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Navigating Trademark Practice Before the PTO 2007

From Filing Through the TTAB Hearing



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Argument in a
Contested TTAB
Proceeding**

- Trademark Searching and Clearance
- Prosecution Part 1 - 2 (d) and 2 (e) Refusals and Substantive Issues in Ex Parte Appeals
- Part 2 – Other Substantive Refusals and Acquired Distinctiveness
- TTAB Parts 1-4, Pleadings, Discovery, Motions, Trial
- The New Trademark Dilution Revision Act
- Ethical Issues in PTO and TTAB Practice



New York City, February 22-23, 2007



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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. The program will also review the key changes under the recently enacted Trademark Dilution Revision Act.

What You Will Learn

- 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, clearance and opinions
- Searching in light of the Madrid Protocol
- Likelihood of confusion

Plus much more.....

- The compulsory counterclaim rule
- Challenges to registrability versus challenges to use
- Strategy for discovery
- Pleadings and related motions
- Nature of a TTAB trial
- The key changes enacted under the new Trademark Dilution Revision Act, including the adoption of a “likelihood of dilution” standard
- When to rely on state dilution laws instead of federal law
- The ethical issues in inter partes proceedings

Special Feature

- 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.

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“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

Reserve your place today, call (800) 260-4PLI.

Please plan to arrive sufficiently in advance of the conference start time to register. A continental breakfast will be available upon your arrival.

First Day: 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
- Searching in light of the Madrid Protocol

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 Part 2 – Other Substantive Refusals and Acquired Distinctiveness

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

Philip G. Hampton, II

2:45 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

Kevin T. Kramer

3:45 Break

4:00 TTAB Part 1 - Pleadings

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

Jonathan Hudis

Second Day: 9:00 a.m. – 4:00 p.m.

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

9:00 TTAB Part 2 - Discovery

- Discovery strategy
- Written discovery
- Depositions
- Motions to compel

James D. Weinberger

10:00 TTAB Part 3 – Motions & Alternative Resolution

- Summary judgment motions
- Other types of TTAB motions
- Settlement strategies

Carla C. Calcagno

11:00 Break

11:15 TTAB Part 4 - 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 The New Trademark Dilution Revision Act: Protecting America's Famous Trademarks and the "Likelihood of Dilution" Standard

- Key changes under the new act, including the adoption of a "likelihood of dilution" standard
- How to prove dilution by blurring and dilution by tarnishment
- Which marks are sufficiently famous and distinctive to qualify for dilution protection?
- The expanded "fair use" and free speech defenses under the Act
- When to rely on state dilution laws instead of federal law

J. Alison Grabell

2:15 Setting the Stage for Oral Argument

Richard L. Kirkpatrick, Helen Hill Minsker

2:30 Live Oral Argument in a Contested TTAB Proceeding

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

3:30 Break

3:45 Questions and Answers with TTAB Judges

*Chief Administrative Trademark Judge J. David Sams,
Administrative Trademark Judge Gerard F. Rogers,
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COURSE HANDBOOK

Navigating Trademark Practice Before the PTO 2007: 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

Richard L. Kirkpatrick (*Pillsbury Winthrop Shaw Pittman LLP, San Francisco*)
With the aid of checklists and hundreds of examples that clarify what is (and is not) in conflict, **Likelihood of Confusion in Trademark Law** shows you how to avoid trademark disputes, establish the strength of marks, and prove (or disprove) similarities, product relatedness, converging channels of trade, actual confusion, and rightful intent for junior users.

1 looseleaf volume, 505 pages, \$195 (Revised annually or as needed):

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Trademark Law

A Practitioner's Guide, Fourth Edition

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

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