

# **Advanced Practice Tips from the TTAB**

**Incorporating amendments to the Rules of Practice in Trademark Cases  
effective January 14, 2017**

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## **I. GENERAL INFORMATION**

This section provides an overview of operations with which those appearing before the Trademark Trial and Appeal Board (TTAB or Board) are most likely to interact.

### **A. Employees and Responsibilities**

In deciding both *ex parte* and *inter partes* cases, the Board's Administrative Trademark Judges work in panels, generally consisting of three judges. The cases are briefed and, on request, argued orally. Before a case reaches a panel, various filings and motions may be addressed through the Board's electronic filing system (ESTTA) or by a Board paralegal or staff attorney.

The Board's paralegal staff handles routine motions and issues orders seeking information regarding the status of cases. For example, in *inter partes* cases, paralegals prepare suspension orders when potentially dispositive motions or motions to compel are filed, and prepare orders disposing of cases when parties agree to settlement through dismissal, abandonment of an application, surrender of a registration, and the like.

The staff attorneys, also referred to as Interlocutory Attorneys, handle all contested pretrial matters and some types of uncontested motions that arise in *inter partes* cases, review orders prepared for their signature by paralegals in *inter partes* cases, and participate in discovery conferences on request of at least one party or when necessary to manage a case.

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 on the proceeding record in TTABVUE, the Board's docket database, which is discussed further *infra*. Often, the Managing Interlocutory Attorney, as necessary to balance dockets, reassigns cases with fully briefed contested motions ready for decision. *Ex parte* appeals are assigned to a paralegal, whose name also is in the appeal record in TTABVUE.

The Board's information specialists provide general information and answer status inquiries. They are reached at the Board's main phone number: (571) 272-8500.

### **B. Electronic Information**

The public may use [www.uspto.gov](http://www.uspto.gov) to access the U.S. Patent and Trademark Office (USPTO) home page. A link to the TTAB home page is available under Quick Links and from the Trademarks home page. Quick Links on both the Trademarks and TTAB home pages allow access to TTABVUE and to ESTTA, the Board's online filing system. The Board's manual of procedure, the TBMP, can be accessed without charge via the Board's web page. The TTAB home page also has other information, including links to combined listings 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. (These documents are not the official versions of the statutes and rules, but a resource provided by the Office.)

In addition, links to various standard documents, policies, and procedures appear on the Board's home page. These include the TTAB's Standard Protective Order, which was revised in 2016 and is automatically imposed in all *inter partes* cases, and materials related to the 2017 changes to the Trademark Rules, including the final notice published at 81 Fed. Reg. 69950 (October 7, 2016), a correction published at 81 Fed. Reg. 89382 (December 12, 2016), and a summary chart listing changes to each rule effective January 14, 2017.

Other resources available on the Board's web page include:

- the TTAB Dashboard, in the USPTO Data Visualization Center, and other information reflecting case pendency measures, new filings, and inventory;
- fee and payment information;
- information on Accelerated Case Resolution;
- the USPTO Freedom of Information Act (e-FOIA) site for searching final TTAB decisions; and
- information concerning oral hearings, which as noted *supra* are available by request in both *ex parte* appeals and *inter partes* proceedings.

The Board has an electronic workflow system, the public interface for which is TTABVUE. The TTABVUE system provides image records of all documents in a TTAB proceeding (other than those designated confidential) and provides the prosecution history of *inter partes* and *ex parte* appeal proceedings, including their current status. One also can access information on 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, or by mark, party, or correspondent 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.

### **C. Use of Authority**

The following sources are appropriate for reference and citation in Board proceedings:

- Precedential decisions of the Board; its primary reviewing court, the U.S. Court of Appeals for the Federal Circuit; and the Federal Circuit's predecessor, the U.S. Court of Customs and Patent Appeals (CCPA).
- The U.S. Trademark Act (Lanham Act), 15 U.S.C. § 1051 et seq.
- Rules of Practice in Trademark Cases, 37 C.F.R. Part 2.
- The TBMP and the Trademark Manual of Examining Procedure (TMEP).

## *TIPS*

- Case citations should be to the U.S. Patent Quarterly (USPQ).
- The Board manual is cited as “TBMP § XXX (Jan. 2017).”
- Board decisions that are not designated as precedential are not binding on the Board, but may be cited for whatever persuasive weight they may carry. Because each case must be decided on its own record, over-reliance on nonprecedential decisions should be avoided. *See In re Cordua Rests., Inc.*, 823 F.3d 954, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1440 (TTAB 2016).

### **D. Electronic Filing and Proceeding Files**

As of January 14, 2017, unless ESTTA is unavailable due to technical problems or extraordinary circumstances are present, **all Board filings must be made electronically via ESTTA** (with the appropriate fee, where applicable), including:

- Requests for extensions of time to file a notice of opposition.
- Notices of opposition.
- Petitions for cancellation.
- Answers to notices of opposition and petitions for cancellation.
- Motions in *inter partes* proceedings.
- Stipulations to reschedule pretrial disclosure and trial dates.
- Trial evidence, including deposition transcripts.
- Appeal briefs in both *ex parte* and *inter partes* cases.
- Notices of appeal and elections for judicial review of Board decisions.

Trademark Rules 2.126 and 2.191. Paper filings of pleadings and extensions of time to oppose must be accompanied by a Petition to the Director of the USPTO under § 2.146 and a fee. For any application seeking to extend a foreign registrant’s international registration into the United States through the Madrid Protocol, however, an extension of time to oppose or notice of opposition must be filed via ESTTA, without exception. Trademark Rule 2.101(b)(3). The scope of an opposition against an application filed pursuant to the Madrid Protocol is limited to the goods, services, grounds, and named opposers identified in the ESTTA cover sheet, and cannot be amended once filed. Trademark Rules 2.104(c) and 2.107(b).

## ***TIPS***

- Plan ahead, docket filing deadlines, and allow plenty of time to resolve issues that may arise due to unexpected problems using ESTTA.
- On successful transmission, a 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, notify the Board and provide the ESTTA tracking number. The information will be forwarded to a Board IT specialist, who will attempt to remedy the problem quickly.
- Any questions regarding the technical aspects of ESTTA should be directed to the Board. If the Information Specialist or Board attorney or paralegal cannot answer the question due to its highly technical nature, the question will be forwarded to a Board IT specialist. You may also submit the technical question by email to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov). (Note: This email address is used for technical inquiries only, not for filing with the Board.)
- For immediate help, call (571) 272-8500 during business hours.

## **II. TIPS FOR *EX PARTE* APPEALS**

Chapter 1200 of the TBMP is devoted to *ex parte* appeals and contains significant information regarding appeals from denials of registration. The following tips are intended to help appellants avoid some common errors.

### **A. Refusal on the Ground of Likelihood of Confusion**

Many denials of registration that are appealed to the Board are made on the ground of a likelihood of confusion with a cited registration pursuant to Section 2(d) of the Trademark Act. The issues specific to these refusals discussed below arise with particular frequency.

#### Suspension

When an application is refused registration on the ground of a likelihood of confusion with an existing registration, an applicant should always check the status of the cited registration. If the cited registration is still in existence, but the time for a post registration filing is approaching, the Board will consider a request for suspension. The Board will grant a request for suspension of an appeal after the fifth anniversary of the issue date of the cited registration if a Section 8 or 71 affidavit is due. When renewal is due, requests for suspension will be granted after the ninth anniversary of the issue date of the cited registration. For further discussion of the Board's suspension practice, see TBMP § 1213 (Jan. 2017).

