

# **Inter Partes Proceedings at the TTAB: Advanced Practice Tips**

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## **Table of Contents**

<b>I.</b>	<b>GENERAL INFORMATION.....</b>	<b>1</b>
	Employees and Duties .....	1
	Electronic Information .....	1
	Electronic Filing and Proceeding Files.....	2
	How to Contact the Board .....	4
<b>II.</b>	<b>PRE-TRIAL CONSIDERATIONS; CORRESPONDENCE &amp; SERVICE .....</b>	<b>5</b>
	NO Suspension.....	5
	Amendments During Opposition Period .....	5
	Pre-Trial Phase of Oppositions/Extension Practice.....	5
	Correspondence Addresses on Board Files .....	6
	Withdrawals of Attorney/Changes in Representation .....	6
	Assignments/Mergers/Acquisitions.....	7
	Communication With Adverse Party.....	7
<b>III.</b>	<b>INTER PARTES PLEADING, DISCOVERY, DISCOVERY MOTIONS .....</b>	<b>8</b>
	In General .....	8
	Jurisdiction Over Applications/Registrations; Proper Captioning .....	8
	Notice of Opposition and Petition for Cancellation—Contents .....	8
	Notice of Opposition and Petition for Cancellation—Service .....	10
	Answer—Contents .....	10
	Answer—Service.....	11
	Motions, in General .....	11
	Motions or Stipulations Relating to Late/No Answer .....	12
	Motion to Dismiss in Lieu of Answer .....	12
	Motion to Strike Matter From Pleading .....	13
	Settlement and Discovery Planning Conference .....	13
	Motions to Extend/Re-open—Without Consent .....	14
	Discovery in General, Including Initial Disclosures .....	15
	Interrogatories .....	16
	Requests for Production of Documents.....	17
	Requests for Admissions .....	17
	Depositions .....	17
	Discovery and Testimony Depositions Contrasted .....	17

Standard Protective Order .....	18
Motions to Compel/for Protective Orders .....	18
Stipulations to Extend Time to Respond to Discovery.....	20
Motion for Discovery Sanctions.....	20
Motion to Suspend for Civil Action .....	21
Motion for Summary Judgment .....	21
Accelerated Case Resolution (ACR) .....	22
Motion for Discovery Under Federal Rule 56(d) .....	23
Presenting Motion/Response During Phone Conference .....	24
Stipulations/Consented Motions to Dispose of Cases .....	25
Disclosure of Testifying Experts .....	25
Board Conference with Parties, Counsel.....	26
<b>IV. INTER PARTES TRIALS, TRIAL MOTIONS, BRIEFING .....</b>	<b>26</b>
Trial in General .....	26
Pretrial Disclosures.....	26
Taking Testimony.....	27
Making Objections to Testimony Depositions .....	28
Correcting, Filing and Serving Transcripts .....	28
Notice of Reliance .....	29
Documents Produced by Adversary .....	29
Notice of Reliance and Internet Evidence .....	30
Motion to Strike Notice of Reliance.....	31
Motion to Amend Pleadings to Conform to Evidence .....	31
Rebuttal Testimony Period .....	31
Motion to Dismiss for Failure to Prosecute; Plaintiff Failure to File Brief.....	31
Briefs .....	31
Oral Hearing .....	32

## I. GENERAL INFORMATION

### Employees and Duties

In deciding *inter partes* cases, the Board's Administrative Trademark Judges work in panels, generally consisting of three judges. The record in such cases varies in quantity and quality, and the cases are briefed, and, perhaps, argued orally before a panel of judges. Before an *inter partes* case reaches a panel, however, the Board may have considered various filings and motions through the Board's electronic filing system (ESTTA) or by a Board paralegal or staff attorney.

The Board automatically processes an initial request to extend the time for filing an opposition, or any request based on good cause that will not run more than 120 days from the date of publication of the mark for opposition, if filed electronically through the Board's ESTTA system. Most oppositions filed electronically are instituted automatically. In addition, many motions filed electronically are automatically associated with the appropriate electronic case files and routed to a Board paralegal or attorney for action. Certain consented motions, however, are approved automatically. Paralegals at the Board enter extensions of time to oppose, institute new proceedings, and enter motions that cannot be processed electronically through ESTTA.

The Board's paralegal staff also handles routine motions and issues orders seeking information regarding the status of cases. For example, in *inter partes* cases, paralegals process consented motions to extend or suspend which are not filed electronically or for which an inquiry as to the status of the matter which occasioned an existing extension or suspension is appropriate; prepare suspension orders when potentially dispositive motions or motions to compel are filed; prepare orders relating to attorneys' requests to withdraw; prepare orders under Trademark Rules 2.128 and 2.134; and prepare orders disposing of cases when parties agree to settle cases through dismissal, abandonment of an application, surrender of a registration, and the like.

The staff attorneys, also referred to as Interlocutory Attorneys, review orders prepared for their signature by the paralegals on *inter partes* cases, participate in discovery conferences upon request of at least one of the parties, handle all contested pre-trial matters that arise in *inter partes* cases, and handle certain types of uncontested motions.

Generally, every pending *inter partes* case that is not yet briefed and submitted for decision is assigned to a paralegal (for entering motions and other filings) and a staff attorney (for deciding contested motions and managing the progress of the case). The names of the attorney and paralegal assigned to the case are available on TTABVUE. Often, the Managing Interlocutory Attorney, as necessary to balance dockets, reassigns cases with fully briefed contested motions ready for decision. The Board's information specialists provide general information and answer status inquiries. The Board's main phone number is (571) 272-8500.

### Electronic Information

The general public may use [www.uspto.gov](http://www.uspto.gov) to access the USPTO's home page. A link to the TTAB home page is available under Quick Links and from the Trademarks home page. For direct access to the Board's page from your browser, use the following address: <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>.

Quick Links allows access to the Board's home page, ESTTA, the Board's online filing system, and TTABVUE, the Board's docket database. The TTAB home page also has other information, including a link to a combined listing of the Trademark Rules, from Title 37 of the Code of

Federal Regulations, and the Trademark Act, from Title 15 of the U.S. Code. This document does not present the *official* versions of either, but is a resource presented by the Office.

In addition, links to the Board's weekly summary of issued decisions, to the final Board decisions posted on the USPTO's Freedom of Information Act ("FOIA") site, and to various documents regarding policy and procedure appear on the Board's home page. These documents include the TTAB's standard protective order, a copy of an announcement in the *Official Gazette* regarding telephone conferencing for *inter partes* proceedings, and materials regarding the 1998 and the 2007 changes to the Trademark Rules, among other resources. The Federal Register notice of the final 2007 rules and a summary chart listing each changed rule for the 2007 rules changes remain posted on the TTAB's webpage.

The Board's manual of procedure, the **TBMP** (not to be confused with the TMPEP, the USPTO's manual of trademark examining procedure), can also be accessed without charge via the Board's web page. It is available in two forms: a searchable form and pdf. **The manual is referenced as "TBMP § XXX (2015)."**

The Board's web page also has a link to access archived editions of the TBMP. The second edition, accessed using the "archive" link, remains relevant to the very few *inter partes* cases commenced prior to November 1, 2007. However, even for these cases, the second edition of the TBMP must be read in conjunction with the August 1, 2007, Federal Register notice detailing significant changes to TTAB rules of procedures. That notice may be access via the TTAB's home page and is available at [www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf).

**TIP:** If the answer to a practice and procedure question is in one of these online resources, any call to the Board may be met with a polite suggestion that the caller look up the answer on his or her own. Also, do not call and ask: "Are there are any cases on\_\_\_\_?" (A surprising number of people do.)

#### Electronic Filing and Proceeding Files

The Board has an electronic workflow system known as TTABIS. The great majority of pending *inter partes* proceeding files now exist only in electronic form. A very few older pending proceeding files are "hybrid" files, meaning that older paper submissions remain in proceeding folders in the Board's physical file storage, but as new papers for these cases have been filed, they are either submitted electronically or scanned into the TTABIS system and stored in electronic image form. The public interface for TTABIS is TTABVUE.

The TTABVUE system provides image records of all electronically filed or scanned documents in a TTAB proceeding and provides the prosecution history of *inter partes* and *ex parte* appeal proceedings, including current status. One can also access information on "potential oppositions," *i.e.*, applications that are the subject of extensions of time to oppose. Case searches can be conducted by *inter partes* proceeding number, the number of an involved application or registration, by mark, or by party name. Embedded links in the prosecution history of a particular *ex parte* appeal file history, potential opposition file history, or *inter partes* file history provide access to the image versions of the corresponding documents. TTABVUE can be accessed via Quick Links from the USPTO home page and from a link on the TTAB home page.

There is also a link on Quick Links and on the Board's web page for the ESTTA electronic filing system. ESTTA can be used to file any document in a TTAB proceeding, with specific forms for extensions of time to oppose a published application, notices of opposition, petitions to cancel, *ex*

*parte* appeals or motions or briefs for any pending *inter partes* or *ex parte* proceeding (opposition, cancellation, concurrent use and appeal). Electronically filed extensions of time to oppose are processed automatically, in most cases within one business day, as are notices of appeal and notices of opposition. All ESTTA filings are acknowledged with a return e-mail. Other filing options are forms for filing consented motions to extend time or suspend in *inter partes* cases. A filer using these forms receives an automatic grant of the motion, via e-mail communication to both parties. ESTTA filings not processed automatically still receive the benefit of immediate routing to the correct TTAB employee for processing.

**TIP:** Plan ahead, keep filing deadlines in mind, and allow plenty of time to resolve issues that may arise because unexpected problems may occur with ESTTA. While use of ESTTA is highly recommended, if the ESTTA system is down, parties should submit their filings on paper to meet their deadlines.

**TIP:** Upon successful submission and transmission, the filing will be assigned an ESTTA tracking number. If the submitting party encounters a problem, such as the filing not appearing in the TTABVUE docket history, a Board IT specialist will be able to remedy the problem quickly if provided with the ESTTA tracking number.

**TIP:** If a submission is “bulky” (*i.e.*, greater than 300 pages), it is best to file such submission via ESTTA in multiple, logical parts. For example, a filing that is 400 pages may be submitted in two parts, 300 pages then 100 pages. Of course, if it does not make sense to break the submission up in such a manner, it should be submitted in a manner more reflective of its contents, *e.g.*, 190 pages then 210 pages, because the first 190 pages comprise logically related materials.

**TIP:** Submit deposition transcripts in full page size format.

**TIP:** Any questions regarding the technical aspects of ESTTA should be directed to a Board IT specialist, by email sent to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov). (Note: this email address is used for technical inquiries only, not for filing papers through ESTTA).

**TIP:** For immediate help, call (571) 272-8500 during business hours.

Parties filing papers for proceedings that are already pending can use ESTTA, but be aware of the announcement posted on the Board’s web page regarding use of ESTTA for particular types of filings. The ESTTA form identifies the filer and the nature of the paper, functions as the first page of the document in the record, and provides for attachment of an image-based document (*e.g.*, a brief).

