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1001 In General

15 U.S.C. §1066. *Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to use of which has become incontestable.*

37 CFR §2.83 Conflicting marks.

(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the Official Gazette for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the Official Gazette for opposition or issued on the Supplemental Register.

(c) Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.

37 CFR §2.91 Declaration of interference.

(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Commissioner. Interferences will be declared by the Commissioner only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

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An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict) is entitled to registration. *See* Sections 16 and 18 of the Act, 15 U.S.C. §§1066 and 1068. A "conflict" exists, for interference purposes, whenever "application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive." *See* Section 16 of the Act, 15 U.S.C. §1066. *See also* Section 2(d) of the Act, 15 U.S.C. §1052(d); 37 CFR §2.83; and TMEP §1208.01(a).

Ordinarily, when conflicting applications are pending, the application with the earliest effective filing date is approved for publication in the *Official Gazette* for opposition (if the mark is eligible for registration on the Principal Register), or is registered on the Supplemental Register (if the mark is eligible for registration on the Supplemental Register). Action on any later-filed conflicting application is suspended until the earlier-filed application is registered or abandoned. *See* 37 CFR §2.83, and TMEP §1208.01.

If the owner of an application which conflicts with one or more pending applications wishes to have the PTO set up an interference proceeding between the conflicting applications, rather than have the PTO follow the procedure described in 37 CFR §2.83, that applicant must file a petition to the Commissioner to declare an interference. *See* Section 16 of the Act, 15 U.S.C. §1066; 37 CFR §2.91(a); and TBMP §1002.

NOTE: Although the Commissioner is authorized by Section 16 of the Act to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Act of 1920, and registrations of marks the right to use of which has become incontestable), it is not the Commissioner's practice to do so. *See* TBMP §1002, and authorities cited therein.

1002 Declaration of Interference

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15 U.S.C. §1066. *Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to use of which has become incontestable.*

37 CFR §2.91 Declaration of interference.

(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Commissioner. Interferences will be declared by the Commissioner only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

Under Section 16 of the Act of 1946, 15 U.S.C. §1066, the Commissioner, upon petition showing extraordinary circumstances, may declare that an interference exists when an application conflicts with a registration issued to another, or with an application previously filed by another, that is, "when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive."

A petition for declaration of an interference will be granted by the Commissioner only if the petition shows "extraordinary circumstances which would result in a party being unduly prejudiced without an interference." *See* 37 CFR §2.91(a). *See also In re Ratny*, 24 USPQ2d 1713 (Comm'r 1992); *In re Kimbell Foods, Inc.*, 184 USPQ 172 (Comm'r 1974); and *In re Family Inns of America, Inc.*, 180 USPQ 332 (Comm'r 1974). Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. *See* 37 CFR §2.91(a). *See also In re Kimbell Foods, Inc., supra*. However, a petition to the Commissioner to declare an interference

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has been granted where, but for the interference, multiple oppositions would be necessary. *See In re Family Inns of America, Inc.*, *supra*. *See also* TMEP §§1208.04 and 1208.04(b).

Although the Commissioner is authorized by Section 16 of the Act to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Act of 1920, and registrations of marks the right to use of which has become incontestable--*see* Sections 16, 26, and 46(b) of the Act, and 37 CFR §2.91(b)), it is not the Commissioner's practice to do so. *See In re Kimbell Foods, Inc.*, 184 USPQ 172 (Comm'r 1974), and *Ex parte H. Wittur & Co.*, 153 USPQ 362 (Comm'r 1966). This is because a registration will not be cancelled as a result of a decision in an interference proceeding. A formal petition for cancellation must still be filed and granted, and the registration must be cancelled, before any registration will be issued to the applicant. *See* 37 CFR §2.96; *In re Kimbell Foods, Inc.*, *supra*; *Ex parte H. Wittur & Co.*, *supra*; *Hy-Pure Laboratories, Inc. v. Foley & Co.*, 98 USPQ 280 (Chief Examiner 1953); and *Cudahy Packing Co. v. York Pharmacal Co.*, 93 USPQ 227 (Comm'r 1952). The interference proceeding is superfluous, since the cancellation proceeding by itself will accomplish the same purpose as the two proceedings together.

A petition to the Commissioner to declare an interference should be made by separate paper bearing the title "PETITION TO THE COMMISSIONER," and be accompanied by the fee specified in 37 CFR §2.6(k). For further information concerning the form for a petition to the Commissioner, *see* 37 CFR 2.§146(c), and TBMP §905.

