CHAPTER 700
TRIAL PROCEDURE AND INTRODUCTION OF EVIDENCE

701 Time of Trial

37 CFR § 2.116(b) *The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

(c) *The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

(d) *The assignment of testimony periods corresponds to setting a case for trial in court proceedings.*

(e) *The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.*

37 CFR § 2.121 Assignment of times for taking testimony.
(a)*(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule testimony periods is denied, the testimony periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party.*

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(b)*(1) The Trademark Trial and Appeal Board will schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.*

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Board will schedule testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.

(c) *A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods may remain as set.*

On receipt of a properly filed notice of opposition or petition to cancel (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. The notice includes a trial order assigning each party's time for taking testimony and introducing other evidence in the case.[1] Specifically, the Board schedules a 30-day testimony period for the plaintiff to present its case in chief, a 30-day testimony period for the defendant to present its case and to meet the case of the plaintiff, and a 15-day testimony period for the plaintiff to present rebuttal evidence.[2] The plaintiff's period for presenting its case in chief is scheduled to open 60 days after the close of the discovery period; the defendant's testimony period is scheduled to open 30 days after the close of the plaintiff's testimony period in chief; and the plaintiff's rebuttal testimony period is scheduled to open 30 days after the close of the defendant's testimony period.[3]

If there is a counterclaim, or if proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or if there is an interference or a concurrent use registration proceeding involving more than two parties, the Board schedules testimony periods as specified in 37 CFR § 2.121(b)(2), i.e., giving each plaintiff a period for presenting its case in chief as against each defendant, giving each defendant a period for presenting its case and meeting the case of each plaintiff, and giving each plaintiff a period for rebuttal. The testimony periods are separated from the discovery period by a 60-day interval, and from each other by 30-day intervals.[4] In an interference or concurrent use proceeding, a junior party is in the position of plaintiff and a senior party is in the position of defendant.[5]

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[1] *See* 37 CFR §§ 2.120(a), 2.121 and TBMP § 403.01 (Timing of Discovery in General).

[2] *See* 37 CFR §§ 2.121(b)(1) and 2.121(c).

[3] *See Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 356 (TTAB 1978) (thirty-day interval between each testimony period), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982).

[4] *See* 37 CFR §§ 2.121(b)(2) and 2.121(c). *Examples of trial schedules can be found in the Appendix of Forms for Chapter 300*.

[5] *See* 37 CFR §§ 2.96 and 2.99(e), and TBMP §§ 1005 and 1007.

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[6]

Testimony periods may be rescheduled, extended, or reopened by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.[7] It is preferable, where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion.[8]

The resetting of the closing date for discovery results in the automatic rescheduling of the testimony periods, without action by any party. However, the resetting of a party's time to respond to an outstanding request for discovery does not result in the automatic rescheduling of the discovery and/or testimony periods.[9] When a party's time to respond to an outstanding request for discovery is reset, the discovery and/or testimony 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.[10]

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[6] *See* 37 CFR §2.121(a)(1). *See also M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1072 (TTAB 1990) (untimely deposition stricken); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (opposer's discovery deposition of nonparty witness treated as testimony deposition taken by stipulation prior to trial); and *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979) (discovery deposition of nonparty inadmissible as evidence under a notice of reliance filed by one party without express or implied consent of adverse party; should have taken deposition during trial period or at least moved to take trial testimony prior to assigned testimony period).

Cf. Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, but applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

[7] *See* 37 CFR §§ 2.121(a)(1) and 2.121(c); Fed. R. Civ. P. 6(b); and, *for example*, *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (motion to extend testimony filed on last day with vague references to settlement and no detailed information concerning apparent difficulty in identifying and scheduling its witnesses for testimony denied); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999) (motion to extend denied where sparse motion contained insufficient facts on which to find good cause); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (motion to reopen to submit new evidence denied); and *Pumpkin Ltd v. The Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997) (motion to reopen filed over three months after close of testimony period, due to a docketing error, denied). *See also* TBMP §§ 501 and 509 *regarding stipulations and motions to extend or reopen.*

[8] *See* TBMP § 509.02 (Form and Determination of Motions to Extend or Reopen).

[9] *See 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).

[10] *See* 37 CFR § 2.121(a)(1).

