

Track Two: TTAB-Focused Practice Updates and Strategies

Hon. Gerard F. Rogers
US Patent and Trademark Office, Trademark
Trial and Appeal Board
Alexandria, VA

I. General Information	4-1
II. Pre-Trial Considerations; Correspondence & Service	4-5
III. Inter Partes Pleading, Discovery, Discovery Motions	4-8
IV. Inter Partes Trials, Trial Motions, Briefing	4-21
Exhibit	
Exhibit A PowerPoint Presentation	4-27

I. General Information

A. Who We Are

The Board's Administrative Trademark Judges work in panels of three to decide inter partes cases that include records of varying quantity and quality, are briefed and, perhaps, argued orally. Before an inter partes case reaches this stage, however, a wide variety of filings or motions would have been handled automatically by the Board's electronic filing system (ESTTA) or by a Board legal assistant, paralegal or staff attorney.

An initial request to extend 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, will be processed automatically, if filed electronically through the Board's ESTTA system. Many oppositions filed electronically will be instituted automatically. Finally, many motions filed electronically will be automatically associated with the appropriate electronic case files, and routed to a Board paralegal or attorney for action; some consented motions are approved automatically. Board legal assistants handle the extensions of time to oppose, institution of new proceedings, and entry of motions that cannot be handled electronically.

The Board's large staff of paralegals handles an increasing number and variety of routine motions or may issue a variety of orders related to the status of a particular case. For example, in inter partes cases, paralegals process stipulated motions to extend or suspend (consented motions to extend or suspend may be processed automatically when filed electronically through ESTTA), 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, often referred to as Interlocutory Attorneys, review work of the legal assistants and paralegals on inter partes cases and handle all contested interlocutory matters that arise in inter partes cases.

Generally, every pending inter partes case that is not yet briefed and submitted for decision is assigned to a legal assistant (for entering motions and other filings), a paralegal, and a staff attorney (for deciding contested motions and managing progress of the case). Often, however, cases with fully briefed contested motions will be reassigned to attorneys for decision, as necessary to balance dockets. This is particularly true for summary judgment motions. The Board's two customer service representatives can inform callers which legal assistant, paralegal, or staff attorney is responsible for any particular request for an extension of time to oppose, newly filed opposition or cancellation, or "up and running" inter partes case. They can also answer some status inquiries, including inquiries regarding whether papers have been entered in case files; but receipt and entering of papers can now be checked in the TTAB VUE system, available through the USPTO website. The main phone number is (571) 272-8500.

B. Electronic Information

Use www.uspto.gov to access the USPTO's home page. In the main menu, a click on Trademarks will open a drop-down menu that provides three options for connecting to the TTAB. One is "TTAB," which connects to the TTAB's page and allows access to all TTAB resources. The others are "TTAB online filing," for a direct connection to ESTTA, and "View TTAB Files," for a direct connection to TTAB VUE. For direct access to the Board's page from your browser, use www.uspto.gov/web/offices/dcom/ttab/index.html.

Note that the Trademark Rules, in Title 37 of the C.F.R., the Trademark Act, in Title 15 of the U.S. Code, are accessed through a link on the main Trademarks page, or directly by typing www.uspto.gov/web/offices/tac/tmlaw2.html in your browser. Also, certain rules changes affecting Board practice were included in a larger package of changes resulting from U.S. accession to the Madrid Protocol, an international system for registering marks. The Federal Register notice regarding these changes can be accessed from the main Trademarks web page, or directly via www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf.

If you access the TTAB web page, you will find links to the Board's weekly summary of decisions issued, to the final Board decisions posted on the USPTO's FOIA site, and to various documents regarding policy and procedure subjects. These documents include the TTAB standard protective order, the *Official Gazette* announcement announcing the Board's permanent expansion of telephone conferencing for inter partes proceedings, and two announcements regarding 1998 rules changes, among others. (Do not expect to find a link to the Madrid Protocol final rule, because that is a broader set of rules change, as noted above, not a TTAB-specific rules change.)

CURRENT NOTES: (1) The Board's manual of procedure, the **TBMP** (not to be confused with the TMEP, the USPTO's manual of trademark examining procedure), can also be accessed via the Board's web page. The second edition of the TBMP issued in June 2003 only via the web. Neither the Office nor the GPO publishes the manual in hard copy form. Further revisions were prepared to reflect USPTO rules changes enacted in conjunction with U.S. accession to the Madrid Protocol. Thus, the current version of the manual is referenced as (2d ed. rev. 2004). (2) In the **January 17, 2006 issue of the Federal Register, the Board proposed numerous amendments to the rules governing inter partes proceedings**. A link to the proposals is on the TTAB page. The proposal, and all comments received in response thereto may also be viewed at www.regulations.gov.