A petition to declare an interference should not be filed in an application until the application has been examined by the Trademark Examining Attorney, and the mark has been found registrable but for the existence of one or more pending conflicting applications. When such a petition is filed, the Examining Attorney will immediately forward the petition, together with the application file, to the Assistant Commissioner for Trademarks for determination of the petition. *See* TMEP §1208.04(a).

1003 Institution of Interference

37 CFR §2.92 Preliminary to interference.

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An interference which has been declared by the Commissioner will not be instituted by the Trademark Trial and Appeal Board until the Examiner of Trademarks has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.

37 CFR §2.93 Institution of interference.

An interference is instituted by the mailing of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

An interference proceeding does not commence with the granting of a petition to the Commissioner to declare an interference. Rather, the interference proceeding will not be instituted unless and until the Trademark Examining Attorney has determined that the marks which are to be included in the interference are registrable, but for the interfering marks; and all of the marks have been published (preferably together) in the *Official Gazette* for opposition, subject to the interference. See 37 CFR §2.92, and TMEP §1208.04(c).

If an application published subject to interference is opposed by an entity which is not to be a party to the interference, the opposition may be determined first, following which the interference, if still necessary and appropriate, will be instituted (*cf.* 37 CFR §2.99(c)); alternatively, depending upon the circumstances, the opposition and interference may go forward contemporaneously. If an opposition is filed by an entity which is to be a party to the interference, and the interference is to involve three or more parties, the opposition will be dismissed without prejudice in favor of the interference proceeding, wherein the rights of all parties can be determined in a single proceeding. If an opposition is filed by an entity which is to be a party to the interference, and the interference is to involve only two parties, the rights of the parties will be determined in the opposition, and the interference will not be instituted.

If the marks which are to be included in an interference (1) are found by the Trademark Examining Attorney to be registrable, (2) are published for opposition,

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and (3) survive the opposition period (as indicated in the preceding paragraph), the interference proceeding will be instituted by the Board.

The Board prepares a "notice of interference" notifying the parties that the interference proceeding is thereby instituted, and setting trial and briefing dates in the case. The notice specifies the name and address of each party to the proceeding and of each party's attorney or other authorized representative, if any; the mark of each party; and the serial number, filing date, and publication date of each involved application. *See* 37 CFR §2.93.

An interference proceeding commences when the Board mails the notice of interference to the parties. The notice is mailed to the attorney or other authorized representative of each involved applicant, or, if the applicant does not have an attorney or other authorized representative, to the applicant. *See* 37 CFR §2.93.

It is not the Commissioner's practice to declare an interference with a registration. *See* TBMP §1002, and cases cited therein. However, should the Commissioner elect to declare an interference with one or more registrations, the notice of interference would specify the registration number and issuance date of each involved registration, and would be mailed to the registrant or its assignee of record. *See* 37 CFR §2.93.

There are no pleadings in an interference proceeding. *Cf.* TBMP §§1004, 1105, and 1106. The notice of interference takes the place of pleadings, to the extent that it serves to provide each party with information concerning the involved application (or registration, if an interference should be declared with one or more registrations) of every adverse party.

There is no fee for an interference proceeding, beyond the fee required for a petition to the Commissioner to declare an interference. *See* 37 CFR §2.6. *Cf.* TBMP §1002.

1004 Issues in Interference

37 CFR §2.96 Issue; burden of proof.

The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. ... The issue in an interference between an application and a registration shall be the same, but in

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the event the final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.

Normally, the issue to be determined in an interference proceeding is priority of use. However, such additional issues as the registrability of each mark, and whether there is, in fact, a conflict between the marks involved in the proceeding (i.e., whether the marks do so resemble one another as to be likely, when used in connection with the respective goods and/or services of the parties, to cause confusion, mistake, or deception), are always before the Board in an interference, and may also be determined; there is no requirement that a party file an affirmative pleading of such matters in order to be heard thereon. *See, for example*, Sections 17 and 18 of the Act, 15 U.S.C. §§1067 and 1068; 37 CFR §2.96; *Giant Food Inc. v. Malone & Hyde, Inc.*, 522 F.2d 1386, 187 USPQ 374, 380 (CCPA 1975); *Dynamet Technology, Inc. v. Dynamet Inc.*, 197 USPQ 702 (TTAB 1977), *aff'd*, 593 F.2d 1007, 201 USPQ 129 (CCPA 1979); *Jos. Schlitz Brewing Co. v. United Vintners, Inc.*, 166 USPQ 493, 494 (TTAB 1970); *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214, 217-218 (TTAB 1970); *Tudor Square Sportswear, Inc. v. Pop-Op Corp.*, 160 USPQ 50, 53-54 (TTAB 1968); *La Jolla Sportswear Co. v. Maskuline Underwear Co.*, 114 USPQ 130, 131 (Comm'r 1957); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 325 (1985); and Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13 (deleting former 37 CFR §2.97, which contained a requirement for an affirmative pleading of registrability issues).