**MADRID NOTE:** *For any application seeking, through the Madrid Protocol, to extend a foreign registrant’s international registration into the United States, extensions of time to oppose or a notice of opposition, must be filed via the ESTTA system. Note, too, that the plaintiff will not be able to amend the notice of opposition after it is filed. TBMP §§ 315, 507.01.*

Further, the scope of the grounds for the opposition against an application filed pursuant to the Madrid Protocol is limited to those grounds identified in the ESTTA cover form notwithstanding what grounds are asserted in the attached notice of opposition. TBMP § 315; *see CSC Holdings, LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011); *Hunt Control Sys., Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011).

**NOTE:** A link on the TTAB homepage, “New ESTTA Tips” opens an announcement with current news about ESTTA functionality and with recommendations regarding how best to use ESTTA when filing particular types of motions. There is also a link for “System Status.”

#### How to Contact the Board

Use of ESTTA is the most effective way to submit filings in a proceeding. Otherwise, all mail for trademark matters **under the jurisdiction of the TTAB** should be directed to the address set out below.

U.S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Papers being delivered by hand or by courier should be taken to the Trademark Assistance Center on the Concourse level of the Madison Building, 600 Dulany Street, Alexandria, Virginia.

A TTAB filer may wish to include an attention line or other indication in its transmittal letter to indicate that the paper is for the TTAB. Do not send papers for applications or registrations involved in Board proceedings to Examining Attorneys, Post Registration, or other sections of the Trademark Office.

**TIP:** Even advanced practitioners routinely submit filings for opposed applications via TEAS or to the attention of the Examining Attorney who approved the mark for publication. Do not do this! It can cause serious delays. In contrast to filings for applications involved in oppositions, some filings for registrations involved in cancellation cases must be directed to the Board, while others should be directed to another part of the Office. For example, while a proposed amendment of a registration involved in a cancellation proceeding must to be brought to the attention of the Board, an affidavit of continuing use or a renewal application should be filed with the Post Registration division of the Office. It is always helpful, however, to alert the Board to any filing being made in another part of the USPTO, for any registration involved in a cancellation proceeding.

**Unauthorized filings made by fax or email** may not be acknowledged and will not be considered.

Consistently for the past few years, well over 95% of the submissions to the Board are filed electronically using ESTTA. In the rare event a party finds it must make a filing by paper, do not include any duplicate copies of the filing. Duplicates are simply unnecessary. *See ITC Entm’t Grp. v. Nintendo of Am.*, 45 USPQ2d 2021 (TTAB 1998).

Do not communicate with Board attorneys via email, unless specifically instructed by the Board attorney to do so. Use the telephone for your procedural questions, status inquiries, or requests for phone conferences.



## II. PRE-TRIAL CONSIDERATIONS; CORRESPONDENCE & SERVICE

“Pre-trial” considerations in Board *inter partes* cases are in part the same as those for civil suits, *e.g.*, evaluating possible settlement options, and determining what claims or defenses to pursue if settlement is not possible, but there are some Board-specific considerations. For the prospective opposer, attention must be paid to the time for filing the opposition to an application and the requirements for obtaining extensions of the time to oppose (the opposition period) and/or negotiating to settle with an applicant during the opposition period (original or extended).

### NO Suspension

The Board will not suspend the running of the time for filing an opposition for any reason. Thus, suspension will not be granted on consent of the parties, to accommodate settlement, to allow for the Examining Attorney’s consideration of a proposed amendment (see below), or because the parties are involved in a civil action. TBMP § 209.01(a). Such reasons, however, would be a basis for filing a motion to suspend after institution of an opposition.

### Amendments During Opposition Period

The filing of a request for an extension of the opposition period does not vest the Board with jurisdiction over the file. *Compare* Trademark Rule 2.84, *with* Trademark Rule 2.133. Any amendment proposed by an applicant, whether of its own volition or to accommodate a concern of a potential opposer, should be filed via TEAS using the “Post-Approval/Publication/Post-Notice of Allowance (NOA) Amendment Forms,” accessed through TEAS either via Quick Links or at the Trademarks homepage and more directly at <http://www.uspto.gov/trademarks-application-process/filing-online>. Any phone inquiry for informal discussion of the content of the amendment should be directed to the Examining Attorney. Also, note that the amendment should not be one that would require republication of the mark. Trademark Rule 2.84(b).

**TIP:** Occasionally, an Examining Attorney may not understand that the Trademark Examining Organization’s “dormant” jurisdiction will be revived when the applicant files a post-publication amendment for an application subject to potential opposition, and the Examining Attorney may state that the amendment cannot be discussed because “the Board has the file.” You may need to explain the process if you want to get an informal reading on a contemplated amendment. Of course, the actual decision on any proposed amendment will be based on the written submission. Remember that the Board will not suspend the running of the opposition period for any reason, even while a proposed amendment is being considered. If acceptance of the proposed amendment is critical to the applicant’s avoiding an opposition, the applicant will have to be assiduous in alerting the Board to the filing of the proposed amendment and working with the Examining Attorney to obtain a review of the proposal.

### Pre-Trial Phase of Oppositions/Extension Practice

The attorney who an applicant appoints to prosecute the application will be considered the representative for applicant until the application is either abandoned or results in issuance of a registration. Thus, if the application is allowed, the mark is published for opposition, and is then subject to extensions of time to oppose, the Board will communicate with applicant’s counsel regarding the approval of extensions. Likewise, if an opposition is filed, the Board will notify the attorney. Such notification is separate and distinct from Rule 2.101(b), 37 C.F.R. § 2.101(b), which requires the opposer to send a service copy of its notice of opposition to the applicant or its counsel or domestic representative.



An attorney who wishes to withdraw from representation of an applicant during the opposition period (original or extended) must direct the request for leave to withdraw to the Board, not the law office in which the application was examined. If a potential opposer retains new counsel, then the new attorney can file the next extension request or the opposition. There is no need for the prior attorney to file a request to withdraw; however, the new attorney should include a request to change the correspondence address to his or her address (see *infra*).

During the period for filing a notice of opposition, there generally are no service requirements for the attorneys for the applicant and the potential opposer. For example, an applicant who files an amendment need not send a service copy to a potential opposer. Similarly, a potential opposer need not forward a service copy of an extension request to the applicant. There are, however, many practical reasons for doing so, especially if the parties are actively negotiating a settlement. Under Trademark Rule 2.101(b), 37 C.F.R. § 2.101(b), the notice of opposition must be served on the applicant by the opposer and proof of service must be included for the Board at the time of filing of the notice of opposition.

#### Correspondence Addresses on Board Files

The attorney who prosecuted an application will be listed as defendant's counsel in an opposition. The attorney filing the opposition will be listed as plaintiff's counsel. Thereafter, the Board will accept filings signed by any attorney, since the attorney's signature on the filing constitutes a representation to the Board that the filing is authorized. Trademark Rule 2.17. However, the Board will not change a correspondence address merely because a new attorney files a paper; there must be a specific request to change the correspondence address. Trademark Rule 2.18. Also, because attorneys for applicants often have been appointed by a power of attorney in the filed application, a revocation or new power may be required when an applicant chooses new counsel.

The correspondence address in a cancellation proceeding is that of the registrant until an appearance has been made by an attorney or an appointment of an attorney has been made.

#### Withdrawals of Attorney/Changes in Representation

Client and counsel share a duty to remain in contact with each other and the Board, and to communicate changes in representation. When a client loses interest in a case and/or counsel has difficulty communicating with the client, the Board should be promptly notified. Likewise, when an attorney leaves a firm or wishes, for whatever reason, to withdraw from representation of a party, the Board must be notified. Often, the Board does not find out about such a situation until long after an important deadline has passed. *CTRL Sys. Inc. v. Ultraphonics of N. Am., Inc.*, 52 USPQ2d 1300 (TTAB 1999).

**Counsel** of record, whether of record because appointed by a power of attorney in an application, or through the filing of a pleading (i.e., notice of opposition, petition for cancellation, answer to petition), **remains of record** and is responsible for safeguarding the client's interests **unless counsel seeks, and is granted, leave to withdraw**. Patent and Trademark Rules 2.19, 11.116, 37 C.F.R. §§ 2.19, 11.116. For an attorney whose client is involved in a Board proceeding, it is the Board that grants or denies requests to withdraw. TBMP § 513. **All too often, attorneys cease representing their clients and fail to file requests to withdraw.**

### Assignments/Mergers/Acquisitions

When an application or registration is assigned, or a party merges with or is acquired by another party, it is not unusual for correspondence problems to arise and/or for prosecution or defense of a case to suffer. Except in unusual circumstances, the Board will not conduct double correspondence, *i.e.*, it will only conduct correspondence with one attorney, firm or party on each side of a case.

**TIP:** Parties may provide a reasonable number of email addresses with respect to correspondence from the Board. Thus, it is suggested that they do so in instances where more than one attorney or firm is representing a party or parties on each side of the case. This situation may arise, for example, in consolidated proceedings where there are several unrelated plaintiffs against a single defendant or when an assignment occurs and the assignee is joined.

When an application or registration is assigned during pendency of a proceeding, the Board generally will join the assignee. The assignor remains a party. This facilitates taking of discovery and the presentation of evidence at trial from all relevant parties. If the assignor and assignee are to be represented by different attorneys, it is the responsibility of the parties to so inform the Board. Moreover, while the Board, when it becomes aware of an assignment or other transfer of interest, may order joinder sua sponte, it is the assignee/transferee that bears responsibility for filing a motion to join or substitute. In conjunction with filing such a motion, the party should provide explicit information about future correspondence.

### Communication With Adverse Party

Clearly, there are times when adversaries do not communicate well. Communication problems, however, are not unique to adversaries who are actively contesting a case. Even as between parties that are negotiating to settle or negotiating terms for providing discovery material, it is not unusual for parties to have misunderstandings regarding requests to extend or suspend. Sometimes, the misunderstanding is whether settlement talks are extant. *See Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925 (TTAB 1999). Moreover, the Board often receives complaints that an extension or suspension was requested as a ruse, and the additional time was used by the adversary to prepare a motion for summary judgment or a complaint for a civil action. The Board is usually unable to aid a party that has not been careful in its dealings with an adversary. When involved in negotiations, parties are well advised to timely seek extensions of Board dates, reduce agreements to writing and file them in the form of a stipulation, or at least maintain a paper trail. TBMP § 501.02.