In Board inter partes proceedings, the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period.[11]

702 Manner of Trial and Introduction of Evidence – In General

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations).[12]

Within the parameters of these rules, there are a number of ways to introduce evidence into the record in a proceeding before the Board. Evidence may be introduced in the form of testimony depositions taken by a party during its testimony period, and documents and other exhibits may be made of record with appropriate identification and introduction by the witness during the course of the deposition.[13] Certain specified types of evidence, including official records and printed publications as described in 37 CFR § 2.122(e) and discovery responses under 37 CFR § 2.120(j), may, but need not be introduced in connection with the testimony of a witness. Such evidence may instead be made of record by filing the materials with the Board under cover of a notice of reliance during the testimony period of the offering party.[14] In addition, the parties may enter into a wide variety of stipulations concerning the timing and/or introduction of specified matter into evidence.[15] For example, the parties may stipulate that matter otherwise improper for a notice of reliance (such as documents obtained by production under Fed. R. Civ. P. 34) may be introduced in that manner, that testimony may be submitted in the form of an affidavit, that a party may rely on its own discovery responses or that notices of reliance can be filed after the testimony periods have closed. There may also be circumstances where improperly offered or

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[11] *See* TBMP § 504.01 (Time for Filing Judgment on Pleadings) and authorities cited therein. *See also Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (Board proceedings approximate the proceedings in a courtroom trial) and *Time Warner Entertainment Company v. Jones.* 65 USPQ2d 1650 (TTAB 2002) (trial in a Board proceeding takes place during the testimony periods). *Cf.* TBMP § 528.02 (Time for Filing Motion for Summary Judgment).

[12] 37 CFR § 2.122(a). *Cf.* TBMP §§ 101.01 and 101.02.

[13] *See generally,* TBMP § 703 regarding testimony depositions. *See also* TBMP § 704.13 regarding introducing testimony from another proceeding, and TBMP § 530 regarding motions to use testimony from another proceeding.

[14] *See generally,* TBMP § 704.02 regarding the types of evidence that may be submitted by notice of reliance and the requirements for the introduction of such evidence by notice of reliance. *See also Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1786 n.4 (TTAB 2001) (notices of reliance must be filed before closing date of party's testimony period).

[15] *See* TBMP § 705 regarding stipulated evidence.

otherwise noncomplying evidence may nevertheless be deemed stipulated into the record where, for example, no objection to the evidence is raised and/or the nonoffering party treats the evidence as being of record.[16]

A discussion of the time and manner of taking testimony depositions and introducing evidence is presented in the sections that follow.

Because the Board is an administrative tribunal, its rules and procedures differ in some respects from those prevailing in the Federal district courts.[17] For example, proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based on the written record therein.[18] The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board.[19]

Depositions may be noticed for any reasonable place in the United States.[20] As a result, parties do not have to travel to the offices of the Board, or to the geographical area surrounding the Board's offices, to take their testimony. A party to a proceeding before the Board need never come to the offices of the Board at all, unless the party wishes to argue its case at oral hearing (and an oral hearing is held only if requested by a party to the proceeding--*see* 37 CFR § 2.129(a)).

The papers and other materials filed with the Board during the course of an inter partes proceeding are kept, during the course of the proceeding, in the physical possession of the Board.[21] However, no paper, document, exhibit, etc. will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.[22]

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[16] *See generally* TBMP § 704 regarding the introduction of other evidence.

[17] *See Yamaha International Corp. v. Hoshino Gakki Co.*, *supra* and *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). *Cf.* TBMP §§ 102.03 (General Description of Board Proceedings) and 502.01 (Available Motions). *For a discussion concerning the general nature of trials in proceedings before the Board, see Fischer Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 867 (TTAB 1979); *La Maur, Inc. v. Bagwells Enterprises, Inc., supra; and Litton Business Systems, Inc. v. J. G. Furniture Co.,* 190 USPQ 431 (TTAB 1976).

[18] *See* 37 CFR § 1.2.

[19] *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991) and *La Maur, Inc. v. Bagwells Enterprises, Inc., supra*.

[20] *See* 37 CFR § 2.123(c).

[21] *See* TBMP § 120 (Access to Files).

[22] *See* 37 CFR § 2.123(l), and TBMP § 706 (Noncomplying Evidence).

703 Taking and Introducing Testimony

703.01 Oral Testimony Depositions

703.01(a) In General

A testimony deposition is a device used by a party to a Board inter partes proceeding to present evidence in support of its case. Testimony is taken out of the presence of the Board, on oral examination or written questions, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board.[23] During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) in behalf of the party.[24]

Testimony depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, but also those documents and other exhibits which may not be made of record by notice of reliance.[25] However, only evidence admissible under the applicable rules of evidence may properly be adduced during a testimony deposition; inadmissibility is a valid ground for objection.[26]

For a comparison of testimony depositions and discovery depositions, see TBMP § 404.09.

703.01(b) Form of Testimony

37 CFR § 2.123(a)*(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

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[23] *See* TBMP § 702 (Manner of Trial and Introduction of Evidence). *See also* TBMP § 502.01 (Available Motions).

[24] *See* TBMP § 404.02 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

[25] *See generally* TBMP § 704 describing types of evidence admissible by notice of reliance.

[26] *See* 37 CFR §§ 2.122(a) and 2.123(k), and TBMP § 707.03 (Objections to Trial Testimony Depositions).