## Scope of Identification of Goods and Services

The Board's analysis of a likelihood of confusion is based on the scope of the identifications in the cited registration and the subject application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1354 (TTAB 2015). Thus, it is unavailing to argue or submit evidence that either the applicant or the owner of the cited registration uses a mark for fewer than all goods or services encompassed by the identification, or that the nature or prices of the goods are different.

### **TIPS**

- Where the identified goods or services are unrestricted, they are presumed to travel through all channels of trade and to all consumers normal for goods or services of the identified type. *See Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990); *In re Anderson*, 101 USPQ2d 1912, 1920 (TTAB 2012).
- Where an applicant's identified goods or services are identical to those identified in the cited registration, the Board must presume that the channels of trade and classes of customers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).
- Likelihood of confusion must be found as to the entire class if confusion is likely with respect to any item within the identification of goods or services in that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015).

### **B. Listings of Third-Party Registrations**

Applicants commonly encounter problems properly introducing and using evidence of third-party registrations. TMEP § 710.03 (Jan. 2017) explains the treatment of third-party registrations during examination, while TBMP § 1208.02 (Jan. 2017) addresses issues pertaining to both cited and third-party registrations on appeal.

The Board does not take judicial notice of records that exist within USPTO databases, including registrations. *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986). This includes the file of a cited registration, which is not automatically of record. *In re Sela Prods., LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013).

Submission of a list, chart, or other summary of third-party registrations is insufficient to make the underlying registrations of record. *In re Hoeflin*, 97 USPQ2d 1174, 1177 (TTAB 2010); *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002). Nor is a commercial search report proper evidence of such registrations. *In re Dos Padres Inc.*,

49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Hub Distrib., Inc.*, 218 USPQ 284, 285 (TTAB 1983). To make registrations of record, copies of the registrations or the electronic equivalent – e.g., printouts from the USPTO Trademark Electronic Search System (TESS) or Trademark Status and Document Retrieval (TSDR) databases – must be submitted during examination. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006).

If an applicant submits improper evidence of third-party registrations when the problem can be cured, the Examining Attorney must object to the evidence. Otherwise, the Board may deem the objection waived. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007).

### **TIPS**

- The evidentiary value of third-party registrations typically is minimal in the likelihood of confusion context. They are not evidence of use and cannot justify registration of a similar mark. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *Productos Lacteos Tocombo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011).
- However, evidence of third-party registrations and use can be relevant to show that a mark or portion of a mark (in association with the particular goods or services) is descriptive, suggestive, or so commonly used that consumers will look to other elements to distinguish source. *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015).
- In contrast to registrations, third-party applications have no probative value other than as evidence that they were filed. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007). Expired and cancelled third-party registrations generally are evidence only of the fact that the registrations issued. *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006).

### **C. Briefs**

Briefs should include reference to compliance with requirements not the subject of the appeal. Trademark Rule 2.142(c). *Ex parte* appeal briefs are limited to 25 pages, reply briefs to 10 pages. Trademark Rule 2.142(b)(2).

Citations to evidence should reference the electronic application record by date, the name of the paper, and the page number in the electronic record. For example: “December 14, 2016 Office Action, TSDR p. 6” or, for any evidence appearing in TTABVUE after appeal, “4 TTABVUE 2.” Trademark Rule 2.142(b)(3).

Good cause must be shown to obtain an extension of time to file a brief. The Board considers reasons for an extension in context of the number of requests, so good cause for a first extension may not suffice for a subsequent extension. TBMP § 1203.02(d) (Jan. 2017).

### ***TIPS***

- Late filing a brief cannot be cured by a petition to revive. TBMP § 1203.02(a) (Jan. 2017).
- Evidence should not be attached to an appeal brief, which merely adds needless bulk to the file. The record in the application should be complete before an appeal is filed, and evidence submitted for the first time with a brief is untimely. Trademark Rule 2.142(d); TBMP § 1203.02(e) (Jan. 2017). Even if evidence is already of record, it should not be attached as an exhibit to a brief, but instead cited in the electronic record in the body of the brief. TBMP § 1203.01 (Jan. 2017).
- To enter evidence into the record after appeal, an applicant or examining attorney should request remand. Trademark Rule 2.142(d).

#### **D. Requests for Reconsideration and Remand**

Appellate briefs sometimes include offers to restrict an identification of goods or services, amend an application from the Principal Register to the Supplemental Register, and the like, if the Board is not otherwise persuaded the mark is registrable. This is improper. After decision by the Board, absent order of the Director, an application can be reopened only to enter a disclaimer. Trademark Rule 2.142(g). If an applicant wishes to have the Board consider an amendment in the alternative, it should request remand before the Board decides the appeal so the examining attorney can evaluate the amendment.

If an applicant files a notice of appeal and a request for reconsideration, and a subsequent final Office Action issues, an applicant does not have a right to file a second request reconsideration. Rather, the applicant must request remand. *See* TBMP §§ 1204, 1207 and 1209.04 (Jan. 2017).

### ***TIP***

- A second refusal repeating all refusals and requirements may be considered as a final refusal for purpose of appeal. Trademark Rule 2.141(a).

### **III. TIPS FOR *INTER PARTES* PROCEEDINGS**

#### **A. Jurisdiction over Applications and Registrations**

The Board has jurisdiction over an application or registration subject to an *inter partes* proceeding. Accordingly, any amendment, change of address, change of counsel, etc.,

must be filed with the Board. There is one exception: Maintenance documents related to a registration involved in a cancellation action (e.g., an affidavit of continuing use or a renewal application) must be filed with the Post Registration division of the Office. Nonetheless, it is always helpful to alert the Board to any filing being made in another part of the USPTO concerning a registration involved in a cancellation action.

### ***TIP***

- Filings for opposed applications often are submitted via the Trademark Electronic Application System (TEAS) or to the Examining Attorney who approved the mark for publication, rather than via ESTTA. Do not do this! It can cause serious delays and may result in the filing not being considered.

### **B. Service of Submissions and Papers**

Pursuant to the 2017 amendments to the Trademark Rules, plaintiffs no longer need to serve complaints on defendants. Trademark Rules 2.101(a) and (b) and 2.111(a) and (b). The Board's notice of institution includes a web link or web address to access the electronic proceeding record and constitutes service of the complaint on the defendant. Trademark Rules 2.105(a) and 2.113(a).

All submissions and papers in *inter partes* cases must be served via email unless the parties stipulate otherwise. There is an exception if the serving party encounters technical difficulties or other extraordinary circumstances, but the serving party must show by written explanation that service by email was attempted but could not be made. Trademark Rule 2.119(a) and (b).

### **C. Pleadings and Related Motions**

The 2017 amendments to Trademark Rule 2.112(a) require petitioners to provide the Board with the current email address(es) of the current owner of the registration it seeks to cancel, to the best of the plaintiff's knowledge.

#### Notice of Opposition and Petition to Cancel

A well-drafted complaint puts the parties and the Board on clear notice of the pleaded claim(s) and may avoid needless and costly motion practice. To avoid ambiguity, consider using the statutory language to plead a claim, and set forth separate claims under separate headings. In addition, keep in mind that the Board's jurisdiction is limited to determining whether a mark is entitled to federal registration. Allegations of trademark infringement and unfair competition fall outside of the Board's jurisdiction and should not be included in a notice of opposition or petition to cancel.