**NOTE Regarding Foreign Parties:** *Under Trademark Rule 2.119, a foreign party to a Board proceeding is not required to appoint a domestic representative. When an adversary is not resident in the United States, is not represented by a U.S. attorney, AND has not appointed a domestic representative, service must be made on the adversary abroad. (On the other hand, most foreign parties involved in proceedings before the Board have both a domestic representative and U.S. counsel representing them. Often the domestic representative and counsel is the same individual.) An appointment of domestic representative is considered effective until revoked or a substitute domestic representative is appointed. Accordingly, if a domestic representative is appointed to receive correspondence on behalf of an applicant during prosecution of the application, the appointment is considered to continue even after a registration issues.*

### III. INTER PARTES PLEADING, DISCOVERY, DISCOVERY MOTIONS

#### In General

The Board accommodates parties' negotiations to settle cases by liberally granting suspensions. Due dates, *e.g.*, for an answer or for responses to discovery requests, scheduling orders, and the like, should not be forgotten while the parties are negotiating. **It is a mistake for a party to presume that the mere existence of settlement talks will discharge any obligation to respond to discovery, take discovery, or present evidence; it is a mistake made too often.** Unfortunately, the mistake often is not recognized until the party that deferred activity files a motion to extend or reopen that is contested by the adversary.

The better practice, **when settlement negotiations are ongoing**, is for the parties to stipulate to a suspension for a time certain. Suspension for settlement talks is always subject to the right of either party to request resumption at any time if talks break down, so there is no downside risk of delay by stipulating to suspension. **A stipulated suspension is preferred over a series of stipulated extensions.** The Board may suspend, *sua sponte*, if multiple extensions are stated to be for the purpose of accommodating settlement talks.

**NOTE:** *After the pleadings close, the parties are required to confer to discuss settlement, possible narrowing of claims or defenses, and to plan for disclosures and discovery ("discovery conference"). The Board has stated that it will continue with its policy of liberally granting suspensions to accommodate settlement talks, so long as the requests are filed before the pleadings close **or** after the discovery conference.*

**TIP:** While the Board is liberal in granting periods of suspension to accommodate settlement discussions, the Board also has an interest in bringing its pending cases to conclusion. Prolonging the pendency of the case for years to accommodate occasional discussions of settlement is disfavored. Parties seeking numerous suspensions for settlement talks will be required to provide evidence of their progress towards settlement in order to show good cause for continued suspension for settlement talks in long pending cases.

#### Jurisdiction Over Applications/Registrations; Proper Captioning

Remember, once a notice of opposition or petition to cancel is filed, the Board has jurisdiction over a defendant's involved application or registration. Any amendment, change of address, change of counsel, etc., must be filed to the attention of the Board with reference made to the application serial number or registration number *and* the opposition number or cancellation number. Filing to the attention of the Examining Attorney, for an application, or to Post Registration, for an existing registration, with or without reference to the pending Board case, will delay processing and action. Filings with **typographical errors** in case numbers, application numbers or registration numbers are **too frequent, undermining novice and experienced practitioners alike.**

#### Notice of Opposition and Petition for Cancellation—Contents

Remember the narrow scope of the Board's jurisdiction, namely, determining the right to federal registration of a mark. Draft your pleadings with this in mind. Thus, do not make allegations that are better suited for civil cases involving trademark infringement or unfair competition.

To avoid any ambiguity, when pleading a statutory ground for relief set forth the ground in the language of the statute itself. A well-drafted complaint sets the proper course for the proceeding and may head off an initial flurry of pleading motions. Further, a good complaint shows your opponent and the Board that you have given thought to the case and that you know what you will need to prove to prevail in the proceeding.

**TIP:** Clear and precise pleadings avoid needless and costly motion practice. Do not use a claim of false suggestion of a connection under Section 2(a) as a substitute for a claim of likelihood of confusion under Section 2(d). This problem usually arises in petitions to cancel registrations that are over five years old. The claims under Sections 2(a) and 2(d) are different, requiring different proofs. The Board will deny attempts to get around the five-year limitation of Section 14(1) of the Trademark Act when a plaintiff essentially makes a claim of likelihood of confusion under the guise of a claim of a false suggestion of a connection. Also, recall that a dilution claim requires a pleading that the claimed mark became famous prior to the defendant's first use date or application filing date.

**TIP:** Where multiple claims are asserted, it is particularly helpful to the Board when the plaintiff provides separate headings for each claim. Doing so provides clarity for the plaintiff and its claims; assists the defendant in recognizing the claims and in forming its answer; and reduces motion practice in regard to the sufficiency of the claims.

**TIP:** When seeking to amend the pleadings, point specifically to the proposed changes. For example, if a new claim is being added, specifically state as much, including an instruction directing the Board and any adverse party to the paragraphs in which the new claim is found, and provide information about whether the remaining paragraphs are unchanged or, if changed, specify what and where they are. It is particularly helpful when a party seeking to amend its pleading provides the amended pleading and a copy with tracked changes illustrating where changes were made, throughout the proposed pleading.

Exhibits to a party's pleading are not of record unless they are identified and introduced during the proper testimony period. The only exception is that a federal trademark registration owned by the plaintiff and pleaded in the notice of opposition or petition for cancellation is in evidence if the pleading is accompanied by a copy or original of the registration, prepared and issued by the USPTO and showing current status and title, or by a printout of information from the electronic database records of the USPTO showing the current status of and title to the registration.

**NOTE:** *Take care that whatever reprints from USPTO electronic database records are used by a filer must be sufficient to prove both the status of and title in a particular registration.*

**TIP:** It is highly recommended that plaintiffs elect this option, which provides an easy and quick method for making the pleaded registration of record for all purposes in the proceeding. At a minimum, doing so helps focus discovery activities on matters truly in need of inquiry, and helps avoid the unfortunate situation where, after trial and at final decision, it is first recognized that plaintiff had not properly made the pleaded registration of record.

Oppositions filed against applications based on a request for extension of protection under 66(a) of the Trademark Act may not be amended to add a claim. *See O.C. Secrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327 (TTAB 2010). Claims are limited to those identified in the ESTTA cover form notwithstanding what claims are asserted in the attached notice of opposition. *See CSC Holdings, LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011); *see also* TBMP §§ 315, 507.01.

### Notice of Opposition and Petition for Cancellation—Service

A plaintiff filing a notice of opposition or petition for cancellation is required to send a service copy of its pleading, including any exhibits, to the attorney, domestic representative or party (applicant or registrant) itself. *See* Trademark Rules 2.101(b), 2.111(b); TBMP § 309.02(c); and the full explanation of the import of these amendments in the 2007 notice of final rulemaking. In general, **for a notice of opposition**, the plaintiff must forward its service copy to the correspondence address for the applicant shown in USPTO records, whether that is an attorney, domestic representative or the applicant. In contrast, **for a petition for cancellation**, the plaintiff must serve the owner of the registration at its address shown in USPTO records, or the owner's domestic representative, if one is of record. Note that there is a distinction to be drawn between an attorney that represented a registrant before the USPTO during the application process and an appointed domestic representative. The TTAB considers the attorney's role as counsel to end when the registration issues but considers the appointment of a domestic representative to continue until revoked. **For both types of cases, it is especially important to note that the plaintiff's pleading must include proof of service (see Trademark Rule 2.119 for acceptable methods of service) or the pleading will be considered defective and the case not properly commenced. In addition, actual service must be made by the opposer or petitioner. ESTTA does not serve the complaint on the defendant. In the absence of proof of service or actual service in accordance with the proof of service, the proceeding may be dismissed as a nullity.** *See Schott AG v. L'Wren Scott*, 88 USPQ2d 1862 (TTAB 2008), *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008). For an opposition to be considered timely, service must be made during the opposition period. However, for a cancellation proceeding, a slight delay in serving the petition is not necessarily fatal. *See Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB 2012) (although respondent's motion to dismiss for insufficient service must be granted, respondent is clearly on notice of the instant proceeding and the proceeding is resumed with an amended date of institution); *Equine Touch Found., Inc. v. Equinology, Inc.*, 91 USPQ2d 1943 (TTAB 2009) (copy of petition served by mail 7 days after filing through ESTTA—defective service curable because petitioner acted promptly and petition to cancel not time barred at time service made).

**TIP:** If the plaintiff receives a returned service copy, it is most expedient to so notify the Board via ESTTA.

**TIP:** A plaintiff may serve the complaint on more than one address if there is any concern over which is the correct address.

### Answer—Contents

Do not include a boilerplate affirmative defense that the complaint fails to state a claim. Such a pleading often results in a motion to strike decided in plaintiff's favor, since a plaintiff usually is able to plead a claim for relief. Rather than attacking the sufficiency of the pleading by way of a pro forma affirmative defense, if you really believe that the pleading is lacking, then you should file a formal motion.

Do not include pro forma defenses of laches and acquiescence when answering a complaint. Before asserting such defenses, consider the limitations placed on them by the U.S. Court of Appeals for the Federal Circuit, the Board's reviewing court, and the Board. Generally, a laches defense is unavailable in an opposition proceeding, while in a cancellation proceeding the time for laches to run begins with the issuance of the registration. Under certain circumstances, however, a laches or estoppel defense in an opposition may be based upon the opposer's failure to



object to the applicant's prior registration of substantially the same mark as that in the opposed application.

Decide before answering, if you can, whether to seek restriction of a plaintiff's registration under Section 18 of the Trademark Act, and then assert this as a counterclaim in the answer. If the grounds for a Section 18 counterclaim are learned during discovery, promptly move to amend the answer before trial, so as to give the plaintiff adequate notice of the proposed restriction.

If you are aware of grounds for a counterclaim when you file your answer, plead the (compulsory) counterclaim at that time. Failure to do so may preclude you from asserting the counterclaim later. If the grounds are learned after answer, a motion to amend to plead the counterclaim should be made promptly after the grounds are learned.

#### Answer—Service

The defendant (applicant or registrant) in a TTAB proceeding has always borne an obligation to forward a service copy of its answer to the plaintiff.

#### Motions, in General

Trademark Rule 2.127 is the Board's motions rule. The response period for any motion is 15 days from the date of service; add 5 days if service was made by first class mail, Express Mail, or overnight courier. **Do NOT add 5 days if service was made by electronic means such as e-mail or fax**, when parties have agreed to use electronic transmission for service. See Trademark Rule 2.119(b)(6), (c).

**TIP:** As a practical matter, many parties elect to retain traditional service methods but also agree to send email courtesy copies or courtesy notifications that the receiving party is being served separately by a traditional method.

**Failure to file a brief in opposition to any motion may lead to its being granted as conceded; do not assume that a motion will be denied as ill-taken or untimely.** Indeed, such conceded motions may be reviewed in only a cursory manner or may not be read at all, on the theory that the non-moving party does not contest any of the content of the motion. Reply briefs on motions are not required, are discouraged, and seldom make much difference. Nonetheless, they may be filed, and are encouraged if a non-moving party raises a new issue (of fact or law) in its response to a motion or if the reply will assist the Board in resolving a complicated issue; however, "last word" replies by a movant, masquerading as assistance for the Board on a purportedly complicated issue, do not fool the Board or the non-movant. Any reply brief, if filed, must be filed within the same 15 days, plus 5 for service, if applicable, that govern responding to a motion. **Surreplies and any other filings, no matter how titled, will not be considered.** TBMP § 502.02(b).

