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Chapter 400 DISCOVERY

401 In General

Through the use of the various discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in inter partes proceedings before the Board; a party may ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case, may simplify the issues, or may reveal a basis for a motion for summary judgment, an additional claim (in the case of a plaintiff), or an additional defense or counterclaim (in the case of a defendant). At the very least, discovery enables the discovering party to better prepare for trial.¹

The conduct of discovery in Board inter partes proceedings is governed by 37 CFR § 2.120. Discovery before the Board under 37 CFR § 2.120 is similar in many respects to discovery before the Federal district courts under the Federal Rules of Civil Procedure. Ordinarily, the discovery provisions of the Federal Rules of Civil Procedure are applicable in Board inter partes proceedings, except as otherwise provided in 37 CFR § 2.120. However, the provisions of the Federal Rules relating to automatic disclosure and pretrial conferences are not applicable in Board proceedings. *See* 37 CFR § 2.120(a). Specifically, the following provisions do not apply: Rules 16(b); 26(a)(1)-26(a)(4); 26(b)(4); 26(d) first sentence; 26(e)(1); 26(f); 26(g)(1); 30(a)(2)(C); 33(a) last sentence; 34(b) last sentence of first paragraph; 36(a) last sentence of first paragraph; 37(a)(2)(A); 37(c)(1); and 37(g).²

The differences that exist between the two discovery systems are due primarily to the administrative nature of Board proceedings.³

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those that do not.⁴

¹ *For a discussion of the purposes served by discovery, see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979). *See also* *Bison Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) and *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978).

² *See* "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). *See also, for example, Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999) (petitioners need not prepare list of trial witnesses and documents), *appeal filed, Pro-Football, Inc. v. Harjo, mot. to dismiss denied, (not reported in F.Supp.2d)*, 57 USPQ2d 1140 (D.D.C. 2000).

³ *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing procedure in inter partes proceedings are adapted from the Federal Rules with modifications appropriate to the administrative process).

⁴ *See* TBMP § 408.01 (Duty to Cooperate).

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402 Scope of Discovery

402.01 In General

The general scope of the discovery that may be obtained in inter partes proceedings before the Board is governed by Fed. R. Civ. P. 26(b)(1), which provides, in part, as follows:⁵

Parties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party, including the existence, description, nature, custody, condition, and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. ... Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. ...

A party may take discovery not only as to matters specifically raised in the pleadings,⁶ but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim.⁷

A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way.⁸

Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding.⁹

⁵ See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988) (admissibility not necessary). See also *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975) (relevancy construed liberally).

⁶ See *Varian Associates v. Fairfield-Noble Corp.*, *supra* and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition).

⁷ See *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information concerning possible abandonment, if revealed, may provide basis for counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (the mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, cannot be construed as a collateral attack on the registration); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974).

⁸ See *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (scope of discovery limited only by restrictions in Rule 26(b)(1) of Federal Rules).

⁹ Fed. R. Civ. P. 26(g). See *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984); and TBMP § 408.01 (Duty to Cooperate).

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In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of Fed. R. Civ. P. 26(g), a certification by the party or its attorney that, *inter alia*, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary.¹⁰ A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another.¹¹

402.02 Limitations on Right to Discovery

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, *inter alia*, it is unreasonably cumulative or duplicative; or is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive; or "where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information."¹²

For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by

¹⁰ See *Fed. R. Civ. P. 26(g)*. See also *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (petitioner estopped to challenge respondent's interrogatories as excessive in number having served virtually identical set on respondent); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties served identical discovery requests on each other and are constrained to answer each completely). See also *Medtronic, Inc. v. Pacemaker Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (applicant, having served 114 interrogatories, is estopped from challenging opposer's 122 interrogatories as excessive); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 623 (TTAB 1974); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477 (TTAB 1974); and TBMP § 408.01 (Duty to Cooperate).

Cf. *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990) as cited in *Miss America Pageant v. Petite Productions, Inc.*, *supra* at 1069 (no estoppel where opposer served a different, albeit also excessive, set of interrogatories on applicant).

¹¹ See *Miss America Pageant v. Petite Productions, Inc.*, *supra* at 1069 (Board was persuaded that certain interrogatories would be burdensome).

¹² *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696, 1699 (Fed. Cir. 1990) and Fed. R. Civ. P. 26(b)(2). See also, for example, *Haworth Inc. v. Herman Miller Inc.*, 998 F.2d 975, 27 USPQ2d 1469, 1472 (Fed. Cir. 1993) (must first seek discovery from party before burdening nonparty); *Katz v. Batavia Marine & Sporting Supplies Inc.*, 984 F.2d 422, 25 USPQ2d 1547, 1549 (Fed. Cir. 1993) (in response to nonparty's prima facie showing that discovery was burdensome, party did not meet burden of showing need for information sought), and *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999) (motion for protective order to prohibit deposition of "very high-level official of a large corporation" granted).

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providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.¹³

In addition, a party will not be permitted to obtain, through a motion to compel, discovery broader in scope than that actually sought in the discovery request(s) to which the motion pertains.¹⁴

The Board may refuse to permit the discovery of confidential commercial information, or may allow discovery thereof only under an appropriate protective agreement or order.¹⁵ Similarly, information protected by the attorney-client privilege is not discoverable unless the privilege has been waived,¹⁶ and documents and things prepared in anticipation of litigation or for trial by or

¹³ See, for example, *See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 115 S.Ct. 1426 (1995) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, objection to evidence introduced by applicant at trial was overruled); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) (production of representative sample was not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 148 (TTAB 1985) (representative sample of invoices from identified calendar quarters is sufficient where there are so many items as to make respondent's task unduly burdensome); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (permitted to identify reasonable number of corporate officers most knowledgeable); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (burden of calculating sales and advertising figures in round numbers for six categories of goods for each year since 1936 mitigated by limiting sales figures to five most recent years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (applicant allowed to produce ten representative samples of documents pertaining to the marketing of each copy machine or as alternative, may allow opposer's representative to visit sites where relevant documents are kept); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowed to furnish representative samples of advertisements).

¹⁴ See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980).

¹⁵ See, for example, Fed. R. Civ. P. 26(c); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1862 (TTAB 2001) (protective agreement would adequately protect against disclosure of trade secret manufacturing and technical information); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (unless issue is abandonment or first use, party need not reveal names of its customers, including dealers, it being sufficient to identify classes of customers and types of businesses); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980) (need for names of customers, as in case where issue is abandonment, outweighs justification for protecting customer confidentiality); and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (protective order must contain provision that customer names will be revealed only to applicant's attorneys). See also *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) and TBMP § 412 (Protective Orders).

¹⁶ See, for example, Fed. R. Civ. P. 26(b)(5) and *Red Wing Co. v. J. M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (party making claim of privilege must do so expressly and otherwise describe the nature of the withheld information as provided in Rule 26(b)(5)).

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for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means.¹⁷

403 Timing of Discovery

403.01 In General

37 CFR § 2.120(a) ... The Trademark Trial and Appeal Board will specify the opening and closing dates for the taking of discovery. The trial order setting these dates will be mailed with the notice of institution of the proceeding. The discovery period will be set for a period of 180 days. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.

...

When a timely opposition or petition to cancel in proper form has been filed, and the required fee has been submitted (or at the time described in 37 CFR § 2.92 for an interference and 37 CFR § 2.99(c) for a concurrent use proceeding); the Board sends out a notice advising the parties of the institution of the proceeding.¹⁸ The notice includes a trial order setting the opening and closing dates for the discovery period and assigning each party's time for taking testimony.¹⁹ The date set for the close of discovery is 180 days after the opening of discovery.

The discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period.²⁰ A party has no obligation to respond to an untimely request for discovery.

¹⁷ See, for example, Fed. R. Civ. P. 26(b)(3) and (b)(5); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975). See also *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974) and TBMP § 412 (Protective Orders).

¹⁸ See 37 CFR §§ 2.105 and 2.113; and TBMP §§ 310, 1003 and 1106.

¹⁹ See 37 CFR §§ 2.120(a) and 2.121(a).

²⁰ See *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (although a specific time period is not provided in Rule 34, it is implicit that utilization thereof is limited to the discovery period) and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978).

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403.02 Time for Service of Discovery Requests

37 CFR § 2.120(a) ... *Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.*

Interrogatories, requests for production of documents and things, and requests for admission may be served on an adversary from the day the discovery period opens through the last day of the discovery period, even though the answers thereto will not be due until after the discovery period has closed.²¹ However, discovery depositions must be not only noticed but also taken during the discovery period (unless the parties stipulate that the deposition may be taken outside of the period).²²

403.03 Time for Service of Discovery Responses

37 CFR § 2.120(a) ... *Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days from the date of service of such discovery requests. ...*

Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days after the date of service of the request for discovery.²³ If service of the request for discovery is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the request.²⁴

Discovery in proceedings before the Board is not governed by any concept of priority of discovery or deposition. That is, a party which is the first to serve a request for discovery does not thereby gain a right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Rather, a party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor

²¹ See *Luemme Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999). See also *Rhone-Poulenc Industries v. Gulf Oil Corp.*, *supra*; *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974); *AMP Inc. v. Raychem Corp.*, 179 USPQ 857 (TTAB 1973); and *Deere & Co. v. Deerfield Products Corp.*, 176 USPQ 422 (TTAB 1973).

²² See 37 CFR § 2.120(a). See also *Smith International, Inc. v. Olin Corp.*, *supra*; and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, *supra*.

²³ See 37 CFR § 2.120(a) and Fed. R. Civ. P. 33(b)(3), 34(b), and 36(a).

²⁴ See 37 CFR § 2.119(c), and TBMP § 113.05. See also *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987).

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under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery.²⁵

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits.²⁶ Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.²⁷ In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.²⁸

403.04 Extensions of Discovery Period and/or Time to Respond to Discovery Requests

37 CFR § 2.120(a) ... *The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.*

* * * *

... The time to respond [to interrogatories, requests for production of documents and things, and requests for admission] may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery

²⁵ See Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986).

²⁶ See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). See also *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding time to answer); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (party seeking discovery is required to make good faith effort to determine why no response has been made before coming to Board with motion to compel).

²⁷ See *No Fear Inc. v. Rule*, *supra* at 1554.

²⁸ See *No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

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and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

37 CFR § 2.121(a)(1) ... *The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party.*

The closing date of the discovery period may be extended by stipulation of the parties approved by the Board, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. An extension of the closing date for discovery will result in a corresponding extension of the testimony periods without action by any party.²⁹

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period.³⁰ Thus, a party which waits until the waning days of the discovery period to serve interrogatories, requests for production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto after the close of the discovery period, that it needs an extension of the discovery period in order to take "follow-up" discovery.³¹

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, rob its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion.³²

The time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. However, an extension of a party's time to respond to an outstanding request for discovery will not result in an automatic corresponding extension of the discovery and/or

²⁹ See 37 CFR § 2.121(a)(1). *For information concerning stipulations to extend, see TBMP § 501.03. For information concerning motions to extend, see TBMP § 509.*

³⁰ See *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed); and Janet E. Rice, *TIPS FROM THE TTAB: The Timing of Discovery*, 68 Trademark Rep. 581 (1978).

³¹ See *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1316 n. 4 (TTAB 1992).

³² See *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975).

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testimony periods.³³ Such periods will be rescheduled only on stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.

A stipulation to extend or reopen only the time for responding to a request for discovery (that is, not to extend or reopen also the closing date for the discovery period and/or testimony periods) does not have to be filed with the Board. However, to avoid any misunderstanding between the parties as to the existence and terms of such a stipulation, it is recommended that the stipulation be reduced to writing, even if it is not filed with the Board.

403.05 Need for Early Initiation of Discovery

403.05(a) To Allow Time for "Follow-up" Discovery

If a party wishes to have an opportunity to take "follow-up" discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and serve additional discovery requests prior to the expiration of the discovery period.³⁴

403.05(b) To Facilitate Introduction of Produced Documents

37 CFR § 2.120(j)(3)(ii) A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).

37 CFR § 2.122(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered, and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official

³³ See 37 CFR §§ 2.120(a) and 2.121(a); and *PolyJohn Enterprises Corp. v. 1-800-TOILETS, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002) (mistaken belief that resetting time to respond to discovery also extended discovery and testimony periods did not constitute excusable neglect to reopen).