1005 Burden of Proof

37 CFR §2.96 Issue; burden of proof.

... The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. ...

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37 CFR §2.116(b) ... *A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

In an interference proceeding, the party whose involved application has the latest filing date is the junior party. When there are three or more parties to an interference, a party is a junior party to every other party whose involved application has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution is deemed to have the latest filing date, and that applicant is the junior party. *See* 37 CFR §2.96.

A junior party in an interference proceeding is in the position of plaintiff, and has the burden of proof, as against every party that is senior, that is, as against every party whose involved application has an earlier filing date. Conversely, a senior party is in the position of defendant as against every party that is junior, that is, as against every party whose involved application has a later filing date. *See* 37 CFR §§2.96 and 2.116(b). *See also Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673 (CCPA 1972); and *McNeil v. Mini Mansions, Inc.*, 178 USPQ 312 (TTAB 1973).

1006 Addition of Party

37 CFR §2.98 Adding party to interference.

A party may be added to an interference only upon petition to the Commissioner by that party. If an application which is or might be the subject of a petition for addition to an interference is not added, the examiner may suspend action on the application pending termination of the interference proceeding.

A party may be added to an interference only upon petition to the Commissioner filed, pursuant to 37 CFR §2.98, by the party to be added.

For information concerning joining or substituting a transferee when there has been an assignment of a mark which is involved in an interference proceeding, *see* TBMP §512.01.

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1007 Conduct of Proceeding

Once commenced (*see* TBMP §§1002 and 1003), an interference proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that there are no pleadings (*see* TBMP §§1003 and 1004), and therefore no motions relating to pleadings; the issues of priority of use, likelihood of confusion, and registrability are always before the Board (*see* TBMP §1004); a party's burden of proof as against another party to the proceeding depends upon the filing date of its involved application (*see* TBMP §1005); and additional parties may be added to the proceeding upon petition to the Commissioner filed by the party to be added (*see* TBMP §1006).

In addition, the trial and briefing schedule in an interference involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation. In the notice of interference which commences an interference proceeding, the Board sets trial and briefing dates in the case. *See* TBMP §1003. Specifically, the Board sets a closing date for discovery (which opens when the notice of interference is served by the Board upon the parties), and schedules testimony periods so that each party in the position of plaintiff (*see* TBMP §1005) will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal; the testimony periods are separated from the discovery period and from each other by 30-day intervals. *See* TBMP §701. Similarly, the Board schedules briefing periods so that each party, beginning with the junior-most party and ending with the senior-most party, will have a time for filing its main brief on the case, and each junior party will have a time for filing a reply brief. *See* TBMP §801.02(e).

Set forth below is a sample trial and briefing schedule for an interference involving parties A, B, C, D, and E, where A is junior to every other party; B is junior to C, D, and E, and senior to A; C is junior to D and E, and senior to A and B; D is junior to E, and senior to A, B, and C; and E is senior to every other party:

THE PERIOD FOR DISCOVERY TO CLOSE : July 2, 1984

Testimony period for A to close : August 31, 1984
(opening 30 days prior thereto)

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Testimony period for B to close (opening 30 days prior thereto)	: October 30, 1984
Testimony period for C to close (opening 30 days prior thereto)	: December 31, 1984
Testimony period for D to close (opening 30 days prior thereto)	: March 1, 1985
Testimony period for E to close (opening 30 days prior thereto)	: April 30, 1985
Rebuttal testimony period for A to close (opening 15 days prior thereto)	: June 14, 1985
Rebuttal testimony period for B to close (opening 15 days prior thereto)	: July 29, 1985
Rebuttal testimony period for C to close (opening 15 days prior thereto)	: September 12, 1985
Rebuttal testimony period for D to close (opening 15 days prior thereto)	: October 28, 1985
Briefs on final hearing (37 CFR 2.128) shall become due as follows:	
Brief for A shall be due	: December 27, 1985
Brief for B shall be due	: January 26, 1986
Brief for C shall be due	: February 25, 1986
Brief for D shall be due	: March 27, 1986
Brief for E shall be due	: April 26, 1986

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Reply briefs, if any, shall be due as follows:

Reply brief for A shall be due : May 11, 1986

Reply brief for B shall be due : May 26, 1986

Reply brief for C shall be due : June 10, 1986

Reply brief for D shall be due : June 25, 1986

With the exceptions noted above, the practices and procedures for taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in an interference as in an opposition or cancellation.