The Board does not require or want either a notice of motion or a proposed order. A motion and the brief in support thereof should be combined into one submission. Most routine motions require that the parties focus on facts that bear on the moving party's request. The Board is aware of applicable law. **Unless the motion raises a novel or unsettled question of law, the parties should concentrate on the facts, not the law.**

**The page limits for briefs on motions cannot be waived or exceeded, even by agreement of the parties.**

**NOTE:** Trademark Rule 2.127, 37 C.F.R. § 2.127, has been clarified to comply with existing decisional law and provides that a table of contents, an index of cases, and other items, if included in a combined motion and brief, all count against the page limit. The rule does not, however, require use of a table of contents, index of cases, description of the record, etc. It is the filing party's choice as to what shall be included; but what the party chooses to include will be counted against the limit. Also, Trademark Rule 2.126, 37 C.F.R. § 2.126, has been amended to delete the option to submit filings to the Board on CD-ROM.

**TIP:** However, in a situation involving a summary judgment motion, or response thereto, with many exhibits, a table of exhibits is helpful to the Board.

#### Motions or Stipulations Relating to Late/No Answer

**Late Answers**—If you receive a notice of institution and misdocket the due date for the answer or otherwise miss the due date, contact plaintiff first to see if it will stipulate to late filing of the answer. If so, then file the answer with a stipulation. Plaintiff should agree to late filing if its counsel understands Board practice enough to realize that there is little chance the Board would refuse to accept a late answer and enter default judgment. If plaintiff does not stipulate, then file the answer with a motion to accept it, motion to cure default, or the like. Just because the Board is liberal in curing defaults, do not merely file the answer late without explanation. Sometimes, even experienced practitioners make the mistake of doing this.

If you get a notice of default, do not call the Board attorney assigned to the case to explain why your client did not answer (*e.g.*, talking settlement with opposer). The default cannot be cured by phone. Write in with your explanation. If the parties agree, they can simply stipulate to resetting of the due date for answer, which will cure the default, and there will be no need to explain the reason for the delay. If you respond to the notice of default on the merits, focus on the facts contributing to default, not an explanation of applicable law; the Board is familiar with applicable law.

When the defendant fails to answer, the plaintiff can move for entry of default judgment, so long as it has waited long enough to receive any service copy that should have been sent. That motion will serve in lieu of a notice of default from the Board and will act to place defendant on notice of possible default judgment sooner than the Board may do so. There must be proof that a service copy of the motion was sent to defendant for this strategy to work.

**TIP:** To save the client the expense of drafting and filing the motion, plaintiff's attorney can call and remind the Board paralegal to issue the notice of default, so long as 15 days have passed since answer was due. The Board's paralegals draft notices of default and default judgment orders. The name of the assigned paralegal can be found on TTABVUE.

#### Motion to Dismiss in Lieu of Answer

If confronted with a motion to dismiss under Fed. R. Civ. P. 12(b)(6) challenging the sufficiency of the complaint, do not respond to the motion by arguing the merits of the case. The question raised by such a motion is solely whether the claim is sufficiently pleaded, and not whether the claim is meritorious. *See, e.g., Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403 (TTAB 2010) (Board found petitioner's allegations relating to priority to be sufficient for petitioner's claim under Section 2(d), leaving to trial the question whether the particular activities constituted use of a type sufficient to support the claim). A defendant should be sure that a motion to dismiss



has a reasonable basis. *See Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184 (TTAB 2009) (Board sanctioned applicant for filing untenable motion to dismiss).

**TIP:** Remember that a plaintiff may respond to a motion to dismiss by filing an amended pleading. Fed. R. Civ. P. 15(a)(1)(B). The amendment will be accepted “as a matter of course” and will effectively moot the motion under Rule 12(b)(6).

**TIP:** Even in situations where a motion to dismiss is considered on its merits and is well-taken, the Board often allows the plaintiff leave to amend the defective pleading.

**NOTE:** *Fed. R. Civ. P. 12(b) provides for the possibility that a motion to dismiss may be treated as a motion for summary judgment if “matters outside the pleadings are presented to and not excluded by the court.” However, under the Trademark Rules, a party may not file a motion for summary judgment until after initial disclosures have been made, unless filed on grounds of claim or issue preclusion or lack of jurisdiction. Trademark Rule 2.127(e)(1). Therefore, the Board will exclude from its consideration matters outside the pleadings that are presented with or by a motion to dismiss and will not treat the motion as a motion for summary judgment, unless the matter presented with or by the motion to dismiss relates to claim or issue preclusion or lack of jurisdiction by the Board to hear a claim. See TBMP § 503.04.*

#### Motion to Strike Matter From Pleading

Remember the narrow scope of the Board’s jurisdiction, namely, determining the right to federal registration of a mark. Draft your pleadings with this in mind. Thus, do not make allegations that are better suited for civil cases involving trademark infringement or unfair competition. The Board has never been a forum for infringement claims and does not recognize Section 43(a) of the Trademark Act as a cause of action within its jurisdiction. These are easy targets for a defendant’s motion to strike matter from a pleading.

Do not include a boilerplate affirmative defense that the complaint fails to state a claim. Such a pleading often results in a motion to strike decided in plaintiff’s favor, since a plaintiff usually is able to plead a claim for relief. Rather than attacking the sufficiency of the pleading by way of a pro forma affirmative defense, if you really believe that the pleading is lacking, make a formal motion to dismiss. Pro forma defenses of laches and acquiescence are easy targets for a motion to strike. Before asserting such defenses, a defendant should consider the limitations placed on them by decisions of the Court of Appeals for the Federal Circuit and the Board.

#### Settlement and Discovery Planning Conference

Parties to Board *inter partes* cases are required to conference in accordance with the relevant requirements of Fed. R. Civ. P. 26(f). The 2007 notice of final rulemaking (accessible on the TTAB home page of the USPTO website) provides a detailed discussion of what subjects parties are expected to discuss during such conferences, and notes that the parties’ discussions must also include matters they are directed by the Board’s institution order to discuss. *See TBMP § 401.01.* The parties must conference within 30 days of the close of pleadings. Thus, if the defendant defaults or the plaintiff withdraws prior to answer, the conferencing requirement becomes moot. Similarly, a motion to dismiss would result in deferral of the conferencing requirement. Until the pleadings close, there can be no meaningful conference. Mere settlement discussions are not a substitute for the discovery conference. Settlement discussions before and/or during the conference are encouraged, but Trademark Rule 2.120(a)(1) requires that other topics also be

addressed in the conference. *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009). See also TBMP § 401.01.

While the parties are required to conference, the Board does not participate unless invited to by any party. See TBMP § 401.01 for further information about requesting Board involvement in the discovery conference.

**NOTE:** *The ESTTA system includes a form for requesting participation of a Board attorney in the settlement and discovery planning conference.*

**TIP:** Use of the ESTTA form for requesting the participation of a Board attorney in the settlement and discovery conference is the most effective way to do so. If the requesting party has not been contacted by a Board attorney to arrange the conference within a few days, then a follow-up call is in order. If something is filed after the request (*e.g.*, a change of correspondence address, a consented motion to extend dates pending conclusion of the conference, an amended pleading), the later-filed submission may overtake the request for Board participation and delay its acknowledgment by the Board.

The Board is unlikely to find good cause to suspend any case between close of the pleadings and the deadline for the conference, even on consent of the parties to discuss settlement, because settlement is a subject to be discussed in the conference. Nor will the Board extend the deadline date for the conference solely to accommodate settlement discussions. However, the deadline will be reset as necessary for situations such as a defendant's default, a motion to dismiss, or filing of a counterclaim. Further, when suspension or extension is warranted for a reason other than to accommodate settlement discussions, a motion to suspend or extend will be considered.

When a party refuses to participate in a settlement and discovery planning conference, any adverse party may make a motion for sanctions. There is no requirement that a motion to compel attendance precede the motion for sanctions. Such a motion for sanctions, however, must be filed prior to the deadline for any party to make its initial disclosures. It must be remembered that all parties share the obligation to arrange the conference. TBMP § 408.01.

#### Motions to Extend/Re-open—Without Consent

Motions to extend or reopen can, of course, arise whenever there is a deadline looming or recently expired. Keep in mind that motions to extend or re-open the time to answer and motions to extend time to file final briefs on the case are treated more liberally than motions to extend or re-open during discovery or trial periods. **Do not make the mistake of assuming that the Board's liberality with respect to pleading deadlines will also apply to discovery and trial deadlines.**

The Board has no rule of its own on extensions. Thus, Federal Rule 6 applies. Fed. R. Civ. P. 6. **Good cause must be shown to obtain an extension of an unexpired period under 6(b)(1)(A); excusable neglect must be shown to obtain an extension of an expired period (also referred to as a "re-opening" of the period) under 6(b)(1)(B). Many practitioners fail to distinguish the two.**

The Supreme Court's *Pioneer* decision (*Pioneer Inv. Servs v. Brunswick Assocs. Ltd. P'ship*, 507 U.S. 380 (1993)), and the Board's *Pumpkin* decision (*Pumpkin, Ltd. v. Seed Corps*, 43 USPQ2d 1582 (TTAB 1997)) are excusable neglect cases to note.

A frequent deficiency of movants who seek an extension or re-opening is their failure to make a detailed presentation of facts supporting their position. The party moving for an extension or re-opening has the burden of persuading the Board that it was diligent in meeting its responsibilities and should be permitted additional time. Also, when a non-movant has rebutted specific facts alleged by the movant, the movant should focus any reply brief it may file on overcoming the specifics of the response, not in making a general rebuttal. All too often, a non-movant scores points by making specific rebuttals and the movant fails to revisit the issue when it files a reply brief. Thus, on a motion to extend or re-open, both the movant and non-movant must take care to focus on the specifics of the factual issues; even **eloquent appeals for the Board to exercise its equitable powers often fail in the face of specific demonstrations of fact.**

Motions to extend or re-open frequently are rooted in a party's assertion that it deferred relevant activities because it thought the parties were going to settle. Settlement negotiations will generally constitute good cause for a motion to extend, although if it is believed that the motion will be contested, it is advisable to detail the circumstances that bear this out. The mere fact that settlement negotiations were ongoing will not usually constitute excusable neglect for a motion to reopen; accordingly, the better practice in such a situation is to file a motion to extend or for suspension prior to the expiration of the pertinent time period.

It is not unusual for parties to consent to a series of motions to extend but then have one party later throw up its hands and say, "enough is enough." Often, when a series of consented motions to extend is followed by a contested motion, the movant will not have included a very specific showing in the motion that has become the first to be contested. The Board may grant the contested motion but note that, in view of its having been contested, no further motions to extend will be approved except upon agreement of the parties or a showing of extraordinary circumstances.

Nowadays, if the Board denies a motion to extend, it is more likely than in the past that it will leave schedules as set, unless to do so would, in the Board's view, work some injustice. Generally, however, if the Board denies a motion to extend discovery, trial dates usually will be reset. Similarly, if the Board denies a motion to extend a particular trial period, later periods likely will be reset. *See* TBMP § 536; *see, e.g., Vital Pharms. Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011).