³⁴ See TBMP § 403.04 (Extensions of Discovery and Time to Respond).

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record of the [United States] Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Documents produced in response to a request for production of documents may not be made of record by notice of reliance alone, except to the extent that the documents are admissible by notice of reliance as printed publications or official records under 37 CFR § 2.122(e). However, there are a number of different methods by which documents produced in response to a request for production of documents that do not qualify for submission under Rule 2.122(e) may be made of record.³⁵ Three of the easiest methods are available for use only if the request for production of documents is served relatively early in the discovery period.

First, if the discovery period has not yet expired, a party that has obtained documents from another party through a request for production of documents may serve on its opponent a request for admission of the genuineness of the subject documents, which should be attached as exhibits to the request for admission.³⁶ Then, during its testimony period, the propounding party may file a notice of reliance, pursuant to 37 CFR § 2.120(j)(3)(i), on the request for admission, the exhibits thereto, and its adversary's response.

Second, if the discovery period has not yet expired, the party which obtained the documents may make them of record by taking a discovery deposition of its adversary, marking the documents as exhibits thereto, and having the witness identify the documents during the deposition. The propounding party may then submit the deposition and identified exhibits during its testimony period under a notice of reliance.

Third, the request for production of documents may be combined with a notice of the taking of the adversary's discovery deposition; that is, the combined request and notice may ask that the deponent bring the requested documents to his or her deposition. However, a party served with a request for production of documents has 30 days from the date of service of the request in which to respond thereto, plus an extra 5 days if service of the request was made by first-class mail, "Express Mail," or overnight courier.³⁷

³⁵ See TBMP § 704.09 (Discovery Depositions). For a full discussion of making evidence of record in a Board proceeding, see Chapter 700.

³⁶ See Fed. R. Civ. P. 36(a).

³⁷ See TBMP § 403.03 (Time for Discovery Responses).

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Moreover, in proceedings before the Board, a discovery deposition must be both noticed and taken before the end of the discovery period.³⁸ Thus, a combined notice of deposition and request for production of documents normally must be served at least 35 days prior to the close of the discovery period.

404 Discovery Depositions

404.01 When and By Whom Taken

Discovery depositions must be both noticed and taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period).³⁹ Discovery depositions generally may be taken by any party.

404.02 Who May be Deposed

A discovery deposition generally may be taken of any person, whether or not the person is a party, and whether or not the person resides in the United States. However, the Board's permission must be obtained under the following circumstances:⁴⁰

- (1) If the person to be examined is confined in prison; or
- (2) If, without written stipulation of the parties, (i) a proposed deposition would result in more than ten depositions being taken by the plaintiffs, or by the defendants, or (ii) the person to be examined already has been deposed in the case.

For information concerning limitations on the right to discovery, see TBMP § 402.02.

³⁸ See TBMP § 403.02 (Time for Discovery Requests).

³⁹ See *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (it is clear from the language of Fed. R. Civ. P. 30 and 33 that while interrogatories need only be "served" during the discovery period, depositions must be "taken" during the discovery period); and TBMP § 403.02 (Time for Service of Discovery Requests)

⁴⁰ See Fed. R. Civ. P. 30(a).

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404.03 Place of Deposition; Oral or Written Deposition; Securing Attendance of Deponent

404.03(a) Person Residing in the United States – In General

37 CFR § 2.120(b) Discovery deposition within the United States.

The deposition of a natural 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 by stipulation. ...

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 by stipulation.⁴¹ The deposition may be taken either orally, or on written questions in the manner described in 37 CFR § 2.124.⁴²

404.03(a)(1) Person Residing in United States – Party

If a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, the deposition may be taken on notice alone.⁴³

404.03(a)(2) Person Residing in United States – Nonparty

37 CFR § 2.120(b) Discovery deposition within the United States.

... The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure.

⁴¹ See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (general rule in Federal district court that a plaintiff is required to make itself available for examination in district where suit is brought does not apply in Board proceedings).

⁴² See Fed. R. Civ. P. 26(a)(5), 30, and 31. For information on the taking of a discovery deposition on written questions, see TBMP § 404.07.

⁴³ See 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). For information concerning notices of deposition, see TBMP § 404.05. For information concerning testimonial depositions of adverse witnesses residing in United States, see TBMP § 703.01(f)(2).

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If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent.⁴⁴ If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45.⁴⁵ The subpoena must be issued from the United States district court in the Federal judicial district where the deponent resides or is regularly employed.⁴⁶

If a person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States District Court that issued the subpoena; the Board has no jurisdiction over such depositions.⁴⁷

404.03(b) Person Residing in a Foreign Country – Party

37 CFR § 2.120(c) Discovery deposition in foreign countries.

(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the

⁴⁴ See 37 CFR § 2.120(b).

⁴⁵ See *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2048-49 (TTAB 1988) (deposition of former employee can only be taken by voluntary appearance or by subpoena); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383-384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Fed. R. Civ. P. 30(a)(1) and 45.

Cf., regarding testimony depositions, *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (testimony deposition on written questions of adverse party); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (testimony deposition of adverse witness); and TBMP § 703.01(f)(2) (Unwilling Witness Residing in U.S.).

⁴⁶ See generally cases cited in preceding footnote.

⁴⁷ See, for example, *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (motion to quash subpoenaed third-party depositions due to scheduling problems denied). See also *In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201 (D.Del. 1973); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318 (TTAB 1971); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383-384 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

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manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

The discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party may be taken on notice alone.⁴⁸

However, if the discovery deposition of such a person is taken in a foreign country, it must be taken on written questions, in the manner described in 37 CFR § 2.124, unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination.⁴⁹

For information concerning the procedure for taking discovery depositions on written questions, see TBMP § 404.07. For information on a motion to take a foreign deposition orally, see TBMP § 520.

The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition.⁵⁰

⁴⁸ See 37 CFR §§ 2.120(c) and 2.124. Compare TBMP § 703.01(g) (Persons Before Whom Depositions may be Taken); the *testimony* deposition of an adverse party, unless obtained voluntarily, may be taken in a foreign country, if at all, only by the letter rogatory procedure or by procedures provided under the Hague Convention or other applicable treaties.

⁴⁹ See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); 37 CFR § 2.120(c)(1); and TBMP § 520 (Motion to take Foreign Deposition Orally). See also *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1925 (TTAB 1989) (by motion); *Fischer Gesellschaft m.b.H. v. Molnar and Company, Inc.*, 203 USPQ 861, 866 (TTAB 1979) (by motion); *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (by stipulation); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984). Cf. TBMP § 703.01(b) (Form of Oral Testimony Depositions).

⁵⁰ See *Jain v. Ramparts Inc.*, *supra* at 1431 and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978) (deposition may only be taken by written questions unless otherwise stipulated, or unless the party is present in the U.S.). See also *Miller v. N. V. Cacao-En Chocoladefabrieken Boon*, 142 USPQ 364 (E.D. N.Y. 1964); and Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253 (1980) and *Jonergin Co. v. Jonergin Vermont Inc.*, *supra*.

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404.03(c) Person Residing in a Foreign Country – Nonparty

404.03(c)(1) Willing Nonparty

The discovery deposition of a natural person who resides in a foreign country, and is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party, i.e., in the manner described in TBMP § 404.03(b).⁵¹

404.03(c)(2) Unwilling Nonparty

There is no certain procedure for obtaining, in an inter partes proceeding before the Board, the discovery deposition of a natural person who resides in a foreign country, is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, and does not agree to appear voluntarily to be deposed. However, a party may be able to obtain the discovery deposition of such a person through the letter rogatory procedure, whereby an unwilling nonparty witness in a foreign country sometimes may be compelled to respond to questions routed through diplomatic channels to an appropriate judicial authority in the foreign country.⁵²

The term "Letters rogatory" is defined in *Black's Law Dictionary* (Fifth Edition 1979) as follows:

A request by one court of another court in an independent jurisdiction, that a witness be examined upon interrogatories sent with the request. The medium whereby one country, speaking through one of its courts, requests another country, acting through its own courts and by methods of court procedure peculiar thereto and entirely within the latter's control, to assist the administration of justice in the former country. The Signe, D.C.La., 37 F. Supp. 819, 820.

⁵¹ Cf. 37 CFR §§ 2.120(c) and 2.123(a).

⁵² See, in general, Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). Cf. *DBMS Consultants Ltd. v. Computer Associates International, Inc.*, 18 FR Serv 3d 33, 131 FRD 367 (D. Mass. 1990) (court granted application for issuance of a letter rogatory finding that it would be unjust and inappropriate to require oral examination and that opposing party has shown no good reason to deny the application).

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A formal communication in writing, sent by a court in which an action is pending to a court or judge of a foreign country, requesting that the testimony of a witness resident within the jurisdiction of the latter court may be there formally taken under its direction and transmitted to the first court for use in the pending action. Fed. R. Civ. P. 28.

This process was also in use, at an early period, between the several states of the Union. The request rests entirely upon the comity of courts towards each other.

While the letter rogatory procedure is usually conducted through the judicial system, because the proceeding is before an administrative body, the Board in this instance would function as the initiating “court” contemplated by the rule.

A party that wishes to have the Board issue a letter rogatory should file a written request therefor with the Board.⁵³ The party must also submit an original and two copies of the proposed letter rogatory, and an original and two copies of the questions to be propounded to the nonparty witness. If the official language of the foreign country is not English, the propounding party must submit an original and two copies of the letter rogatory and questions in English, and an original and two copies thereof translated into the official language. In addition, the propounding party must serve on each adverse party a copy of every paper submitted to the Board.⁵⁴

If the request is granted, each adverse party will be given an opportunity to submit cross-questions, a copy of which must also be served on the propounding party. If an adverse party does submit cross questions, the propounding party, in turn, will be given an opportunity to submit redirect questions, a copy of which must be served on each adverse party.⁵⁵ As in the case of the initial questions, an original and two copies of any cross questions and redirect questions must be submitted to the Board; if the official language of the foreign country is not English, an original and two copies of the questions in English, and an original and two copies thereof translated into the official language, must be submitted.

After the original and copies of the letter rogatory, and of all of the questions, have been submitted to the Board, and the letter rogatory has been approved as to

⁵³ See Fed. R. Civ. P. 28(b).

⁵⁴ See 37 CFR § 2.119(a). Cf. 37 CFR § 2.124(b)(2).

⁵⁵ Cf. 37 CFR § 2.124(d)(1).

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form, the letter rogatory will be issued by the Board. The letter rogatory will be signed by the Chief Administrative Trademark Judge; the signature will be authenticated in such a manner as to meet the requirements of the foreign country; and the original and one copy of the letter rogatory and accompanying questions will be forwarded to the United States Department of State with a transmittal letter from the Board (the remaining copy of these papers will be retained in the Board proceeding file). In its transmittal letter, the Board will request, pursuant to 28 U.S.C. § 1781 (which authorizes the Department of State to, *inter alia*, "receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution"), that the Department of State transmit the letter rogatory to the appropriate judicial authority in the foreign country, and, after execution, receive it back and return it to the Board. Thereafter, the Department of State will transmit the letter rogatory, through diplomatic channels, to the appropriate judicial authority in the foreign country.

The party seeking discovery must pay all fees, including authentication, consular, and foreign government fees, charged in connection with the letter rogatory procedure. The Department of State will require the propounding party to make a deposit to cover the consular and foreign government fees. Payment may be made by certified check or money order made payable to the American Embassy/Consulate [insert the name of the appropriate city, i.e., Paris, Bonn, Tokyo, etc.]. Any unused portion of the deposit will be returned to the depositor after completion of the letter rogatory process.

Further information concerning the letter rogatory process may be obtained from the Office of Citizens Consular Services, Department of State, 2201 C Street N.W., Washington, D.C. 20520.