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) Stipulations. *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken either on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124.[27]

However, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--see 37 CFR § 2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination.[28] What constitutes good cause to take an oral deposition is determined on a case-by-case basis.[29]

In addition, a testimony deposition taken in a foreign country must be taken by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.[30]

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[27] *See* 37 CFR § 2.123(a)(1). *For information concerning testimony depositions on written questions, see* TBMP § 703.02.

[28] 37 CFR § 2.123(a)(1). *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990) (good cause to take oral deposition of expert witness, during rebuttal testimony period); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (good cause shown where deponents were former employees of respondent and present employees of petitioner and were being deposed for first time during rebuttal period); and TBMP § 531 (Motion that Deposition on Written Questions be Taken Orally).

[29] *See Feed Flavors Inc. v. Kemin Industries, Inc., supra* at 591 and TBMP § 531.

[30] *See* 37 CFR § 2.123(a)(2). *See also* TBMP § 520 (Motion to take Foreign Deposition Orally) and*, with respect to discovery depositions*, *Jain v. Ramparts Inc.,* 49 USPQ2d 1429, 1431 (TTAB 1998); 37 CFR § 2.120(c)(1); TBMP § 404.03(b) (Person Residing in Foreign Country – Party); and *Orion Group Inc. v. Orion Insurance Co. P.L.C.,* 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause to take oral deposition of witness in England under the

By written agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit by such witness or witnesses.[31] The parties may also stipulate in writing the facts in the case of any party, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony.[32]

703.01(c) Time for Taking Testimony

A party may take testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[33]

For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see TBMP §§ 509 and 701.

703.01(d) Time and Place of Deposition

37 CFR § 2.123(a)*(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of*

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circumstances and since fares to England were not that much greater than fares within U.S. and no translation was required).

[31] 37 CFR § 2.123(b). *See Order Sons of Italy in America v. Memphis Mafia Inc*., 52 USPQ2d 1364, 1365 n.3 (TTAB 1999) ("statement" with exhibits by defendant's officer stricken where there was no agreement that defendant could file testimony in form of affidavit or declaration); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403-04 n.9 (TTAB 1998) (no agreement; officer's affidavit not considered); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.3-4 (TTAB 1989) (although parties had stipulated to submission of testimony by affidavit, opposer's objection was well taken because applicant's unsworn statement did not constitute testimony); *Chase Manhattan Bank, N.A. v. Life Care Services Corp*., 227 USPQ 389, 390 (TTAB 1985) (affidavits submitted by agreement of the parties); *Oxy Metal Industries Corp. v. Transene Co.,* 196 USPQ 845, 847 n.20 (TTAB 1977) (stipulation to presentation of evidence by affidavit evidence reduces cost of litigation); and *National Distillers and Chemical Corp. v. Industrial Condenser Corp*., 184 USPQ 757, 758-59 (TTAB 1974) (both parties submitted stipulated testimony and exhibits).

Cf. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993) (objection waived where although there was no such agreement, plaintiff did not object to declarations with exhibits submitted by defendant and moreover considered the evidence as if properly of record).

[32] 37 CFR § 2.123(b). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (stipulation for use of discovery deposition as testimony deposition) and *Oxy Metal Industries Corp. v. Transene Co.*, *supra*, at 847 n.20 (litigation expenses can be saved where parties agree to introduce all uncontroverted facts by affidavit or stipulated facts and provide balance through deposition testimony).

[33] *See* 37 CFR § 2.121(a)(1). *See also* TBMP § 701 (Time of Trial) and authorities cited therein.

the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

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(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.*

A testimony deposition may be noticed for any reasonable time during the deposing party's testimony period.[34] A testimony deposition may not be taken outside the deposing party's testimony period except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[35]

A testimony deposition to be taken in the United States may be noticed for any reasonable place.[36] A party may not take depositions in more than one place at the same

[34] *See* 37 CFR § 2.123(c).

[35] *See* 37 CFR § 2.121(a)(1) and *Fossil Inc. v. Fossil Group,* 49 USPQ2d 1451, 1454 n.1 (TTAB 1998) (stipulation that testimony deposition of applicant's witness could be taken prior to its testimony period on the same day as opposer's witness to achieve efficiencies in time and cost). *See also* TBMP § 701 (Time of Trial) and authorities cited therein. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n..2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

[36] *See* 37 CFR § 2.123(c).

time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.[37]

A deposition may not be noticed for a place in a foreign country, unless the deposition is to be taken on written questions as provided by 37 CFR § 2.124, or unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination.[38]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[39]

703.01(e) Notice of Deposition

37 CFR § 2.123(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.*

Before the oral depositions of witnesses may be taken by a party, the party must give due (i.e., reasonable) notice in writing to every adverse party.[40]

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[37] *See* 37 CFR § 2.123(c).