TIP: If the answer to a practice and procedure question is in one of these sources, any call to the Board may be met with a 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.)

C. Electronic Filing and Proceeding Files

Over the past five years, the Board has implemented a system for creating electronic or “paperless” proceeding files, known as TTABIS. The great majority of pending inter partes proceeding files now exist in electronic form. Most of the remaining proceeding files are “hybrid” files, meaning that older paper submissions remain in proceeding folders on the Board’s docket shelves, but as new papers for these cases are filed, they are scanned into the TTABIS system and stored in electronic image form. The public interface for the TTABIS system is TTAB VUE.

The TTAB VUE system provides image records of all scanned or electronically filed 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, so there are various ways to search for information. 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. TTAB VUE can be accessed via a link on the TTAB web page.

There is also a link 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 brief for any pending inter partes or ex parte proceeding (opposition, cancellation, concurrent use and appeal). 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, effectively jumping to the head of the line.

Parties filing papers for proceedings that are already pending can use ESTTA as follows. 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). One should use the specific form for confidential material filed by ESTTA. Also, while there are various means for paying the filing fee when using ESTTA to file a new proceeding, there is not, at this time, any means for paying a fee associated with a paper for an already pending inter partes proceeding. Since papers requiring a fee once a case is up and running are few in number, this limitation generally will not present a problem. If, however, the paper requires a fee (for example, an answer with a counterclaim), and the filer has a USPTO deposit account, the ESTTA filing can authorize deduction of the fee from that account.

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.

D. How to Reach Us

All mail for the trademark matters **under the jurisdiction of the TTAB** should be directed to the general trademarks address, set out below.

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

For papers being delivered by hand or by courier, have the paper taken to the Trademark Assistance Center on the Concourse level of the Madison Building, 600 Dulany Street, Alexandria.

While the USPTO no longer uses any of the specialized "Box" addresses previously used for trademark mail, the 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 Trademarks.

Even advanced practitioners routinely send filings for opposed applications via TEAS or to the attention of the Examining Attorney who approved the mark for publication. Don't do it! It can cause serious delay. In one instance, a respondent in a cancellation case, with consent of the petitioner, submitted an amendment for its registration. But filing was made to the attention of the Post Registration section. It was not brought to the Board's attention until **two years after** the cancellation case had been dismissed, when the respondent filed a Section 8 & 15 affidavit reciting the amended identification.

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

Papers filed with the Board by mail are often accompanied by **unnecessary extra copies**. Don't send them. They waste paper and resources and are no longer required under any circumstances. In fact, originals are sometimes lost among the sea of unnecessary copies that must be discarded or recycled. See *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021 (TTAB 1998). Even better, use ESTTA whenever possible, for it results in faster processing for counsel and client.

NOTE: Changes to certain TTAB rules in the Madrid Protocol final rule removed the only four instances in which extra copies of papers were required. Thus, extensions of time to oppose no longer are filed in triplicate and a plaintiff's pleading in an opposition or cancellation no longer is filed in duplicate. Likewise, stipulated motions to extend dates in an inter partes proceeding, and final briefs on the case in such proceedings no longer are filed in triplicate. Each of these items should be filed without copies. In addition, when filing in paper form, please adhere to Trademark Rule 2.126, which requires, among other things, that paper submissions not be bound or contain tabs extending beyond the edge of the paper.

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, determining what claims 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 opposition period and/or negotiating to settle with an applicant during the opposition period (original or extended).

A. NO Suspension

The Board will not suspend the running of the opposition period 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. See TBMP §209.01(a). As a result, parties may find it necessary to file a motion to suspend for any of various reasons soon after institution of an opposition.

B. 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 Rules 2.84 and 2.133. Any amendment proposed by an applicant, whether of its own volition or to accommodate a concern of a potential opposer, should be faxed to Post Publication Amendments / Corrections at 571-270-9007. 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. See Trademark Rule 2.84(b).

TIP: Note that 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.

C. Pre-Trial Phase of Oppositions/Extension Practice

The attorney for an applicant, appointed 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 communi-

cate with applicant's counsel regarding the approval of extensions. Likewise, if an opposition is filed, the Board will notify the attorney.

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, they should include a request to change the correspondence address to the new attorney (see *infra*).

During the opposition period, 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 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 to settle their differences.

D. 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. See 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. See Trademark Rule 2.18. Also, because attorneys for applicants often have received a power of attorney in the filed application, a revocation or new power may be required when an applicant chooses new counsel.