Once the appropriate foreign judicial authority has received the letter rogatory, it may or may not be executed. As indicated above, the letter rogatory "rests entirely upon the comity of courts towards each other." Some countries refuse or are reluctant to lend assistance in the taking of a discovery deposition in their country through the letter rogatory procedure, and compliance with the procedural requirements for a letter rogatory does not ensure that the requested deposition will be completed.⁵⁶ Before a request for issuance of a letter rogatory is filed with the Board, the requesting party should examine the law and policy of the involved foreign country, and consult with the Office of Citizens Consular Services,

⁵⁶ See *NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to Fed. R. Civ. P. 28(b)*, and Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2083 (1994).

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Department of State, in order to determine whether the country in question is likely to honor a letter rogatory, particularly a letter rogatory issued by the Board.

Even in those foreign countries that are not reluctant to execute a letter rogatory, the foreign judicial authority may refuse to honor a letter rogatory issued by the Board (an administrative tribunal) rather than by a United States district court. Further, if the foreign country has a "blocking statute" prohibiting its residents from disclosing certain types of information in judicial or administrative proceedings outside of the foreign country, a letter rogatory may not be honored if the foreign judicial authority believes that disclosure of the information requested therein would violate the blocking statute.⁵⁷

If a letter rogatory is honored, its probative value may be limited. In executing the letter rogatory, the foreign judicial tribunal will follow its customary procedures for taking testimony. The fact that these procedures may differ from those normally followed in proceedings before the Board does not mean that the deposition must necessarily be excluded. Rather, any such differences are matters to be considered by the Board in determining the probative value of the deposition.⁵⁸

A party considering the filing of a request for issuance of a letter rogatory should bear in mind not only the complexity and uncertain outcome of the procedure, but also its time-consuming nature. The entire process, from the filing of the initial request for issuance of a letter rogatory, to receipt by the Board either of the completed deposition, or of notification that the letter rogatory will not be honored; will consume months, if not years. During the interim, proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory.⁵⁹

The Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (commonly known as the "Hague Convention"), opened for signature March 18, 1970, 23 U.S.T. 2555, T.I.A.S. No. 7444, prescribes procedures under which a judicial authority in one member country may request evidence located in another. The Convention offers another possible method by which a party to an inter partes proceeding before the Board may attempt to obtain the discovery

⁵⁷ See Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

⁵⁸ See Fed. R. Civ. P. 28; *NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to Fed. R. Civ. P. 28(b)*; and Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2083 (1994).

⁵⁹ Cf. 37 CFR § 2.124(d)(2).

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deposition of an unwilling nonparty witness residing in a foreign country, if the foreign country is a member of the Convention.⁶⁰

The Hague Convention provides for the compulsion of evidence (including the deposition of an unwilling witness) in a member country pursuant to a "letter of request," which is very similar in nature to a letter rogatory.⁶¹ However, the Board has been advised by the Department of State that foreign countries are more likely to lend assistance in the taking of a discovery deposition if the request therefor is made under the more formal letter rogatory procedure. Before filing a motion for issuance of a letter of request, the moving party should consult with the Office of Citizens Consular Services, Department of State, in order to determine whether the foreign country in question is likely to honor a letter of request, particularly a letter of request issued by the Board.

404.03(d) Foreign Person Present Within the United States – Party

37 CFR § 2.120(c)(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if

⁶⁰ See, for example, *Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522 (1987) (although Hague not exclusive discovery procedure, it may apply even if Federal Rules of Civil Procedure are available); *In re Anshuetz & Co., GmbH*, 838 F.2d 1362 (5th Cir. 1988) (U.S. district courts have discretion to resolve discovery conflicts between Federal Rules of Civil Procedure and Hague Convention); Wright, Miller and Marcus, *Federal Practice and Procedure: Civil 2d* § 2005 (1994); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). For general information concerning the Hague Convention, see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) (applicant failed to establish necessity of using Hague procedures). [NOTE: This case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

⁶¹ For information concerning the letter of request procedure under the Hague Convention, see Chapter 1 of the Convention. See also *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991).

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the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

Whenever a natural person who is a foreign party, or an officer, director, or managing agent, of a foreign party, or some other person who consents to testify on a foreign party's behalf, is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination on notice pursuant to 37 CFR § 2.120(c)(2).⁶² Indeed, this option was available even before the adoption of 37 CFR § 2.120(c)(2).⁶³

When the discovery deposition of a foreign party, or an officer, director, managing agent, or other person who consents to testify on behalf of a foreign party, is taken in the United States by oral examination pursuant to 37 CFR § 2.120(c)(2), the deposition must be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition.⁶⁴

404.03(e) Foreign Person Present Within the United States – Nonparty

If the proposed deponent is a foreign person who is present within the United States but the person is not a party to the proceeding and is not willing to appear voluntarily, it may be necessary to secure the deponent's attendance, if at all, by the procedures set forth in TBMP § 404.03(c).

404.04 Persons Before Whom Depositions May be Taken

Fed. R. Civ. P. 28. Persons Before Whom Depositions May Be Taken

(a) Within the United States. *Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the*

⁶² See also Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984).

⁶³ See *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978). and *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983).

⁶⁴ See 37 CFR § 2.120(c)(2).

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examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.

(b) In Foreign Countries. Depositions may be taken in a foreign country (1) pursuant to any applicable treaty or convention, or (2) pursuant to a letter of request (whether or not captioned a letter rogatory), or (3) on notice before a person authorized to administer oaths in the place where the examination is held, either by the law thereof or by the law of the United States, or (4) before a person commissioned by the court, and a person so commissioned shall have the power by virtue of the commission to administer any necessary oath and take testimony. A commission or a letter of request shall be issued on application and notice and on terms that are just and appropriate. It is not requisite to the issuance of a commission or a letter of request that the taking of the deposition in any other manner is impracticable or inconvenient; and both a commission and a letter of request may be issued in proper cases. A notice of commission may designate the person before whom the deposition is to be taken either by name or descriptive title. A letter of request may be addressed "To the Appropriate Authority in [here name the country]." When a letter of request or any other device is used pursuant to any applicable treaty or convention, it shall be captioned in the form prescribed by that treaty or convention. Evidence obtained in response to a letter of request need not be excluded merely because it is not a verbatim transcript, because the testimony was not taken under oath, or because of any similar departure from the requirements for depositions taken within the United States under these rules.

(c) Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

Discovery depositions in Board inter partes proceedings may be taken before the persons designated by Rule 28 of the Federal Rules of Civil Procedure.

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a Board proceeding discovery deposition "shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending."⁶⁵ As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter that is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a Board proceeding discovery deposition may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a Board proceeding discovery deposition taken of a

⁶⁵ See Fed. R. Civ. P. 28(a).

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willing witness in a foreign country usually may be taken on notice before a United States consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed.⁶⁶ A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

404.05 Notice of Deposition

Fed. R. Civ. P. 30(b) Notice of Examination: General Requirements; ...

(1) A party desiring to take the deposition of any person upon oral examination shall give reasonable notice in writing to every other party to the action. The notice shall state the time and place for taking the deposition and the name and address of each person to be examined, if known, and, if the name is not known, a general description sufficient to identify the person or the particular class or group to which the person belongs. ...

37 CFR § 2.124(b)(2) [Depositions upon written questions] *A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.*

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party may be taken on notice alone.

⁶⁶ See Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2083 (1994).

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Prior to the taking of a discovery deposition on notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party.⁶⁷ The elements to be included in the notice are specified in Fed. R. Civ. P. 30(b)(1), for a deposition on oral examination, and in 37 CFR §§ 2.124(b)(2) and 2.124(c), for a deposition on written questions.⁶⁸ It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition. The deposition must be taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period).⁶⁹

In noticing the deposition of a corporation, partnership, association, governmental agency, or other juristic person, the deposing party may, in lieu of naming a person to be deposed, simply name as the deponent the corporation, partnership, association, governmental agency, or other juristic person, and describe with reasonable particularity the matters on which examination is requested. The named organization must, in turn, designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may state, for each person designated, the matters on which he or she will testify. Each designated person must testify not only as to those matters within his or her knowledge, but also as to matters known or reasonably available to the organization.⁷⁰

For information concerning the procedure for combining a notice of taking a discovery deposition with a request for production of documents, see TBMP § 406.01.

404.06 Taking a Discovery Deposition

The manner of taking a discovery deposition in an inter partes proceeding before the Board is very similar to taking a testimony deposition.⁷¹

For information concerning the procedure for taking a testimony deposition (including the examination of witnesses, the form of a deposition, and the protection of confidential information or trade secret material forming part of a deposition transcript or exhibits thereto) see TBMP §§

⁶⁷ See Fed. R. Civ. P. 30(b)(1), and 37 CFR §§ 2.120(c), 2.124(b)(2), and 2.124(c). Cf. 37 CFR § 2.123(c); Fed. R. Civ. P. 31(a)(3); and TBMP § 703.01(e) (Notice of Testimony Deposition).

⁶⁸ See also, e.g., *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (subject matter of deposition to be described with reasonable particularity in the notice).

⁶⁹ See TBMP § 403.02 (Time for Service of Discovery Requests).

⁷⁰ See Fed. R. Civ. P. 30(b)(6) and 31(a)(3), and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383 (1985).

⁷¹ See *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991).

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703.01 and 703.02. *For a discussion of significant differences between discovery depositions and testimony depositions, see TBMP § 404.09. For information concerning the procedure for taking a discovery deposition on written questions, see TBMP § 404.07.*

On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone.⁷² A deposition taken by telephone is regarded as taken in the Federal judicial district and at the place where the witness is to answer the questions propounded to him or her.

404.07 Discovery Depositions on Written Questions

Discovery depositions on written questions are taken in the manner prescribed by 37 CFR § 2.124.

404.07(a) Depositions on Written Questions: Before Whom Taken

37 CFR § 2.124(a) A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.

A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28.⁷³

404.07(b) Depositions on Written Questions: When Taken

37 CFR § 2.120(a) ... Discovery depositions must be taken, ...on or before the closing date of the discovery period as originally set or as reset.

Discovery depositions must be both noticed and taken during the discovery period.⁷⁴ Thus, it is recommended that a party, which desires to take a discovery deposition on written questions, initiate the procedure early in its discovery period.

⁷² See Fed. R. Civ. P. 30(b)(7), and *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, *supra* at 1553 (leave to take telephonic depositions should be liberally granted in appropriate cases current federal practice favors use of technological benefits).

⁷³ See 37 CFR § 2.124(a) and TBMP § 404.04 (Persons Before Whom Depositions May be Taken).

⁷⁴ See 37 CFR § 2.120(a). See also TBMP § 404.01 (When and by Whom Taken).

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404.07(c) Depositions on Written Questions: Place of Deposition

For information concerning the place where a discovery deposition on written questions is taken, see TBMP § 404.03.

404.07(d) Depositions on Written Questions: Notice of Deposition

37 CFR § 2.124(b)(2) A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery disposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. ...

A party that desires to take a discovery deposition on written questions must serve notice thereof on each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board.⁷⁵

The notice must state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the person is to be provided so the responding party can designate one or more persons to be deposed. The notice must also be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken, and by the written questions to be propounded on behalf of the deposing party.⁷⁶

For further information concerning notices of deposition in general, see TBMP § 404.05.

⁷⁵ See 37 CFR § 2.124(b)(2).

⁷⁶ See 37 CFR §§ 2.124(b)(2), 2.124(c), and 2.124(d)(1).

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404.07(e) Depositions on Written Questions: Examination of Witness

37 CFR § 2.124(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. ...

(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

Within 20 days from the date of service of the notice (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight courier,⁷⁷ any adverse party may serve cross questions on the deposing party. A party that serves cross-questions on the deposing party must also serve copies thereof on every other adverse party. Within 10 days from the date of service of the cross questions (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if

⁷⁷ See 37 CFR § 2.119(c).