[38] *See* 37 CFR §§ 2.123(a)(2) and 2.123(c). *See also* TBMP § 703.01(b) (Form of Testimony).

[39] *See* 37 CFR § 2.123(b).

[40] 37 CFR § 2.123(c*). See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Assn v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable); *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time to prepare for deposition); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was

The notice must specify the time and place the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. If the name of a witness is not known, the notice must include a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation.[41]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[42]

Ordinarily, a notice of oral deposition need not be filed with the Board, except as part of the completed deposition.[43] However, if a certified copy of the notice of deposition is, for some reason, required for use before a Federal district court, the notice of deposition must be filed with the Board for purposes of certification.[44]

For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, see 37 CFR § 2.123(e)(3) and TBMP § 533.02.

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shown). *See also* TBMP § 533.02 (Motion to Strike on Ground of Improper or Inadequate Notice). *Cf.* TBMP § 404.05 (Notice of [Discovery] Deposition).

[41] *See* 37 CFR § 2.123(c). *See also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony not considered where notice failed to specify name of party being deposed), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352, 353 (TTAB 1976) (testimony stricken where notice identified one witness and indicated that "possibly others will testify"; and where opposer proceeded to take testimony of unidentified witness, applicant objected, did not cross-examine the witness, and moved to strike testimony); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313, 314 (TTAB 1971) (objections sustained where identification of possible witnesses as "such other persons as may be called" insufficient to identify witness or group to which witness belongs), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973). *Cf.* TBMP § 404.05 (Notice of [Discovery] Deposition).

[42] 37 CFR § 2.123(b).

[43] *See* Rany L. Simms, *TIPS FROM THE TTAB: Whether and When to File Papers During Trademark Proceedings*, 67 Trademark Rep. 175 (1977), and 37 CFR § 2.123(f).

[44] *See* TBMP §§ 122 (Certification) and 703.01(f)(2) (Securing Attendance of Unwilling Witness Residing in U.S.).

703.01(f) Securing Attendance of Unwilling Adverse Party or Nonparty

703.01(f)(1) In General

Normally, during a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness who is willing to appear voluntarily to testify on behalf of the party. These testimony depositions may be taken, at least in the United States, on notice alone.

However, where a party wishes to take the testimony of an adverse party or nonparty, or an official or employee of an adverse party or nonparty, and the proposed witness is not willing to appear voluntarily to testify, the deposition may not be taken on notice alone. Rather, the party that wishes to take the deposition must take steps, discussed below, to compel the attendance of the witness. If the witness resides in a foreign country, the party may not be able to take the deposition.[45]

703.01(f)(2) Unwilling Witness Residing in United States

If a party wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena.[46]

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[45] *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (after unsuccessfully attempting to take testimony deposition on written questions of adverse party's officer on notice alone, opposer obtained subpoena from U.S. district court ordering appearance); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (it is incumbent on deposing party to have a subpoena issued from the U.S. district court where witness is located and have same properly served on witness with sufficient time to apprise him that he is under order to appear) ; Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (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 TBMP §§ 703.01(f)(2) (securing attendance of unwilling witness residing in U.S.), 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country), and 703.02 (testimony depositions on written questions). *See also Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 55 n.7 (TTAB 1983) (no adverse inference can be drawn from adverse party's failure to appear and produce requested documents at testimony deposition where party attempted to secure attendance by notice alone), *aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

[46] *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, *supra*; *Consolidated Foods Corp. v. Ferro Corp.*, *supra*; Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness*

The subpoena must be issued, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, from the United States district court in the Federal judicial district where the witness resides or is regularly employed. Occasionally district courts may request a "matter number" for the issuance of a subpoena. If that is the case, the requesting party should obtain one from the court or determine whether the Board's proceeding number will satisfy the court. If**,** for any reason, a certified copy of the notice of deposition is required in connection with the subpoena, such as for purposes of a motion to quash the subpoena, or a motion to enforce the subpoena, the interested party should contact the clerk of the court to determine whether the court will require a formal certified copy (i.e., a certified copy bearing a USPTO seal) of the notice.[47] A certified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and certified by the USPTO as being a true copy of the notice of deposition filed in the proceeding before the Board. A copy of a notice of deposition cannot be certified by the USPTO unless it has been filed in the Board proceeding.[48]

If a person named in a subpoena compelling attendance at a testimony 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. Similarly, any request to quash a subpoena must be directed to the United States district court that issued the subpoena. The Board has no jurisdiction over depositions by subpoena.[49]

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in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). *Cf.* TBMP § 404.03(a)(2) (securing attendance of nonparty residing in U.S. at discovery deposition).

[47] *NOTE: The Board no longer provides verified copies of filings.*

[48] *For further information relating to USPTO certification of a notice of deposition, see* TBMP § 122 (Certification).

