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What's Your Story? Every Famous Mark Has One: Persuasion in Trademark Opposition Briefs

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WHAT'S YOUR STORY? EVERY FAMOUS MARK HAS ONE:

PERSUASION IN TRADEMARK OPPOSITION BRIEFS

I. INTRODUCTION

A key contention of legal writing scholarship is that the legal resolution is rooted in storytelling.¹ The law consists of an endless telling and retelling of stories. Clients tell stories to their lawyers, who must figure out how to frame their client's narrative into a legal context. Lawyers retell their clients' stories to judges using pleadings, motions, and legal briefs. Judges and administrators retell these stories in the form of an opinion or verdict.

Storytelling in the legal context is an important element of persuasion. For the purpose of this comment, legal storytelling is defined as the use of fiction-writing techniques and elements to craft a non-fictional account of a client's story.² These elements or "basic building blocks"³ include theme, character, conflict, resolution, organization, plot, and point of view.⁴ Current legal writing scholarship generally applies these elements to the practice of law, or specific areas of law such as criminal law, personal injury law, civil rights law, etc. However, this type of scholarship applied to other areas of practice, such as intellectual property law, is limited. In Intellectual Property ("IP") practice, this legal writing scholarship is usually limited to patent litigation due to its inherently technical and complex concepts.⁵ Other areas of practice in IP, such

1. See, e.g., Brian J. Foley & Ruth Anne Robbins, *Fiction 101: A Primer for Lawyers on How to Use Fiction Writing Techniques to Write Persuasive Fact Sections*, 32 Rutgers L. J. 459, 462 (2001); Jonathan K. Van Patten, *Storytelling for Lawyers*, 57 S. D. L. Rev. 239, 239 (2012); Steven D. Stark, *Writing to Win: The Legal Writer* 95–96 (2012); Anthony G. Amsterdam & Jerome Bruner, *Minding the Law* 110–142 (2000); Tami Cowden, *Telling the Client's Story: Using Fiction-Writing Techniques to Craft Persuasive Briefs*, Nevada Lawyer, Sept. 2006, at 32; Jeffrey D. Jackson, *For Effective Persuasion, Don't Neglect the Narrative*, 84 J. Kan. B. Ass'n 12, 12 (2015); Kenneth D. Chestek, *The Plot Thickens: The Appellate Brief as Story*, 14 J. Legal Writing Inst. 127, 130 (2008).

2. This definition was crafted from a series of legal writing sources. See, e.g., Foley & Robbins, *supra* note 1, at 463; Patten, *supra* note 1; STARK, *supra* note 1; Cowden, *supra* note 1.

3. Foley & Robbins, *supra* note 1, at 461.

4. See, e.g., Foley & Robbins, *supra* note 1, at 461; Patten, *supra* note 1, at 241; Cowden, *supra* note 1, at 32–34; Chestek, *supra* note 1, at 137.

5. For legal writing scholarship on intellectual property, see Erin Coe, *The 5 Biggest Mistakes Attys Make in Fed. Circ. Briefs*, LAW360 (Nov. 3, 2015), <https://www.law360.com>

as trademark law, are excluded from this literature. Given trademark law's exclusion from legal writing scholarship, this type of scholarship is needed.

This comment will address common issues in the fact sections of trademark opposition briefs, and discuss how storytelling elements can improve persuasion in these briefs. An opposition is an *inter partes* proceeding that occurs before the Trademark Trial and Appeal Board ("TTAB"). The process allows any interested party to seek a remedy prior to the registration of a mark; the interested party or "opposer" files an action challenging the application of a mark if the party believes he or she will be harmed by the mark's registration.⁶ The trademark opposition process raises the stakes for the registration of a mark for competing forces of both the opposer and applicant. In high-stakes litigation, both parties must employ their skills of persuasion to obtain the desired outcome. In an opposition, the parties get this chance with the trademark opposition trial brief. Trademark practitioners rarely appear in person before the TTAB, so the trial brief often serves as a party's sole opportunity to present its narrative of the facts and the legal principles supporting its position.⁷ However, the narrative within the trial briefs misses the mark. The facts are presented as a collection of facts rather than a story that contains facts. As a result, the Introduction and Statement of Facts sections turn into a lackluster compilation of facts about a party's mark. The inclusion of storytelling elements and techniques will improve both persuasion and advocacy in trademark opposition briefs.

Initially, this comment will discuss the overall importance of legal storytelling and will present common storytelling elements that are often employed in the legal writing discipline. The second section will briefly discuss the challenges of storytelling in IP cases and the importance of expanding legal writing scholarship in IP litigation. The third section will examine the opposition proceeding and its related procedure, the primary types of claims raised in an opposition proceeding, and end with an assessment of opposition briefs.

/articles/721572/the-5-biggest-mistakes-attys-make-in-fed-circ-briefs [https://perma.cc/GPM7-JYQQ]; Bill Donahue, *5 Skills of the Most Successful Patent Litigators*, LAW360 (Apr. 1, 2013), <https://www.law360.com/articles/428521/5-skills-of-the-most-successful-patent-litigators> [https://perma.cc/UZY5-AZB5]; James C. Yoon, *Fictional Characters, Storytelling and Patent Trials*, LAW360 (Feb. 18, 2009), <https://www.law360.com/articles/87908/fictional-characters-storytelling-and-patent-trials> [https://perma.cc/8FDW-PU8D]; Steve Hansen, *Tell Me a Story About Claim Construction*, HANSEN IP LAW PLLC (Apr. 23, 2012), <https://hanseniplaw.com/tell-me-a-story-about-claim-construction/> [https://perma.cc/B8EA-2NGL].