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service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), any party that served cross-questions may serve recross questions on the deposing party. A party which serves recross questions on the deposing party must also serve copies thereof on every other adverse party.⁷⁸

Written objections to questions may be served on the party that propounded the questions. A party that serves objections on a propounding party must also serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). The substitute questions must also be served on every other adverse party.⁷⁹

As all discovery depositions must be completed within the discovery period, including depositions on written questions, on motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 CFR § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions to allow for the orderly completion of the depositions on written questions.⁸⁰

Within 10 days after the last date when questions, objections, or substitute questions may be served, the deposing party must mail a copy of the notice and copies of all the questions to the officer designated in the notice. A copy of the notice and of all the questions mailed to the officer must also be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question.⁸¹

404.07(f) Depositions on Written Questions: Objections

37 CFR § 2.124(d)(1) ... Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served

⁷⁸ See 37 CFR § 2.124(d)(1). See also *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

⁷⁹ See 37 CFR § 2.124(d)(1). See also *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990).

⁸⁰ See 37 CFR § 2.124(d)(2). Cf. 37 CFR § 2.124(d)(2) regarding suspension of proceedings for testimonial depositions on written questions.

⁸¹ See 37 CFR § 2.124(e).

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on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

* * * *

(g) Objections to questions and answers in depositions upon written questions may be considered at final hearing.

Written objections to questions propounded for a deposition on written questions may be served on the party that propounded the questions. Any party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party.⁸²

Objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board (unless waived) at final hearing.⁸³

For further information concerning the raising of objections to discovery depositions, see TBMP § 404.08. For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP §§ 707.02 and 532.

404.07(g) Depositions on Written Questions: Form of Deposition; Signature

37 CFR § 2.124(e) ... The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question.

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question.⁸⁴

For further information concerning the form of a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(g), and TBMP § 703.01(i). For information concerning signature of a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(e)(5), and TBMP § 703.01(j).

⁸² See 37 CFR § 2.124(d)(1). See also TBMP § 703.02(k) (Objections to Testimony Depositions on Written Questions).

⁸³ See 37 CFR § 2.124(g), and *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy deferred until final hearing).

⁸⁴ See 37 CFR § 2.124(e).

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404.07(h) Depositions on Written Questions: Certification of Deposition

37 CFR § 2.124(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. When the transcript has been certified, the officer should mail the transcript and exhibits to the party that took the deposition.⁸⁵

404.07(i) Depositions on Written Questions: Service, Correction, and Making the Deposition of Record

37 CFR § 2.124(f) The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see §2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by §2.120(j). ...

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party.⁸⁶ The party that took the deposition must also assure that the transcript is correct.⁸⁷

If the discovery deposition is to be made of record, the same procedures provided by 37 CFR § 2.120(j) are to be followed.⁸⁸

⁸⁵ See 37 CFR § 2.124(e). For further information concerning certification of a deposition taken in an inter partes proceeding before the Board, see, for example, 37 CFR § 2.123(f), and TBMP § 703.01(k).

⁸⁶ See 37 CFR § 2.124(f). See also TBMP § 703.01(m) regarding service of testimony deposition transcript.

⁸⁷ See 37 CFR §§ 2.124(f) and 2.125(b). For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, see TBMP § 703.01(n).

⁸⁸ See 37 CFR § 2.124(f). See also, with respect to making a discovery deposition of record, TBMP § 704.09 and *Fischer Gesellschaft M.b.H. v. Molnar and Co., Inc.*, 203 USPQ 861 (TTAB 1979).

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404.07(j) Deposition on Written Questions: Utility

A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. Moreover, it deprives an adverse party of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions.⁸⁹

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country. Moreover, the deposition on written questions is generally less expensive than the deposition on oral examination, and is usually more convenient for the witness.

404.08 Discovery Deposition Objections

404.08(a) Objections to Notice

Objections to errors and irregularities in a notice of the taking of a discovery deposition must be promptly served, in writing, on the party giving the notice; any such objections that are not promptly served are waived.⁹⁰ *For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP §§ 707.02 and 532.*

⁸⁹ See 37 CFR 2.124(d)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989); and Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253, 253 (1980). See also *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985); and TBMP § 703.02(m) (Utility of Testimony Depositions on Written Questions).

⁹⁰ See Fed. R. Civ. P. 32(d)(1). Compare *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997) (Board will not rule in advance of deposition as to whether information sought is confidential or otherwise objectionable) and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (objections to subject matter of deposition may only be raised during, not prior to, the deposition) with *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (objections to subject matter of 30(b)(6) deposition raised prior to deposition).

Cf., generally, with regard to notice of testimony depositions, 37 CFR § 2.123(j); Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (premature taking of testimony deposition could have been corrected upon seasonable objection); *Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony deposition excluded where notice did not name witness and objection was timely made and consistently maintained), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982). *For additional case cites, see Appendix of Cases.*

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404.08(b) Objections as to Disqualification of Officer

An objection to the taking of a discovery deposition because of a disqualification of the officer before whom the deposition is to be taken, is waived unless it is made before the deposition begins, or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence.⁹¹

404.08(c) Objections During Deposition

Fed. R. Civ. P. 32(d)(3)(A) Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.

(B) Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.

Objections to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony "are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time."⁹²

In the case of a discovery deposition taken on oral examination, objections to errors and irregularities occurring at the deposition in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and objections to errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonably made at the deposition.⁹³

For information concerning objections to the form of questions in the case of a discovery deposition on written questions, see TBMP § 404.07(f).

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Questions objected to ordinarily should be answered

⁹¹ See Fed. R. Civ. P. 32(d)(2). Cf. 37 CFR § 2.123(j).

⁹² See Fed. R. Civ. P. 32(d)(3)(A). Cf. 37 CFR § 2.123(k).

⁹³ See Fed. R. Civ. P. 32(d)(3)(B). Cf. 37 CFR § 2.123(j).

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subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential.⁹⁴ If a witness, having stated an objection to a discovery deposition question, answers the question subject to the objection, and the deposition is subsequently made of record in the proceeding pursuant to the provisions of 37 CFR §§ 2.120(j)(1), (2), (3)(i), and (4), the propriety of the objection will be considered by the Board at final hearing when the objections are preserved and raised in the final briefs; that is, the Board will evaluate the testimony in light of the stated objection.⁹⁵

*For information concerning the propounding party's options if a witness not only objects to, but also refuses to answer, a particular question during a discovery deposition, see TBMP § 411.03.*⁹⁶

404.09 Discovery Depositions Compared to Testimony Depositions

A discovery deposition, like a testimony deposition, may be taken either on oral examination or on written questions.⁹⁷ In fact, the actual taking of a discovery deposition is very similar to the taking of a testimony deposition. Nevertheless, there are substantial differences between the two, stemming from the differences between the discovery and trial stages of a proceeding. Some of the most significant differences are discussed below. A discovery deposition is a broad discovery device used by a party to obtain from an adversary information about the adversary's case, or to obtain from a nonparty information that may be helpful to the deposing party's case. 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 narrower 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 himself or herself (if

⁹⁴ See 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b), 30(c), and 37(a); Fed. R. Evid. 501; and Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2113 (1994). See also *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (Board, upon motion to compel, allowed parties time to work out protective order under which confidential information would be provided).

⁹⁵ See 37 CFR § 2.120(j)(3)(i); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979) (objections to discovery deposition questions should be preserved and argued in the briefs at final hearing); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

⁹⁶ See also *Neville Chemical Co. v. Lubrizol Corp.*, *supra* (if opposer objects to and refuses to answer certain deposition questions, applicant may seek subpoena for immediate resolution or file motion to compel answers).

⁹⁷ See Fed. R. Civ. P. 26(a).

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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.⁹⁸

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time.⁹⁹ A party may only take a testimony deposition during the party's assigned testimony period; each party has an assigned testimony period, and only the party to which a particular testimony period is assigned may take testimony therein.¹⁰⁰

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.¹⁰¹ In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection.¹⁰²

In both types of depositions, questions 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.¹⁰³ Both types of depositions are taken out of the presence of the Board, and if a witness not only objects to, but also refuses to answer a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by adjourning the deposition and applying, under 35 U.S.C. § 24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer.¹⁰⁴

In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the

⁹⁸ See *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978) and *Bison Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987). See also Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

⁹⁹ See *Smith International, Inc. v. Olin Corp.*, *supra*; *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978); and TBMP § 403.02 (Time for Service of Discovery Requests).

¹⁰⁰ See 37 CFR § 2.121(a)(1).

¹⁰¹ See Fed. R. Civ. P. 26(b)(1).

¹⁰² See 37 CFR §§ 2.122(a) and 2.123(k), and TBMP § 533 (motions to strike trial testimony depositions).

¹⁰³ See 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b)(5), 30(c), and 37(a)(2)(B); Fed. R. Evid. 501; and Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2113 (1994).

¹⁰⁴ See *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974). See also *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953).

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Board to compel the witness to answer the unanswered question.¹⁰⁵ A motion to compel is not available, however, in the case of a testimony deposition taken in a proceeding before the Board, nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition.¹⁰⁶

Accordingly, in those cases where the witness in a *testimony* deposition refuses to answer a particular question, no court action is sought, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony.¹⁰⁷

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 the party's testimony period, the deposition together with a notice of reliance thereon.¹⁰⁸ That is, the offering of a discovery deposition in evidence is voluntary, not mandatory.¹⁰⁹ Every testimony deposition taken *must* be filed, and, when filed, becomes part of the record; a notice of reliance thereon is not necessary.¹¹⁰

The discovery deposition of an adverse party may be taken on notice alone.¹¹¹ However, the testimony deposition of an adverse party, unless obtained voluntarily, may only be taken pursuant to a subpoena issued by a United States district court.¹¹²

¹⁰⁵ See 37 CFR § 2.120(e) and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

¹⁰⁶ See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998) (motion to compel not available) and *Ferro Corp. v. SCM Corp.*, *supra*. (should have applied to district court for order compelling answers).

¹⁰⁷ See *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (a refusal to answer, if found to be unjustified, may be construed against the objecting party). See also TBMP § 707.03(d) (refusal to answer testimony deposition question), and authorities cited therein.

¹⁰⁸ See TBMP § 704.09 (introducing discovery depositions into evidence).

¹⁰⁹ See, for example, *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); 37 CFR §§ 2.120(j)(1), (j)(2), and (j)(3)(i); TBMP § 704.09 (introducing discovery depositions); and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Reporter 353 (1980).

¹¹⁰ See generally 37 CFR § 2.123, and TBMP § 703.01(l) (Testimony Deposition Must be Filed).

¹¹¹ See TBMP § 404.03 (Securing Attendance of Deponent).

¹¹² See 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976); and TBMP § 703.01(f) (Securing Attendance of Adverse Party or Nonparty). For further information concerning differences between discovery and testimony depositions, see *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, *supra* (discovery deposition of nonparty is not admissible as evidence under a notice of reliance absent compelling circumstances or consent of the adverse party given the functional and historical differences between discovery and trial); *Smith International, Inc. v. Olin Corp.*, *supra*; and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

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405 Interrogatories

405.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written interrogatories on any other party.¹¹³ Interrogatories may be served on an adversary from the day discovery opens through the last day of the discovery period, even though the answers thereto will not be served until after the discovery period has closed.¹¹⁴

405.02 Scope

Interrogatories may seek any information that is discoverable under Fed. R. Civ. P. 26(b)(1).¹¹⁵ An interrogatory that is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact.¹¹⁶

405.03 Limit on Number

405.03(a) Description of Limit

37 CFR § 2.120(d)(1) The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties. A motion for leave to serve additional interrogatories must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. ...

The total number of interrogatories which a party may serve on another party, in a proceeding, may not exceed 75, counting subparts, except that the Board, may allow

¹¹³ See TBMP § 403.01 (Timing of Discovery in General).

¹¹⁴ See TBMP § 403.02 (Time for Service of Discovery Requests).

¹¹⁵ See Fed. R. Civ. P. 33(c).

¹¹⁶ See Fed. R. Civ. P. 33(b); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (query whether opposer believes marks in question to be confusingly similar must be answered even though it requires opposer to draw legal conclusion). See also *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973).