E. 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. See *CTRL Systems Inc. v. Ultraphonics of North America 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 responsible for safeguarding the client's interests **unless counsel seeks, and is granted, leave to withdraw**. See Patent and Trademark Rules 2.19 and 10.40. Though the former of these two rules suggests that it is the Commissioner for Trademarks that must approve withdrawal, for an attorney whose client is involved in a Board proceeding, it is the Board that grants or denies requests to withdraw. See TBMP §513. **All too often, attorneys break with their clients and fail to file requests to withdraw.**

F. 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 or firm on each side of a case.

When an application or registration is assigned during pendency of a proceeding, the Board generally will join the assignee. The assignor remains a party. 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 who 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.

In one recent case involving an assignment of the mark relied on by plaintiff, the assignor's attorney specifically stated that correspondence should be conducted with him; the assignee did not file a motion to join or substitute. The assignor sought to withdraw the complaint but, because of the assignment and uncertainty regarding representation of the parties, the Board allowed time for the plaintiff's withdrawal of the proceeding to be rescinded. Per the request of counsel, plaintiff's copy of the order was sent only to assignor's representative. When no response was received, the case was dismissed. The assignee's later request to reopen was denied.

G. 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. Parties are well advised to reduce agreements to writing and file them in the form of a stipulation, or at least maintain a paper trail. See TBMP §501.02.

CURRENT NOTE: A recent change to Patent and Trademark Rule 2.119 means that a foreign party to a Board proceeding is no longer required to appoint a domestic representative. When an adversary is not resident in the United States and 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 not only have a domestic representative, U.S. counsel also represents them. Thus, this change should have significance in only a small number of Board cases.)

III. Inter Partes Pleading, Discovery, Discovery Motions

A. 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 of six months. 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 extensions are stated to be for the purpose of accommodating settlement talks.

B. Jurisdiction Over Applications/Registrations; Proper Captioning

Remember, 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, and undermine novice and experienced practitioners alike.**

C. Notice of Opposition and Petition for Cancellation

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: 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.

Exhibits to pleadings are not of record unless they are identified and introduced during testimony. 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.

NOTE: Plaintiffs currently are not required to serve a copy of the complaint on the defendant, however, the Board is in the process of considering comments received in response to its previously mentioned notice of proposed rulemaking, which would amend various rules and include requiring plaintiffs to serve the complaint on defendants. See Notice of Proposed Rulemaking at www.regulations.gov or www.uspto.gov/web/offices/dcom/ttab/index.html.

D. Filing Combined Pleadings

The TBMP clearly authorizes filing of combined or consolidated complaints. They can, however, present processing problems. To minimize potential problems, counsel should list all targeted applications or registrations in the caption for the pleading; title the document as a “Combined Notice of Opposition” or in some other appropriate manner; file only one check for all relevant fees, or make a specific authorization to make a single deduction for the total amount due from a deposit account; explain what you are filing in a cover letter; and **do not** send any copies, just the original.

E. Answer

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, make a formal motion. If you really believe that the pleading is lacking, then you should be willing to 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 Court of Appeals for the Federal Circuit, the Board’s reviewing court. Under certain circumstances, however, a laches or estoppel defense in an inter partes proceeding 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 at a later time. If the grounds are learned after answer, the counterclaim should be pleaded promptly after the grounds are learned.

F. Motions in General

Rule 2.127 is the Board's motions rule. The response period for any motion is 15 days from date of service; add 5 days if service was made by first class mail, Express Mail, or overnight courier. **Failure to file a brief in opposition to any motion may lead to it being granted as conceded; do not assume that a motion will be denied as ill-taken or untimely.** Reply briefs on motions are not required, are discouraged, and seldom make much difference. Nonetheless, they may be considered 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; "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, that govern responding to a motion. **Surreplies and any other filings, no matter how titled, will not be considered.** See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000) (reply brief read but given no weight; surreply returned to filer), and *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 n.2 (TTAB 1999) (Board exercised discretion to consider surreply filed prior to amendment of rules barring their filing).

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 October 9, 1998 amendments to the Board's rules introduced **page limits for briefs on motions.** These **cannot be waived or exceeded, even by agreement of the parties.**

G. Motions or Stipulations Relating to Late/No Answer

Late Answers—If you receive 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 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. Even experienced practitioners sometimes do this.

If you get a notice of default, do not call the Board attorney who signed the order to explain why you did not answer (*e.g.*, were 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 to issue the notice of default, so long as 30 days have passed since answer was due. The Board's legal assistants and/or paralegals draft notices of default and default judgment orders. Call customer service and ask who is handling entering of papers and mailing of orders for your case, so you can target your request for issuance of the notice of default.