**A motion to extend that does not include the consent of the non-movant should not set forth a new deadline or dates.** Instead, the movant should request an extension of a specified length, measured prospectively from the date of the Board's ruling on the motion. Otherwise, the Board may eventually approve a motion to extend as uncontested, but the movant will find that the requested extension period has expired.

**A plaintiff seeking to extend its trial period must be particularly careful.** It is not unknown for the Board to deny a plaintiff's motion to extend and then go straight to entry of judgment dismissing the case, if the record is devoid of evidence to support plaintiff's claims.

#### Discovery in General, Including Initial Disclosures

A party may not serve interrogatories, requests for production, requests for admissions, or take discovery depositions until it has made its initial disclosures. Trademark Rule 2.120(a); Fed. R. Civ. P. 26(a); *see* TBMP § 401.02; *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010). Such disclosures must be made no later than 30 days after the opening of the discovery period.

Parties may agree to waive initial disclosures, subject to Board approval, and proceed solely with traditional discovery. *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767 (TTAB 2008). If an adverse party does not provide initial disclosures, a party should first file a motion to compel. Trademark Rule 2.120(e)(1). A party may not move for entry of sanctions for failure of an adverse party to provide initial disclosures unless it first obtains an order from the Board compelling the disclosures and the adverse party then fails to comply with the order. *See Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541 (TTAB 2008); TBMP §§ 523, 527.02(b); *see also Influence, Inc. v. Elaina Zuker*, 88 USPQ2d 1859 (TTAB 2008) (motion to compel better initial disclosures granted).

**TIP:** To maximize your discovery time, be prepared to make your initial disclosures during the settlement and discovery planning conference. If the case is not settled, you will be able to start taking discovery as soon as discovery opens.

When serving discovery requests, keep in mind the extent of the Board's jurisdiction in *inter partes* proceedings, and tailor your discovery accordingly. Therefore, do not, for example, ask questions that are better suited to trademark infringement or unfair competition actions in federal court.

Although interrogatories and other written discovery requests may be served through the last day of discovery (as opposed to a discovery deposition which must be both noticed *and* taken by the close of discovery), the better practice is to take discovery early in the discovery period. The disadvantages of waiting until the waning days of the discovery period include: you may be precluded from using the fruits of discovery during discovery depositions; there is no opportunity for follow-up discovery; and there may be no way to get late obtained documents into the record. Remember, too, that **motions to extend discovery to allow for follow-up** or because of asserted inadequate responses **will not be viewed favorably if the information was not sought until late in the discovery period**.

In fashioning interrogatories and other written discovery requests, keep in mind the goose-gander rule: generally, a party may not be heard to argue that a discovery request by its adversary is improper when the party itself previously served substantially the same request.

A party which responds to a request for discovery by indicating that it does not have the information sought *or* by interposing objections to providing it, later may be barred by its own action from introducing the information as part of its evidence on the case (provided that the party which had been thwarted in its attempt to obtain the information raises the issue by objecting to introduction of the evidence in question).

### Interrogatories

Interrogatories, counting subparts, may not exceed 75, except that the Board may allow more upon a showing of good cause or on stipulation. (Good cause to exceed the limit is difficult to establish and even stipulations to exceed the limit will be carefully scrutinized.) Remember to reserve some portion of your 75 interrogatories for follow-up unless you are sure that you will not be serving such follow-up. The Board does not include instructions or definitions in counting interrogatories; nor will these be viewed as having a “multiplying effect” on the interrogatories. For example, if more than one mark is involved, or if only one mark is involved but instructions inform the responding party that answers to interrogatories should cover all of the party's marks that contain any element of the one mark that is involved, then an interrogatory seeking information for each such mark will be treated as one interrogatory.

### Requests for Production of Documents

The place for production of documents is the place where the documents are usually kept, or where the parties agree, or where and in the manner which the Board, upon motion, orders. As a practical matter, however, parties in Board proceedings often extend the courtesy to each other of copying and sending responsive documents (in either hard copy or electronic format), a practice which the Board encourages. In appropriate cases, the Board may, upon motion, order that the party from which production is sought make copies of requested documents and send them to the requesting party at the requesting party's expense.

### Requests for Admissions

Requests for admissions are useful for establishing the authenticity of documents and for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters to be tried.

**TIP:** Serve document requests early enough in discovery so that you will be able to use requests for admissions to authenticate the produced documents. Then, at trial, you will be able to introduce the requests for admissions, responses thereto, and the documents which were authenticated through the admissions via the notice of reliance procedure.

### Depositions

The discovery deposition of a person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree. The attendance of a nonparty must be secured by subpoena unless the witness is willing to appear voluntarily, and all further proceedings relating to the discovery of the nonparty, including motions to quash the subpoena or for sanctions for defiance of the subpoena, are within the control of the district court that issued the subpoena.

Upon stipulation of the parties, or upon motion granted by the Board, a deposition may be taken by telephone. The location of the telephonic deposition is the same as a regular deposition, where the witness resides or is regularly employed or where the parties agree. While the Board has no objection if the parties wish to electronically record a deposition, all testimony submitted to the Board must be in written form. A party wishing to introduce, at trial, the discovery deposition of its adversary cannot do so by submitting an audiotape or videotape or other electronic media but must, instead, submit a written transcript. In contrast, an electronic recording of, for example, a commercial demonstration may be made of record as an exhibit to a deposition transcript.

If a party witness not only objects to, but also refuses to answer, a particular question, the propounding party may wait until the completion of the deposition and then file a motion with the Board to compel the witness to answer the unanswered question.

### Discovery and Testimony Depositions Contrasted

There are distinctions between discovery depositions and testimony depositions. While the mechanics of taking the two types of depositions are very similar, there are substantial differences between the two attributable to the different purposes of the discovery and trial stages of a proceeding. Discovery is the phase for acquiring information about the other side's case or information from third parties; the testimony periods comprise the phase of the proceeding when



all testimony is taken and all other evidence is introduced, in order to establish the formal record upon which the case is to be decided.

The discovery deposition is taken of the adversary or a nonparty, or an official or employee of the adversary or a nonparty. A testimony deposition, on the other hand, is a device used by a party to present evidence in support of its own case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party. While a deposition of an adversary may be taken during a party's testimony period, these are rare and involve some risk for the party taking the deposition because, as discussed below, the entire testimony deposition becomes part of the record.

A discovery deposition may only be taken during the discovery period, which generally is ongoing for all parties at the same time. A party may only take a testimony deposition during the party's assigned testimony period; and whether a party has one or more testimony periods depends on the party's position as plaintiff or defendant and whether there is a counterclaim in the case. A discovery deposition does not form part of the evidentiary record in a case unless a party entitled to offer it into evidence files, during that party's testimony period, the transcript of the deposition, or relevant portion thereof, together with a notice of reliance thereon. That is, the offering of a discovery deposition in evidence is elective, not mandatory. In contrast, the transcript of every testimony deposition must be filed and, when filed, becomes part of the record. A notice of reliance should not be used for the filing of a testimony deposition.

The transcript of any deposition, once made of record, is of record for all purposes. Either party can make of a deposition transcript what it will, regardless of which party filed it.

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence. In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid objection.

In both types of depositions, a question objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged, confidential business information or irrelevant personally identifiable information. If the answer involves confidential material, then the answer may be made after stating that it is covered by the terms of the extant protective agreement or order.

#### Standard Protective Order

The Board's **standard protective order** is accessible via the TTAB web page. The standard protective order **applies to every case**, though the parties can agree to augment or supplement its provisions or agree to substitute an alternative order or agreement. Parties must still invoke the provisions of the standard order to protect their information or documents and things. In addition, the application of the standard order does not preclude a party from filing a motion for a protective order when the standard order is not viewed as providing adequate protections.

#### Motions to Compel/for Protective Orders

It is no secret to litigators that judges do not like discovery disputes featuring motions to compel or motions for protective orders. It should be no surprise to TTAB practitioners that Board

attorneys do not like them either. From the perspective of Board attorneys, discovery disputes involving motions to compel or for protective orders almost always result from the parties' failure to cooperate, rather than from genuine differences of opinion about what is or is not discoverable under the applicable law.

The credibility of the parties—in many cases, this means the credibility of the parties' attorneys—is often at issue. Counsel should expect that Board attorneys called on to resolve discovery disputes will be making judgments on party or counsel credibility, through reference to patterns of conduct. A party or counsel perceived as the “bad guy” or as less cooperative may face an uphill battle.

Apart from the credibility of the parties or their attorneys, the Board will assess whether there has been a good faith effort to resolve the discovery issues in dispute. The movant must state that a good faith effort has been made to settle the dispute. The movant must further support such statement by specific recitation of facts regarding conversations between or among counsel, or by submitting copies of correspondence exchanged between counsel, demonstrating that the requisite effort to settle the dispute has been made in order to avoid any unnecessary arguments or distractions concerning the sufficiency of the effort to resolve the dispute. Of course, when no responses whatsoever have been provided, the showing need not be as great as when there is a dispute over the sufficiency of responses or propriety of objections.

If a majority, or even a significant number, of discovery requests are in dispute, then the Board may decline to resolve the dispute on the theory that the parties could not have made a sufficient, good-faith effort to resolve it themselves.

The TBMP includes specific guidelines on what is discoverable in Board cases. *See, e.g.*, TBMP § 414. It is surprising how often disputes regarding discoverability arise, despite TBMP guidelines covering the point. In addition, in Board cases counsel often use discovery requests that might be routine in district courts but should not be propounded in Board cases, usually because they seek information that is related to matters beyond the Board's jurisdiction.

Keep in mind that the Board's caseload may not afford its attorneys the luxury of routinely researching each particular discovery request in dispute. If the TBMP does not say you can have access to a particular type of document or piece of information, it is your burden as the moving party to convince the Board attorney that you should be able to have it. A movant viewed as credible, reasonable and mindful of the Board's limited jurisdiction is a much more sympathetic figure than a movant with a strained view of what's relevant and reasonable.

The movant on a motion to compel often argues why the information it is seeking is discoverable; but fails to grasp that the discovery request it propounded does not literally seek such information. Sometimes the failure is not the responding party's response; it is the inquiring party's request.

Board attorneys will prefer, when possible, to deal with related discovery requests in groups, rather than to have to slog through individual requests. If you can frame your motion to compel in this way, it likely will be better received.

Board attorneys are big fans of practitioners who extend each other reciprocal courtesies. The Board has received motions to compel where one party has already copied and forwarded documents responsive to its adversary's document requests, only to then be told by the adversary that it will comply with the letter of the law and make documents available for inspection, but



will not copy and forward them. Of course, when the courteous party files a motion to compel copying and forwarding, the Board must deny it, because this is not required. On the other hand, in appropriate cases, the Board may order that the party from which production is sought make photocopies of requested documents and mail them to the requesting party at the requesting party's expense.