6. Rules of Practice in Trademark Cases, 37 C.F.R. § 2.101 (2016).

7. WILLIAM M. BRYNER & CHARLES H. HOOKER III, *Briefs on Final Hearing and Oral Argument*, in A LEGAL STRATEGIST'S GUIDE TO TRADEMARK TRIAL AND APPEAL BOARD PRACTICE 289–90 (Jonathan Hudis ed., 3d ed. 2016).

I. LEGAL STORYTELLING GENERALLY

First, what is a story? Stories are commonly defined as an account of something that happens; and stories usually contain a beginning, middle, and an end.⁸ This definition is sufficient, but legal storytelling goes a little further than the common story definition because of the boundaries and limitations placed on legal storytellers.⁹ For the purpose of this comment, legal storytelling is defined as the use of fiction-writing techniques and elements to craft a non-fictional account of a client's story.¹⁰ Legal storytelling is important because a legal dispute is a clash of competing stories. Each party presents its narrative hoping to create a reaction in the factfinder that is favorable to its clients' position.¹¹

Legal storytelling has been popular among legal writing scholars for some time.¹² But its popularity is growing within the legal profession. Judges are addressing the importance of telling stories within a brief, regardless of the subject matter. Supreme Court Chief Justice John Roberts stated, “[e]very lawsuit is a story . . . [even] if it’s about a dry contract interpretation . . . no matter how dry it is, something’s going on that got you to this point.”¹³ Empirical data from a limited study also suggest that legal professionals prefer

8. See Kendall Haven, *Story Proof: The Science Behind the Startling Power of Story* 12–13 (2007). Kendall Haven defines a story as “a detailed, character-based narration of a character’s struggles to overcome obstacles and reach an important goal. Stories are character-based and are driven by the details that describe that character’s goals, motives, obstacles, and struggles.” *Id.* at 79. See also, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/story> [<https://perma.cc/9VFA-5SG9>] (defining story as “an account of incident or events” or “a statement regarding the facts pertinent to a situation in question.”); Foley & Robbins, *supra* note 1, at 466 (defining story as “an account of a character running into conflict and the conflict’s being resolved.”); Annette Simmons, *THE STORY FACTOR: SECRETS OF INFLUENCE FROM THE ART OF STORYTELLING* 31 (2001) (“A story is a narrative account of an event or events—true or fictional. The difference between giving an example and telling a story is the addition of emotional content and added sensory details in the telling. A story weaves detail, character, and events into a whole that is greater than the sum of its parts.”).

9. Unlike fiction writers, a legal storyteller cannot make up a story. In this way, legal storytellers are more akin to a non-fiction writer. But nevertheless, a legal storyteller has more boundaries. Legal storytellers “must know available facts before they try to tell the story.” Cowden, *supra* note 1, at 32. Legal storytellers can only include the legally relevant facts that are consistent with controlling authority.

10. Foley & Robbins, *supra* note 1 at 463; Patten, *supra* note 1; Stark, *supra* note 1; Cowden *supra* note 1.

11. Cowden, *supra* note 1; Foley & Robbins, *supra* note 1; STARK, *supra* note 1, at 102.

12. See, e.g., Foley & Robbins, *supra* note 1, at 459 (2001); Louis J. Sirico, Jr. & Nancy L. Schultz, *PERSUASIVE LEGAL WRITING* (4th ed. 2015); Ross Guberman, *POINT MADE: HOW TO WRITE LIKE THE NATION’S TOP ADVOCATES* (2d ed. 2014); Philip N. Meyer, *STORYTELLING FOR LAWYERS* (2014); Cowden, *supra* note 1; Stark, *supra* note 1, at 102.

13. Bryan A. Garner, *Chief Justice Roberts*, 13 *SCRIBES J. OF LEGAL WRITING* 16 (2010).

briefs with a storytelling format.¹⁴ Professor Kenneth Chestek conducted a small study with a diverse group of legal professionals—made up of appellate judges, appellate practitioners, law clerks, law professors, and court staff attorneys—to decide which sample briefs were more persuasive: briefs written in a classical logical format or briefs written with more of story format.¹⁵ The results of the study illustrated that professionals collectively found story briefs more persuasive.¹⁶

To write a compelling story in a legal brief, scholars recommend that brief writers consider several important elements: setting, theme, character, conflict, plot, and point of view or perspective.¹⁷ This comment will only discuss two of the elements: theme and character.