When the defendant fails to answer on time but wants to defend on the merits, the plaintiff should consent to late filing of the answer if defendant asks, because they are almost universally allowed to answer and defend, and any money spent on contesting a motion to reopen time to answer, motion to cure default, or the like, is not well spent.

H. 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.

TIP: Remember that a plaintiff may respond to a motion to dismiss by filing an amended pleading. Since such amended pleading would be filed "before a responsive pleading is served" the amendment will be accepted "as a matter of course" and will effectively moot the motion under Rule 12(b)(6).

I. 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) 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, make a formal motion. If you really believe that the pleading is lacking, then you should be willing to file 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 the Court of Appeals for the Federal Circuit.

J. Motions to Extend/Re-open

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 reopen the time to answer and motions to extend time to file final briefs on the case, for unique reasons, are treated more liberally than motions to extend or reopen 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. **Good cause must be shown to obtain an extension under 6(b)(1); excusable neglect must be shown to obtain a re-opening under 6(b)(2). Many practitioners fail to distinguish the two.**

The Supreme Court's *Pioneer* decision (*Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et al.*, 507 U.S. 380 (1993)), and the Board's *Pumpkin* decision (*Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997)) are excusable neglect cases to note.

A frequent failure 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. The subjective belief must be borne out by objective facts tending to show that the movant relied, to its detriment, on promises of the adversary or that, under the totality of the circumstances, it was reasonable for the movant to defer otherwise necessary activities.

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 it having been contested, no further motions to extend will be approved except upon agreement of the parties or a showing of extraordinary circumstances. But the movant faced with sudden and unexpected resistance ought to file a reply brief if its motion was not particularly strong on the facts because it did not expect the resistance.

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. *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1928 (TTAB 1999).

A motion to extend that cannot be said by the movant to be consented to by the non-movant must not set forth a new deadline or dates. Instead, the movant must seek 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 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.

K. Discovery in General

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

The automatic disclosure provisions of the Federal Rules of Civil Procedure, as amended December 1, 1993, have not been applied in Board proceedings. Nor does the Board currently require a discovery conference. *See* 1159 TMOG 14 (February 1, 1994).

NOTE: The Board's January 17, 2006 notice of proposed rulemaking would inject a form of disclosure into inter partes cases, and would allow either party to request a conference to focus on possible settlement and on disclosure and discovery issues. The Board is in the process of reviewing the comments received in response to the notice and may yet issue a final rule addressing these issues. See Notice of Proposed Rulemaking at www.regulations.gov or www.uspto.gov/web/offices/dcom/ttab/index.html.

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 documents discovered late into the record. Remember, too, that **motions to extend discovery to allow for follow-up** or because of asserted inadequate responses, **may not be viewed favorably if the information was not sought until late in the discovery period.**

Note that under 1998 amendments to the Board's rules, the Board now provides a 180-day period for taking discovery and will "scrutinize carefully" any motions to extend discovery that are not filed by agreement of the parties. Extensions are becoming harder to obtain.

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).

L. Interrogatories

Interrogatories, counting subparts, may not exceed 75, except that the Board may allow more upon a showing of good cause or on stipulation. Remember to reserve some

portion of your 75 interrogatories for follow-up interrogatories unless you are sure that you will not be serving such follow-up. The Board does not count 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.

NOTE: In the referenced notice of proposed rulemaking, the Board has proposed to reduce the number of interrogatories. See the Notice of Proposed Rulemaking at www.regulations.gov or www.uspto.gov/web/offices/dcom/ttab/index.html.

M. Requests for Production of Documents

The place of 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. In appropriate cases, the Board may, upon motion, 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.

N. Requests for Admission

Requests for admission 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 admission to authenticate the produced documents. Then, at trial, you will be able to introduce the requests for admission, responses thereto, and the documents which were authenticated through the admissions via the notice of reliance procedure.

O. 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. A telephonic deposition is taken in the district and at the place where the witness is to answer the questions. While the Board has no objection if the parties wish to videotape 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 but must, instead, submit a written transcript. In contrast, a videotape of, for example, a commercial demonstration may come in 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.

P. 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.

A discovery deposition may only be taken during the discovery period, which generally is ongoing for all parties at the same time. A testimony deposition may only be taken by a party 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 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 or confidential.

Q. Motion for Protective Order

Most motions of this type stem from the parties having failed to agree on the provisions to be included in a protective agreement that will shield confidential or sensitive information from public view (when such information is filed with the Board), and from access by other than specific individuals (when such information is exchanged between the parties). The Board prefers the parties to agree on the terms of a protective agreement and will select between competing proposals only if absolutely necessary.