Exhibits to a party's pleading are not part of the trial record unless they are identified and introduced during the party's testimony period. Trademark Rule 2.122(c). The one exception is that a federal trademark registration pleaded by the plaintiff is evidence of record if the complaint is accompanied by a copy of the registration prepared and issued

by the USPTO showing the current status and title of the registration, or a printout of information from USPTO electronic database records showing the current status and title of the registration. Trademark Rule 2.122(d).

### *TIPS*

- The Board recommends that a plaintiff make its pleaded registration(s) of record when it files the complaint. This helps focus discovery on matters in dispute and avoids the unfortunate situation in which a plaintiff has not properly made the pleaded registration(s) of record during its testimony period and, as a result, cannot establish standing.
- Make sure to plead all elements of each claim. With respect to dilution, parties often forget to allege that the pleaded mark became famous prior to the defendant's first use date or application filing date. *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1612 (TTAB 2010); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001).
- Grounds for cancellation of a registration five years or older are limited to those listed in Trademark Act Section 14(3) through (5).
- Do not use a claim of false suggestion of a connection under Trademark Act Section 2(a) as a substitute for a claim of likelihood of confusion under Section 2(d). These are different claims requiring different proofs. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 508 (Fed. Cir. 1983). The Board will deny a party's attempt to circumvent the five-year limitation of Trademark Act Section 14(1) by substituting a Section 2(a) claim for a Section 2(d) claim.

### Answer

In an answer, a defendant must admit, deny, or state that it is without sufficient knowledge to admit or deny each allegation set forth in the complaint. Do not include a boilerplate affirmative defense that the complaint fails to state a claim on which relief can be granted. Such a pleading often results in a motion to strike decided in the plaintiff's favor because a plaintiff usually is able to plead a claim for relief. If a pleading is insufficient, file a motion to dismiss pursuant to FED. R. CIV. P. 12(b)(6). Also do not include in an answer pro forma defenses of laches or acquiescence. These defenses are severely limited in *inter partes* proceedings, and may not be available at all with respect to certain claims (e.g., fraud, abandonment, functionality and genericness).

If a defendant is aware of grounds for a compulsory counterclaim when the answer is filed, the counterclaim must be pleaded at that time. Trademark Rules 2.106(b)(2)(i) and 2.114(b)(2)(i). If grounds for a compulsory counterclaim are learned after an answer is filed, the defendant must promptly move to file a motion for leave to amend to add the counterclaim. *Id.* A defendant that fails to timely file a compulsory counterclaim may be precluded from asserting the counterclaim.

### ***TIPS***

- Do not embed a motion to dismiss or other motion in an answer. Board personnel generally do not read pleadings unless necessitated by a motion, so an embedded motion usually will not come to the Board's attention in a timely manner.
- Under the 2017 rules amendments, a defendant must promptly inform the Board of the filing of any related proceeding. Trademark Rules 2.106(b)(3)(i) and 2.114(b)(3)(i).

#### Amendments to Pleadings

The Board is liberal in allowing amendments to a pleading when justice so requires, FED. R. CIV. P. 15, but certain amendments are impermissible. As noted *supra*, oppositions filed against applications based on a request for extension of protection under 66(a) of the Trademark Act are limited to the goods, services, and grounds set forth on the ESTTA cover sheet. Also, the 2017 amendments to Trademark Rule 2.107(a) and (b) clarify that an opposition against an application under Trademark Act Section 1, 44, or 66(a) may not be amended to add a joint opposer after the close of the time period for filing an opposition.

### ***TIP***

- When seeking to amend a pleading, identify the specific proposed changes in the motion. It is particularly helpful for a party to include a copy of the proposed amended pleading with changes tracked.

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

A defendant that misses the deadline to file an answer should first contact the plaintiff to see if it will stipulate to late filing of the answer. If the plaintiff stipulates, the answer should be filed with a stipulation to reset the due date for the answer. If the plaintiff does not stipulate, the defendant should file its answer with a motion to cure default or reopen. The Board is liberal in allowing a defendant to cure default, but a defendant should not file a late answer without explanation. Default cannot be cured by a phone call to the Board.

### ***TIPS***

- Plaintiffs should consent to late-filed answers because there is little chance that the Board will refuse to accept a late answer and enter default judgment. *Paolo's Assocs. Ltd. P'ship v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r 1990).
- The Board generally issues a notice of default about 10 days after the expiration of an answer deadline. To save the client the expense of a motion for default

judgment, if 15 days have passed since the answer deadline, counsel may call the Board paralegal assigned to the case regarding status of the notice of default.

### Motion to Dismiss in Lieu of Answer

A motion to dismiss under FED. R. CIV. P. 12(b)(6) challenges whether the plaintiff's claim(s) are sufficiently pleaded, not whether the claim(s) can be proven. Accordingly, the parties should not argue the merits of the case on a motion to dismiss. *See, e.g., Petróleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403 (TTAB 2010).

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.” But in Board proceedings, a party may not file a motion for summary judgment until the party has served its initial disclosures, unless the motion is on grounds of claim or issue preclusion or lack of Board jurisdiction. Trademark Rule 2.127(e)(1). Accordingly, the Board will exclude from consideration matters outside the pleadings that are presented with a motion to dismiss and will not treat the motion as a motion for summary judgment, unless the matter presented relates to claim or issue preclusion or the Board's lack of jurisdiction to hear a claim. FED. R. CIV. P. 12(d); *Zoba Int'l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 (TTAB 2011).

### ***TIPS***

- A plaintiff may respond to a motion to dismiss by filing an amended pleading under FED. R. CIV. P. 15(a)(1)(B). The amended pleading will be accepted “as a matter of course” and will moot the motion under Rule 12(b)(6).
- Even in situations where a motion to dismiss is considered on its merits and is well-taken, the Board often will allow the plaintiff leave to amend the defective pleading.

### **D. Discovery Conference, Accelerated Case Resolution (ACR), Suspension, and Settlement**

#### Discovery Conference

Parties are required to participate in a discovery conference within the deadline set by the Board to discuss the subjects set forth in FED. R. CIV. P. 26(f) and the Board's institution order. Trademark Rule 2.120(a)(1) and (2)(i); *Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761-62 (TTAB 2009); TBMP § 401.01 (Jan. 2017). Settlement discussions are encouraged, but are not a substitute for the discovery conference. *Promgirl*, 94 USPQ2d at 1761-62.

A party may request Board participation in the discovery conference. Trademark Rule 2.120(a)(2)(i). This may be particularly helpful when a party is appearing *pro se*, when it appears that the claims or defenses have not been adequately pleaded, or if the case is one that might become unnecessarily contentious. The Board also has the discretion to

participate *sua sponte* in the discovery conference. *Id.* A party can request Board participation in the discovery conference by telephone or through ESTTA using the form provided. Often the Board is able to act more quickly on a telephone request.