A. Traditional Storytelling Elements in Legal Writing

Theme and character are considered two of the most important storytelling elements.¹⁸ In literature, theme is defined as the moral of the story.¹⁹ In a legal brief, the same idea applies, but the theme is also the “big idea” that brings the story together.²⁰ Therefore, it should be straightforward and not complex. Without a theme, a story is just a collection of facts. It gives the story its meaning.²¹ The theme helps the judge learn and understand who the client is, what the client needs, why the client acted in a particular way, and why the judge should find in the client’s favor. In fact, the theme is not a legal issue at all, but “a commonly held belief or universal truth [that] allows [the writer] to tap into the reader’s values and experiences.”²²

A good story not only contains a theme, but also revolves around characters.²³ The characters are usually the people or personalities who appear in the stories.²⁴ In fiction writing and novels, the characters’ goals are what

14. See Kenneth D. Chestek, *An Empirical Study of the Power of Story*, 7 J. ASS’N LEGAL WRITING DIRECTORS 1, 3 (2010).

15. *Id.* at 10, 17.

16. *Id.* at 29. Although appellate judges were used in the study, there is no reason why administrative judges in an administrative tribunal would not equally prefer storytelling briefs.

17. See, e.g., Foley & Robbins, *supra* note 1, at 461; Patten, *supra* note 1; Cowden, *supra* note 1, at 32–34; Chestek, *The Plot Thickens*, *supra* note 1, at 137.

18. Scholars disagree on which element is the most important, but for the purpose of this comment, both elements are considered important. Foley & Robbins, *supra* note 1; Cowden, *supra* note 1, at 32–34; Paul N. Luvera, *The Art of Storytelling*, 58 WASH. ST. B. NEWS 21, 23 (2004). Patten, *supra* note 1, at 241.

19. Chestek, *supra* note 1, at 146.

20. James W. McElhaney, *Story Line*, 92 A.B.A. J. 26, 26–27 (2006).

21. Patten, *supra* note 1, at 241.

22. Cowden, *supra* note 1, at 32.

23. Foley & Robbins, *supra* note 1, at 467.

24. Cowden, *supra* note 1, at 32.

keep a novel alive. However, this idea is not unique to fiction writing and novels. Legal writing scholars believe the same is true in legal storytelling.²⁵

II. STORYTELLING IN IP CASES

Despite the rise in popularity of legal storytelling in the legal profession, legal writing scholarship within the practice of IP law regarding legal storytelling is limited. The limited scholarship focuses more on patent litigation because of its technical and complex concepts. It may seem difficult to tell a compelling story about technical concepts like infringing semiconductors using traditional storytelling elements, and in fact, it is difficult.²⁶ But difficult does not mean impossible.

Practitioners recommend several techniques in approaching briefs in patent cases. To start off, practitioners first recommend simplifying the content into straightforward terms, cutting the technical jargon.²⁷ This will avoid the brief writer appearing condescending.²⁸ Next, practitioners recommend making the story revolve around people. When it comes to technical and complex concepts in patent law, scholars recommend focusing on the technology from the perspectives of the user and inventor, rather than the components of the technology.²⁹

In a blog post about creating narratives in claim constructions briefs, Attorney Steve Hansen recommends that brief writers build a narrative based on the intrinsic evidence.³⁰ “Create a narrative from the intrinsic evidence by using the claim terms in a manner that is consistent with your constructions and inconsistent with your opponent’s constructions.”³¹ Specifically, the patent holder has the advantage of telling the story of the invention.

Since legal writing literature currently focuses only on patent law within IP practice, this Comment will increase legal writing scholarship in IP litigation practice.

25. Meyer, *supra* note 1, at 73 (stating that character development still matters in legal storytelling); Cowden, *supra* note 1, at 33 (stating that all characters must have goals).

26. One practitioner even suggests hiring an appellate specialist trained in storytelling “to keep a brief from becoming stuck on the technical aspect of the case.” Coe, *supra* note 5.

27. Donahue, *supra* note 5; Coe, *supra* note 5.

28. See Donahue, *supra* note 5.

29. Stark, *supra* note 1, at 102; Guberman, *supra* note 12, at 67–72, 77–80.

30. An important note is that construction claims, much like trademark oppositions, are won on briefs.

31. Hansen, *supra* note 5.

III. APPLICATION OF STORYTELLING TO TRADEMARK OPPOSITION BRIEFS

Stories told in a trademark opposition differ from the average story told in a tort or criminal law case. While an interesting tale involving people drives the story in a tort or criminal case, the mark drives the story in an opposition. At first glance, one would think that a story would not be possible in a trademark opposition proceeding; however, an opposition is much like any other legal dispute. A conflict has erupted because the opposing plaintiff has interfered and stopped a trademark application during the registration process.

A. Trademark Opposition Proceeding Generally

A trademark opposition proceeding is one of four types of *inter partes* proceedings that occur before the TTAB.³² If the United States Patent and Trademark Office (“USPTO”) determines that a mark is entitled to registration, it publishes the mark in the Official Gazette of the USPTO. Within thirty days of the publication date, interested members of the public may file a petition opposing the USPTO’s decision to register the mark.³³ Any interested party may file a petition (or opposition) with the TTAB if the party believes he or she would be damaged by registration of the applicant’s mark on the Principal Register.³⁴ The process is intended to be a “backstop” for the examination process and “remedy oversight or error, not to substitute the examination process.”³⁵ An opposing party can only oppose an application to register on the Principal Register. An applicant’s registration for the Supplemental Register is not subjected to opposition claims, because supplemental registration is not considered as important as principal registrations.³⁶

B. Procedure of Opposition Proceedings

Oppositions before the TTAB resemble a civil court action. Oppositions are governed by procedural practice rules in the Federal Rules of Civil Procedure (“FRCP”).³⁷ The party opposing registration files a Notice of

32. Erik M. Pelton, *Inter Partes Matters: General Background and Prefiling Considerations*, in A LEGAL STRATEGIST’S GUIDE TO TRADEMARK TRIAL AND APPEAL BOARD PRACTICE 9–10 (Jonathan Hudis ed., 3d ed. 2016).