[49] *See, for example, In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201, 201 (D.Del. 1973) (no power to grant protective order with respect to depositions taken by subpoena); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (no authority to quash subpoena); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318, 319 n.2 (TTAB 1971) (opposer's allegation in its brief that applicant defied a subpoena to produce witnesses is a matter opposer should have pursued before the court that issued the subpoena); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (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).

703.01(f)(3) Unwilling Witness Residing in Foreign Country

There is no certain procedure for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a nonparty (or an official or employee of an adverse party or nonparty), and is not willing to appear voluntarily to testify. However, the deposing party may be able to obtain the testimony deposition of such a witness through the letter rogatory procedure or The Hague Convention letter of request procedure.[50]

For information concerning these procedures, see TBMP § 404.03(c)(2).

703.01(g) Persons Before Whom Depositions May be Taken

37 CFR § 2.123(d) Persons before whom depositions may be taken. *Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.*

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, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the 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]."*

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

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.*

Depositions in Board inter partes proceedings may be taken before the persons described in Fed. R. Civ. P. 28.[51]

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a Board proceeding testimony 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."[52] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter who is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a Board proceeding testimony deposition may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a Board proceeding testimony deposition taken of a 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.[53] A party which wishes to take a testimony 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. The testimony of an unwilling adverse party or nonparty witness may be taken in a foreign country, if at all, only by the letter rogatory procedure, or by the letter of request procedure provided under the Hague

[51] 37 CFR § 2.123(d).

[52] *See* Fed. R. Civ. P. 28(a).

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

Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, or by any other procedure provided for the purpose by any future treaty into which the United States may enter.[54]

If the parties so stipulate in writing (and if permitted by the laws of the foreign country, in the case of a deposition to be taken in a foreign country), a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[55]

703.01(h) Examination of Witnesses

37 CFR § 2.123(e) Examination of witnesses. (1) *Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition is to be taken.*

(2) *The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be taken stenographically and transcribed, unless the parties present agree otherwise. In the absence of all opposing parties and their attorneys or other authorized representatives, depositions may be taken in longhand, typewriting, or stenographically. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly to the contrary.*

(3) *Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

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[54] *Cf.* TBMP §§ 404.03(c) (concerning discovery deposition of nonparty residing in foreign country) and 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country).

[55] 37 CFR § 2.123(b).

(4) *All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.*

Fed. R. Civ. P. 30(b)(7) *The parties may stipulate in writing or the court may upon motion order that a deposition be taken by telephone or other remote electronic means. For the purposes of this rule and Rules 28(a), 37(a)(1), and 37(b)(1) a deposition taken by such means is taken in the district and at the place where the deponent is to answer questions.*

Before testifying, a witness whose testimony deposition is being taken for use in a Board inter partes proceeding must be duly sworn, according to law, by the officer before whom the deposition is to be taken.[56]

The deposition is taken in answer to questions, and the questions and answers are recorded in order by the officer, or by some other person (who is subject to the provisions of Fed. R. Civ. P. 28) in the presence of the officer, except when the officer's presence is waived on the record by agreement of the parties. The testimony is taken stenographically and transcribed, unless the parties present agree otherwise. If no adverse party, or its attorney or other authorized representative, attends the deposition, the testimony may be taken in longhand, typewriting, or stenographically.[57]

The Board does not accept videotape depositions. A deposition must be submitted to the Board in written form. However, a videotape of a commercial, demonstration, etc., may be submitted as an exhibit to the testimony of a witness.

On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone.[58] A deposition taken by telephone is taken in the district and at the place where the witness is to answer the questions propounded to him or her.

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[56] 37 CFR § 2.123(e)(1). *See Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (objection to deposition taken in Honduras that officer designated in notice did not take deposition and that the transcript did not show due administration of the oath overruled where the person who conducted the deposition had authority to do so under Honduran law and the oath was administered in standard manner under Honduran law). *See also* TBMP § 703.01(g) (Persons Before Whom Depositions May be Taken).

[57] 37 CFR § 2.123(e)(2).

[58] *See* Fed. R. Civ. P. 30(b)(7), and *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552-53 (TTAB 1991) (Board granted request to attend deposition by telephone noting that trademark rules do not specifically provide for or prohibit depositions by telephone and that federal court practice favors use of technological benefits).

Exhibits which are marked and identified at the deposition will be deemed to have been offered in evidence, even if no formal offer thereof is made, unless the intention of the party marking the exhibits is clearly to the contrary.[59]

If exhibits are large, bulky, valuable, or breakable, the Board strongly prefers that they be photographed (or, in the case of documents, photocopied), and that the photographs (or photocopies) be filed with the Board in lieu of the originals. The originals should, of course, be shown to every adverse party. If an original exhibit does not photograph (or photocopy) well, and one of the parties intends to request that an oral hearing be held on the case, the parties may agree that the original be carried to the oral hearing and given to the Board at that time.[60] If the original exhibits require special handling*, e.g.,* they are large, bulky, valuable or breakable, the filing party should contact the Board for hand delivery and safe retrieval.