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additional interrogatories on motion therefor showing good cause, or on stipulation of the parties.¹¹⁷

405.03(b) Application of Limit: Sets of Interrogatories

The numerical limit of 37 CFR § 2.120(d)(1) pertains to the total number of interrogatories that one party may serve on another party over the course of an entire proceeding, not just per set of interrogatories. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of interrogatories directed to the same party, the interrogatories in the separate sets would be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded.¹¹⁸

Accordingly, a party which is preparing a first set of interrogatories should reserve a portion of its allotted 75 interrogatories (counting subparts) to use for follow-up discovery, unless it is sure that it will not be serving follow-up interrogatories.

405.03(c) Application of Limit: Multiple Marks, Etc.

Trademark Rule 2.120(d)(1) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional interrogatories. However, a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex

¹¹⁷ For information on motions for leave to serve additional interrogatories, see TBMP § 519.

¹¹⁸ See *Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

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issues, and these are factors that will be considered in determining a motion for leave to serve additional interrogatories.¹¹⁹

405.03(d) Application of Limit: Counting Interrogatories

In determining whether the number of interrogatories served by one party on another exceeds the limit of 37 CFR § 2.120(d)(1), the Board will count each subpart within an interrogatory as a separate interrogatory, regardless of whether the subpart is separately designated (i.e., separately numbered or lettered).¹²⁰

If an interrogatory includes questions set forth as numbered or lettered subparts, each separately designated subpart will be counted by the Board as a separate interrogatory. The propounding party will, to that extent, be bound by its own numbering system, and will not be heard to complain that an interrogatory, although propounded with separately designated subparts, should nevertheless be counted as a single interrogatory because the interrogatory concerns a single transaction, state of facts, etc., or because the division was made for clarification or convenience.¹²¹

On the other hand, if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory.¹²² For example, if two or more questions are combined in a single compound interrogatory, and are not set out as

¹¹⁹ See Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹²⁰ See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

¹²¹ See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹²² See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

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separate subparts, the Board will look to the substance of the interrogatory, and count each question as a separate interrogatory.¹²³

If an interrogatory contains both an initial question, and follow-up questions to be answered if the first is answered in the affirmative, the initial question and each follow-up question will be counted as separate interrogatories.¹²⁴

Similarly, if an interrogatory begins with a broad introductory clause ("Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:") followed by several subparts ("Applicant's date of first use of the mark on the goods listed in the application," "Applicant's date of first use of the mark on such goods in commerce," etc.), the Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated.¹²⁵

If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests "all relevant facts and circumstances" concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory.¹²⁶

The introductory instructions or preamble to a set of interrogatories will not be counted by the Board as interrogatories or subparts for purposes of determining whether the limit specified in 37 CFR § 2.120(d)(1) has been exceeded. On the other hand, the Board's determination, on a motion to compel, of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble; the Board is not bound by

¹²³ See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹²⁴ See *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹²⁵ Cf. *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹²⁶ See Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*; and Notice of Final Rulemaking, published in the *Federal Register* on August 22, 1989 at 54 FR 34886 and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26.

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the instructions or preamble, and will make its own independent determination of the adequacy of the answer, without regard to the instructions or preamble.¹²⁷

405.03(e) Remedy for Excessive Interrogatories

37 CFR § 2.120(d)(1) ... If a party upon which interrogatories have been served believes that the number of interrogatories served exceed the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.

If a party on which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number.¹²⁸ A party should not answer what it considers to be the first seventy-five interrogatories and object to the rest as excessive.¹²⁹

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of Rule 2.120(e), including the requirement that a motion to compel be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable

¹²⁷ See *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992) and *Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹²⁸ See 37 CFR § 2.120(d)(1) and *Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

¹²⁹ *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

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to reach agreement.¹³⁰ It is further recommended that the moving party set out its counting method showing that the number of interrogatories does not exceed seventy-five.¹³¹

If, on determining a motion to compel filed in response to a general objection to interrogatories on the ground of excessive number, the Board finds that the interrogatories are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not exceeding the numerical limit. The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely.¹³²

However, if the revised set is not served until after the close of the discovery period, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information not sought in the excessive set.¹³³

Although there are no limitations on the number of document requests that may be served, a party may properly refuse to respond to a document request seeking all documents identified or referred to in response to interrogatories if the number of interrogatories is believed to be excessive.¹³⁴

¹³⁰ See 37 CFR §§ 2.120(d)(1) and 2.120(e); and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

¹³¹ For further information concerning motions to compel discovery, see TBMP § 523.

¹³² See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990). See also *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990); and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

Cf. *Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1468 n.6 (TTAB 1990) (opposer may seek answers by taking discovery deposition of applicant).

¹³³ See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, *supra*; *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, *supra*; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹³⁴ See *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1399 (TTAB 1990) (refusal to respond to document requests was proper; petitioner could not respond to document requests without first having to answer excessive interrogatories).

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In those cases where a party which has propounded interrogatories realizes, on receipt of a general objection thereto on the ground of excessive number, that the interrogatories are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of interrogatories, in the manner normally allowed by the Board, instead of bringing their dispute to the Board by motion to compel.¹³⁵

[NOTE: Although some of the cases cited in this TBMP section were decided under an earlier version of 37 CFR § 2.120(d)(1) governing the procedure for objecting to interrogatories on the basis of their excessive number, the decisions are otherwise applicable to the issues which may arise under Rule 2.120(d)(1).¹³⁶

405.04 Responses to Interrogatories

405.04(a) Time for Service of Responses

Responses to interrogatories must be served within 30 days after the date of service of the interrogatories.¹³⁷ If service of the interrogatories is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the interrogatories.¹³⁸

A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits.¹³⁹ Objections going to the merits of an interrogatory or

¹³⁵ See Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹³⁶ See Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

¹³⁷ See TBMP § 403.03 (Time for Service of Discovery Responses).

¹³⁸ See 37 CFR § 2.119(c), and TBMP §§ 113.05 (Additional Time for Service by Mail) and 403.03 (Time for Service of Discovery Responses).

¹³⁹ See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). See also *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding time to respond); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (although party failed to timely respond to

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other discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.¹⁴⁰ In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.¹⁴¹

405.04(b) Nature of Responses

Ordinarily, a party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer.¹⁴² If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number.¹⁴³

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto.¹⁴⁴

In some cases, the information sought in an interrogatory may be derived or ascertained from the business records of the responding party, or from an examination, audit, or inspection of those business records (including a compilation, abstract, or summary thereof) and the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party. In those cases, the responding party may answer the interrogatory by itself providing, in its written answer to the interrogatory, the information sought. Alternatively, the responding party may answer the interrogatory by specifying the records from which the information may be

discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel).

¹⁴⁰ See *No Fear Inc. v. Rule*, *supra* at 1554.

¹⁴¹ See *No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

¹⁴² See Fed. R. Civ. P. 33(b)

¹⁴³ See 37 CFR § 2.120(d)(1), and TBMP § 405.03(e) (Remedy for Excessive Interrogatories).

¹⁴⁴ See G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

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derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts, or summaries. If the responding party elects to answer an interrogatory by specifying and producing business records, the specification must be in sufficient detail to permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained.¹⁴⁵

A responding party cannot simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents.¹⁴⁶

It is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those interrogatories that it believes to be proper and stating its objections to those that it believes to be improper.¹⁴⁷

405.04(c) Signature of Responses

Interrogatories must be answered by the party served. If the party served is a corporation, partnership, association, or governmental agency, the interrogatories must be answered by an officer or agent, who must furnish whatever information is available to the party served.¹⁴⁸

The term "agent" includes an attorney, who may answer even though he has no personal knowledge of the facts stated in the answers; the attorney's answers, like an officer's answers, must contain the information available to the party served.¹⁴⁹ However, an attorney who answers interrogatories on behalf of a corporation, partnership, association, or governmental agency may thereafter be exposed to additional discovery and possibly even disqualification.¹⁵⁰

¹⁴⁵ See Fed. R. Civ. P. 33(c); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (responding party may not merely agree to provide access to voluminous records which may contain responsive information); and *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1435 (TTAB 1998) (identifying prerequisites for exercising the option to produce business records in lieu of answering interrogatories).

¹⁴⁶ See Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2178 (1994) and *No fear Inc. v. Rule*, *supra*.

¹⁴⁷ See TBMP § 410 (Asserting Objections to Discovery).

¹⁴⁸ See Fed. R. Civ. P. 33(a) and (b).

¹⁴⁹ See *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1665 (TTAB 1988).

¹⁵⁰ See 37 CFR § 10.63, and *Allstate Insurance Co. v. Healthy America Inc.*, *supra*.

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Answers to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them.¹⁵¹

406 Requests for Production of Documents and Things

406.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve requests for production of documents and things on any other party.¹⁵² Requests for production may be served from the day discovery opens through the last day of the discovery period, even though the answers thereto may not be served until after the discovery period has closed.¹⁵³ If requests for production are combined with a notice of taking a discovery deposition (i.e., if it is requested that the deponent bring designated documents to the deposition), the requests for production must be served at least 35 days prior to the scheduled date of the deposition if service of the requests for production is made by first-class mail, "Express Mail," or overnight courier, and at least 30 days prior to the deposition if service of the requests for production is made by one of the other methods specified in 37 CFR § 2.119(b).¹⁵⁴

If a discovery deposition deponent is a nonparty witness residing in the United States¹⁵⁵ production of designated documents by the witness at the deposition may be obtained by means of a subpoena duces tecum.¹⁵⁶ A subpoena is unnecessary, however, if the nonparty witness is willing to produce the documents voluntarily.

406.02 Scope

Fed. R. Civ. P. 34(a) Scope. Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on the requestor's behalf, to inspect and copy, any designated documents (including writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations from which information can be obtained, translated,

¹⁵¹ See Fed. R. Civ. P. 33(b)(2).

¹⁵² See Fed. R. Civ. P. 34(a); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); and TBMP § 403.01 (Timing of Discovery In General).

¹⁵³ See TBMP § 403.02 (Time for Discovery Responses).

¹⁵⁴ See Fed. R. Civ. P. 34(b); 37 CFR § 2.119(c); and TBMP §§ 113.04 (Manner of Service), 113.05 (Additional Time for Service by Mail), and 403.03 (Time for Service of Discovery Responses).

¹⁵⁵ See TBMP § 404.03(a)(2) (Nonparty Residing in U.S.).

¹⁵⁶ See Fed. R. Civ. P. 45 and 35 U.S.C. § 24.

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if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served; or (2) to permit entry upon designated land or other property in the possession or control of the party upon whom the request is served for the purpose of inspection and measuring, surveying, photographing, testing, or sampling the property or any designated object or operation thereon, within the scope of Rule 26(b).

The scope of a request for production, in an inter partes proceeding before the Board, is governed by Fed. R. Civ. P. 34(a), which in turn refers to Fed. R. Civ. P. 26(b).¹⁵⁷

Generally, a party does not have an obligation to locate documents that are not in its possession, custody or control and produce them during discovery.¹⁵⁸

Because proceedings before the Board involve only the right to register trademarks, the request for entry upon land for inspection and other purposes is rarely, if ever, used in Board proceedings.

406.03 Elements of Request for Production; Place of Production

Fed. R. Civ. P. 34(b) Procedure. *The request shall set forth, either by individual item or by category, the items to be inspected and describe each with reasonable particularity. The request shall specify a reasonable time, place, and manner of making the inspection and performing the related acts. ...*

37 CFR § 2.120(d)(2) *The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.*

A request for production must include the elements specified in Fed. R. Civ. P. 34(b), as set forth above.

¹⁵⁷ For a discussion of the scope of discovery permitted under Fed. R. Civ. P. 26(b), see TBMP § 402 (Scope of Discovery).

¹⁵⁸ See Fed. R. Civ. P. 34(c) for discovery of documents in possession of a third party. See also *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999), appeal filed, *Pro-Football, Inc. v. Harjo*, mot. to dismiss denied, (not reported in *F.Supp.2d*), 57 USPQ2d 1140 (D.D.C. 2000).