The parties share an obligation to arrange and participate in the discovery conference. *Promgirl*, 94 USPQ2d at 1761. When a party refuses or is unresponsive to requests to participate in the discovery conference, the adverse party may move for sanctions. There is no requirement that a party first file a motion to compel attendance, but a motion for sanctions must include evidence of the movant's good-faith effort to schedule the conference. *Id.* A motion for sanctions for failure to participate in the discovery conference must be filed before the deadline for initial disclosures. Trademark Rule 2.120(h)(1).

### Accelerated Case Resolution

Accelerated Case Resolution (ACR) is an abbreviated trial on the merits approximating a summary bench trial, available by stipulation of the parties. ACR, as discussed in detail in TBMP § 702.04 (Jan. 2017), can take almost any form the parties agree will move the proceeding forward in an efficient and expeditious manner. The earlier in a proceeding parties elect ACR, the greater the efficiencies. Accordingly, parties should consider the possibility of using ACR early in a case and discuss ACR during the discovery conference.

If parties do not agree to ACR at the beginning of a case, they should revisit the issue after the exchange of initial disclosures and again after the exchange of initial discovery responses or the close of discovery. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1827 (TTAB 2012). ACR is less effective if the parties have engaged in full discovery, but even on the eve of trial parties may agree to efficiencies, such as shortening the trial by combining trial and briefing periods. TBMP § 528.05(a)(2) (Jan. 2017).

When ACR is adopted early in a proceeding, parties generally agree to abbreviate or forgo discovery and forfeit trial in favor of submitting briefs with attached evidence. Parties must agree that the Board may resolve any genuine disputes of material fact raised by the parties' filings or the record. *See, e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1776 (TTAB 2013); TBMP § 702.04(b). Parties may further stipulate to some or all facts and also may reach procedural agreements, such as stipulating to a page limit for briefs or to the admissibility of evidence and the types of evidentiary objections that may be raised. *Chanel*, 106 USPQ2d at 1775-76.

In addition, parties may stipulate to ACR when a motion for summary judgment or cross-motions for summary judgment have been filed and briefed. In this scenario, 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 a finding that no genuine disputes of material fact exist for judgment to be granted to a party. *See, e.g., Weatherford/Lamb Inc. v. C&J Energy Servs. Inc.*, 96 USPQ2d 1834, 1836 (TTAB 2010); TBMP §§ 528.05(a)(2) and 702.04(c) (Jan. 2017).

### ***TIP***

- Parties interested in ACR should request a telephone conference with the assigned Interlocutory Attorney, who can assist the parties in negotiating a suitable ACR stipulation. In addition, the Board has developed several models to assist the parties in framing an ACR approach to their case. As noted *supra*, these options may be accessed from the Board’s home page under “TTAB Suggestions for ACR.”
- Parties not willing to stipulate to ACR still may agree to simplify proceedings by entering into a wide variety of factual and procedural stipulations. *See* Trademark Rule 2.120(a)(2)(iv); *see also Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007); TBMP § 702.04(e) (Jan. 2017).
- The 2017 amendments to the Trademark Rules made a number of ACR-type efficiencies available to all parties by stipulation (including, for example, to limit discovery and to rely on summary judgment materials as trial evidence).

### **Suspension for a Civil Action**

The Board generally orders suspension of a case when one or both parties are involved in a collateral civil action. All that need be shown is that the civil action *may* have a bearing on the Board proceeding. Trademark Rule 2.117(a). The Board has not changed its general practice in the wake of the Supreme Court’s decision in *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015).

The party that prevails in the civil action should file with the Board a motion to resume proceedings after time has elapsed for any appeal in the civil action. The motion should include the particular disposition of the Board case that the party believes is warranted and a copy of the court’s final decision.

### ***TIP***

- A party moving to suspend for a civil action should attach to its motion copies of the operative complaint and answer in the civil action. Failure to do so may delay consideration of the motion. TBMP § 510.02(a) (Jan. 2017).

### **Settlement and Suspension for Settlement**

Most Board cases settle. Plaintiffs withdraw complaints; defendants abandon applications or surrender registrations. Sometimes parties agree to make amendments or enter into consent agreements in an attempt to facilitate registration of pending application(s). 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, abandoned, or surrendered, and whether the Board case is to be dismissed with or without prejudice.

The mere existence of settlement negotiations does not discharge a party's obligation to comply with deadlines. Accordingly, it is prudent for parties involved in settlement discussions to stipulate to suspend proceedings. Such stipulations are subject to the right of either party to request resumption of the proceeding.

### ***TIPS***

- The Board prefers that parties stipulate to suspend for settlement rather than stipulate to extend deadlines. If the parties file multiple extensions for settlement discussions, the Board may *sua sponte* suspend proceedings. Trademark Rule 2.117(c).
- The Board is liberal in granting suspension to accommodate settlement discussions, but the Board also has an interest in bringing its cases to conclusion. 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. The Board retains discretion to condition approval of a consented or stipulated motion to suspend on the parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate. *Id.*
- Do not move to suspend or extend deadlines after an answer is filed, but before the required discovery conference on the basis of possible settlement. The Board is unlikely to find good cause to suspend or extend between the close of the pleadings and the deadline for the discovery conference, even on consent, because settlement is a subject to be discussed during the discovery conference. If suspension or extension is warranted for a reason other than to accommodate settlement discussions, the Board will consider a motion to suspend or extend filed after the pleadings close, but before the discovery conference is completed.

### **E. Discovery**

A party may seek discovery of any non-privileged matter that is relevant to the party's claims or defenses and proportional to the needs of the case. Trademark Rule 2.120(a)(1); *Emilio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015). Because Board proceedings concern only the right to registration, discovery in a Board proceeding generally is more limited than discovery in a trademark infringement action.

#### Initial Disclosures

Initial disclosures must be made no later than 30 days after the opening of the discovery period. They must include: (1) the identity of and contact information for each witness that a party is likely to use to support its case, and the subject matter about which each witness is likely to have discoverable information; and (2) the categories of documents on which a party may rely in prosecuting or defending its case and the location of such documents. Trademark Rule 2.120(a)(1) and (a)(2)(ii). Alternatively, a party may actually produce the

documents on which it may rely at trial. The Board favors this approach, as it streamlines discovery and may assist the parties in negotiating an early settlement.

A party may not pursue discovery until it has made initial disclosures. Trademark Rule 2.120(a)(3); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010). Parties have a duty to timely supplement initial disclosures unless the supplemental information or documents have been disclosed during discovery. FED. R. Civ. P. 26(e)(1); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1345 n.7 (TTAB 2013). A party that fails to timely supplement initial disclosures may be precluded from introducing the withheld information at trial. *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326, 1328 (TTAB 2011).

If an adverse party does not serve initial disclosures, a party may file a motion to compel. Under the 2017 amendments to Trademark Rule 2.120(f)(1), such a motion must be filed within 30 days of the initial disclosure deadline. If an adverse party does not comply with a Board order compelling initial disclosures, a party may move for sanctions. See *Kairos Inst. of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541 (TTAB 2008); TBMP §§ 523 and 527.02 (Jan. 2017).

### ***TIP***

- To maximize discovery time, be prepared to serve initial disclosures concurrently with the discovery conference.

### **Standard Protective Order**

As noted *supra*, the Board's standard protective order automatically applies to every case, unless the parties stipulate to modify it or to substitute an alternative agreement and the Board approves the stipulation. Trademark Rule 2.116(g). Accordingly, parties should not object to a discovery request on the ground that it seeks confidential information or documents, but rather should produce responsive information and documents designated under the appropriate tier of confidentiality. *Amazon Techs. Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009).