Finally, note the distinction between a motion to compel initial disclosures, which must be filed prior to the close of discovery, and a motion to compel discovery, which may be filed after the close of discovery so long as it is filed prior to the opening of the first testimony period. Note, however, that a party that does not receive initial disclosures and waits until the end of the discovery period to file a motion to compel them may be found, because of the delay, to have waived its right to the initial disclosures. **Filing of a motion to compel disclosures or discovery will result in issuance of a suspension order by the Board. Once the motion is filed and served, neither party may thereafter serve any additional discovery, but neither party may refuse to provide required disclosures or responses to discovery requests served prior to the filing and service of the motion to compel.**

**TIP:** The Board encourages parties to request a phone conference whenever, despite good faith efforts to resolve a dispute, they reach an impasse in regard to their conferencing obligation, disclosure requirements or discovery. *Cf. Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759 (TTAB 2009) (“it is always preferable to involve the Board”).

**TIP:** The Board attorney may convene a telephone conference upon his or her own initiative. Be aware when filing a motion, or being served with a motion, that the matter may be heard by telephone conference.

#### Stipulations to Extend Time to Respond to Discovery

There are, of course, prescribed times for responding to discovery requests. Frequently, parties who are being cooperative during discovery will agree to extend response periods. Often, however, they do not reduce these agreements to writing. Then, when the parties have a falling out, and a motion to compel is filed, the movant will insist on receiving discovery responses without objections. The non-movant may be disadvantaged if it did not reduce to writing any agreement to extend its response period.

Note that Federal Rule 29 requires reduction to writing of stipulations to extend the time to respond to interrogatories, document requests and requests for admission. Fed. R. Civ. P. 29. The Board does not require this, though the TBMP § 403.04 recommends it. The recommendation should be taken seriously.

#### Motion for Discovery Sanctions

If a party that served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to compel or to test the sufficiency of the response, the party may not thereafter be heard to complain about the sufficiency of the response. If the requesting party does file a motion to compel, the motion should **not** include a request for sanctions for failure of the responding party to cooperate during discovery. The Board will not enter such sanctions unless a previous Board order relating to discovery has been violated. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000), *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000). (However, the Board may enter sanctions if

a party fails to attend a properly noticed discovery deposition, or the responding party has clearly indicated that it will not be responding. Trademark Rule 2.120(g).) See TBMP § 527.

#### Motion to Suspend for Civil Action

When parties are involved in a collateral civil action, suspension of the Board case is almost always ordered. The pleadings in the civil case, or at least enough of the pleadings to establish that suspension is appropriate, should be filed with the Board. All that need be shown is that the judge or jury in the civil action may be called upon to decide issues that would have a bearing on the Board case, *i.e.*, if issue preclusion may result, then it is not necessary that the civil action present the possibility of claim preclusion.

**TIP:** Note that Board paralegals are now preparing orders on many, if not most, motions to suspend because of a civil action. They will first look to see if the motion is on consent of the parties. Next, they will look to see if the prayer for relief in the civil action requests an order from the court relating to the Board proceeding, or relating to the application or registration involved in the Board proceeding. (In essence, this is a prayer that seeks invocation of court authority under Section 37 of the Lanham Act.) If the prayer includes such a request, then suspension will be ordered. Thus, for a party desiring suspension of the Board case, an appropriate prayer for relief, in the complaint filed with the court, generally will preclude any argument over whether suspension of the Board case is appropriate.

**TIP:** When a party files a motion to suspend for civil action at the same time it files its complaint or answer, the motion should be filed separately. Pleadings are not read by Board personnel until a motion necessitating such reading is filed. Thus, a motion to suspend (or any other motion) embedded in a pleading usually will not come to the Board's attention in a timely manner.

The party that prevails in the civil action should file a motion to resume Board proceedings, including a copy of the court's decision, *and*, in the same motion, should request the particular disposition of the Board case that the party believes is warranted. Do not just file a copy of the court's decision; but also state what the Board should do as a result of the court's decision.

#### Motion for Summary Judgment

The prospects of a favorable ruling on a motion for summary judgment are not strong. Nonetheless, in those cases where the material facts are clearly undisputed and are truly compelling, or where the motion is based on some theory of *res judicata*, summary judgment is a good way to avoid a useless trial. See, e.g., *Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1490 (TTAB 2015) (successful motion based on *res judicata*).

A motion for summary judgment may not be filed until the party has made its initial disclosures (except for a motion asserting claim or issue preclusion or lack of jurisdiction), and must be filed prior to the opening of the first testimony period for the plaintiff. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768 (TTAB 2010). See TBMP §§ 401.02, 528.02. If testimony periods are reset prior to the opening of the plaintiff's testimony period, a motion for summary judgment filed before a first trial period commences is timely. Once the first trial period commences, however, any motion for summary judgment filed thereafter is untimely, even if it is filed prior to the opening of a rescheduled testimony period for plaintiff, and even if no trial evidence was actually adduced by the plaintiff while its trial period was open. The Board will not hesitate to deny any such motion that is untimely, even if the non-movant does not raise the issue.

For moving parties, make sure that the ground upon which you are seeking summary judgment is a ground that was raised in the pleadings. The Board will not entertain a motion for summary judgment on an unpleaded ground, unless the parties have treated the unpleaded issue on its merits and the nonmoving party has not objected to the motion on the ground that it is based on an unpleaded issue. Also, a party which seeks summary judgment on an unpleaded issue may (and is advised to) contemporaneously move to amend its pleading to assert the ground or defense.

**TIP:** If you are a plaintiff moving for summary judgment, make sure that your evidence includes proof of your standing in the case. For a plaintiff pleading a claim under Section 2(d), and relying on ownership of a federal registration, submission of a copy of the registration, certified by the USPTO as to current status and title, generally would suffice; as would copies of USPTO electronic database records showing current status of and title to the registration. *Cf. Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009).

When moving for summary judgment, make sure that your position is supported by evidence and is not limited to mere argument. All too often, the Board sees motions for summary judgment that are woefully lacking in probative evidence.

It is important to remember that evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. For example, during its testimony period, a party may take the deposition of the affiant who provided an affidavit used for an earlier motion for summary judgment; the affiant/deponent would identify the affidavit and testify as to the accuracy of the information therein, and the affidavit would then be introduced into the record as an exhibit to the deposition.

Whether moving for or objecting to summary judgment, make sure that the brief is specific in setting out the material facts that are or are not genuinely in dispute. Although it is not required, it is helpful if the parties specifically list the material facts not in dispute. This helps the Board get to the crux of the motion and may allow the Board at least to narrow the issues for trial even if the motion does not result in disposition of the entire case. It is also helpful if the parties actually stipulate to the undisputed material facts.

Trademark Rule 2.127(e) provides a 30-day period for responding to the motion for summary judgment. This is longer than the standard 15-day period for responding to other types of motions.

#### Accelerated Case Resolution (ACR)

Accelerated Case Resolution, or ACR, is an abbreviated trial on the merits of a case. It is a procedural option available when agreed upon by both parties. In form it can vary, but may be thought of as approximating a summary bench trial.

In one typical form, the Board may handle a motion for summary judgment and response, or cross-motions for summary judgment, as the final record and arguments upon which a case may be decided. In a situation where the summary judgment motion is already filed and briefed, the parties stipulate that the Board may make findings of fact on the summary judgment record, in lieu of adhering to the summary judgment standard that would require finding no genuine dispute of material fact exists, such that one party is entitled to judgment in its favor (or, of course,

finding the existence of genuine disputes of material fact such that neither party is entitled to judgment in its favor). *See, e.g., Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826 (TTAB 2012); *Weatherford/Lamb, Inc. v. C&J Energy Servs., Inc.*, 96 USPQ2d 1834 (TTAB 2010); *see* TBMP §§ 528.05(a)(2), 702.04(c). In another approach to ACR, the parties agree to submit their briefs with their evidentiary submissions, so as to merge the trial and briefing periods. The parties further agree to appropriate limitations on the presentation of evidence or briefing options, such as to present evidence by affidavit or declaration, to submit a joint stipulation of facts, to limit their main briefs to 25 pages and any reply brief to 10 pages, and to stipulate that the Board may resolve any genuine dispute of material fact that may exist in the record. TBMP § 702.04(b). The two approaches are very similar but, usually, the former situation arises when, after filing cross motions for summary judgment, the parties elect ACR. The latter situation arises when the parties first elect ACR and then file their submissions, knowing in advance of filing that they are putting together their ACR record and brief.

In another form, the parties stipulate to facts, leaving the Board to apply the law to the stipulated facts; or the parties may stipulate to some facts and agree that the Board will resolve any remaining issues of fact based on the submissions made in conjunction with the ACR briefs and evidence. TBMP § 702.04(d)-(e). *See also Edom Laboratories, Inc. v. Lichter*, 102 USPQ2d 1546 (TTAB 2012).

These are examples, as the Board's ACR option provides the parties significant flexibility to agree on a proceeding format that they find most efficient. Several models have been developed by the Board to assist the parties in framing an ACR approach to their case. These options may be accessed from the Board's home page under "TTAB Suggestions for ACR" and directly at <http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/ttab-acr-options>. Please note that at least one model does not allow for an oral hearing. Also posted on the Board's home page are "Stakeholder Suggestions for ACR."

Parties should think about the possible use of ACR, as an alternative to full discovery and trial, early in the case. Use of ACR should be discussed in the settlement and discovery planning conference. The earlier in the proceeding the parties elect ACR, the greater the efficiencies they will realize. Election of ACR early in the proceeding allows the Board an opportunity to work with the parties to tailor a limited disclosure and discovery period, to narrow and focus the issues, to facilitate prompt submission of stipulations, and to set the periods for filing cross-motions or, if preferred, ACR briefs and evidence. Even if the parties do not agree to use ACR when they conference, they should revisit the issue after initial disclosures have been exchanged and initial discovery responses have been provided.

ACR is a less effective option if the parties have already engaged in full discovery and find themselves on the eve of trial. However, even in this latter situation, the parties may agree to combine their trial and briefing periods to shorten the remaining schedule.

#### Motion for Discovery Under Federal Rule 56(d)

If an initial motion for summary judgment is not filed as part of the ACR procedure and is solely an attempt by the movant to obtain judgment, the non-moving party generally must choose between filing a response to a motion for summary judgment or seeking an extension of time to respond until after the non-moving party has had an opportunity to take discovery necessary for framing a response.

A motion for extension of time to respond until after the movant has had an opportunity to take discovery must be accompanied by an affidavit. The motion or affidavit must set forth the specific subjects on which discovery is needed and why material cannot be obtained other than from the party that filed the motion for summary judgment (or, in some cases, from third parties). When the Board grants a request for Rule 56(d) discovery, the discovery allowed is limited to that which the nonmoving party *must* have in order to oppose the motion for summary judgment.

**Do not** file a Rule 56(d) motion if you can respond without discovery. **Do not** file a Rule 56(d) motion simply because you had served discovery before the motion for summary judgment but the requests went unanswered after the adversary concluded that the filing of the motion for summary judgment tolled its obligation to respond. **Do not** file a combined response and alternative request for discovery under Rule 56(d); the response will show that you do not need discovery to be able to respond.