In the June 20, 2000 *Official Gazette*, the Board published a standard protective order. It is also accessible via the TTAB web page. Parties are free to adopt this as is or modify it to meet their needs. This may speed exchange of discovery material. If progress in discovery is being endangered because the parties cannot agree on the terms for a protective agreement, then the Board may impose the standard order.

NOTE: The notice of proposed rulemaking includes a provision that would make the Board's standard order automatically applicable in every inter partes proceeding. The parties, however, would remain free to enter into an agreement more to their liking and to substitute that for the Board's standard order. See Notice of Proposed Rulemaking at www.regulations.gov or at www.uspto.gov/web/offices/dcom/ttab/index.html.

R. Motion to Compel

It's no secret to litigators that judges do not like motions to compel. It should be no surprise to TTAB practitioners that Board attorneys don't 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—for the most part, 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 counsel credibility, through reference to patterns of conduct. Counsel perceived as the “bad guy” or the less cooperative of the parties' attorneys, 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 on a motion to compel cannot simply state that an effort has been made to settle the dispute. It is the obligation of the moving party to establish, by specific recitation of facts regarding conversations between counsel, or by submitting copies of correspondence exchanged between counsel, that the requisite effort to settle the dispute has been made. 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 percentage, 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.

Keep in mind that the TBMP includes specific guidelines on what is discoverable in Board cases. It is surprising how often disputes regarding discoverability arise, despite TBMP guidelines covering the point. In addition, counsel often use in Board cases discovery requests that might be routine in district courts but should not be propounded in Board cases. For example, while it is quite routine for litigators in court to seek identification of a party's proposed witnesses, TBMP §414(7) provides that a party need not specify the witnesses it intends to call. (Of course, this does not mean that a party can refuse to identify an individual as knowledgeable about a particular subject in response to an interrogatory and still use the witness at trial.)

NOTE: The notice of proposed rulemaking would require disclosure of witnesses a party plans to call at trial, or will call if the need arises. Disclosure of testifying experts would also be required. See the Notice of Proposed Rulemaking at www.regulations.gov or at www.uspto.gov/web/offices/dcom/ttab/index.html.

Keep in mind that the Board's caseload does 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 get 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.

Keep in mind that 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 that the 1998 amendments to the Board's rules of practice require a motion to compel (and the related motion to determine the sufficiency of responses to requests for admissions) to be filed prior to the opening of the first testimony period. Under the amended rules, the Board schedules sufficient time between the close of discovery and the opening of the first testimony period to allow for timely filing of a motion to compel, even in regard to discovery requests served at or near the end of the discovery period. Also under the amended rules, **the Board will suspend proceedings when it receives a motion to compel, but the filing of the motion shall not toll the time for a party to respond to outstanding discovery requests or to appear for any noticed deposition.**

S. 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 behind the eight ball, if it did not reduce to writing any agreement to extend its response period.

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

T. 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). (Although the Board may also enter such 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).)

U. 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 which 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 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.

The party which prevails in the civil action should file a motion to resume Board proceedings **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.

V. Motion for Summary Judgment

As a result of a string of reversals by the Federal Circuit in cases where the Board granted summary judgment, the prospects of a favorable ruling on a motion for summary judgment have been diminished. 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.

Any motion for summary judgment must be filed prior to the opening of the first testimony period for the plaintiff. 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 an 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 matter.

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.

When moving for summary judgment, make sure that your position is supported by evidence. 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 trial 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 genuine issues of material fact which are or are not in dispute. Although it is not required, it is helpful if the parties specifically list the issues not in dispute. This helps the Board get to the crux of the motion and may allow the Board to at least 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.

The 1998 amendments to the Board's rules of practice provide 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.

NOTE: Upon the consent or request of the parties, the Board has handled motions for summary judgment as the final record on which a case may be decided. Typically, such 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 cross-motions for sum-

mary judgment. The Board may soon engage in broader efforts to promote this option for “Accelerated Case Resolution,” and may actively seek to determine which pending cases would be attractive candidates for use of this option.

W. Motion for Discovery Under Federal Rule 56(f)

A 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. Do not file a Rule 56(f) motion if you can respond without discovery. Do not file a Rule 56(f) 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(f); the response will show that you do not need discovery to be able to respond.

The motion 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 a request for Rule 56(f) discovery is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment.

Note that the 1998 amendments to the **Board’s rules of practice allow a party filing a motion under Rule 56(f) 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(f) 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.

X. Presenting Motion/Response During Phone Conference

The Board conducted a pilot project regarding expanded use of telephone conferences to present and/or dispose of motions from mid-1998 until mid-2000.