Every adverse party must be given a full opportunity to cross-examine the witness. If the notice of deposition served by a party is improper or inadequate with respect to the witness, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence.[61]

All objections made at the time of the taking of a testimony deposition as to the qualifications of the officer taking the deposition, the manner of taking the deposition, the evidence presented, the conduct of any party, or any other objection to the proceedings, are noted by the officer upon the deposition. Evidence objected to is taken subject to the objections.[62]

Questions to which an objection is made 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.[63] *For information concerning the propounding party's recourse if a witness not only objects to, but also refuses to answer, a particular question, see* TBMP §§ 404.09 and 707.03(d) and authorities cited therein.

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[59] 37 CFR § 2.123(e)(2). *Cf. Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1838 n.4 (TTAB 1989) (decided prior to the rule change which eliminated "formal" introduction of exhibits).

[60] *See* Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

[61] 37 CFR § 2.123(e)(3). *For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, see* 37 CFR § 2.123(e)(3), and TBMP §§ 533.02 and 707.03(b)(2*).*

[62] 37 CFR § 2.123(e)(4). *See also* TBMP § 707.03 (Objections to Trial Testimony Depositions).

[63] *See* TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

For further information concerning the raising of objections to testimony depositions, see TBMP §§ 533 and 707.03 and authorities cited therein.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[64]

703.01(i) Form of Deposition

37 CFR § 2.123(g) Form of deposition. ***(1)*** *The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition may be written on legal-size or letter-size paper, with a wide margin on the left hand side of the page, and with the writing on one side only of the sheet. The questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used, and each question must be followed by its answer.*

(2) *Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.*

(3) *Each deposition must contain an index of the names of the witnesses, giving the pages where their examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.*

37 CFR § 2.125(d) *Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.*

A deposition must be submitted to the Board in written form. The Board does not accept videotape depositions.

The particular requirements for the form of a written deposition are specified in 37 CFR § 2.123(g).

Although 37 CFR § 2.123(g)(1) provides, inter alia, that a deposition may be written on either legal-size or letter-size paper, letter-size is recommended, because the case may ultimately be appealed to a Federal court which requires letter-size paper.

[64] 37 CFR § 2.123(b).

Exhibits must be marked as specified in 37 CFR § 2.123(g)(2). The Board, in its discretion, may refuse to enter and consider improperly marked exhibits.[65]

For information concerning deposition objections based on errors or irregularities in form, see TBMP § 707.03(c).

703.01(j) Signature of Deposition by Witness

37 CFR § 2.123(e)(5) *When the deposition has been transcribed, the deposition shall be carefully read over by the witness or by the officer to him, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.*

The signature of a deposition by the witness is governed by 37 CFR § 2.123(e)(5). The deposition does not have to be signed in the presence of the officer before whom the deposition was taken. It may be signed in the presence of any officer authorized to administer oaths.

Reading and signature cannot be waived by mere agreement of the witness; the agreement of every party is required.[66]

703.01(k) Certification and Filing of Deposition

37 CFR § 2.123(f) Certification and filing of deposition.
(1) *The officer shall annex to the deposition his certificate showing:*
(i) Due administration of the oath by the officer to the witness before the commencement of his deposition;
(ii) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his presence;
(iii) The presence or absence of the adverse party;
(iv) The place, day, and hour of commencing and taking the deposition;
(v) The fact that the officer was not disqualified as specified in Rule 28 of the

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[65] 37 CFR § 2.123(g)(2). *Cf. Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (these requirements are for the convenience of the Board; improperly marked exhibits considered); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (the Board has discretion to consider improperly marked exhibits); and G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

[66] *See* 37 CFR § 2.123(e)(5). *See alsoTampa Rico Inc. v. Puros Indios Cigars Inc.*, *supra* at 1383 (TTAB 2000) (where witness did not sign his deposition, the defect was curable and allowed time to file and serve a signed copy) and Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc.,* 63 USPQ2d 1782, 1787 (TTAB 2001) (depositions which were not signed and included no waiver were nevertheless considered where no objections were made).

Federal Rules of Civil Procedure.