Trademark Rule 2.127(e) **allows a party filing a motion under Rule 56(d) only 30 days to do so**, as measured from the date of service of the motion for summary judgment. **Extensions will not be granted, even on consent**, though parties embarking on settlement discussions following the filing of a motion for summary judgment can stipulate to suspend the case before the 30-day response period has expired, thereby preserving some of the response period for filing of the motion under Rule 56(d) at a later date (if the suspension for settlement talks does not result in settlement).

**TIP:** If you have outstanding discovery requests, and responses to some of those requests would provide the material or information needed to be able to respond to your adversary's motion for summary judgment, then submit copies of the requests and note those for which responses are needed in your motion under Rule 56(d).

#### Presenting Motion/Response During Phone Conference

Parties may opt to use telephone conferences to present and/or dispose of motions. *See Official Gazette* announcement of June 20, 2000, at 1235 TMOG 68, accessible on the Board's web page. *See also* TBMP § 502.06(a), *Electronic Indus. Ass'n v. Potega*, 50 USPQ2d 1775, 1776-77 (TTAB 1999) (discussion of a phone conference).

**TIP:** Always follow up a written request for a phone conference with a telephone call to the appropriate Interlocutory Attorney. Better yet, make the phone call first and use a writing only to confirm the request, for service on your adversary, and to submit any material or briefs required by the Interlocutory Attorney. Please note that the Board does not consider a phone request for a phone conference to constitute an impermissible ex parte communication, when limited to merely requesting the conference and without any presentation of arguments on the issues or motions to be presented during the conference. Thus, accusing your adversary of improper ex parte communication with the Board, when you are informed that it has requested a phone conference, generally is unwarranted. However, conferences are more easily arranged when the party preparing to request a phone conference informs its adversary in advance and discusses possible dates and times for the conference. Also, remember that when a motion is filed the non-movant has the option of calling the assigned Interlocutory Attorney and requesting a phone conference for the purpose of presenting its response to the motion orally, thus hastening resolution of the motion and avoiding delay.



### Stipulations/Consented Motions to Dispose of Cases

Most Board cases settle. Many settle without the pleadings even being completed. Others settle after pleading and some discovery allows the parties to obtain a fuller understanding of their respective positions. Plaintiffs withdraw complaints; defendants abandon applications or surrender registrations. Sometimes they agree to make amendments or enter into consent agreements intended to smooth the way for pending application(s). Often, the resulting filings are improperly captioned, sent to the wrong correspondence address, fail to list Board opposition or cancellation numbers, do not bear proof that service copies have been sent to the adversary; and either fail to comply with applicable Board rules, which makes pigeon-holing the filings difficult, or fail to specify the precise terms on which the parties want the case disposed.

The simplest way to settle a Board case is to file a single stipulation, signed by each party, specifying whether the involved application or registration is to be amended or abandoned/surrendered, and whether the Board case is to be dismissed with prejudice or without prejudice. Use the opposition number or cancellation number in the caption. Send it to the TTAB; *do not* send it to the Examining Attorney who approved the application or to the Post Registration section and do not file it via TEAS, the electronic filing system for Trademark applications and related filings. Be explicit and do not leave loose ends. If the parties are utilizing a stipulation to dispose of a case, the Board does not need original signatures. A photocopy will suffice. In this way, the parties can file the stipulation as an attachment to an ESTTA filing.

### Disclosure of Testifying Experts

Board rules for *inter partes* cases require disclosures by any party planning to use an expert to present testimony at trial. The disclosures are essentially those required by Fed. R. Civ. P. 26(a)(2), unless directed otherwise by an order of the Board. Such disclosures are required no later than 30 days prior to the close of discovery, for any party that has, at that time, plans to use an expert to support a claim, counterclaim or defense. The Board generally will suspend proceedings and issue any necessary orders to allow for discovery about the expert(s). A party deciding to use an expert solely for contradicting or rebutting another party's previously disclosed expert is allowed time to retain and disclose plans to use that expert.

**TIP:** It is recommended that the parties resolve between themselves any purported, curable defects in timely served expert disclosures. *See Gen. Council of the Assemblies of God v. Heritage Music Found.*, 97 USPQ2d 1890 (TTAB 2011) (respondent timely served expert disclosures and cured deficiencies when brought to its attention).

**TIP:** Experts are rarely used in Board cases, because of the expense. When used, the typical use is of a survey expert. If you think you may use a survey expert in your case, even if the possibility is remote, you will want to discuss in the settlement and discovery planning conference possible stipulations regarding entry into the record of expert reports and testimony. For example, parties might agree that expert testimony can be presented in affidavit form and survey results and documents can be introduced as exhibits. Parties could also agree to reserve the right to undertake live cross-examination, if necessary. Such arrangements might be more efficient than required disclosures, discovery about the experts, and presentation of the experts at trial. *See Trademark Rule 2.120(a)(2)* ("Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.")

### Board Conference with Parties, Counsel

The Board may require the parties and their counsel to attend a conference in person with a Board judge, panel of judges and/or a Board attorney, to resolve complex discovery and/or pretrial issues. *See, e.g., Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633 (TTAB 2011). If the Board identifies the case as being, or having the potential to be, overly contentious and/or involve creation of excessive records, the Board will not hesitate to call such a conference. *See id., Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1592 n.5 (TTAB 2011); TBMP § 502.06(b).

## **IV. INTER PARTES TRIALS, TRIAL MOTIONS, BRIEFING**

### Trial in General

Although the involved application or registration file automatically is part of the record, remember that allegations in the file must be established at trial (as, for example, the dates of first use). Submissions made by applicant during the prosecution of the application are part of the record without any action by the parties. *See, e.g., Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 97 USPQ2d 1626 (Fed. Cir. 2009). Be mindful, however, that statements of fact and documents and things filed in an application or registration may be used *against* the applicant or registrant, that is, as admissions against interest. Opinions or legal conclusions asserted in an application file, however, are not admissions, but are merely illuminative of shade and tone in the picture confronting the decision maker. *See, e.g., Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978).

Also, exhibits attached to pleadings are not considered part of the trial record, except for a certified copy of a pleaded registration, prepared by the USPTO and showing status and title, or copies of USPTO electronic database records showing status and title of a pleaded registration.

Stipulate to facts. This provides a real saving of time and expense to the parties and to the Board, and reasonable counsel should be able to agree on a number of facts in any case. *See Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to 13 paragraphs of facts).

**TIP:** Do not prove your adversary's case. For example, by introducing the entire transcript of a discovery deposition of an adversary, or all of your adversary's interrogatory responses, you may be introducing portions of the deposition or interrogatory responses that are beneficial to the adversary's case. Be careful to rely selectively on only those parts of discovery responses or discovery depositions that are helpful to your case.

### Pretrial Disclosures

Each party is required, 15 days prior to the opening of each of its assigned testimony periods, to disclose witnesses who either will be called or may be called if the need arises. The disclosure required involves providing other parties with the names and certain identifying information about each such witness; a summary of the subjects on which the witness is expected to or may testify; and a summary of the types of documents and things that will or may be introduced as exhibits during the testimony deposition of the witness. If a party does not provide this information for a witness as part of its pretrial disclosures, the Board may, upon motion, strike the testimony of the witness. *See Carl Karcher Enters. Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370 (TTAB 2011); *Jules Jurgensen/Rhapsody, Inc. v. Peter Baumberger*, 91 USPQ2d



1443 (TTAB 2009); *see also Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (motion to preclude testimony of witness first identified in pretrial disclosures granted); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011) (failure to name one witness until original pretrial disclosures were made and twenty-six witnesses until a supplement to amended pretrial disclosures, was neither harmless nor substantially justified; motion to quash granted as to twenty-six witnesses but testimony of one witness, identified months earlier, not excluded provided adverse party be given an opportunity to take a discovery deposition); *Byer Cal. v. Clothing for Modern Times, Ltd.*, 95 USPQ2d 1175 (TTAB 2010) (motion to exclude witness “granted in part”). A party that has no plans to take testimony from witnesses must make a disclosure noting that it plans to take no testimony. *See* TBMP § 702 (discussion of pretrial disclosures), the notice of final rulemaking, available by a link on the TTAB home page of the USPTO website. Note that a pretrial disclosure does **not** serve in lieu of a proper notice to other parties of the scheduled testimony deposition of a witness. Also note that a party need not disclose plans to file notices of reliance.

### Taking Testimony

Through the taking of depositions during the testimony period, a party may introduce into evidence not only the testimony of its witness, but also those documents and other exhibits that may not be made of record by notice of reliance. Thus, a party may make of record, as exhibits to testimony, its *own* responses to interrogatories, document production requests or requests for admissions, by having its witness testify so as to identify them and certify the accuracy of the responses. If the witness was previously a witness in a discovery deposition, he or she can similarly identify and certify the discovery deposition testimony. A party can also use testimony depositions to make of record exhibits to pleadings by having its witness testify regarding the exhibits, or can make of record materials submitted with a summary judgment motion, by having the witness identify and testify as to the accuracy of an affidavit made in support of the motion.

Testimony depositions, as in the case of discovery depositions, may be taken by telephone, but may not be submitted in an electronically recorded format. A telephonic deposition is taken upon stipulation of the parties or following grant of a motion for leave to do so; the location of the deposition is the place where the witness is to answer the questions. While the Board has no objection if the parties wish to have a deposition electronically recorded, the testimony submitted to the Board must be in written form. The Board will not review any electronic recordings (*e.g.*, dvd’s, videotapes) of depositions. In contrast, an electronic recording of, for example, a commercial demonstration may be made of record as an exhibit to a deposition transcript.

**TIP:** It is preferable that parties refrain from filing exhibits having intrinsic value. Rather, the parties should file photographs of such exhibits. The same goes for large or breakable exhibits. Thus, during the taking of testimony it may be helpful to have a witness be shown both the item itself and the photograph thereof, so that there will be no question that filing of the photograph will satisfactorily serve in lieu of filing of the item itself.

**TIP:** Be selective in the introduction of exhibits to a testimony deposition. For example, the Board does not need to see every advertisement or every catalog. A representative sample of them is sufficient, with accompanying testimony about the extent of publication, circulation figures and the like which would bear on the degree of exposure to the relevant public. Too often, witnesses are asked simply to read what is in exhibits, without being asked important questions necessary to establish the foundation for introduction of the exhibit, knowledge of the subjects discussed in the exhibit, or even being asked if the exhibits accurately reflect what the witness knows.

**TIP:** If a party wishes to make of record its registrations through the testimony of a witness, the witness must have knowledge of the registrations and must specifically testify as to the title and status of each, *i.e.*, that the party is the owner and that the registration is currently in effect. It is not unusual for a witness to be asked to “identify” a registration by reading the number, mark, and listed goods or services, without ever being asked to testify from personal knowledge that the party owns the registration and that it is valid (*i.e.*, current and has had necessary post registration filings made to maintain it).