The 2017 rules amendments specify that the Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding a party's designation. Trademark Rule 2.116(g).

### **Written Discovery**

The 2017 rules amendments made significant changes to discovery practice. Discovery must be served early enough in the discovery period so that responses will be due no later than the close of discovery. Trademark Rule 2.120(a)(3). Interrogatories, document requests, and requests for admission are limited to 75 each. Trademark Rule 2.120(d), (e) and (i). One additional comprehensive request for admission independent of the 75 limit

may be propounded to authenticate specific documents produced by an adverse party. Trademark Rule 2.120(i).

A party may move to exceed the limits on written discovery on a showing of good cause. *Id.* If a party believes its adversary has exceeded 75 interrogatories, document requests, or requests for admission, the recourse is to assert a general objection on that basis. Trademark Rule 2.120(d), (e) and (i); *Emilio Pucci*, 118 USPQ2d at 1385.

The period to respond to written discovery is 30 days. Trademark Rule 2.120(a)(3). The 2017 rules amendments removed the provision that added five days to the response time after service by mail. Even when parties stipulate to service by first-class mail, the response time is 30 days from the date of service which, for service made by first-class mail, is the date of mailing.

The 2017 rules amendments require that all papers must be served by email unless otherwise stipulated. Trademark Rule 2.119(b). This includes discovery responses.

Objections to discovery requests must be stated with particularity. If an objection is made as to only a portion of a discovery request, the part objected to must be specified. FED. R. CIV. P. 33(b)(4), 34(b)(2)(B)-(C), and 36(a)(5). A party also must indicate whether it is withholding documents based on an objection. FED. R. CIV. P. 34(b)(2)(C). A party asserting privilege must provide a privilege log. FED. R. CIV. P. 26(b)(5)(A).

Failure to respond timely to discovery requests may waive the right to assert merit-based objections (e.g., objections that a request is overly broad, vague, ambiguous, burdensome, oppressive, or not calculated to lead to the discovery of admissible evidence). *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). Also, requests for admission are admitted as a matter of law when a party does not timely respond. FED. R. CIV. P. 36(a)(3); *Fram Trak Indus. Inc. v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006).

### ***TIPS***

- When drafting discovery requests, remember that such requests must be proportional to the needs of the case. Also, consult Section 414 of the TBMP, which sets out numerous examples of the types of information and documents that are discoverable in Board proceedings. Parties frequently come to the Board with discovery disputes that could have been resolved easily had the parties reviewed Section 414 of the TBMP and the relevant case law.
- Keep in mind the goose-gander rule: Generally, a party may not be heard to argue that a discovery request propounded by its adversary is improper when the party itself previously served a substantially identical request. *Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667 (TTAB 1986).
- For interrogatories and document requests, each subpart will count as a separate request for purposes of the 75 limit. Trademark Rule 2.120(d) and (e). The Board does not include instructions or definitions in counting interrogatories or

document requests; nor will these be viewed as having a “multiplying effect” on discovery requests. For example, if more than one mark is involved, or if only one mark is involved but instructions inform the responding party that responses should cover all of the party’s marks that contain any element of the one mark that is involved, then a discovery request seeking information or documents for each such mark will be treated as one discovery request.

- Serve discovery requests early in the discovery period to ensure that time remains for follow-up discovery before discovery closes.
- Parties frequently agree to extend discovery response periods, but under the 2017 rules amendments, they may not stipulate that responses are due after discovery closes. Trademark Rule 2.120(a)(3). Any agreement to extend discovery response periods should be reduced to writing to avoid misunderstandings and motions to compel. TBMP § 403.04 (Jan. 2017).
- A party that responds to a discovery request by indicating that it does not have the information or documents sought, or by objecting to providing the requested material, may be barred from introducing the material in evidence at trial if the propounding party objects on this basis. *See Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 n.5 (TTAB 1988).
- Although discovery requests must be served early enough to allow for responses before the close of discovery, the duty to supplement discovery responses continues after the close of discovery. FED. R. CIV. P. 26(e).

### Discovery Depositions

The discovery deposition of a person will be taken in the Federal judicial district where the person resides or is regularly employed, or anywhere the parties agree. Trademark Rule 2.120(b). The discovery deposition of a foreign party taken in a foreign country must be taken on written questions. Trademark Rules 2.120(c)(1) and 2.124. The Board will not order a person residing in a foreign country to come to the United States for his or her discovery deposition. *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998).

The discovery deposition of a nonparty must be secured by subpoena unless the witness is willing to appear voluntarily. Any issues related to the discovery deposition of a nonparty by subpoena (e.g., a motion to quash the subpoena or for sanctions for defiance of the subpoena) are within the control of the district court that issued the subpoena; the Board has no jurisdiction to address such issues. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014).

On stipulation of the parties or motion granted by the Board, a deposition may be taken by telephone or video conference. *See* FED. R. CIV. P. 30(b)(4); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007). The location of the telephonic or video deposition is

the same as a regular deposition: where the witness resides or is regularly employed or where the parties agree.

If a party witness objects and refuses to answer a particular question, the propounding party may wait until the completion of the discovery deposition and then file a motion with the Board to compel the witness to answer the question.

#### Disclosure of Testifying Experts

Experts are rarely used in Board cases because of the expense. A party that decides to use an expert witness must make an expert disclosure pursuant to FED. R. CIV. P. 26(a)(2). Trademark Rule 2.120(a)(2)(iii). Under the 2017 amendments to Trademark Rule 2.120(a)(2)(iv), the disclosure deadline always must be scheduled before the close of discovery. When an expert is disclosed, the Board generally will suspend proceedings and issue any necessary orders to allow for expert discovery and the disclosure of rebuttal experts. Trademark Rule 2.120(a)(2)(iii).

#### ***TIPS***

- Parties should resolve between themselves any curable defects in timely served expert disclosures. *See Gen. Council of the Assemblies of God v. Heritage Music Found.*, 97 USPQ2d 1890 (TTAB 2011).

#### **F. Motions in General; Motions for Summary Judgment**

Pursuant to the 2017 amendments to Trademark Rule 2.127(d), the filing of a potentially dispositive motion automatically suspends proceedings with respect to all matters not germane to the motion. The amendments also make clear that the Board may suspend proceedings *sua sponte*. Trademark Rule 2.117(c).

The deadline to respond to a motion for summary judgment is 30 days. Trademark Rule 2.127(e). As noted *supra*, because service between parties is now by email, the 2017 rules amendments removed the five days previously added to response periods for service by mail, so that the period to respond to all other motions and to file reply briefs is 20 days. Trademark Rules 2.119 and 2.127.

Reply briefs on motions are discouraged because they generally have little persuasive value. *No Fear*, 54 USPQ2d at 1553. A reply brief may be useful, however, if the 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. Any filing in the nature of a surreply, no matter how captioned, will not be considered. Trademark Rule 2.127(a) and (e)(1); *Pioneer Kabushiki Kaisha v. Hitachi High Techs. Am. Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005).

Briefs in support of or in opposition to a motion may not exceed 25 pages; reply briefs are limited to 10 pages. Trademark Rule 2.127(a). These page limits cannot be waived or exceeded, even by agreement of the parties. Exhibits to a motion are not counted toward

the page limit, but a table of contents, index of cases, or description of the record does count against the page limit.