***(2)** If any of the foregoing requirements in paragraph (f)(1) are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing. The officer or the party taking the deposition, or its attorney or other authorized representative, shall then promptly forward the package to the address set out in § 1.1(a)(2)(i). If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted by the officer or the party taking the deposition, or its attorney or other authorized representative, in a separate package marked and addressed as provided in this section.*

37 CFR § 2.125 Filing and service of testimony.
***(a)** One copy of the transcript of testimony taken in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

* * * *

***(c)** One certified transcript and exhibits shall be filed with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.*

The certification and filing of a deposition are governed by 37 CFR § 2.123(f).[67] The certified transcript, with exhibits, should be sent to the Board at its mailing address, i.e., Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

[67] The Board interprets "promptly forward," in 37 CFR § 2.123(f)(2), as meaning forwarded at any time prior to the submission of the case for final decision. *See authorities cited in note 69 infra.*

The certified transcript and exhibits must be filed with the Board.[68] The Board will accept transcripts of testimony depositions at any time prior to the submission of the case for final decision.[69] In addition, a notice of reliance on the deposition transcript need not (and should not) be filed.[70] However, notice of the filing of the certified transcript, and accompanying exhibits, with the Board must be served on each adverse party. A copy of each such notice must also be filed with the Board.[71] In addition, one copy of the deposition transcript, together with copies, duplicates, or photographs of the exhibits thereto, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose.[72] *For information concerning the remedy that an adverse party may have if it is not timely served with a copy of the deposition and exhibits, see* TBMP § 703.01(m*).*

703.01(l) Testimony Deposition Must be Filed

37 CFR § 2.123(h) Depositions must be filed. *All depositions which are taken must be duly filed in the Patent and Trademark Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.*

All trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding.[73] If a party which took a testimony deposition refuses to file it,

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[68] *See* 37 CFR § 2.125(c).

[69] *See* Notice of Final Rulemaking, published in the *Federal Register* on September 9, 1998 at 63 FR 48081 and comments and responses published in the notice in regard to amendment of 37 CFR §§ 2.123(f) and 2.125(c). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (where the wording "promptly filed" in an earlier version of Rule 2.125(c) was construed as meaning filed at any time prior to final hearing).

[70] *See, for example, Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1898 n.2 (TTAB 1988) and *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.1 (TTAB 1982) (notice of reliance on exhibits introduced in connection with testimony superfluous).

[71] *See* 37 CFR § 2.125(c). *See also Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, n.4 (TTAB 2001) (testimony depositions are not filed by notice of reliance but instead are filed under cover of notice of filing which must also be served on each adverse party).

[72] *See* 37 CFR § 2.125(a).

[73] *See* 37 CFR § 2.123(h). *See also, for example, Order Sons of Italy in America v. Memphis Mafia, Inc.,* 52 USPQ2d 1364, 1366 n.4 (TTAB 1999); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, *supra* (opposer was not prejudiced by transcript of testimony deposition filed for first time with applicant's brief on the case because opposer should have assumed it would become part of the record); and *Anheuser-Busch, Inc. v. Major*

the Board, in its discretion, may refuse to further hear or consider the party, or may receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.[74]

703.01(m) Service of Deposition

37 CFR § 2.125 Filing and service of testimony.
(a) *One copy of the transcript of testimony taken in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

One copy of the transcript of trial testimony, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose.[75]

The requirement that a copy of the transcript, with exhibits, be served on every adverse party within the time specified in 37 CFR § 2.125(a) is intended to ensure that each adverse party will have the testimony before it has to offer its own evidence, or, if the testimony in question is rebuttal testimony, to ensure that each adverse party will have the testimony before it has to prepare its brief on the case.[76] If a copy of the transcript,

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Mud & Chemical Co., 221 USPQ 1191, 1192 n.7 (TTAB 1984). *Cf. An Evening at the Trotters, Inc. v. A Nite at the Races, Inc.*, 214 USPQ 737, 738 n.2 (TTAB 1982) (deposition which had not been filed but was not completed and was not referred to by either party was considered terminated and omitted by stipulation).

[74] 37 CFR § 2.123(h).

[75] 37 CFR § 2.125(a).

[76] *See Techex, Ltd. v. Dvorkovitz*, 220 USPQ 81, 82 n.2 (TTAB 1983) (opposer's objection to introduction of deposition overruled where opposer had been given time to request additional time for rebuttal in light of late-served copy of transcript but failed to do so), and *S. S. Kresge Co. v. J-Mart Industries, Inc.*, 178 USPQ 124, 125 n.3 (TTAB 1973) (applicant's objection in its brief to opposer's introduction of exhibits which were allegedly missing from service copy of deposition transcript, was untimely).

with exhibits, is not served on each adverse party within that time, any adverse party that was not served may have remedy by way of a motion to the Board to reset its testimony and/or briefing periods, as may be appropriate.[77]

If a party that took a deposition fails to serve a copy of the transcript, with exhibits, on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may take any of the actions mentioned in 37 CFR § 2.125(a).

