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BOOK REVIEW*

*By Leigha R. Santoro***

A Legal Strategist's Guide to Trademark Trial and Appeal Board Practice. Theodore H. Davis Jr., ed. 2025. Pp. 536. \$179.95 (hardback); electronic version available. ABA Book Publishing, American Bar Association, 321 N. Clark Street, Chicago, Illinois 60654-7598.

A Legal Strategist's Guide to Trademark Trial and Appeal Board Practice is a comprehensive practitioner-focused resource that combines procedural guidance, strategic considerations, useful tips, and suggestions for the various proceedings before the Trademark Trial and Appeal Board ("TTAB"), including oppositions, cancellations, and ex parte appeals. Editor Theodore H. Davis Jr. has compiled eleven chapters of practical advice and strategic insights for both attorneys who are new to TTAB practice and experienced TTAB practitioners. Most notably, each chapter concludes with a valuable checklist of issues and topics to consider for every stage of a TTAB proceeding from prefiling through an appeal, including ethical considerations and settlements.

The first eight chapters are organized in a manner that tracks TTAB practice, beginning with general background and prefiling considerations and ending with appeals, which is especially useful for new attorneys or those unfamiliar with TTAB proceedings.

In Chapter One, John C. Heinbockel provides general background information regarding the different types of proceedings before the TTAB, timing for filing proceedings, and other considerations, including entitlement to a cause of action, signature requirements, and fees. This chapter also considers the advantages and disadvantages of a TTAB proceeding compared with federal court litigation. Christina D. Frangiosa discusses the pleadings and commencement of TTAB proceedings in Chapter Two, covering the process from the complaint through the answer and counterclaims—the initial steps of both cancellation and opposition proceedings. This chapter is particularly useful to practitioners seeking a concise introduction to the procedural requirements at the outset of a TTAB matter.

* This book review should be cited as Leigha R. Santoro, 116 Trademark Rep. 702 (2026) (reviewing Theodore H. Davis Jr., ed., *A Legal Strategist's Guide to Trademark Trial and Appeal Board Practice* (2025)).

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Chapter Three, authored by Rebecca Gan, provides an overview of each form of discovery (interrogatories, requests for production, requests for admissions, and discovery depositions) and provides helpful information regarding related concepts such as the duties to cooperate and to provide supplemental responses. Particularly useful is the appendix in this chapter containing some of the more common forms that a practitioner would likely see in a standard TTAB proceeding. In Chapter Four, Stephanie H. Bald and Linda K. McLeod provide an overview of motion practice before the TTAB, including a discussion of each type of motion that can be filed in a TTAB proceeding. This chapter includes many case citations for relevant TTAB decisions and concludes with a comparison chart for the various motions that notes the timing issues, applicable rules, and “important things to remember” for each type of motion discussed, making this chapter a practical and handy resource for both experienced practitioners and those who are new to TTAB proceedings.

In Chapter Five, Maryann E. Licciardi and Eric J. Shimanoff discuss the basics of TTAB trial procedures, including notices of reliance, judicial notice, stipulated testimony, and objections. The authors of this chapter include “Practice Tips” throughout for quick reference and practical guidance, ranging from expected topics like scheduling and taking depositions, to more obscure topics that may not ordinarily be considered by practitioners such as naming conventions for confidential material filed with the TTAB. In Chapter Six, Tyson Smith considers the use of experts, including survey, linguistics, and technical experts, and provides an overview of surveys that may be used in TTAB proceedings. This chapter provides guidance to help practitioners understand the basics of survey design, including what is and is not admissible so that practitioners can use the surveys in the most effective manner. In Chapter Seven, William M. Bryner, Charles H. Hooker III, and Jessica W. Truelove discuss final briefing procedure and oral arguments before the TTAB, including the requirements for requesting the same. This chapter also includes tips and suggestions for effective brief writing and oral advocacy before the TTAB, providing practical guidance for new practitioners and experienced practitioners who may not often reach this stage of a TTAB proceeding. Finally, in Chapter Eight, Jenna F. Karadbil discusses appeals of TTAB decisions to the U.S. Court of Appeals for the Federal Circuit and federal district courts, including timing requirements, service of process, the record on appeal, and the scope of appellate review. This chapter provides a comprehensive summary of the procedural and substantive differences between the forums, which can be a useful reference for practitioners deciding in which forum to bring an appeal.

In the last few chapters of *A Legal Strategist's Guide to Trademark Trial and Appeal Board Practice*, the authors address issues that could be raised at any point in a TTAB proceeding. For example, in Chapter Nine, Roberta S. Bren and Jane Shay Wald discuss the basics of settlement and alternative dispute resolution, including the benefits of settlement and factors to consider when determining whether settlement is appropriate in a particular case. The discussion of settlement basics in this chapter is useful not only during TTAB proceedings, but also for practitioners to consider whether settlement can be reached before a proceeding is even filed. In Chapter Ten, Cathleen E. Stadecker considers the related proceedings of ex parte appeals before the TTAB. Unlike the preceding chapters that focus on specific aspects of opposition and cancellation proceedings, this chapter considers the entire ex parte appeal process from prefiling through to review of the TTAB's decision. In addition to providing pointers and tips for filing, this chapter considers key procedural considerations, including fees, timing, and evidentiary issues, and the chapter concludes with a list of recent decisions where the TTAB reversed the examining attorney's refusal to register on grounds of either likelihood of confusion or descriptiveness, making this chapter a useful reference for practitioners.

Finally, in Chapter Eleven, Chris Williams-Lopez addresses ethical considerations before the TTAB; this chapter discusses general ethical rules that are applicable to all practitioners involved in TTAB proceedings, guidelines regarding sanctions in such proceedings, and information regarding ethical considerations for dealing with pro se adverse parties. Given the importance of professional responsibility issues in contentious proceedings, this chapter serves as a useful reminder of the ethical obligations that underpin effective TTAB practice.

Each individual chapter of this book provides a high-level overview of a particular aspect of TTAB proceedings; when viewed as a whole, this practice guide is a helpful resource for any TTAB practitioner. Although this edition incorporates the TTAB's 2021 and 2023 updates to the rules of practice, some of the information may be out-of-date. For example, the Electronic System for Trademark Trials and Appeals ("ESTTA") has already been replaced by TTAB Center as the filing portal for the United States Patent and Trademark Office ("USPTO") for notices of opposition and petitions for cancellation, with more motions and filings being transferred to this portal every month. Each chapter includes a helpful checklist of information that is still relevant to consider for each stage of a proceeding and citations to rules and decisions for more information that can assist practitioners throughout a proceeding. This practice guide provides all information that a practitioner would expect from such a resource. This resource is

most useful for practitioners who are new to TTAB practice, but experienced practitioners will also benefit from the helpful summaries, case citations, and checklists, especially when it comes to some of the less common issues and procedural aspects of TTAB proceedings.