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The place of production is governed by 37 CFR § 2.120(d)(2).¹⁵⁹ However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party.¹⁶⁰

On motion pursuant to 37 CFR § 2.120(d)(2), the Board may order the place and the manner in which the documents are to be produced. The Board may, for example, order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party when the responding party has unreasonably refused to produce documents.¹⁶¹

406.04 Responses to Requests for Production

406.04(a) Time for Service of Responses

Responses to requests for production must be served within 30 days after the date of service of the requests.¹⁶² If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests.¹⁶³

A party which fails to respond to requests for production during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the requests on their merits.¹⁶⁴

¹⁵⁹ See also *Electronic Industries Assn. v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1015 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976) (documents requested to be produced as part of a discovery deposition would be produced where they are located); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449, 451 (1984).

¹⁶⁰ See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) and *Electronic Industries Assn. v. Potega*, *supra*.

¹⁶¹ See *No Fear Inc. v. Rule*, *supra* at 1555 (at the responding party's expense as a discovery sanction); *Unicut Corp. v. Unicut, Inc.*, *supra* (at the requesting party's expense); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, *supra*. Cf. *Electronic Industries Assn. v. Potega*, *supra*.

¹⁶² See Fed. R. Civ. P. 34(b), 37 CFR § 2.120(a) and TBMP § 403.03 (Time for Service of Responses).

¹⁶³ See 37 CFR § 2.119(c) and TBMP §§ 113.05 (Additional Time for Mail) and 403.03 (Time for Responses).

¹⁶⁴ See TBMP §§ 403.03 (Time for Responses) and 405.04(a) (Time for Responses to Interrogatories) and cases cited therein. See also *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (applicant, having waived its right to object to discovery requests on their merits was not entitled to raise objection regarding place of production of documents).

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406.04(b) Nature of Responses

A response to a request for production of documents and things must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated.¹⁶⁵ If objection is made to only part of an item or category, the part must be specified. A party that produces documents for inspection must produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request.¹⁶⁶

It is generally inappropriate for a party to respond to requests for production by filing a motion attacking them, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by indicating, with respect to those requests that it believes to be proper, that inspection and related activities will be permitted, and by stating reasons for objection with respect to those requests that it believes to be improper.¹⁶⁷

407 Requests for Admissions

407.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written requests for admissions on any other party.¹⁶⁸ Like interrogatories and requests for production of documents, requests for admission may be served on an adversary from the day the discovery period opens through the last day of the discovery period, even though the answers thereto will not be due until after the discovery period has closed.¹⁶⁹

¹⁶⁵ See Fed. R. Civ. P. 34(b) and *No Fear Inc. v. Rule*, *supra* at 1555 (a proper response requires stating as to each request either that there are responsive documents and they will be produced (or withheld on a claim of privilege) or stating party has no responsive documents).

¹⁶⁶ See Fed. R. Civ. P. 34(b) and *No Fear Inc. v. Rule*, *supra* at 1556, *citing* 8A Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* § 2213 (2d ed. 1994) (party may not simply dump large quantities of documents containing responsive as well as unresponsive documents).

¹⁶⁷ See TBMP § 410 (Asserting Objections).

¹⁶⁸ See Fed. R. Civ. P. 36(a) and TBMP § 403.01 (Time of Discovery In General).

¹⁶⁹ See TBMP § 403.02 (Time for Requests).

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407.02 Scope and Nature of Requests for Admission

Fed. R. Civ. P. 36(a) Request for Admission. *A party may serve upon any other party a written request for the admission, for purposes of the pending action only, of the truth of any matters within the scope of Rule 26(b)(1) set forth in the request that relate to statements or opinions of fact or of the application of law to fact, including the genuineness of any documents described in the request. Copies of documents shall be served with the request unless they have been or are otherwise furnished or made available for inspection and copying. ...*

Each matter of which an admission is requested shall be separately set forth. ...

The scope and nature of requests for admission, in inter partes proceedings before the Board, are governed by Fed. R. Civ. P. 36(a), which in turn refers to Fed. R. Civ. P. 26(b)(1).¹⁷⁰

Requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters that must be tried.¹⁷¹ These requests are also useful as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents.¹⁷²

407.03 Responses to Requests for Admission

407.03(a) Time for Service of Responses

Responses to requests for admission must be served within 30 days after the date of service of the requests.¹⁷³ If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests.¹⁷⁴

If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect or unless a motion to withdraw or

¹⁷⁰ For a discussion of the scope of discovery permitted under Fed. R. Civ. P. 26(b)(1), see TBMP § 402.01. See also TBMP § 402.02 (Limitations).

¹⁷¹ Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985).

¹⁷² See TBMP § 403.05(b) (Facilitates Introduction).

¹⁷³ See TBMP § 403.03 (Time for Service of Responses).

¹⁷⁴ See 37 CFR § 2.119(c), and TBMP §§ 113.05 (Additional Time) and 403.03 (Time for Discovery Responses).

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amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board.¹⁷⁵

For information concerning motions pursuant to Fed. R. Civ. P. 36(b) to withdraw or amend admissions, see TBMP § 525.

407.03(b) Nature of Responses

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested.¹⁷⁶

The Board prefers that the responding party reproduce each request immediately preceding the answer or objection thereto.¹⁷⁷

An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. *"A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny."*¹⁷⁸

If the responding party objects to a request for admission, the reasons for objection must be stated. If a responding party believes that a matter of which an admission has been requested presents a genuine issue for trial, the party may not object to the request on that

¹⁷⁵ See Fed. R. Civ. P. 6(b) and 36(a); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) ("...where failure to timely respond to a request for admission has harsh result, Rule 36(b) provides method for obtaining relief."); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989); and *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979). See also *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd*, *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

Cf. Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

¹⁷⁶ See Fed. R. Civ. P. 36(a).

¹⁷⁷ See G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

¹⁷⁸ Fed. R. Civ. P. 36(a).

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ground alone. Rather, the party may deny the matter; alternatively, the party may set forth reasons why it cannot admit or deny the matter.¹⁷⁹

It is generally inappropriate for a party to respond to requests for admission by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those requests that it believes to be proper and stating its reasons for objection to those that it believes to be improper.¹⁸⁰

407.03(c) Signature of Responses

Answers and objections to requests for admission may be signed either by the responding party, or by its attorney.¹⁸¹

407.04 Effect of Admission

Any matter admitted (either expressly, or for failure to timely respond) under Fed. R. Civ. P. 36 is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission.¹⁸²

For further information concerning motions to withdraw or amend an admission, see TBMP § 525.

An admission made by a party under Fed. R. Civ. P. 36 is only for the purpose of the pending proceeding. It is not an admission for any other purpose, nor may it be used against that party in any other proceeding.¹⁸³

¹⁷⁹ See Fed. R. Civ. P. 36(a).

¹⁸⁰ See TBMP § 410 (Asserting Objections).

¹⁸¹ See Fed. R. Civ. P. 36(a).

¹⁸² See Fed. R. Civ. P. 36(b). See also *American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (an admission not withdrawn or amended cannot be rebutted by contrary testimony at trial).

¹⁸³ See Fed. R. Civ. P. 36(b).

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408 Duties to Cooperate, Search Records, Supplement

408.01 Duty to Cooperate

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case.¹⁸⁴

It should be noted, in this regard, that under the provisions of Fed. R. Civ. P. 26(g)(2), the signature of an attorney or party to a discovery request, response, or objection:¹⁸⁵

. . . constitutes a certification that to the best of the signer's knowledge, information, and belief, formed after a reasonable inquiry, the request, response, or objection is:

(A) consistent with [the Federal Rules of Civil Procedure] and warranted by existing law or a good faith argument for the extension, modification, or reversal of existing law;

(B) not interposed for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation; and

(C) not unreasonable or unduly burdensome or expensive, given the needs of the case, the discovery already had in the case, the amount in controversy, and the importance of the issues at stake in the litigation.

¹⁸⁴ See, for example, Fed. R. Civ. P. 26(g); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (in view of parties' impasse, Board was burdened with resolving numerous requests for discovery); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (both parties failed to cooperate, thus saddling Board with needless motions); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties must narrow amount of disputed requests to reasonable number); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984) (failure to cooperate in discovery resulted in entry of sanctions); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (it was clear from number and nature of opposer's discovery requests and applicant's blanket objections thereto that neither party was cooperating). See also *C. H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506 (TTAB 1980); *C. H. Stuart Inc. v. S. S. Sarna, Inc.*, 212 USPQ 386 (TTAB 1980); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623 (TTAB 1974); and *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477 (TTAB 1974).

Cf. Micro Motion Inc. v. Kane Steel Co., 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990).

¹⁸⁵ See also *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) *Cf.* 37 CFR § 10.18(a); Fed. R. Civ. P. 11; and TBMP § 106.02 (Signatures).

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Provision is made, in Fed. R. Civ. P. 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule.

Because the signature of a party or its attorney to a request for discovery constitutes a certification by the party or its attorney that, *inter alia*, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another.¹⁸⁶

408.02 Duty to Search Records

A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. A responding party which, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question) unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e).¹⁸⁷

408.03 Duty to Supplement Discovery Response

Fed. R. Civ. P. 26(e) Supplementation of ... Responses. *A party who has ... responded to a request for discovery with a ... response is under a duty to supplement or correct the ... response to include information thereafter acquired if ordered by the court or in the following circumstances:*

* * * *

(2) *A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.*

The duty to supplement discovery responses in proceedings before the Board is governed by Fed. R. Civ. P. 26(e)(2).¹⁸⁸ Under that rule, a party that has responded to a request for discovery with

¹⁸⁶ See, for example, *Miss America Pageant v. Petite Productions, Inc.*, *supra* at 1069 (Board was persuaded that certain interrogatories would be unduly burdensome).

¹⁸⁷ See *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987).

¹⁸⁸ See 37 CFR § 2.116(a).

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a response is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2).¹⁸⁹ In addition, a duty to supplement responses may be imposed by order of the Board.¹⁹⁰

409 Filing Discovery Requests and Responses With Board

37 CFR § 2.120(j) Use of discovery deposition, answer to interrogatory, or admission.

* * * *

(6) Paragraph (j) of this section will not be interpreted to preclude the reading or the use of a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.

* * * *

(8) Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.

Discovery requests, discovery responses, and materials or depositions obtained through the discovery process, should not be filed with the Board except when submitted:

- (1) With a motion relating to discovery [e.g., motion to compel, motion to determine the sufficiency of an answer or objection to a request for admission, motion for leave to serve additional interrogatories];
- (2) In support of or in response to a motion for summary judgment;
- (3) Under a notice of reliance during a party's testimony period; or
- (4) As exhibits to a testimony deposition.

¹⁸⁹ See *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998).

¹⁹⁰ Cf. *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431 (TTAB 1985); and *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60 (TTAB 1982).

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Authorities and cases regarding the filing of discovery materials with the Board are cited in the note below.¹⁹¹

In addition, when a party objects to proffered evidence on the ground that it should have been, but was not, provided in response to a request for discovery, a copy of the pertinent discovery request(s) and response(s) should be submitted in support of the objection.

Discovery papers or materials filed with the Board under circumstances other than those specified above may be returned to the party that filed them.¹⁹²

410 Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery

The rules governing discovery in proceedings before the Board provide both for the assertion of objections to discovery requests believed to be improper, and a means (namely, the motion to compel, in the case of discovery depositions, interrogatories, and requests for production; and the motion to test the sufficiency of answers or objections, in the case of requests for admission) for testing the sufficiency of those objections. It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those that it believes to be improper.¹⁹³

¹⁹¹ See 37 CFR §§ 2.120(j)(6) and (j)(8). See also *The Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479, 1480 (TTAB 1990) (regarding combined sets of interrogatories which are subject to a motion relating to discovery); *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (regarding a motion for summary judgment); *Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc.*, 5 USPQ2d 1067, 1070 (TTAB 1987) (respondent again reminded that discovery materials are not to be filed with the Board except under specified circumstances); and *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979) (filing of a discovery deposition not required or desired in the absence of a notice of reliance); and G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163, 166-167 (1981) (but note that this article was written prior to the rule changes noted above).