33. *See* Rules of Practice in Trademark Cases, 37 C.F.R. §2.101 (2016).

34. The Lanham (Trademark) Act, 15 U.S.C. § 1063 (2012). *See* 37 C.F.R. §2.101; TRADEMARK TRIAL AND APPEAL BOARD, TRADEMARK MANUAL OF BOARD PROCEDURES (T.B.M.P.) §§303 et seq. (2017); TRADEMARK TRIAL AND APPEAL BOARD, TRADEMARK MANUAL OF EXAMINING PROCEDURE (T.M.E.P.) § 1503.01 (2017).

35. 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 20:2 (5th ed. 2017).

36. 15 U.S.C. § 1092.

37. 37 C.F.R. § 2.116(a).

Opposition—comparable to a Complaint—stating its bases for the opposition.³⁸ Since the proceedings are governed by federal regulations, the Notice of Opposition must comply with Rule 8(a) of the FRCP, which requires “a short and plain statement of the claim showing that the pleader is entitled to relief” and a “demand for the relief sought.”³⁹ The applicant is entitled to file an answer and present affirmative defenses and counterclaims.⁴⁰

Following the pleading stage, the opposition proceeding continues into the discovery⁴¹ and trial⁴² phase of the process. Trial practice before the TTAB differs from a trial held in federal court in the sense that an actual “trial” does not take place before a judge or an administrator.⁴³ However, the Trademark Rules of Practice make up for the difference by assigning testimony periods, where each party receives the opportunity to introduce evidence.⁴⁴ Following the “trial,” the parties review testimony and prepare legal briefs.⁴⁵

But first, to proceed with an opposition proceeding before the TTAB, the opposer must plead and meet two requirements in the Notice of Opposition: (1) standing and (2) stating the grounds on which they are challenging registration.⁴⁶

C. Standing

The Lanham (Trademark) Act limits opposing plaintiffs to “any person[s] who believe that he would be damaged by registration of the (applicant’s) mark.”⁴⁷ To meet the standing requirement, the plaintiff is not required to possess ownership rights in a similar or competing mark.⁴⁸ However, the opposer must show that “it has a ‘direct interest and personal stake in the outcome of the proceedings.’”⁴⁹ The opposer only needs to show “that it is more than a ‘mere intermeddler’ and has ‘a positive interest in the outcome

38. 37 C.F.R. § 2.116(c).

39. FED. R. CIV. P. 8(a)(2)–(3). The Federal Rules of Civil Procedure 8(a)(1) requires a “short and plain statement of the grounds for the court’s jurisdiction, unless the court already has jurisdiction and the claim needs no new jurisdictional support.”

40. 37 C.F.R. § 2.106.

41. 37 C.F.R. § 2.120.

42. 37 C.F.R. § 2.116.

43. MCCARTHY *supra* note 35, at § 20:101.

44. 37 C.F.R. § 2.116.

45. 37 C.F.R. § 2.128; 3 MCCARTHY, *supra* note 35, at § 20:103.

46. McCarthy, *supra* note 35, at §20:3; JOSEPH R. DREITLER & MARY R. TRUE, *Pleadings and Commencement of Proceedings*, in A LEGAL STRATEGIST’S GUIDE TO TRADEMARK TRIAL AND APPEAL BOARD Practice 30–31, (Jonathan Hudis ed., 3d ed. 2016).

47. The Lanham (Trademark) Act. 15 U.S.C. § 1063 (2012).

48. Dreitler & True, *supra* note 46, at 34.

49. *Id.*

beyond that of the general public.”⁵⁰

D. Grounds–Dilution

The Lanham Act does not state statutory grounds for sustaining an opposition challenge.⁵¹ However, the TTAB has held that an opposer may raise any legal defect or deficiency in the mark’s application.⁵² This includes any statutory bars to registration enumerated in Sections 2(a) to 2(e) of the Lanham Act.⁵³ These grounds for opposition include likelihood of confusion, descriptiveness or genericness, deception or fraud, abandonment, and dilution. For the purposes of this comment, only dilution will be addressed.

In an effort to protect the value of their famous trademark, an owner of a famous trademark can oppose an application under 15 U.S.C. § 1125(c), or the federal trademark antidilution law. The purpose of the antidilution law is to protect the goodwill associated with a well-known mark (which may have been built up over many years) and reduce consumer confusion. Dilution occurs when the distinctive quality of a famous mark is blurred⁵⁴ or tarnished⁵⁵ by “another’s use of the same or similar mark on goods/services, whether or not those goods/services are similar to the plaintiff’s goods/services, and whether or not consumers are confused.”⁵⁶

Trademark dilution laws underwent changes in 2006 with the Trademark Dilution Revision Act of 2006 (“TDRA”).⁵⁷ Congress amended the laws in response to the United States Supreme Court decision, *Moseley v. V Secret*

50. *Id.*

51. 15 U.S.C. § 1063.