The Board may grant a motion as conceded where the non-movant has failed to respond. Trademark Rule 2.127(a). Matters that are conceded or not potentially dispositive may be acted on by a single Administrative Trademark Judge, an Interlocutory Attorney, a Board paralegal, or order generated by ESTTA. Trademark Rule 2.127(c). An order “By the Board” has the same legal effect as an order issued by a three-judge panel. *Id.*

On the parties’ request or its own initiative, the Board may convene a telephone conference to decide a motion. Trademark Rule 2.120(j)(1). Telephone conferences are particularly helpful when a motion is time-sensitive (e.g., a motion to extend or a motion to quash a deposition). A party seeking a telephone conference on a motion should contact the assigned Interlocutory Attorney via phone. If the Interlocutory Attorney determines that it is appropriate to hear the motion by phone, he or she will contact the parties to schedule a mutually agreeable time for the conference.

The Board also may require the parties and their counsel to attend an in-person or telephone conference with a Board attorney, judge, or panel of judges to resolve complex discovery or pretrial issues. Trademark Rule 2.120(j)(2); *see also, e.g., Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633 (TTAB 2011); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1592 n.5 (TTAB 2011); TBMP § 502.06(b) (Jan. 2017).

### ***TIPS***

- The time to file a reply brief will not be extended or reopened, even by stipulation of the parties. Trademark Rule 2.127(a).
- Because the Board does not consider surreplies, a movant should not file a motion to strike a surreply.

### **Motions to Extend or Reopen**

Motions to extend or reopen a deadline are governed by FED. R. CIV. P. 6. Good cause must be shown to obtain an extension of an unexpired period. FED. R. CIV. P. 6(b)(1)(A); *Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). Excusable neglect must be shown to reopen an expired period. FED. R. CIV. P. 6(b)(1)(B); *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P’ship*, 507 U.S. 380 (1993); *Pumpkin, Ltd. v. Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

Settlement negotiations generally constitute good cause for a motion to extend, but if the movant believes that the motion will be contested, it is advisable to detail the supporting circumstances. The mere fact that settlement negotiations are ongoing usually will not constitute excusable neglect to reopen an expired period. *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859-60 (TTAB 1998).

If the Board denies a motion to extend or reopen, it is likely to leave schedules as set unless doing so would work some injustice (e.g., if the Board denies a motion to extend discovery, trial dates usually will be reset; if the Board denies a motion to extend a particular trial period, later periods likely will be reset). *Vital Pharms. Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011).

### ***TIPS***

- If possible, a party should file a motion to extend before the expiration of a deadline rather than a motion to reopen after a deadline has passed because the “good cause” standard applicable to extension requests is less onerous than the “excusable neglect” standard applicable to motions to reopen.
- A party seeking an extension without consent should not propose specific new deadlines or dates. Instead, the movant should request an extension for a specified length of time, measured prospectively from the date of the Board’s ruling on the motion. Otherwise, if the Board approves a motion to extend as uncontested, the movant may find that the requested extension period has expired.
- A plaintiff seeking to extend or reopen its trial period must be particularly careful. If the record is devoid of evidence to support the plaintiff’s arguments, the Board may deny a plaintiff’s motion to extend or reopen and proceed immediately to entry of judgment dismissing the case, as further discussed in the Trial section *infra*. *Vital Pharms.*, 99 USPQ2d at 1711.

### **Motions to Compel**

As noted in the Discovery section *supra*, under the 2017 amendments to Trademark Rule 2.120(f)(1), a motion to compel initial disclosures must be filed within 30 days after the initial disclosure deadline, while a motion to compel discovery must be filed before the deadline for the plaintiff’s pretrial disclosures. The Board will suspend proceedings pending the disposition of a motion to compel, except that the parties will remain obligated to serve initial disclosures, to respond to outstanding discovery requests, and to attend discovery depositions noticed prior to the filing of the motion to compel.

Discovery disputes almost always result from the parties’ failure to cooperate, rather than from genuine differences of opinion about what is discoverable under the applicable law. The Board will consider the merits of a discovery dispute only where the movant has shown that it made a good-faith effort to resolve the dispute and that the parties were unable to resolve their differences. Trademark Rule 2.120(f)(1); *see also Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014). A showing of a good-faith effort requires more than one telephone call, letter, or email exchange. The Board expects that the parties will engage in a meaningful effort to understand their differences and investigate ways to resolve their dispute. *Id.*; *Sentrol*, 231 USPQ at 667.

To demonstrate a good-faith effort, a movant should include in its motion the dates on which the parties communicated regarding the discovery dispute and a summary of such discussions, along with copies of any relevant correspondence. *Hot Tamale*, 110 USPQ2d at 1081. When no discovery responses have been provided, the showing of a good-faith effort need not be as great as when there is a dispute over the sufficiency of responses or the propriety of objections. When a significant number of discovery requests are in dispute, 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. *Sentrol*, 231 USPQ at 667.

### ***TIPS***

- Parties have a duty to cooperate under the Federal Rules of Civil Procedure and the Trademark Rules. The Board looks with extreme disfavor on those who do not cooperate in the discovery process. TBMP § 408.01 (Jan. 2017).
- The Board encourages parties to request a telephone conference when, despite good-faith efforts to resolve a dispute, they reach an impasse regarding discovery. *See Promgirl*, 94 USPQ2d at 1762. The Board also may *sua sponte* convene a telephone conference to decide a motion to compel.
- A movant has the burden of demonstrating that it is entitled to certain discovery and therefore should cite cases to support its position.
- To the extent possible, group related discovery requests together in a motion to compel. This will streamline the issues for the Board.
- A 2017 amendment to Trademark Rule 2.120(f)(2) provides that if a motion to compel is filed after discovery has closed, the parties need not make pretrial disclosures until directed to do so by the Board.

### **Motion for Discovery Sanctions**

A party may move for discovery sanctions where its adversary fails to comply with a prior Board order relating to discovery. A party also may seek sanctions (without first moving to compel) where an adversary fails to participate in the required discovery conference or to appear for its deposition, or clearly states that it will not make required disclosures or respond to discovery requests. Trademark Rule 2.120(h)(1) and (2); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

The Board may impose a range of discovery sanctions, including striking all or part of a party's pleading, prohibiting a non-complying party from relying on certain evidence at trial, and entering judgment against a disobedient party. Trademark Rule 2.120(h)(1) and (2). But the Board will not hold a party in contempt or award expenses, including attorneys' fees. Trademark Rule 2.127(f).

## Motions for Summary Judgment and Rule 56(d) Discovery

A party moving for summary judgment bears the burden of demonstrating the absence of any genuine disputes of material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987). This is a difficult burden to satisfy in Board proceedings, where the claims and defenses at issue generally are fact-intensive. But where the burden is met, summary judgment may avoid a costly and time-consuming trial. *See, e.g., Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861 (TTAB 2016); *Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409 (TTAB 2015).

A party may seek summary judgment only on pleaded claims or defenses. FED. R. CIV. P. 56(a). The Board will not entertain a motion for summary judgment on an unpleaded claim or defense unless the non-movant does not object on this basis and the parties treat the unpleaded issue on its merits. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); TBMP § 528.07(a) (Jan. 2017).