¹⁹² See 37 CFR § 2.120(j)(8).

¹⁹³ See *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1863 (TTAB 2001) (burden is on the party seeking the information to establish why it is relevant); *Luemme Inc. V. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999) and *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections with particularity). See also *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974); and *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974).

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Further, if a party on which interrogatories have been served in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the responding party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number; a motion for a protective order is not the proper method for raising the objection of excessive number.¹⁹⁴

Nevertheless, there are some situations in which a party may properly respond to a request for discovery by filing a motion attacking it. In cases where, for example, a request for discovery constitutes clear harassment, or where a defendant on which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest, the party on which the request was served may properly respond to it by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions.¹⁹⁵

If the discovery sought is a discovery deposition, and the request therefor constitutes harassment, there is insufficient notice, etc., the party on which the request was served may file either a motion to quash the notice of deposition or a motion for a protective order.¹⁹⁶

411 Remedy for Failure to Provide Discovery

411.01 Interrogatories or Requests for Production

If any party fails to answer any interrogatory, the party seeking discovery may file a motion with the Board for an order to compel an answer. Similarly, if any party fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion for an order to compel production and an opportunity to inspect and copy.¹⁹⁷

¹⁹⁴ See 37 CFR § 2.120(d)(1); TBMP § 405.03(e) (Remedy for Excessive Interrogatories); and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

¹⁹⁵ See, for example, 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high-level official granted); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted since obligation to respond to discovery requests rests with assignee); and *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash one notice to depose person who was no longer an employee and another notice to depose person with authority to negotiate settlement, granted).

¹⁹⁶ See, for example, *FMR Corp. v. Alliant Partners*, *supra* at 1763 (motion for protective order) and *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash). See also TBMP § 521 (motion to quash) and TBMP § 526 (motion for a protective order).

¹⁹⁷ See 37 CFR § 2.120(e). Cf. Fed. R. Civ. P. 37(a)(2)(B). For information concerning motions to compel, see TBMP § 523.

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411.02 Requests for Admission

If a party on which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board.¹⁹⁸

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the answer or objection.¹⁹⁹ If the Board determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served.²⁰⁰

411.03 Discovery Depositions

If a party fails to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(3), or if a party or such designated person, or an officer, director or managing agent of a party, fails to attend a discovery deposition, or fails to answer any question propounded in a discovery deposition, the party seeking discovery may file a motion with the Board for an order to compel a designation, or attendance at a deposition, or an answer.²⁰¹

A discovery deposition is taken out of the presence of the Board, and if a witness objects to, and refuses to answer, a particular question, and the propounding party wishes to obtain an immediate ruling on the propriety of the objection, it may do so only by adjourning the deposition and applying, under 35 U.S.C. § 24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer.²⁰² In the absence of a court order compelling an answer, the propounding party's only alternative, if it

¹⁹⁸ See TBMP § 407.03(a) (Time for Responses). *For information on motions to withdraw or amend admissions, see TBMP § 525.*

¹⁹⁹ See 37 CFR § 2.120(h), and Fed. R. Civ. P. 36(a).

²⁰⁰ See Fed. R. Civ. P. 36(a). *For information on motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.*

²⁰¹ See 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a). *For information concerning motions to compel, see TBMP § 523.*

²⁰² See *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974). *Cf. Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983) (where a witness refuses to answer a question in a testimony deposition). See also *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953).

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wishes to compel an answer, is to complete the deposition and then file a motion to compel with the Board.²⁰³

411.04 Discovery Sanctions

In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide discovery. The sanctions which may be entered by the Board include, *inter alia*, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; drawing adverse inferences against uncooperative party; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party.²⁰⁴

412 Protective Orders

37 CFR § 2.120(f) *Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party provide or permit discovery.*

412.01 In General

On motion, showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (1) through (8) of Fed. R. Civ. P. 26(c).²⁰⁵

For further information on motions for protective orders, see TBMP § 410 (Motions Attacking Requests for Discovery), TBMP § 412.02 (Protective Order Regarding Confidential and Trade Secret Information) and TBMP § 526 (Motion for Protective Order).

²⁰³ See 37 CFR § 2.120(e), and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

²⁰⁴ See 37 CFR §§ 2.120(g)(1) and (2), and 2.127(f), and TBMP § 502.05 (Attorneys' Fees). *For further information concerning discovery sanctions and when they are available, see TBMP § 527.01.*

²⁰⁵ See 37 CFR § 2.120(f). *See also* TBMP §§ 527.01(a) (sanctions), and 703.01(p) (confidential materials).

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412.02 Protective Order Regarding Confidential and Trade Secret Information

412.02(a) Upon Motion

When the Board grants a motion for a protective order with respect to confidential or trade secret information, it may direct either the disclosing party, or the parties together, to prepare an order with terms that are mutually agreeable to them.²⁰⁶ Other alternatives involve accepting a protective order proffered by a party, or ordering parties to adhere to Board's standard protective order.²⁰⁷ If the Board orders that the parties abide by the terms of this order, the parties may subsequently agree to modifications or additions, subject to Board approval.

412.02(b) Upon Stipulation

Parties to proceedings before the Board may, and often do, enter into stipulated protective orders, that is, agreements as to specified procedures and restrictions that shall govern the disclosure of any confidential or trade secret information.²⁰⁸ The Board has a standardized protective order which parties are free to use or modify as appropriate. The standardized protective order can be found in the Appendix of Forms in this manual and on the USPTO web site at: www.uspto.gov.

If the parties enter into a stipulated protective order, a copy of the executed agreement should be filed with the Board so that the Board is on notice that confidential material may be filed in connection with the proceeding. The Board will acknowledge receipt of the agreement, but the parties should not wait for the Board's acknowledgement to conduct themselves in accordance with the terms of their agreement. The terms of the agreement are binding as of the date the agreement is signed.²⁰⁹

Only confidential or trade secret information should be filed pursuant to a stipulated protective order. Such an order may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that except for matter filed under seal pursuant to a protective order issued by a court or by the Board, the file of a

²⁰⁶ See, for example, *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

²⁰⁷ The standard protective order can be found in the Appendix of Forms in this manual and on the USPTO web site at: www.uspto.gov.

²⁰⁸ See Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

²⁰⁹ See TBMP § 412.05 (Signature of Protective Agreement).

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published application or issued registration, and all proceedings relating thereto, are available for public inspection.²¹⁰

412.02(c) In Camera Inspection

In situations where there is a dispute between the parties to a proceeding as to the relevance and/or confidentiality of a document, or portions thereof, sought to be discovered, and the Board cannot determine from the arguments of the parties, on motion to compel production, whether the document is relevant and/or confidential, the Board may request that a copy of the document be submitted to the Board for an in camera inspection, after which the document will be returned to the party which submitted it.²¹¹

412.02(d) Contents of Protective Order

Typically, a protective order dealing with confidential or trade secret information contains provisions such as the following:

- (1) A definition of the type of material to be considered confidential or trade secret information.
- (2) A description of the manner in which confidential or trade secret information is to be handled.
- (3) A requirement that a party claiming confidentiality or trade secret designate the information covered by the claim prior to disclosure of the information to the discovering party.
- (4) A provision that a party may not designate information as confidential or trade secret unless the party has a reasonable basis for believing that the information is, in fact, confidential or trade secret in nature.
- (5) A provision that information designated by the disclosing party as confidential or trade secret may not include information which, at or prior to disclosure thereof to the discovering party, is known to or independently developed by the discovering party; or is public knowledge or becomes available to the public without violation of the agreement.

²¹⁰ See *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000) and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, *supra*.

²¹¹ See Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, *supra*.

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- (6) A provision that information designated by the disclosing party as confidential or trade secret may not include information that, after the disclosure thereof, is revealed to the public by a person having the unrestricted right to do so.
- (7) A provision that information designated by the disclosing party as confidential or trade secret may not include information which is acquired by the discovering party from a third party, which lawfully possesses the information and/or owes no duty of nondisclosure to the party providing discovery.
- (8) A specification of the persons to whom confidential or trade secret information may be disclosed (e.g., outside counsel; house counsel; counsel's necessary legal and clerical personnel).
- (9) A provision that all persons to whom confidential or trade secret information is disclosed shall be advised of the existence and terms of the protective order.
- (10) A provision that the discovering party will not disclose or make use of confidential or trade secret information provided to it under the order except for purposes of the proceeding in which the information is provided.
- (11) A means for resolving disputes over whether particular matter constitutes confidential or trade secret information.
- (12) A provision that if material designated as confidential or trade secret is made of record in the proceeding, it shall be submitted to the Board in a separate sealed envelope or other sealed container bearing the proceeding number and name, an indication of the general nature of the contents of the container, and, in large letters, the designation "CONFIDENTIAL."
- (13) A statement that at the end of the proceeding, each party shall return to the disclosing party all confidential information and materials, including all copies, summaries, and abstracts thereof.

The Board's standardized protective order can be found in the Appendix of Forms in this manual and on the USPTO web site at: www.uspto.gov.

*For additional information concerning the contents of a protective order, see the cases and authorities cited in the note below.*²¹²

²¹² See Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981). See also *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000) (stipulated protective agreement should include provision that it may be amended without leave of Board); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (in addition to

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412.03 Signature of Protective Order

Stipulated protective orders may be signed either by the parties thereto, or by their attorneys, or by both. However, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding.²¹³

Imposition of the terms of a protective order by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order.

The terms of the protective order are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

412.04 Filing Confidential Materials With Board

37 CFR § 2.27 Pending trademark application index; access to applications.

(d) Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection ...

(e) Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the board shall be filed under seal.

provisions mandated by Board, protective order may contain other provisions as are agreeable to parties); and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (Board required provision that information furnished by opposer would be confined to applicant's attorneys).

²¹³ See *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445, n.3 TTAB 2000) (Board's jurisdiction would not extend to third-party signatory); and *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987). See also, with respect to violation of a Board protective order after the conclusion of the Board proceeding, *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991) (bringing confidential business documents into the public record in violation of the Board's protective order established a cause of action in district court).

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Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying.²¹⁴ Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. If a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.²¹⁵

Confidential materials filed in the absence of a protective order are not regarded as confidential and are not kept confidential by the Board.²¹⁶ The mere stamping of "confidential" on documents does not operate in lieu of a protective order or agreement.

In the event that material designated as confidential (including trade secret material) is made of record in the proceeding, it should be submitted to the Board in a separate sealed envelope or other sealed container prominently marked with the word "CONFIDENTIAL." Many attorneys also like to attach to the sealed envelope or other sealed container a statement, such as the following:

FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER.
The materials contained in this envelope have been designated confidential, pursuant to a protective order, and are not to be disclosed or revealed except to the Trademark Trial and Appeal Board and counsel for the parties, or by order of a court.

The envelope or other container should also bear information identifying the proceeding in connection with which it is filed (i.e., the proceeding number and name), and an indication of the nature of the contents of the container (i.e., "Applicant's Answers to Opposer's Interrogatories 8 and 19," "Pages 22-26 From the Discovery Deposition of John Doe," "Opposer's Exhibits 3-5 to the Discovery Deposition of John Smith," etc.).

²¹⁴ See, e.g., *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file).

²¹⁵ See 37 CFR § 2.27(d) and (e); *Duke University v. Haggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000); and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

²¹⁶ See *Harjo v. Pro-Football, Inc.*, *supra* (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file).

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412.05 Handling of Confidential Materials By Board

Confidential materials (including trade secret information) filed under seal subject to a protective order are stored by the Board in a secure location, and are disclosed only to the Board and to those people specified in the protective order as having the right to access.²¹⁷ After the proceeding before the Board has been finally determined, all confidential materials are returned to the party that submitted them.²¹⁸

413 Telephone and Pre-Trial Conferences

When appropriate and necessary, a motion relating to discovery may be resolved by telephone conference, or by pre-trial conference at the offices of the Board. In either case, the conference will involve the parties or their attorneys and an Attorney-Advisor, or a Member, or the Board.²¹⁹

414 Discovery Guidelines

Listed below are guidelines, with case citations, relating to the discoverability of a variety of matters:

(1) The identification of discovery documents (as opposed to their substance) is not privileged or confidential.²²⁰

(2) In those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.²²¹

²¹⁷ See Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements, supra*, and TBMP § 120.02.