52. *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382 (T.T.A.B. 1991) (stating that an opposer may rely on a ground that negates the applicant’s right to registration, once standing has been established).

53. *Id.*

54. Dilution by blurring occurs when there is an association and the opposer’s famous mark that is likely to impair the distinctiveness of the famous mark. 15 U.S.C. § 1125(c)(2)(B) (2012). The Board considers the following factors to determine whether a likelihood of dilution by blurring exists. The degree of similarity between the mark or trade name and the famous mark.

The degree of inherent or acquired distinctiveness of the famous mark.

The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

The degree of recognition of the famous mark.

Whether the user of the mark or trade name intended to create an association with the famous mark.

Any actual association between the mark or trade name and the famous mark.

55. Dilution by tarnishment occurs when the similarity between a mark and a famous mark is likely to harm the reputation of the famous mark. 15 U.S.C. § 1125(c)(2)(c).

56. Ann Schofield Baker & Christopher Bovenkamp, *What Is a Trademark Anyway?* 45 ADVOCATE TEXAS 49, 51 (2008).

57. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.101 (5th ed. 2017).

*Catalogue, Inc.*⁵⁸ The TDRA made it easier for trademark owners to prove dilution of their marks, since proof of actual dilution was no longer necessary to prove.⁵⁹ The trademark owner could now rely on likelihood of dilution, either by blurring or tarnishment.⁶⁰

To successfully oppose a trademark application based on a likelihood of dilution claim, the opposing plaintiff must first show that their mark is a famous mark in the minds of the general public prior to the application's filing date. Under section 1125 of the Lanham Act, "a mark is famous if it is widely recognized by the general consuming public . . . as a designation of source of the goods or services of the mark's owner."⁶¹ To determine whether a mark is famous, courts consider several factors set forth in the statute.⁶² These factors can be met by introducing a variety of evidence: sales of goods or services in both in dollar value and units sold; survey evidence showing consumer recognition of the mark; advertising and promotional expenditures; or industry awards.⁶³

However, establishing fame under the dilution statute is hard to prove.⁶⁴ The standard under the dilution statute is "more rigorous and demanding"⁶⁵ than the standard under the likelihood of confusion standard, placing quite the burden for mark owners who wish to seek the famous status for their marks. "Fame for dilution purposes is an 'on-off' test—the mark is or is not eligible for the extraordinary protection of dilution law. And it is eligible only if it is clearly proven to belong in the 'famous' category of truly elite marks."⁶⁶ This

58. *Id.*

59. *Id.*

60. *Id.*

61. 15 U.S.C. § 1125(2)(A).

62. *See id.*

The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

The amount, volume, and geographic extent of sales of goods or services offered under the mark.

The extent of actual recognition of the mark.

Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

63. *See, e.g.,* Chanel, Inc. v. Makarczyk, 110 U.P.S.Q.2d 1213 (T.T.A.B. 2014); UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011); National Pork Board v. Supreme Lobster & Seafood Co., 96 U.S.P.Q.2d 1479 (T.T.A.B. 2010).

64. *See, e.g.,* Coach Servs. v. Triumph Learning, 668 F.3d 1356 (Fed. Cir. 2012), *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164, 1180 (T.T.A.B. 2001).

65. McCarthy, *supra* note 57, at § 24:104.

66. *See* Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En, 1772, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1694 (Fed. Cir. 2005) ("While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak.").

differs from the lower burden for fame under the test for likelihood of confusion, which has a lower threshold.⁶⁷ Despite the difference in fame for confusion and fame for dilution, famous marks have a broader range of protection.⁶⁸

E. Opposition Briefs

Practitioners in TTAB proceedings rarely appear before the Board in person during the course of the proceeding. Because practitioners rarely appear in person, the main briefs serve as the party's opportunity to present its narrative of the facts and legal principles supporting its position. The Board will decide the case based on the written record unless either party requests an oral hearing before the Board.⁶⁹ However, given the Board's unique practice, extra care and planning should be taken in drafting the main brief.

The rules governing submission of the main briefs are set forth in title 37 of the Code of Federal Regulations.⁷⁰ However, these rules address only form⁷¹ and formatting⁷² requirements for the main brief. Neither these rules, nor the TTAB's guide for practitioners (the "TBMP"),⁷³ provide guidance on how the content should be presented in the brief.

67. *Eleven, Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1722 (T.T.A.B. 2007) ("A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.").

68. *See Weider Publications, LLC v. D & D Beauty Care Co. LLC*, 109 U.S.P.Q.2d 1347 (T.T.A.B. 2014).

69. *Bryner & Hooker*, *supra* note 7, at 291.

70. *See* 37 C.F.R. § 2.122(a) (2017).

71. *See* 37 C.F.R. § 2.128 (stating that a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety).

72. *See* 37 C.F.R. § 2.126(a). Practitioners must meet the following requirements.

A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;

A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;

If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;

A paper submission must not be stapled or bound;

All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);

Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.

