



Impressions of a TTAB Oral Argument Hearing From a First-Time Advocate

By Nick Guinn

As an IP practitioner, day in and day out you probably find yourself filing applications, responding to office actions, sending and responding to cease-and-desist letters, and handling litigation in U.S. District Court. If you work in the area of trademarks long enough, one of your clients' applications will be refused registration due to a blocking registration owned by a junior user. You may also discover that a third party has applied to register a confusingly similar mark in direct conflict with a registration owned by your client.

To overcome the refusal or protect your client's rights, you should consider filing a Notice of Opposition or Petition to Cancel with the Trademark Trial and Appeal Board objecting to the application or registration. Frequently, the parties settle the dispute long before the case proceeds into the trial phase. In rare cases, however, the matter proceeds to trial and ultimately reaches a final oral hearing in front of a panel of three TTAB judges at the U.S. Patent and Trademark Office (USPTO) in Alexandria, Virginia. One of my recent matters bucked the settlement trend, which allowed me to participate in such a hearing.

In this particular case, the parties submitted their trial briefs and included requests for oral hearing pursuant to Trademark Rule 2.129(a). In July 2017, the Board instructed the parties to confer and provide available dates between September and December, among other things, related to oral argument. Within fifteen days, and after conferring via email, the parties jointly submitted a proposed date with the Board. The Board scheduled oral hearing for a mid-September afternoon, at 2:00 p.m.

With my hearing date set, I began preparation by browsing the web for information about oral arguments in front of the TTAB. Unfortunately, a significant void exists in the resources available on the subject of TTAB oral hearings and protocol. The closest references are those that describe oral argument before federal appellate courts. A colleague pointed me to a 1980s article on TTAB oral hearings from the Trademark Reporter, but even that reference failed to yield any helpful tips and was potentially stale given its age.

Unsuccessful in my internet research, and with only three weeks remaining to prepare, I decided to control the things that I could—my familiarity with the relevant facts and law. While most experienced advocates agree that you should not simply regurgitate the substance of your briefs, I found it

useful to review each of the final briefs several times. As I saw it, the parties had distilled their most important points into these briefs. In our case, we were addressing relatively straightforward likelihood of confusion and priority issues—nothing precedential or otherwise groundbreaking. With that in mind, I identified the one or two best facts for each of the digits of confusion. I also identified the three biggest weaknesses in our case and made myself well versed in the opinions that best supported our position and distinguished those decisions most likely to hurt us.

In addition to those key points, I focused on developing a strong introduction and closing to my argument. I also recalled the countless conversations with fellow associates describing the various nuances of our case. I reexamined each of the instances where I delivered insightful explanations, and more importantly the times where I failed to explain or persuade. Each of those conversations supplied fodder for potential questions from the Board. I made sure that I had a strong answer to each question anticipated from the Board.

I arrived a few days early for personal reasons and took in some of the sights. If you are short on time, arriving the day before is more than sufficient. One of my main travel recommendations when visiting the USPTO is flying into Ronald Reagan Airport rather than Dulles. The USPTO is an easy drive from Reagan. There are several hotels in and around Alexandria. I suggest the **Westin Alexandria**, which is a great hotel and, most importantly, only a three-minute walk from the Madison Building where the TTAB hearing rooms are located.



The USPTO headquarters in Alexandria, Virginia.

On the morning of the hearing, I followed my normal routine of cardio—swimming in this case—followed by breakfast. After breakfast, I paced around my hotel room feeling excited, while reviewing my argument notes and summary. Because my argument was scheduled for the afternoon, I decided to head to the PTO early and observe oral arguments typically scheduled in the morning at 10:00

a.m. I believed that observing one or more live arguments would finally give me the enlightenment I sought.

I made my way over to the Madison building but, unfortunately, there were two problems. First, there were no arguments scheduled that morning. Second, building security would not let me enter the floor until thirty minutes prior to my scheduled argument.

Having already checked out of my hotel, I decided to run through my argument some more, eat lunch at the USPTO cafeteria, and visit the USPTO's **National Inventors Hall of Fame and Museum**. Set aside 30 to 45 minutes for the museum.

I promptly returned to the security checkpoint at 1:30 p.m. Encountering no lines and clearing security, I was directed to the floor of the assigned hearing room. This particular floor housed five or six hearing rooms. I found my room and set up my space. The room had enough space for three to five judges on panel, a podium positioned between two counsel tables, and a row of seats for observers.

The registrant's counsel joined me a few minutes later. An admin for the board visited us to check us in and cover several housekeeping matters—time for argument, order of speakers, and the like. The one thing the admin reminded me to do was reserve time for rebuttal.

We waited a few more minutes—until 2:00 p.m.—when our panel of punctual judges entered the hearing room. Having read so many of their opinions and orders over the years, I found it neat to finally interact with them in person.

As petitioner, I was called to the lectern first and started immediately. I reserved time for rebuttal within one or two sentences of my introduction. Though I was glad that I did not forget to do this, I was certainly thrown out of sync. Unfortunately, I had not made reserving time for rebuttal a part of my rehearsed introduction. By the time “. . . minute for rebuttal” came out of my mouth, I completely froze. At risk of sounding boastful, I have always been comfortable with public speaking and delivering arguments. This sensation was new; I had never frozen in the middle of a speech or argument. But what felt like an eternity was probably only 5 or 10 seconds.

Lost for words, I looked up at the panel. Judge Quinn gave me a friendly grin, which set me back on track. The panel was warm and asked plenty of questions. I was impressed with the panel's familiarity with the facts of the case. The panel picked the weaknesses in our case and inquired about them. I'm glad that I anticipated such questions and prepared strong responses. Before I knew it, my speaking time was over.

My opposing counsel delivered a strong response, and similarly responded to questions concerning the weaknesses in his client's case. His time expired, and I returned for my rebuttal. I focused on two or three issues that the panel focused on with my opposing counsel, and attempted to hammer my client's position home.

When the rebuttal time expired, the panel thanked us and we thanked them. The panel left the room and counsel gathered up. I turned to my opposing counsel and invited them for refreshments at the nearby **Trademark Bar**—housed on the first floor of the Westin Alexandria. For anyone visiting the USPTO for the first time, the Trademark Bar is a must.

I thought sharing post-argument refreshments with opposing counsel epitomized the collegiality that we should strive for in the adversarial process.

About six weeks later, we received an opinion from the Board. Fortunately, the Board ruled in my client's favor.

I look forward to my next oral argument at the TTAB. I suspect that the greatest preparation I have going into subsequent arguments is past experience. For those who lack such experience, I have several tips that should prove useful:

- Update your legal research in advance of your hearing.
- Prepare a detailed outline several weeks out and trim the fat as you familiarize yourself with your arguments.
- Carefully plan your opening sentences, and reserve time for rebuttal if you represent the petitioner.
- Try to maintain a conversation. The panel will probably help you through their questions.
- Make appropriate concessions where you can. Doing so will establish your credibility.
- Practice your argument with colleagues. Identify the sticking points in your argument and fix them.
- Visit the Trademark Bar. ♦

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This article expresses the view of the author and not necessarily that of the State Bar of Texas IP Law Section.