A motion for summary judgment may not be filed until after the moving party has made initial disclosures (except for a motion asserting claim or issue preclusion or lack of Board jurisdiction). Under the 2017 amendments to Trademark Rule 2.127(e)(1), a summary judgment motion must be filed before the plaintiff's deadline to serve pretrial disclosures. If a party believes that it cannot effectively respond to a motion for summary judgment without first taking discovery, it may file a motion pursuant to FED. R. CIV. P. 56(d) to take the needed discovery. Such a motion must be filed within 30 days of service of the motion for summary judgment. This deadline will not be extended or reopened. Trademark Rule 2.127(e)(1). A motion for Rule 56(d) discovery must be supported by an affidavit or declaration setting forth the specific subjects on which discovery is needed and why such evidence cannot be obtained other than from the party that filed the motion for summary judgment. *See* FED. R. CIV. P. 56(d); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992). 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.

Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. However, the 2017 amendments to Trademark Rule 2.127(e)(2) provide that if any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered as trial evidence, which may be supplemented by additional evidence during trial.

### **TIPS**

- A motion for summary judgment or opposition thereto must be supported with evidence. FED. R. CIV. P. 56(c)(1). A plaintiff moving for summary judgment

must remember to include proof of standing. Too often, the Board sees motions for summary judgment woefully lacking in probative evidence.

- Do not file a combined response to a motion for summary judgment and a cross-motion for discovery under FED. R. CIV. P. 56(d). The response brief will demonstrate that discovery is not needed to respond. *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes Inc.*, 63 USPQ2d 2009, 2012 n.8 (TTAB 2002); TBMP § 528.06 (Jan. 2017).
- A party that seeks summary judgment on an unpleaded claim or defense should simultaneously move to amend its pleading to assert the claim or defense on which the motion is based. *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 n.4 (TTAB 1989).
- Parties should avoid filing motions for summary judgment on claims of fraud. The factual question of intent, an element of a fraud claim, is particularly unsuited to disposition on summary judgment. *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991); *DaimlerChrysler Corp. v. Am. Motors Corp.*, 94 USPQ2d 1086, 1090 (TTAB 2010).

### **G. Trial**

The submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions, during assigned testimony periods correspond to the trial in court proceedings. Trademark Rule 2.116(e).

At trial, parties often confuse what evidence is automatically of record and what must be submitted. Pleadings are *not* automatically of record.

The files of opposed applications and registrations subject to petition for cancellation form part of the trial record and should not be resubmitted. Trademark Rule 2.122(b)(1). Statements made in affidavits and declarations in application and registration files, however, are not testimony on behalf of the applicant or registrant. Establishing the truth of matters asserted in such files is governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations. Trademark Rule 2.122(b)(2).

#### Pretrial Disclosures

Fifteen days before the opening of each testimony period, a party must disclose witnesses from whom it will take testimony or may call if the need arises, pursuant to the requirements of Trademark Rule 2.121(e). If a testimony deposition is noticed of a witness either not identified or improperly identified in pretrial disclosures, a party may move to quash the deposition. *Id.*

The pretrial disclosure deadline has new significance under the 2017 rules amendments. As noted *supra*, the following motions must be filed before the deadline for pretrial disclosures for the first testimony period:

- Motions to compel discovery. Trademark Rule 2.120(f)(1) and (2).
- Motions to test the sufficiency of a response or objection to a request for admission. Trademark Rule 2.120(i)(1) and (2).
- Motions for summary judgment. Trademark Rule 2.127(e)(1) and (2).

### ***TIPS***

- A party that plans to submit no witness testimony must so state in its pretrial disclosure. TBMP § 702.01 (Jan. 2017).
- Witnesses from whom a party intends to introduce testimony by affidavit or declaration must be identified in pretrial disclosures. Otherwise, the adverse party can move to strike the testimony. Trademark Rule 2.121(e).
- There is a distinction 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. When the deficiency is in the notice of examination, the motion to strike must seek exclusion of the entire testimony deposition and exhibits. *See Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1445 (TTAB 2009). Either type of motion must be promptly filed after the testimony is taken. Trademark Rule 2.123(e)(3).

### **Testimony**

Under the 2017 rules amendments, a party may opt to submit testimony in the form of an affidavit or declaration, subject to the right to oral cross-examination by the adverse party. Trademark Rule 2.123(a)(1) and (c).

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 a 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. Any objection raised during the deposition must be renewed in a brief on the case or the Board likely will consider the

objection to have been waived. *See generally* TBMP § 707.03 (Jan. 2017). Substantive objections, such as relevancy or hearsay, may be raised for the first time in the brief.

During deposition, a witness should answer questions notwithstanding objections (unless the information sought is, e.g., a trade secret or privileged). Otherwise, if the objection is not well-taken, the Board may construe the refusal against the non-answering party. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993); TBMP § 707.03(d).

Trademark Rules 2.123(f)(2) and 2.125(d) concern *filing* requirements for testimony depositions; Trademark Rule 2.125(a) through (c) concern *service* requirements. Parties should be served with copies of the transcript within 30 days of the deposition. Corrected, certified transcripts need only be filed prior to final hearing to be considered timely filed.

### ***TIPS***

- Deposition testimony must be submitted in written form. Transcripts must be full-sized (not condensed to multiple pages per sheet), and must include a word index. Trademark Rule 2.123(g)(1) and (3).
- Through submitting affidavits or declarations or taking oral depositions during the testimony period, a party may introduce into evidence not only the testimony of its witness, but also documents and other exhibits that may not be made of record by notice of reliance. Be selective, however, in the introduction of exhibits to a testimony deposition, affidavit, or declaration. 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 during deposition 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.
- If a party wishes to make of record its registrations through the oral testimony or declaration 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 any necessary post registration filings have been made to maintain it).
- All exhibits must be submitted electronically and must be clear and legible. Trademark Rule 2.126(a).

## Notices of Reliance

Notices of reliance are addressed in Trademark Rule 2.122(g), which was added in the 2017 rules amendments. The amended rules delineate procedures for notices of reliance and the types of evidence that may be submitted by them, including registrations owned by a party, printed publications and official records, and Internet materials. Trademark Rules 2.120(k), 2.122(d)(2), 2.122(e)(1) and (e)(2).

As explained in the *Ex Parte* discussion *supra*, the Board does not take judicial notice of USPTO records. Third-party registrations may be made of record by submitting plain copies of the registrations or of electronic printouts retrieved from the database of the USPTO. Trademark Rule 2.122(e)(1); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011). Lists of such registrations and trademark search reports from private company databases are inadequate. TBMP § 704.03(b)(1)(B) (Jan. 2017).

Evidence submitted by notice of reliance, as for other trial evidence, must be filed electronically, and must be clear and legible.<sup>1</sup> Trademark Rule 2.126(a).