73. TRADEMARK MANUAL OF BOARD PROCEDURES (TBMP) §§ 801–807 (June 2017).

In reviewing trademark opposition briefs, there are some opposition briefs that fail to provide a clear theme, which results in the statement (or recitation of facts) turning into a collection of facts.⁷⁴ Additionally, some briefs fail to characterize the brand. The role of a trademark practitioner resembles the role of a brand manager. A brand manager controls the brand's reputation, and is hired as both the brand's voice and the architect of a brand's image during the opposition proceeding.

In the first opposition case, UMG Recordings, Inc.—owner of the registered MOTOWN mark on a variety of goods, not limited to musical recordings—initiated an opposition proceeding against Mattel, Inc., who applied to register its MOTOWN METAL mark in connection with toys, games, and related accessories.⁷⁵ The Board found that the applicant's MOTOWN METAL mark was likely to cause confusion and dilute the famous MOTOWN trademarks.⁷⁶

In the second case, opposer Coach Services, Inc.—owner of the registered COACH mark in connection with handbags and other fashion accessories—initiated an opposition proceeding against Triumph Learning, Inc, who applied to register its COACH mark in connection with test preparation and educational materials.⁷⁷ The Board dismissed the opposition, concluding that there was a lack of proof to show that the opposer's COACH mark was famous enough to support a claim of dilution against the applicant's COACH educational materials.⁷⁸ On appeal, the Federal Circuit affirmed the Board's findings regarding the fame for dilution purposes, but vacated and remanded the Board's decision in regard to acquired distinctiveness.⁷⁹

The third case, Chanel, Inc.—owner of CHANEL mark—filed an action against applicant Jerzy Makaczyk, who applied to register CHANEL for “real estate development and construction of commercial, residential and hotel property.”⁸⁰ The Board held that the CHANEL mark was famous for dilution purposes, citing the mark's success and extremely high annual sales figures. The Board held that the Makaczyk's CHANEL mark would dilute the famous

74. For the purpose of this comment, four opposition cases were reviewed. The trademark opposition briefs in each opposition were examined for the two storytelling elements: theme and character.

75. UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011) (Opposition No: 91176791).

76. *Id.*

77. Coach Servs., Inc. v. Triumph Learning LLC, 96 U.S.P.Q.2d 1600 (T.T.A.B. 2010) (Opposition: 91170112), *aff'd* in part, vacated in part, 668 F.3d 1356 (Fed. Cir. 2012).

78. *Id.*

79. Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356 (Fed. Cir. 2012).

80. Chanel, Inc. v. Makarczyk, 110 U.S.P.Q.2d 2013 (T.T.A.B. 2014) (Opposition No. 91208532).

CHANEL mark despite the opposer having no current involvement in real estate, but that many luxury brands license use of their mark to hotels or other related areas.

The final case, In-N-Out Burgers, filed an action against Fast Lane Car Wash & Lube LLC, who applied to register the mark IN & OUT CAR WASH for automobile cleaning and car washing services.⁸¹ The Board held that Fast Lane's application would not dilute IN-N-OUT BURGERS' marks because In-N-Out Burgers failed to prove "fame" for dilution purposes.⁸²

As stated previously, the theme gives the story its meaning. It tells the reader why they should care. For the opposing plaintiff, the purpose of the proceeding is to protect its famous brand from damage, specifically all of the time and hard work that the mark owner expended to turn this mark into a recognized brand. While the purpose of the proceeding may be obvious, it is opposer's burden to show this. One way to show this is with a brief introduction of the mark's history. Every famous mark started somewhere, whether it was a small hat shop, an idea to create a new musical style and sound, or a hamburger restaurant. The introduction of the mark's history, in addition to the evidence of the mark's success and recognition, shows the reader why it should care about protecting this famous brand from other marks that may capitalize on its goodwill.

UMG Recordings's brief starts by telling the reader that "[t]his is a simple case."⁸³ The reader soon learns why the case is simple. In the brief, the reader learns that the MOTOWN Marks have been in use for fifty years, but the reader also learns the value of the MOTOWN brand to the owner. Much of the brand's value stems from its humble beginnings and its immediate success, which the brief writer briefly addresses in "A Brief History of MOTOWN" section and throughout the brief.⁸⁴ In this section, the writer capitalizes on the rich history, discussing MOTOWN's decades of success ranging from the 60s through the present.⁸⁵ In the Argument, the brief writer capitalizes on the creation of MOTOWN in the own words of founder Berry Gordy.⁸⁶ Throughout the brief, the writer weaves its theme of the company's goal to protect the rich history of the MOTOWN marks.

81. In-N-Out Burgers v. Fast Lane Car Wash & Lube, LLC, 2013 WL 3188897 (Opposition No. 91183888).

82. *Id.*

83. Trial Brief of Opposer UMG Recordings, UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011) (Opposition No: 91176791).

84. *Id.* at 5.

85. *Id.* at 5–8.

86. *Id.* at 19.

Like the UMG Recordings's brief, Chanel, Inc. brief starts its facts section by recounting the history of CHANEL.⁸⁷ Here, the reader learns that the CHANEL brand grew from a small Paris hat shop in 1910 to a clothing, fragrance, and accessories line in subsequent years.⁸⁸ The writer guides the reader through CHANEL's history, also mentioning the founder Coco Chanel's death in 1971, stating her death "did not slow the growth of the business."⁸⁹ With this introduction of the CHANEL brand, like the MOTOWN brand, it not only tells the reader but it also shows the reader why the company is opposing the applicant's mark. A famous brand is not born overnight. The mark's journey to its famous status matters as well.