### Making Objections to Testimony Depositions

The manner in which an objection is made to testimony depositions depends on the nature of the objection. If an objection could be cured if seasonably made, it must be raised promptly or it may later be found waived. Thus, for example, an objection that the deposition was taken without adequate notice must be promptly raised by a motion to strike. Other objections, such as to particular questions or a line of questions during the deposition, should be made during the deposition and then either renewed in the trial brief or in a motion to strike testimony filed at the time of briefing. This is because, as a general rule, motions to strike testimony will be deferred until the rendering of the final decision if deciding the motion would require reading the testimony.

Objections to testimony should not be made to disrupt the testimony or to interfere with the examination of a witness. It is better to make a continuing objection to a line of testimony rather than to object to each question.

Any objection raised during the deposition must be renewed in your brief on the case or the Board, in all likelihood, will consider the objection to have been waived.

Questions to which an objection is made should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is privileged. If the answer involves confidential material, then the answer may be made after stating that it is covered by the terms of the extant protective agreement or order. If a testimony witness refuses to answer a question, a motion to compel is not available, since that is a motion relating to discovery activities. If the Board at final hearing finds the objection not well taken, the Board may construe the refusal to answer against the non-answering party and presume that the answer would have been adverse to the position of the party whose witness refused to answer; or the Board may find that the refusal to answer reduces the probative value of the witness’s testimony.

**NOTE:** There is a distinction drawn between a motion based on an allegation that a party failed to make proper or adequate pretrial disclosure and a motion based on an allegation that a party failed to serve a proper or adequate notice of examination. When the deficiency is in the pretrial disclosure, the motion to strike may target all of the testimony (and exhibits), or those portions that were not covered by the disclosure. *See Jules Jurgensen/Rhapsody, Inc. v. Peter Baumberger*, 91 USPQ2d 1443 (TTAB 2009). When the deficiency is in the notice of examination, the motion to strike must seek exclusion of the entire testimony deposition and exhibits. Either type of motion must be promptly filed after the testimony is taken.

### Correcting, Filing and Serving Transcripts

Trademark Rules 2.123(f) and 2.125(c) concern *filing* requirements for testimony depositions; Trademark Rules 2.125(a) and (b) concern *service* requirements. It is commonly assumed that testimony deposition transcripts must be filed with the Board within 30 days of the taking of the

deposition. Also, Rule 2.123(f) states that the court reporter taking down the deposition testimony must file it. In fact, the Board does not require filing by the court reporter and corrected, certified transcripts need only be filed prior to final hearing to be considered timely filed. The parties, however, should be served with copies of the transcript within 30 days of the deposition to facilitate taking of subsequent testimony. An uncertified copy, including copies of exhibits, usually will allow orderly continuation of trial, though it is certainly preferable to have every transcript marked by the witness and attorneys with necessary corrections, and certified after correction, as soon as possible after the taking of the deposition.

Errors in the transcript should be corrected by the officer certifying the transcript, or should be corrected by the witness by writing the correction above the original text and initialing the correction. The Board prefers that the correction be made on the actual pages of the transcript, rather than on a list inserted at the end of the transcript. The Board does not enter corrections for litigants, and a list of corrections at the end of a transcript may be overlooked.

**TIP:** It is preferable for each of the parties to file all of its own testimony depositions at the same time to avoid the problem of separation and possible loss. By keeping the depositions together, the Board is better able to process the testimony and enter it into the file.

#### Notice of Reliance

If a party is relying, by way of a notice of reliance, on a registration it owns, a USPTO status and title copy of the registration must be filed (*i.e.*, a certified copy, prepared by the Office to show the status of, and current title to, the registration); the copy must have been issued by the Office within a reasonably contemporaneous time of the filing of the complaint. Alternatively, the party may submit copies of USPTO electronic database records showing status of and title to the pleaded registration. Third-party registrations may be made of record by way of a notice of reliance by submission of plain copies of the registrations or of electronic printouts retrieved from the database of the USPTO. A listing of third-party registrations or a trademark search report taken from a private company's database is not acceptable.

**TIP:** It is both faster and more economical to take advantage of the Board practice by which a party may make its registrations of record by submitting printouts retrieved from the USPTO electronic databases. Such records should reflect current status and title. Trademark Rule 2.122(d); *see Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009).

#### **Remember that the Board does not take judicial notice of Patent and Trademark Office records.**

A notice of reliance can also be used to introduce certain printed publications in general circulation, government records, and an adverse party's responses to requests for admissions or to interrogatories, but not documents produced by an adversary (see below). See § 704 of the TBMP for more specific information on use of notices of reliance. With respect to discovery responses, the party making these responses of record should be selective, and submit only material that is relevant and helpful to making its own case.

#### Documents Produced by Adversary

Documents produced by an adversary pursuant to a request for production of documents may not be made of record by a notice of reliance, unless they are admissible as printed publications or official records, or unless they were produced in lieu of responses to interrogatories. Annual

reports, catalogs, in-house publications and press releases are not admissible as printed publications. Methods for getting documents into the record include:

- Serve requests for admissions as to the authenticity of the documents the adversary has produced, and then file a notice of reliance on the requests for admissions, the admissions, and the documents or things authenticated by the admissions. This procedure requires that the document production requests be served early enough in the discovery period so that time will remain in the period after the documents are received in which to serve the requests for admissions.
- Offer the produced documents as exhibits in connection with taking the adversary's discovery deposition. Again, the document request must be served early enough in the discovery period that the documents will be produced with sufficient time remaining to take the discovery deposition.
- Offer the produced documents as exhibits in connection with taking the testimony of the adversary as an adverse witness. (Potentially dangerous, since the transcript of every testimony deposition must be filed and you may not have adequate control over what the witness will say.)
- Introduce the produced documents as exhibits during the cross-examination of the adversary's witness. It is risky to rely on this procedure, because it is available only if the adversary takes testimony, and the documents pertain to matters within the scope of the direct examination. Thus, the documents may not come into the record if the adversary does not take testimony, or takes testimony but the scope of it is limited, or if the witness is not familiar with the documents.
- If the documents are provided as part of an answer to an interrogatory, the inquiring party may make them of record by relying on the interrogatory answer that incorporates the document.
- Combine a request for production of documents with a notice of taking deposition, and ask that the requested documents be produced at the deposition. This requires that the combined request for production and notice of deposition be served well prior to the date set for the deposition, because a discovery deposition must be both noticed and taken prior to the close of the discovery period, and because Fed. R. Civ. P. 34(b) allows a party 30 days in which to respond to a request for production of documents.
- By agreement of the parties reduced to a written stipulation. (A recommended alternative that saves time and money for all parties.)

#### Notice of Reliance and Internet Evidence

Documents that are obtained from the Internet that are identified by their date of publication or date that they were accessed and printed, and their source (URL), may be submitted under a notice of reliance in the same manner as a printed publication. TBMP § 704.08(b); *see Safer, Inc. v. OMS Inv., Inc.*, 94 USPQ2d 1031 (TTAB 2010).

### Motion to Strike Notice of Reliance

An objection to a notice of reliance on the ground that it is untimely or does not comply with the procedural requirements of the Trademark Rules must be promptly made. If the objection can be cured, the Board may allow the filing party time to cure the defect, failing which the material will be stricken. If the objection is to the substance of the evidence, *e.g.*, its materiality, relevance or competence, a motion to strike should not be filed at the time the notice of reliance is filed. Rather, the objection should be raised in the party's brief or in a motion to strike filed with the brief.

### Motion to Amend Pleadings to Conform to Evidence

Amendments to pleadings *after* trial are allowed under Federal Rule 15(b) when an unpleaded issue was tried with the express or implied consent of the adversary. Fed. R. Civ. P. 15(b). In the case of implied consent, the moving party must show not only that the adversary failed to object to the introduction of evidence on an unpleaded issue, but also that the adversary was fairly apprised that evidence was being offered in support of the unpleaded issue. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana, Inc.*, 98 USPQ2d 1921 (TTAB 2011).

### Rebuttal Testimony Period

A plaintiff should not use the rebuttal testimony period for a second bite of the apple. Any evidence that supports the pleaded grounds for opposition or cancellation generally constitutes part of the case-in-chief rather than rebuttal and is generally inadmissible as rebuttal. It is preferable to file such a motion prior to briefing, but a motion to strike filed with the defendant's brief will be considered.

### Motion to Dismiss for Failure to Prosecute; Plaintiff Failure to File Brief

When a plaintiff has failed to file any evidence, or has filed only copies of USPTO records that the defendant believes in good faith are insufficient to allow plaintiff to carry its burden of proof, the defendant may move for dismissal. Trademark Rule 2.132; *see Prakash Melwani v. Allegiance Corp.*, 97 USPQ2d 1537 (TTAB 2010) (dismissal under Rule 2.132(a)); *compare* Trademark Rule 2.132(a), *with* Trademark Rule 2.132(b).

When a plaintiff fails to file a brief on the case by the deadline therefor, the Board may issue an order to plaintiff to show cause why the case should not be dismissed based on plaintiff's loss of interest. Trademark Rule 2.128(a)(3). While the order to show cause is easily discharged if the plaintiff retains interest in the proceeding, excusable neglect under Federal Rule 6(b)(1)(B) must be shown to secure acceptance by the Board of a late-filed brief (as well as reopening of trial, should plaintiff seek to have trial reopened). *See Vital Pharms., Inc. v. Conrad J. Kronholm, Jr.*, 99 USPQ2d 1708 (TTAB 2011).

### Briefs

Discuss the pertinent facts of your case in light of the relevant law. Refer to the testimony and evidence of record by citation thereto when making an argument. Use case law strategically. There is no need for string citations to prior case law. Focus on those cases that frame where you think your case fits. Adhere to the page limit (main brief: 55 pages in its entirety; reply brief: 25 pages). **If a party files a brief in excess of the page limit without prior leave of the Board, then the brief in its entirety will be denied consideration.**

**TIPS:** Arguments that are certain losers should be avoided as they weaken the rest of the case. Do not make arguments based on facts that are not of record. Do not assert that the evidence supports a fact if it does not, and do not mischaracterize the facts or a holding of a cited case. This taints credibility.

**TIP:** When referring to evidence, cite to the TTABVue record; e.g., 10 TTABVue at 15 or 10 TTABVue at 47-49 of 241.

### Oral Hearing

Oral arguments in an *inter partes* case are presented to a panel of three TTAB judges. Each side is allotted 30 minutes and a plaintiff may reserve some of its time for rebuttal.

Stick to the facts of your case. Do not make arguments based on facts that are not of record. An oral hearing may not be used as a vehicle for the introduction of evidence.

Engage the judges on the hearing panel in conversation about the case. Do not lecture. The judges will have read the briefs but will not generally have read the record and will therefore have questions about what is in the record and what is not. Be prepared to provide citations to where items of evidence bearing on a particular point can be found. The judges' questions may indicate the legal questions or aspects of a party's theory of the case that concern them most, so be prepared to shift from discussing the points you might otherwise like to make to discussion of the issues or theories that the judges would like to discuss, as revealed by their questions.