### ***TIPS***

- The 2017 rules amendments specify that a notice of reliance must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Trademark Rule 2.122(g). Failure to meet this requirement will be considered a curable procedural defect. *Id.* Thus, this requirement should not be viewed as fertile ground for motion practice.
- Be judicious in submitting discovery responses to the Board. Rather than all admissible responses, consider submitting only those that advance the case. And bear in mind that denials of requests for admission – along with responses to document requests other than objections or statements that no such documents exist – are inadmissible. Trademark Rule 2.120(k)(3)(i); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1657 n.13 (TTAB 2014); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 & n.10 (TTAB 2008).
- As noted *supra*, the rules amendments permit a party to make one comprehensive request for admission authenticating specific documents produced by an adverse party, or specifying which of those documents cannot be authenticated. Trademark Rule 2.120(i). Parties also may authenticate their produced documents by stipulation. Trademark Rule 2.120(k)(3)(ii). Authenticated documents may be submitted by notice of reliance (along with the relevant stipulation or request and admission). Bear in mind, however, that

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<sup>1</sup> Evidence that by its nature cannot presently be submitted through ESTTA, such as DVDs, must be mailed to the Board. This exception does *not* apply to bulky documents, which must be submitted via ESTTA. Trademark Rule 2.123(f)(2).

authenticated documents remain subject to all Federal Rules of Evidence and may constitute hearsay if offered to prove the truth of the matter asserted.

### Dismissal for Failure to Prosecute or File Brief

When a plaintiff has failed to file any evidence, or has filed only copies of USPTO records that the defendant believes are insufficient to allow the plaintiff to carry its burden of proof, the defendant may move for dismissal. Trademark Rule 2.132(b). The Board also may grant judgment for the defendant *sua sponte* when it is clear from the proceeding record that the plaintiff has taken no testimony or offered any other evidence during its testimony period. Trademark Rule 2.132(a).

When a plaintiff fails to timely file a brief on the case, the Board may issue an order to plaintiff to show cause why the case should not be dismissed as conceded. If a plaintiff files a response to the order and shows good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered against the plaintiff for failure to take testimony or submit any other evidence. Trademark Rule 2.128(a)(3); *see also* TBMP § 536 (Jan. 2017).

### Briefs

Briefs should discuss the pertinent facts of a case in light of the relevant statutory and case law. All briefs should adhere to the page limits in Trademark Rule 2.128(b): 55 pages for main briefs and 25 pages for reply briefs. If a party files a brief in excess of the page limit without prior leave of the Board, the brief may not be considered. *Id.* Briefs must meet the requirements of Trademark Rule 2.126 and must contain an alphabetical index of cited cases, which is included in the page limit.

### ***TIP***

- When making an argument, cite the relevant record evidence by its location in the TTABVue record; e.g., 10 TTABVue 15-16.
- The 2017 rules amendments specify that evidentiary objections may either be raised in a party's brief on the case or instead set out in an appendix or separate statement of objections, which does not count against the briefing page limit. Trademark Rule 2.128(b).

### **H. Oral Hearing**

An oral hearing will be scheduled by the Board on request of at least one of the parties. Each side is allotted 30 minutes, and a plaintiff may reserve some of its time for rebuttal.

At hearing, stick to the facts of the case. The judges will have read the briefs but generally will not have reviewed the record and therefore may have questions about what is in the record and what is not.

### ***TIPS***

- Counsel must know the record and should be prepared to outline the most important aspects of the case at the hearing. The primary focus at the hearing, however, should be to answer questions asked by the panel and engage the judges in conversation about the case. For this reason, PowerPoint presentations are ineffective and strongly discouraged.
- If using a demonstrative exhibit, bear in mind that at least one judge is likely to participate in the hearing remotely. Therefore, be prepared with the record citation to the exhibit. New evidence should not be introduced at a hearing.

#### **IV. JUDICIAL REVIEW OF TTAB DECISIONS**

There are two mutually exclusive avenues of appeal from final decisions of the Board in both *ex parte* and *inter partes* cases. First, a party may appeal to the U.S. Court of Appeals for the Federal Circuit, which will review the decision from which the appeal is taken on the record before the USPTO. Second, a party may have remedy by civil action in a U.S. District Court, in which the court “may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear.” Trademark Act Section 21. Appeals are discussed in detail in TBMP Chapter 900.

The 2017 amendments to the Trademark Rules changed § 2.145, the rule pertaining to appeals of Board decisions, by reorganizing the subjects covered and rewording some provisions to improve the clarity and structure of the rule, and to align the provisions with the analogous rules governing judicial review of Patent Trial and Appeal Board decisions in 37 C.F.R. Part 90. Substantively, throughout Trademark Rule 2.145, the amendments removed specific references to times for taking action or other requirements that are specified in the Act or another set of rules (e.g., Federal Rules of Appellate Procedure) and replaced them with references to the applicable section of the Act or rules that set the time or requirements for the specified action. The amendments also changed the times for filing a notice of appeal or commencing a civil action from two months to sixty-three days (i.e., nine weeks) from the date of the final decision of the Board.

### ***TIPS***

- Under the 2017 amendments to the Trademark Rules, copies of notices of appeal, notices of election, and notices of civil action must be filed with the Board via ESTTA and separately with the Office of the General Counsel.
- Parties seeking review of *ex parte* decisions by way of civil action must serve the summons and complaint on the Director addressed to the Office of the General Counsel and a copy of the complaint via ESTTA.

- A notice of a civil action for review of a Board decision in an *inter partes* case must be filed no later than five business days after filing the complaint in district court, and must identify the civil action with particularity, i.e., by case name, case number, and court.
- It is unnecessary to request reconsideration before filing an appeal of a Board decision, but a party requesting reconsideration must do so before filing a notice of appeal or a civil action.
- Pursuant to Trademark Act Section 21(b)(3), in cases where there is no adverse party, the appealing party pays all expenses, including attorney fees, whether or not the appeal succeeds. *See Shammis v. Focarino*, 784 F.3d 219, 114 USPQ2d 1489 (4th Cir. 2015) (ordering applicant to pay \$36,320 in USPTO expenses).

**Generic Schedule**  
**Notation of Certain Items Affected by the 2017 Amended Rules**

No change to the conference, disclosure, discovery, and trial schedule sent to the parties is made by the 2017 rules amendments. However, certain amendments changed the timeliness of some motions and the schedule for written discovery requests. They are marked below as a quick reference guide.

<b>Time to Answer</b>	
<b>Deadline for Discovery Conference</b>	
<b>Discovery Opens</b>	
<b>Initial Disclosures Due</b>	<i>Motion to compel initial disclosures, if any, due in 30 days. 2.120(f)</i>
<b>Expert Disclosures Due</b>	<i>Effectively last day to serve written discovery requests. 2.120(a)(3)</i>
<b>Discovery Closes</b>	<i>Last day for responses to written discovery. 2.120(a)(3)</i>
	<i>Motions to compel discovery, test sufficiency of admission requests, and for summary judgment must be filed “prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset.” 2.120(f) – motions to compel; 2.127(e) – summary judgment motions</i>
<b>Plaintiff’s Pretrial Disclosures Due</b>	<i>Motion to offer into evidence a discovery deposition to be made at time of pretrial disclosures. 2.120(k)(2)</i>
<b>Plaintiff’s 30-day Trial Period Ends</b>	
	<i>Election of oral cross-examination must be made within 20 days from date of service of affidavit or declaration and completed within 30 days from the date of service of notice of election – suspension may be necessary.* 2.123(c)</i>
<b>Defendant’s Pretrial Disclosures Due</b>	
<b>Defendant’s 30-day Trial Period Ends</b>	
	<i>Same</i>
<b>Plaintiff’s Rebuttal Disclosures Due</b>	
<b>Plaintiff’s 15-day Rebuttal Period Ends</b>	
	<i>Same</i>

\* A deposition for oral cross-examination includes any redirect or recross that may occur.