However, this ideal is lost in the Coach Services's brief. Coach Services's brief fails to weave the similar tale into its brief.⁹⁰ COACH, albeit a different brand from MOTOWN, still enjoys a distinctive and illustrious history. According to the documents submitted as Notice of Reliance, COACH started in 1941 in a small workshop in New York City with six skilled workers.⁹¹ Coach Services submitted documents into evidence that discussed its unique history, which started with an idea to create handcrafted natural leather goods.⁹² However, the Coach Services's brief fails to capitalize on this rich history. Like UMG Recordings's brief, Coach Services's brief could have built the theme of its case around its long history to become a luxury accessory brand and its goal to protect their investment in their brand.

Like the Coach Services's brief, the In-N-Out Burgers brief fails to weave a similar tale in its brief. The brief offers information that In-N-Out Burgers is successful, but the brief fails to show us *how* In-N-Out Burgers came to be the successful and famous brand that it is today. Like the Coach Services's brief, this party relies on a lot of data, but fails to show it in their brief. In-N-Out Burgers has a rich history. The reader knows that the In-N-Out Burgers is a successful brand that needs protection, but the writer never shows the reader why, other than the obvious reason of money. The chain was first started at the

87. Trial Brief of Opposer Chanel, Inc., Chanel, Inc. v. Makarczyk, 110 U.S.P.Q.2d 2013 (T.T.A.B. 2014) (Opposition No. 91208352).

88. *Id.* at 7.

89. *Id.* at 8.

90. Trial Brief of Opposer, Coach Servs., Inc. v. Triumph Learning LLC, 96 U.S.P.Q.2d 1600 (T.T.A.B. 2010) (Opposition: 91170112).

91. Plaintiff's First Notice of Reliance Part 3 of 9, Coach Servs., Inc. v. Triumph Learning LLC, 96 U.S.P.Q.2d 1600 (T.T.A.B. 2010) (Opposition: 91170112); "History and Heritage," COACH, <http://www.coach.com/history-heritage.html> [<https://perma.cc/9DMA-95AR>] (last visited September 2017).

92. *Id.*

end of the World War II in 1948 by Harry and Ester Snyder, who set out to make a living by making a hamburger.⁹³ In-N-Out Burgers submitted documents into evidence that discussed its unique history, which started with an idea to create a hamburger restaurant.⁹⁴ This brief could have built the theme of its case around its long history of a family-owned company that cares about protecting its quality food brand.

As stated previously, all stories revolve around characters. However, when most people think of characters in a story, they think of characters in the traditional sense. They think human beings or at least someone who possesses some type of human quality. At first glance, this may not apply to trademarks or service marks, but marks are not devoid of a personality because they appear to lack human traits. With archetypal analysis, a mark can be judged as a person. An archetype, according to author Jim Signorelli “is a generic version of a personality.”⁹⁵ In his book, author Jim Signorelli identifies twelve archetypes⁹⁶ based on the archetypes proposed by Carol S. Pearson and Margaret Mark, with each archetype containing a different human value.⁹⁷ The archetypal analysis is critical because it helps to personalize a mark and differentiate between other marks and brands. This helps the brand to build a strong and long-lasting connection with their users, a connection that turns the brand into a household name. Just like a person, a company’s brand has a unique personality and how people connect with the brand has a huge impact on business. The use of archetypal analysis and how the general public interacts with the mark and brand further illustrates the popularity and success of the brand. As a result, brief writers should consider the use of archetypal analysis when describing the success of the mark in the brief’s fact section.⁹⁸

Applying the archetypal analysis to the UMG Recordings’s brief reveals that the Recitation of Facts starts well. It introduces the reader to a brief history of the MOTOWN recording label, summarizing its success. However, while the brief presents an overall picture of MOTOWN mark, it fails to capture the

93. Plaintiff/Opposer’s Notice of Reliance Part 2 of 2, *In-N-Out Burgers v. Fast Lane Car Wash & Lube, LLC*, 2013 WL 3188897 (Opposition No. 91183888).

94. *Id.*

95. JIM SIGNORELLI, *Story Branding 2.0: Creating Stand-Out Brands Through the Purpose of Story* 100 (2014) (ebook).

96. The twelve archetypes are The Purist, The Pioneer, The Entertainer, The Conqueror, The Wizard, The Protector, The Seducer, The Imagineer, The Emperor, The Rebel, The Source, and The Straight Shooter. *Id.* at 101.

97. There are several sources on brand archetypes, but this comment will focus on the archetypes listed in the Storybranding book, see SIGNORELLI *supra* note 95.

98. For the purpose of this comment, only one archetype will be used to describe each mark, but it should be noted that a brand can have more than one archetype. See SIGNORELLI, *supra* note 95, at 100.

personality of the MOTOWN mark.

