



OHIM Boards of Appeal and U.S. Trademark Trial and Appeal Board: A Close Look and Comparison

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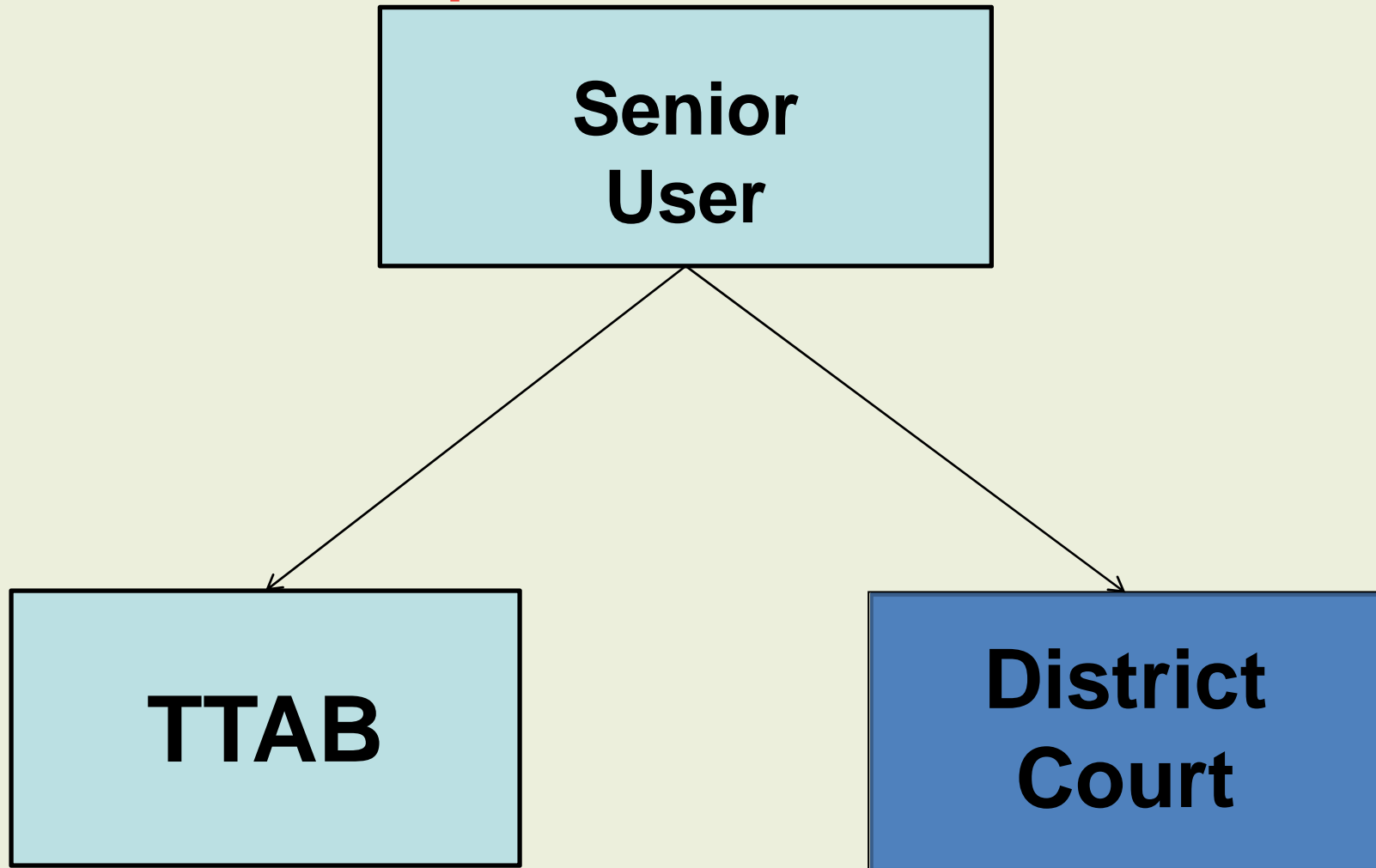
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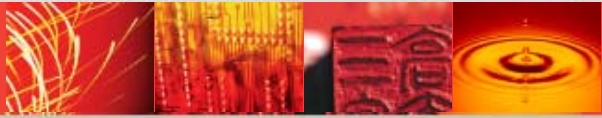
Enforcement Options





TTAB Jurisdiction Narrower Than That of District Court

- District court can award injunctive relief, damages, and attorney's fees.
- TTAB's jurisdiction is limited to determining registration.
- In some cases, a district court action may be necessary.
- Often, however, the TTAB offers several advantages over a district court action.



TTAB Proceedings Are Less Expensive Than District Court Actions

- Given TTAB's limited jurisdiction, discovery is generally less burdensome than in district court.
- Increasingly, the Board's interlocutory attorneys are taking charge early in cases.
- This case management reduces unnecessary expense and motion practice.



Expertise of TTAB Judges

- TTAB Judges are experts on trademark law and issue detailed, high-quality decisions.
- TTAB Judges review the record carefully and understand value of trademark goodwill.



Accelerated Case Resolution Program (ACR)

- Parties can agree to expedite case by using ACR procedure.
- Parties take only limited discovery, if any.
- Parties stipulate to facts on which they agree.
- Parties file their briefs with evidence.
- Board issues decision within 50 days after briefs are filed.
- Akin to summary judgment procedure, except Board can resolve issues of fact in its decision.



Settlement Vehicle

- TTAB case often leads to settlement of dispute, avoiding need for district court action.
- “Settlement and Discovery Planning Conference” affords opportunity to discuss settlement early. No sign of weakness.
- TTAB will liberally grant suspension to allow settlement talks.
- Settlement terms range from complete phase-out of mark to narrowing of identification of goods in application.



Deterrent Effect

- Trademark search report shows aggressive opposition activity.
- Deters others from adopting similar marks.



District Court Deference

- Two phases of enforcement:
 - Victory before TTAB becomes centerpiece in subsequent district court action.
- District courts give significant deference to TTAB findings, in deference to TTAB expertise.



Recap — TTAB Offers:

- Cost savings
- Expertise
- Prompt settlement opportunities
- Deterrence
- Decisions that will be accorded deference by district courts