During the pilot, some parties mistakenly assumed that conferences may be used for making oral reports regarding stipulations and agreed extensions. Conferences are not to be used as a substitute for filing agreed motions to extend or reopen. Some parties faxed the Board briefs on motions scheduled for consideration during phone conferences. This defeats one of the purposes of the phone conference. When a phone conference is scheduled, parties are to file, by fax or courier, only what the Board instructs them to file. Phone conferences are not to be used as a means for making oral arguments on motions that are already briefed; or be used as a means for making oral replies and surreplies.

The expanded availability of phone conferencing was extended from pilot program to a permanent change in June 2000. See the *Official Gazette* announcement of June 20, 2000 at 1235 TMOG 68. The announcement is also accessible via the Office’s web page,

as are all O.G. announcements. See also, the discussion of a phone conference in *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776-77 (TTAB 1999).

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 and for service on your adversary. Please note that the Board does not consider a phone request for a phone conference, when limited to merely requesting the conference and without any presentation of arguments on the subjects or motions to be presented during the conference, to constitute an impermissible ex parte communication. 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.

Y. Stipulations/Consented Motions to Dispose of Cases

Most Board cases settle. 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 plaintiff's application(s). Often, the resulting filings are improperly captioned, sent to the wrong correspondence box, 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 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, without prejudice, or without reference to whether dismissal is with or without prejudice (in the latter instance, dismissal generally would be presumed to be 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, Trademark's electronic filing system. 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.

IV. Inter Partes Trials, Trial Motions, Briefing

A. Trial in General

Although the involved application or registration file automatically is part of the record, remember that the allegations, specimens and other materials in the file are not evidence on behalf of the applicant or registrant. Allegations must be established at trial (as, for example, the dates of first use) and specimens and documents in the file must be identified and introduced as exhibits during testimony. Be mindful, however, that the allegations made and documents and things filed in an application or registration may be used as evidence *against* the applicant or registrant, that is, as admissions against interest and the like.

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.

Stipulate to facts. There is a real savings 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.

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.

B. 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 which 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 can similarly identify and certify his 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 videotaped format. A telephonic deposition is taken upon stipulation of the parties or following grant of a motion for leave to do so, and in the district and at the place where the witness is to answer the questions. While the Board has no objection if the parties wish to have a deposition videotaped, the testimony submitted to the Board must be in written form. The Board will not review any videotapes of depositions. In contrast, a videotape of, for example, a commercial demonstration may come in 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).

C. Making Objections During the Taking of Testimony

Depending on the nature of the objection to testimony, it must either be raised at the time of the testimony deposition; in a promptly filed motion to strike; or in the trial brief. If an objection could be cured if seasonably made, it must be raised promptly or it may later be found waived. An objection that could not have been overcome if presented at the deposition, such as an objection to the materiality of the testimony, or that the testimony constitutes hearsay or improper rebuttal, should not be raised by a motion to strike the deposition transcript. This is because ruling on the objection would require reading the testimony, and a decision on the objection will therefore be deferred until final hearing. Thus, objections that could not be overcome if presented at the deposition may be made at the deposition and should be renewed in the brief but should not prompt the filing of a motion to strike immediately after the deposition.

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, nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection. 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.

D. 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 contin-

uation 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 their 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.

E. 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. 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.

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

F. 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 admission as to the authenticity of the documents the adversary has produced, and then file a notice of reliance on the requests for admission, 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 admission.
- 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.

- Introduce the produced documents as exhibits during the cross-examination of the adversary's witness. This procedure is available only if the adversary takes testimony, and the documents pertain to matters within the scope of the direct examination.
- 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 must 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 (except that a defendant may serve responses either within 30 days after service of the request, or within 45 days after service of the complaint upon it by the Board).
- By agreement of the parties.

G. Motion to Amend Pleadings to Conform to Evidence

Amendments to pleadings **after** trial are allowed under Fed. R. Civ. P. 15(b) when an unpleaded issue was tried with the express or implied consent of the adversary. 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. Simple questions and answers at a deposition generally are not enough to show implied consent to trial of an unpleaded issue.

H. Motion to Strike Testimony/Notice of Reliance

Depending on the nature of the objection to testimony, it must either be raised at the time of the testimony deposition; in a promptly filed motion to strike; or in the trial brief. If an objection to testimony could be cured if seasonably made, it must be raised promptly during the deposition or it will be deemed to have been waived.