Using Signorelli's archetypes, the MOTOWN mark could be typed as the Pioneer. The Pioneer is described as an "individualist, blazing his own trail in pursuit of freedom, adventure and new experiences that feed his soul."⁹⁹ Early on, the MOTOWN label pioneered and created a marketplace for African American artists, who created a new sound for the world to enjoy, known as the "Motown Sound," "the young sound of America."¹⁰⁰ The Opposer's brief recognizes this style, but fails to capitalize on it. Jerry Juste, a UMG Recordings, Inc. executive, "describe[d] the unique 'Motown Sound' that characterized the music of its early artists":

The Motown Sound was typified by a number of characteristics: the use of tambourines to accent the backbeat; prominent and often melodic electric bass guitar lines; distinctive melodies and chord structures; and a call and response singing style that was rooted in gospel music. In addition, the Motown Sound also incorporated pop production techniques such as the use of orchestral string sections, charted horn sections, and carefully arranged background vocals.¹⁰¹

This observation was included in the Board decision, but failed to make it in the final MOTOWN brief. Despite UMG Recordings' success in the proceeding, this observation would have further enhanced the brief.

Like the UMG Recordings's brief, the Chanel, Inc. brief fails to capture the true personality of its mark. The writer states that "the general public knows the CHANEL brand" and cites its success, but the brief writer does not show the reader why consumers identify with the CHANEL mark.

Using Signorelli's archetype classification, the brief writer can tell the story of the CHANEL mark through the lens of the archetype Seducer. The Seducer is described as desiring pleasure, romance and intimacy.¹⁰² This archetype illustrates the CHANEL brand, which sells more than fashion; it sells a lifestyle, specifically to its main consumer, the CHANEL woman. The CHANEL woman has status and is confident, independent and successful. The CHANEL mark offers the reflection of an elegant woman, seductive, sophisticated and yet who loves to attract attention.

The Coach Services brief is also missing character. This is due to the fact that the brief typically cites to the record rather than including important parts of the record in the brief. For example, COACH submitted documents into

99. *Id.* at 103.

100. UMG Recordings Exhibit A Notice of Reliance re: Printed Publications, UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011) (Opposition No: 91176791).

101. Trial Declaration of Jerry Juste, UMG Recordings, Inc. v. Mattel, Inc., 03/16/09, UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011) (Opposition No: 91176791); UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d at 1878.

102. SIGNORELLI, *supra* note 95, at 108.

evidence that reveal the humble beginnings of the COACH brand,¹⁰³ but the brief fails to mention anything about the beginnings of COACH and how it grew into a more recognizable brand. Perhaps, this is part of the reason that the Coach brief ultimately fails to prove that it is a famous mark; it *relied* on the fact that it is a famous mark, rather than *showing* that it is a famous mark.

Using Signorelli's classifications, COACH could characterize itself as a Pioneer of leather good products. The Pioneer is described as an "individualist, blazing his own trail in pursuit of freedom, adventure and new experiences that feed his soul."¹⁰⁴ Since its founding in 1941, Coach Services has been establishing a reputation for production of high-quality leatherwear, calling itself the "the Original American House of Leather,"¹⁰⁵ but this information is missing from the brief.

The In-N-Out Burgers brief is similarly missing character. There, the writer makes reference to what makes the brand different from its competitors, or how customers characterize the In-N-Out Burgers brand. Mr. Andrew Wensinger, general counsel of the company, states this during deposition, characterizing the brand as more than fast-food restaurant.¹⁰⁶ However, the brief writer fails to use this information and expand on how the In-N-Out Burgers' brand is more than a fast-food restaurant.

Using the Signorelli archetype classification, the brief writer could characterize the IN-N-OUT BURGERS mark as the Straight Shooter. The Straight Shooter is described as a brand that tells it like is and values function over form and style.¹⁰⁷ This describes the IN-N-OUT BURGERS brand, especially given the fact that the brand and mark keeps and sticks to its formula for success. While its competitors are changing to keep up with the times, In-N-Out Burgers stays true and authentic to its formula. With its focus on quality, the brand is characterized the same today as it was more than sixty years ago, as reflected by its slogan "Quality you can taste."

103. Plaintiff's First Notice of Reliance Part 3 of 9, *Coach Servs., Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600 (T.T.A.B. 2010) (Opposition: 91170112).

104. SIGNORELLI, *supra* note 95, at 103.

105. *About Coach: Our Story*, COACH, <https://www.coach.com/careers-about-coach.html> [<https://perma.cc/3GSW-HU6P>].

106. Transcript of Video Conference Deposition of Arnold M. Wensinger, Plaintiff/Opposer's Notice of Reliance, *In-N-Out Burgers v. Fast Lane Car Wash & Lube, LLC*, 2013 WL 3188897 (Opposition No. 91183888).

107. SIGNORELLI, *supra* note 95, at 113.

IV. CONCLUSION

The purpose of this Comment was to address how storytelling techniques and elements in legal writing can improve advocacy in trademark opposition briefs. Often, the trademark opposition briefs follow a script or formula when structuring a brief, which leads to dry and often robotic writing. Companies often spend a lot of time and money to develop their brand's identity, especially when the brand and trademark is a famous mark. However, the brand's identity is often buried or lost under a collection of facts in rather than highlighted. The collection of facts should be used to build the story rather than be the complete story.

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