²¹⁸ For information concerning access to protective order materials during an appeal from the decision of the Board, see TBMP § 904.

²¹⁹ See 37 CFR § 2.120(i). For further information concerning the resolution of motions by telephone and pre-trial conference, see TBMP § 502.06.

²²⁰ See *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that client received legal opinions and identity of documents related thereto, not privileged); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (objection to interrogatories on ground of privilege or under Rule 26(b)(3), *i.e.*, material prepared in anticipation of trial, not well taken).

²²¹ See, for example, *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987) (production of representative sample not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985) (allowed to

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(3) The classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers constitute confidential information, and generally are not discoverable, even under protective order.²²² However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order.²²³

(4) Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant).²²⁴

provide representative samples of invoices from each calendar quarter); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579-80 (TTAB 1975) (opposer need not identify dollar value and number of units of product held in inventory but may indicate only whether it does in fact carry such products in stock); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 689-90 (TTAB 1975) (sales and advertising figures for six different categories of goods since 1936 limited to five-year period and a statement that there have been sales for the other years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (production limited to ten representative samples of documents pertaining to selection of each type of copy machine); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (representative samples of advertisements permitted).

Compare *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (if opposers believed the limited information provided by applicant in response to interrogatories was insufficient and that applicant's objections on grounds that the interrogatories were unduly broad, burdensome, etc., were unfounded, opposers could have moved to compel more complete responses), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) and *The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468, 471 (TTAB 1976) (if applicant believed documents produced by opposer were not truly representative, applicant could have filed motion to compel).

²²² See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not reveal names of customers including dealers).

²²³ See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra* at 1675 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985) (need for customer names does not outweigh possible harm, such as harassment of customers); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 169 (TTAB 1980) (possible harm outweighed where issue is abandonment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (name and address of first customer may be revealed to verify date of first use); and *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (must identify class of customers who purchase products under mark, but not names of customers). For additional case cites, see *Appendix of Cases*.

²²⁴ See *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (must identify knowledgeable employees); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (whether applicant received opinions concerning adoption of mark is not privileged and applicant must identify person, date and documents relating thereto); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (identification of persons who suggested use of involved mark on involved goods is not improper).

Cf. *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1974) (applicant's request for writings relating to selection of mark to show what third parties' marks may have been considered and extent to which opposer believed its mark conflicted therewith not permitted).

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- (5) Information concerning a party's first use of its involved mark is discoverable.²²⁵
- (6) Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived).²²⁶
- (7) A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable.²²⁷
- (8) A party's plans for expansion may be discoverable under protective order.²²⁸
- (9) Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence.²²⁹

²²⁵ See, for example, *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195-96 (TTAB 1976) (dates petitioner's plants first began production of goods bearing mark are pertinent to claim of priority), and *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 496 (TTAB 1975) (must provide name, address and affiliation of persons to whom service was first rendered). See also *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (use or intended use of applicant's mark in commerce with U.S. is relevant).

²²⁶ See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that an opinion concerning trademark validity or possible conflicts regarding applicant's adoption and use of mark was given to applicant is not privileged); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975); and *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974) (attorney comments on search report or prosecution of application are privileged).

²²⁷ See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document and witness in support of its pleaded allegations" was equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper); *Milliken & Co. v. Image Industries, Inc.*, 39 USPQ2d 1192, 1197 (TTAB 1996) (need only identify expert witnesses); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (need not disclose entirety of proposed evidence), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (motion to exclude testimony of witness for failure to identify witness during discovery denied); *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542, 543 (TTAB 1974) (opposer need not describe evidence it will rely on to support allegations in opposition); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 124 (TTAB 1974).

²²⁸ See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (opposer's intent to expand business to include manufactured products similar to applicant's is relevant).

²²⁹ See *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001) (no obligation to search for third-party uses); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001)

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(10) Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable.²³⁰ However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published).²³¹

(11) A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion.²³²

(investigation not necessary); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not investigate); and *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show mark is weak). See also *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1363 n.9 (TTAB 1988) (relevant to show purchaser perception of the marks).

²³⁰ See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show admissions against interest, limitations on rights in mark, course of conduct leading to abandonment, that the mark has been carefully policed, etc.); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976) (settlement agreements that have avoided litigation may show limitations on party's rights in mark or reveal inconsistent statements); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580-81 (TTAB 1975) (identity of all civil and USPTO proceedings involving mark is not objectionable); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (contacts with third parties, such as through litigation or agreements, based on pleaded mark for involved goods, are relevant).

²³¹ See *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975) (need not reveal reasons for dismissal of prior opposition against third party) and *Johnson & Johnson v. Rexall Drug Co.*, *supra* at 172 (need not identify all documents pertaining to such litigation).

²³² See *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (where goods of parties differ, determining whether parties market goods of same type is relevant to establishing relationship between goods); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (questions concerning specific goods on which opposer uses mark are proper to extent scope of inquiry is limited to those goods identified in application, or involve goods of type marketed by applicant, or mentioned by opposer during discovery); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 n.2 (TTAB 1985) (information regarding goods other than those in involved application and registration is irrelevant); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 584 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1979) (applicant's use of mark on goods other than those in application irrelevant); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (interrogatory too broad, requiring identity of products having no relevance to opposition); *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493, 493 (TTAB 1973) (applicant need not provide information as to its other marks or its other products, or as to whether involved mark is used on other products). See also *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (although the goods are not the same, they are of the type often made by the same manufacturer), and *Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649, 652

Chapter 400 DISCOVERY

(12) The names and addresses of a party's officers are discoverable. However, if a party has a large number of officers, it need only provide the names and addresses of those officers most knowledgeable of its involved activities.²³³

(13) Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purpose of forestalling a foreign user's expansion into the United States, or where the foreign mark is "famous," albeit not used, in the United States.²³⁴

(CCPA 1975) (in the absence of any showing that manufacturers never use same mark on the two involved classes of goods, the fact that the goods are often made by the same manufacturer, even if under different marks, may be relevant)

²³³ See *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (may identify reasonable number of those most knowledgeable of adoption, selection or day-to-day uses of mark); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (identification of vice-president as most familiar with use held sufficient).

²³⁴ See, for general rule, *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) and *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.). See also *Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481, 489 n.7 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff'd*, *Miller Brewing Co. v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976).

See, *re possible exceptions*, Article 6 bis of the Paris Convention; *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (knowledge of foreign use, in itself, does not preclude good faith adoption and use in U.S.); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, *supra*; *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 702 (TTAB 1986) (in view of applicant's knowledge of opposer's claim to mark in foreign countries and of opposer's intention to enter U.S. market, it appears that applicant intended to preclude opposer from entering U.S. market); *Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A.*, 228 USPQ 589, 595 (TTAB 1985) (presale publicity including providing clothing with mark to competitive skiers insufficient to popularize mark as identifying source to U.S. purchasers and to create priority rights in the U.S.); *Davidoff Extension S.A. v. Davidoff International, Inc.*, 221 USPQ 465, 468 (S.D. Fla. 1983) (foreign corporation with U.S. registration based on foreign registration had rights in mark superior to individual who attempted to use the name in the U.S.); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 77-78 (TTAB 1983) (prior use and advertising in connection with goods marketed in foreign country, whether advertising occurs inside or outside U.S., creates no prior rights in U.S. against one who adopts similar mark prior to foreigner's first use on goods sold in U.S., unless foreign party's mark was famous); *All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc.*, 220 USPQ 1069, 1072 (TTAB 1983) (opposer acquired rights to famous mark in U.S. for competitions held in England prior to adoption of mark by applicant for any goods/services); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 662 (TTAB 1983) (claim of fame in France and existence of pending U.S. application based on foreign registration insufficient to establish that fame extended to U.S.). See also *Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046 (TTAB 1983) and *Johnson & Johnson v. Diaz*, 339 F. Supp. 60, 172 USPQ 35 (C.D. Cal. 1971).

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(14) Generally, the names and addresses of the stockholders of a corporate party or other entities owned or controlled by the party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related companies" within the meaning of Section 5 of the Act, 15 U.S.C. § 1055.²³⁵

(15) The locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its involved mark, are discoverable.²³⁶

(16) Information relating to the areas of distribution for a party's involved goods or services sold under its involved mark is discoverable.²³⁷

(17) The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion.²³⁸

(18) Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order.²³⁹

²³⁵ See *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (irrelevant unless the other company has used the mark); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 472 (TTAB 1974) (no bearing on right to register); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974).

²³⁶ See *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (locations of "all places of business" overly broad); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974).

²³⁷ See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (relevant areas of inquiry include number of salesmen, locations of sales representatives who market goods bearing the mark, and geographic location of dealers who market and distribute the products under the mark); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 196 (TTAB 1976) (petitioner was required to list all states to which its goods were shipped prior to respondent's claimed first use date and to identify persons who would be knowledgeable about such matters); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (information regarding geographic areas of distribution of goods is relevant to questions of likelihood of confusion and abandonment); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 495 (TTAB 1975) (year by year, state by state break down of numbers of magazines distributed is proper); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974).

²³⁸ See *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (may lead to relevant information concerning circumstances surrounding selection of mark, distinctiveness of mark, etc.).

²³⁹ See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of likelihood of confusion and abandonment; response that these figures have been "substantial" is insufficient); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (sales and advertising expenditures have bearing on registrability); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (relevant to issue of abandonment); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to

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(19) Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable.²⁴⁰

(20) Information concerning the technical expertise of the purchasers of a party's products, is relevant to the issue of likelihood of confusion and is discoverable.²⁴¹

(21) A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact.²⁴²

(22) The mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, is not objectionable on the basis that it constitutes a collateral attack on the registration.²⁴³

provide figures for each of last five years and a statement that there have been sales for the other years); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (money expended in advertising to be confined to goods in application); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (required to furnish round figures concerning sales under mark for period of five years as well as advertising expenditures relating thereto).

²⁴⁰ See *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (applicant's knowledge of use by opposer or by the public or the trade, is relevant); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (applicant required to go through its files to determine when it acquired actual knowledge of opposer's marks).

²⁴¹ *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (the sophistication of purchasers a factor in assessing the likelihood of confusion).

²⁴² See Fed. R. Civ. P. 33(c) and 36(a); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988); and *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) (question of whether opposer believes marks to be confusingly similar is relevant).

²⁴³ See *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (party is entitled to take discovery to determine whether grounds exist for any affirmative defenses or counterclaims) and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974).

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Section 404.08 Objections to Notice.

See also Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), *petition to Commissioner denied*, 198 USPQ 485 (Comm'r 1977); *O.M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973).

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See also Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

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412.02 Terms of suggested protective agreement upon stipulation:

Plaintiff

v.

Defendant

Opposition/Cancellation No.

PROVISIONS FOR PROTECTING CONFIDENTIALITY OF INFORMATION REVEALED DURING BOARD PROCEEDING

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, either the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

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TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential—Material to be shielded by the Board from public access.

Highly Confidential—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties’

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designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

Parties are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.

Attorneys for parties are defined as including in-house counsel and outside counsel, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.

Independent experts or consultants include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.

Non-party witnesses include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to confidential or highly confidential information in accordance with the terms that follow in paragraph 4. Further, independent experts or consultants may have access to trade secret/commercially sensitive information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall

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receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking

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the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) *Depositions.*

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) *Filing Notices of Reliance.*

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) *Briefs.*

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

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11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be affected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. Occasions when a whole document or brief must be submitted under seal should be very rare.

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

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13) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information, which the disclosing party intended to designate as protected, shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

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16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Agreement of the Following,
Effective:

[insert signature date]

[print or type name and title of
individual signing for plaintiff]

[print or type name and title of
individual signing for defendant]

[print or type name and law firm of
attorney for plaintiff]

[print or type name and law firm of
attorney for defendant]

By Order of the Board, effective _____.

[print or type name and title of Board attorney
or judge imposing order]