An objection that cannot be overcome when made during a deposition, such as an objection to the materiality of the testimony, or that the testimony constitutes hearsay or improper rebuttal, should **not** be the subject of a motion to strike the deposition transcript after it is filed. This is because ruling on the objection would require reading the testimony, which the Board will not do prior to final hearing. Thus, **objections as to the substance of testimony must be made during the deposition and then be renewed in the brief, but should not prompt the filing of a motion to strike.**

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 which is, for example, privileged or confidential. **If a witness refuses to answer a question during a testimony deposition, a motion to compel is *not* available, as it is in a discovery deposition.** Nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection.

There is a similar procedural/substantive dichotomy with motions to strike notices 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 it 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. Rather, the objection should be raised in the party's brief.

A plaintiff should not use the rebuttal testimony period for a second bite of the apple. Any evidence which 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. Defendants should promptly file a motion to strike improper rebuttal testimony and/or evidence.

I. 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. There is no need for string citations to prior case law. 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.


J. 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 may 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.


Exhibit A
PowerPoint Presentation

 UNITED STATES
PATENT AND
TRADEMARK OFFICE

ICLE 2007 Intellectual Property
Spring Seminar

TTAB Practice Updates and Strategies


Gerard Rogers
Administrative Trademark Judge
Gerard.Rogers@USPTO.GOV

 UNITED STATES
PATENT AND
TRADEMARK OFFICE

What's New?

- Proposed New Rules--71 F.R. 2498, January 17, 2006
- Comments from 28 individuals, law firms, IP organizations
- Proposed rules and comments posted at www.regulations.gov


2

 UNITED STATES
PATENT AND
TRADEMARK OFFICE

Tried and True


- Pleading
- Extensions/Suspensions
- Discovery Disputes
- Phone Conferencing
- Summary Judgment
- Trial Tips

3

 **Pleading**


- Use language of statute and/or citations to statute sections
- Remember you're not in federal court
- Easy on exhibits
- Be reasonable, avoid skirmishes and move forward; amend when needed

4

 **Pleading Motions**


- Motions to dismiss--FRCP 12(b)(6)--rarely successful
- Attachment of, or reference to, matters outside pleadings likely will result in treatment of MTD as MSJ
- Motions for judgment on pleadings—FRCP 12(c) rarely successful

5

 **Extensions/Suspension**

- No suspension during extended opposition period; extensions limited
- Reduce agreements to writing or document discussions
- When discussing settlement, please let us know
- When discussing settlement, suspension preferred over numerous extensions


6

 UNITED STATES PATENT AND TRADEMARK OFFICE

Extensions/Suspension

- An extension is an extension and a reopening is a reopening, no matter what you call it
- Focus on procedural facts
- Board is more liberal at pleading, briefing stages than during discovery and trial


7

 UNITED STATES PATENT AND TRADEMARK OFFICE

Discovery

- Remain mindful of duty to cooperate and be reasonable in requests
- Note availability of standard protective order
- Starting early makes you look good
- NOTE potential for changes under proposed new rules


8

 UNITED STATES PATENT AND TRADEMARK OFFICE

Discovery Requests


- Interrogatories (currently) "limited" to 75 and yet we still see arguments
- No limits on document requests or requests for admission, but exercise self control, *please*
- Depositions limited in number and duration (10 of 7 hours or less)

9

 **Discovery Responses**


- There are far too many objections to reasonable requests (even after accounting for overbroad requests)
- Respond in full when can, or in part, with partial objection, as needed
- Do Not move to strike, for unwarranted protective order or for sanctions

10

 **Good Motion to Compel**


- Discovery requests and responses complained of submitted with motion
- Timely and with strong *showing* by moving party of good faith effort to narrow issues in dispute
- Deficiencies in responses clearly identified and remedy/clarification sought clearly articulated

11

 **Bad Motion to Compel**


- Untimely and/or motion not supported by showing of good faith effort to resolve dispute
- Portion of deposition, discovery requests and responses not submitted with motion
- Nature of deficiency of response not clearly articulated

12

 **Motion for Sanctions**


- Take care to differentiate sanctions sought under FRCP 11, under 37 CFR 2.120(g)(1) or (g)(2), or under Board's inherent authority
- FRCP 11 not available in discovery and requires compliance with safe harbor provision

13

 **Discovery Sanctions**


- Failure to comply with Board order – 37 CFR 2.120(g)(1)
- Affirmative statement will not respond or witness fails to attend properly noticed deposition- 37 CFR 2.120(g)(2)

14

 **Discovery Sanctions**


- Do Not seek prior to issuance of order relating to discovery, except for 37 CFR 2.120(g)(2)
- Do Not rely on equivocal statement to invoke 2.120(g)(2)
- Do Not request that party be held in contempt; or award of costs, fees, expenses see 37 CFR 2.120(g)(1) and 2.127(f)

