

# Trademark Practice Tip: Make Extra Sure Your Cover Sheet Is Complete When Opposing a Madrid Protocol Application

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Late last year, in a decision that bears continued attention, the Trademark Trial and Appeal Board held that oppositions to Madrid Protocol applications filed under Section 66(a) are limited to the grounds set forth in the electronic filing ESTTA cover sheet. *Serralles, Inc. v. Kabushiki Kaisha Dong*. Moreover, an opposer is precluded from amending a notice of opposition to add grounds beyond those set forth in the cover sheet.

In *Serralles*, the opposition was filed based on a likelihood of confusion with the opposer's marks in various pleaded registrations, covering only rum. In its trial brief, the opposer further argued a likelihood of confusion based on its common law rights in the same marks as used on other goods/services (rum cakes, chocolates, and bar services). The applicant objected to any arguments based on the asserted common law rights, as opposer had not pleaded them in its ESTTA cover sheet.

The Board treated the opposer's position as an attempt to amend the pleadings to add common law rights, denied that attempt, and gave no consideration to the opposer's common law rights. Its reasoning was simple: Trademark Rule 2.104(c) means strictly what it says and precludes asserting grounds other than those set forth in the cover sheet. Further, Trademark Rule 2.107(b) precludes any amendment to add grounds not set forth in the cover sheet. One might wonder whether attempting to introduce evidence of use of a pleaded mark for goods/services in addition to those set forth in the registration should be construed as new "grounds," but it seems clear in light of the Board ruling that they are. The Board noted that the cover sheet includes a "check the box" ability to enter unregistered marks and their associated goods/services, and the

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opposer's failure to avail itself of that option was essentially dispositive.

Experienced practitioners should be aware of the desirability of alleging common law rights that may exist in addition to registration rights in a notice of opposition. *Serralles* highlights that it is "speak now or forever hold your peace" when opposing Madrid Protocol applications, and the speaking must be done on the cover sheet.

What remedies would the opposer have in related proceedings? In fact, the opposer appealed to the Federal Circuit, and the parties reached a settlement in which the applicant amended its application to delete certain goods/services. Perhaps the opposer could have asserted its common law rights in a cancellation proceeding or a district court action, but *res judicata* may have prevented such procedural steps. In any event, the practice pointer is clear: an opposer to a Madrid Protocol application must be especially vigilant to assert all grounds for opposition and bases for asserted rights – both registered and unregistered – in the cover sheet.