 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

- Overview of the U.S. trademark registration system
- PTO and TTAB structure, jurisdiction and powers
- Grounds for refusal of registration
- Importance of product configurations and functionality
- Importance of non-traditional marks
- Acquired distinctiveness issues
- Practical tips for trademark searching
- Searching in light of the Madrid Protocol
- Reason to search

Plus much more...

- Tactical considerations in deciding whether to appeal
- The timing and mechanics of appeal
- What are some of the ethical issues in inter partes proceedings?
- Challenges to registrability versus challenges to use
- Pre-trial practice – discovery techniques
- Nature of a TTAB Trial

Special Features

- Live Oral Argument of a 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.

"The live TTAB hearing was extremely illustrative and a wonderful way to bookend the program."

Ellen Dowling, Darby & Darby PC, New York City

"A thoroughly comprehensive, high quality presentation; the TTAB portion was extremely helpful."

Heidi Wanner, Law Office of Heidi C. Wanner, Anchorage, Alaska

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First Day: 9:00 a.m. – 5:00 p.m.

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

9:00

Introduction

Christopher C. Larkin, 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

Christopher C. Larkin

10:15

Trademark Searching and Clearance

- Reasons to search
- Practical tips for searching, clearance and opinions
- Searching in light of the Madrid Protocol

J. Allison Strickland

11:15 **Break**

11:30

Addressing Common Substantive Issues in Ex Parte Prosecution

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

Richard L. Kirkpatrick

12:30 **Lunch**

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

1:45

Special Topics in Ex Parte Prosecution

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

Joseph R. Dreitler

2:45

Petitions to the Commissioner and Ex Parte Appeal Practice

- Petitions versus ex parte appeals
- Preparing the record
- Tactical considerations
- Timing and mechanics of appeal and petitions

Philip G. Hampton, II, Helen Hill Minsker

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

Second Day: 9:00 a.m. – 3:15 p.m.

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

9:00

The Nature of and Grounds for TTAB Inter Partes Proceedings

- Challenges to registrability v. challenges to use
- Standing
- Grounds for opposition

Jonathan Hudis

10:00

Pre-Trial Practice in TTAB Inter Partes Proceedings

- Pleadings and related motions
- The compulsory counterclaim rule
- Discovery techniques
- Common motions

Carla C. Calcagno

11:00 **Break**

11:15

Trial in Inter Partes Proceedings

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

Gary D. Krugman

12:15 **Lunch**

Afternoon Session: 1:15 p.m. – 3:15 p.m.

1:15

Setting the Stage for Oral Argument

Christopher C. Larkin, Helen Hill Minsker

1:30

Live Oral Argument in a Contested TTAB Proceeding

Chief Administrative Trademark Judge J. David Sams, Administrative Trademark Judge Gerard Rogers, Administrative Trademark Judge Ellen J. Seeherman

2:30 **Break**

2:45

Questions and Answers with TTAB Judges

Chief Administrative Trademark Judge J. David Sams, Administrative Trademark Judge Gerard Rogers, Administrative Trademark Judge Ellen J. Seeherman

Other Relevant Products From PLI

COURSE HANDBOOK

Navigating Trademark Practice Before the PTO 2006: From Filing Through the TTAB Hearing, \$179. *The Course Handbook will be available on the first day of the program.*

TREATISES

Likelihood of Confusion in Trademark Law, Twelfth Edition

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

"Practical insight that all trademark law practitioners should have at their fingertips." — Chetuan L. Shaffer, Intellectual Property Counsel, Pacific Bell/Southwestern Bell

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From Filing Through the TTAB Hearing

New York City, February 23-24, 2006

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