15

 **Phone Conferencing**


- Review announcement on TTAB Web page
- Not a means for presenting oral arguments on motions already briefed
- Think ahead--your case is one of hundreds on assigned attorney's docket
- Attorney has discretion whether to hold conference and when

16

 **Phone Conferencing**


- Request for conference may be refused if lengthy written filing already served
- Contact adverse party FIRST to discuss differences and possible dates/times for phone conference
- Contact assigned attorney SECOND and before filing anything

17

 **Phone Conferencing**


- When requesting conference be sure to note all pending motions
- If Board approves request or initiates conference, party must participate
- Requesting party will be expected to initiate conference call
- Board attorney or judge ultimately will decide matters which will be discussed

18

 **Summary Judgment**


- Ground upon which you seek summary judgment must be a ground that was raised in the pleadings
- MSJ must be filed prior to opening of first trial period. *Exceptions:* agreement of the parties to allow consideration of MSJ; claim or issue preclusion; ACR

19

 **Summary Judgment**


- Evidence: Pleadings; depositions or portions thereof; interrogatory responses; produced documents; admissions responses; Nexis; Internet; publications; government documents (including TEAS/X-Search, but not private search reports or mere lists)

20

 **Summary Judgment**


- No notices of reliance necessary
- Affidavits necessary for testimony setting forth personal knowledge of witness or foundation for other items, e.g., Internet evidence

21

 **Summary Judgment**


- 30-day period for responding to the motion, not the standard 15-day period for responding to other types of motions
- Extension may be obtained, but not if the response will be to file a motion for discovery under FRCP 56(f)

22

 **Summary Judgment**


- Non-moving party must choose between filing response on merits or seeking extension of time to respond until after it has had an opportunity to take discovery necessary for framing a response
- If seeking FRCP 56(f) discovery must do so within 30 days—no extensions

23

 **A Few Tips for Trial**


- Depositions of your own witnesses by notice alone; of adverse witnesses or third parties by subpoena; no FRCP 30(b)(6) depositions during trial
- Telephone participation should be by stipulation approved by Board
- Serve working copy of transcript promptly, serve corrected copy before briefing

24

 **Trial Tips**


- Notice of reliance *can* be used for: interrogatory responses, discovery depositions, responses to requests for admissions, printed publications of general circulation, and official records
- *Cannot* use notice of reliance for: produced documents, business records, Internet evidence

25

 **Trial Tips**


- Parties free to stipulate to facts
- Parties free to stipulate to presentation of testimony by affidavit or declaration
- Parties free to stipulate to authenticity of documents produced during discovery
- Parties free to stipulate to introduction of Internet evidence

26

 **Proposed New Rules**


- Plaintiffs will serve complaints on defendants
- Modified form of district court disclosure regime adopted
- No more filing on CD-ROM
- Briefing rule for motions clarified

27

 **Service Requirement**


- Plaintiffs will serve complaints on defendants
- Plaintiff expected to rely on Office records, including assignment records
- Serve additional copy on entity believed to have an interest in application or registration??
- Notify Board of returned service copy

28

 **Settlement Conference**


- Parties must have settlement/discovery conference within 30 days of due date for answer
- Board attorney or judge will participate on request of either party (by phone)
- Seek participation of Board no later than 10 days before conference deadline

29

 **Disclosure/Discovery**


- Standard protective order applicable
- Discovery opens 30 days after due date for answer
- Disclosures due 30 days after discovery opens
- May not seek discovery from adverse party until you have made disclosures
- May not file MSJ until you have made disclosures

30

 **Settlement**


- Board will continue to be liberal in granting extensions of time to answer or suspension *prior to answer* for settlement talks
- Once answer is filed, unlikely to find good cause to delay the settlement/discovery conference

31

 **Settlement**


- After settlement/discovery conference, parties will again be able to seek extensions or suspension re: disclosure deadline, for settlement talks
- Parties may be more likely to discuss settlement after some disclosure

32

 **Scope of Disclosure**


- More limited (?!) than in federal court, because of limited jurisdiction, governing analytical precepts
- Party likely to be found to have met disclosure obligation if it discloses information on subjects listed in notice, as applicable in particular case

33

 **Other Disclosures**

- Plans to use experts must be disclosed 90 days prior to close of discovery
- Pre-trial disclosure, generally limited to identification of witnesses and summary of subjects for their expected testimony, must be made 30 days prior to opening of first testimony period

34

 **Thinking Ahead**

- Who will you serve?
- How will you use settlement/discovery conference?
- Do you want to stipulate to skip disclosures or agree to disclose a fair amount?
- Want a different protective order?
- Do you want to use Accelerated Case Resolution (ACR)?

35