703.01(n) Correction of Errors in Deposition

37 CFR § 2.125(b) *The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board. The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.*

A party that takes testimony is responsible for having any errors in the transcript corrected, on notice to each adverse party, prior to the filing of the certified transcript with the Board.[78]

If the witness, upon reading the transcript, discovers that typographical or transcription errors need to be made, or that other corrections are necessary to make the transcript an accurate record of what the witness actually said during the taking of his or her testimony, the witness should make a list of all such corrections and forward the list to the officer before whom the deposition was taken. The officer, in turn, should correct the transcript by redoing the involved pages. Alternatively, if there are not many corrections to be made, the witness may correct the transcript by writing each correction above the original text that it corrects, and initialing the correction. Although parties sometimes attempt to correct errors in transcripts by simply inserting a list of corrections at the end of the transcript, this is not an effective method of correction. The Board does not enter corrections for litigants, and the list of corrections is likely to be overlooked and/or disregarded. While corrections may be made in a transcript, to make the transcript an accurate record of what the witness said during the taking of his or her testimony,

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[77] 37 CFR § 2.125(a), and *Techex, Ltd. v. Dvorkovitz, supra*.

[78] 37 CFR § 2.125(b), and *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (objection to corrections served four days after filing and less than two weeks prior to due date for reply brief overruled since remedy lies in requesting extension of briefing period rather than having Board exclude the evidence).

material changes in the text are not permitted--the transcript may not be altered to change the testimony of the witness after the fact.[79]

If corrections are necessary, the party that took the deposition must serve on every adverse party a copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.[80]

If errors are discovered after the transcript has been filed with the Board, a list of corrections, signed by the witness, should be submitted to the Board (and served on every adverse party), together with a request for leave to correct the errors. Alternatively, the parties may stipulate that specified corrections may be made. If the request is granted, or if the parties so stipulate, the party that took the deposition should send a representative to the offices of the Board to make the listed corrections by writing them above the original text in the transcript.[81]

703.01(o) Objections to Testimony Depositions

For information concerning objections to testimony depositions, see TBMP § 707.03. *See also* TBMP § 533.

703.01(p) Confidential or Trade Secret Material

37 CFR § 2.125(e) *Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(g).*

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[79] *See Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321, 1325 (TTAB 1992) (any substantive changes made to testimony deposition on written questions would not be considered); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 333 n.4 (TTAB 1985) (Board gave no consideration to response or corrected response when the correction, which changed the percentage of opposer's business income derived from licensing, was substantive); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.2 (TTAB 1982) (change in testimony from "...designing that type of game..." to "...designing that Simon Says type of game..." was substantive in nature and not permitted).

[80] *See* 37 CFR § 2.125(b). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, *supra*.

[81] *See* Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

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.[82] Therefore, only the particular exhibits or deposition transcript pages that disclose confidential information should be filed under seal pursuant to a protective order. If a party submits a transcript or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.[83]

Confidential materials filed in the absence of a protective order are not regarded as confidential and are not kept confidential by the Board.[84] The mere stamping of "confidential" on documents does not operate in lieu of a protective order or agreement.

703.02 Testimony Depositions on Written Questions

703.02(a) Depositions on Written Questions: When Available

37 CFR § 2.123(a)*(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) Stipulations. *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By written agreement of*

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[82] *See Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1445 (TTAB 2000) and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

[83] *Cf.* 37 CFR § 2.120(f), and TBMP §§ 120.03 (Files of Terminated Proceedings), 412 (Protective Orders), 526 (Motion for a Protective Order), and 527.01 (Motion for Discovery Sanctions).

[84] *See 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).

the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.

Ordinarily, the testimony of a witness may be taken either on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124.[85] *For information concerning depositions on oral examination, see* TBMP § 703.01.

However, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--see 37 CFR § 2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination.[86]

In addition, a testimony deposition taken in a foreign country must be taken by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.[87]

703.02(b) 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. See 37 CFR § 2.124(a). *For further information, see* TBMP § 703.01(g).

703.02(c) Depositions on Written Questions: When Taken

37 CFR § 2.121 Assignment of times for taking testimony.
(a)(1) *The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times*

[85] 37 CFR § 2.123(a)(1).

[86] *See* 37 CFR § 2.123(a)(1), and TBMP § 703.01(b) (Form of Testimony) and cases cited therein.

[87] 37 CFR § 2.123(a)(2), and TBMP § 703.01(b) and cases cited therein.

assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. ...

37 CFR § 2.124(b)(1) *A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(d)(2) *... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.*

A party may take testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.[88]

A party that desires to take a testimony deposition on written questions must serve notice thereof on each adverse party within 10 days from the opening date of the deposing party's testimony period, as originally set or as reset.[89]

On receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions on written questions.[90]

For information concerning the time for taking a discovery deposition, see TBMP § 404.01.

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[88] 37 CFR § 2.121(a)(1). *See* TBMP § 701 (Time of Trial) and authorities cited therein. *For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see* TBMP §§ 509 (Motions to Extend Time and Motion to Reopen Time) and 701.

[89] 37 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notice of testimony depositions on written questions, while served eight months after testimony period originally opened, were nonetheless timely having been served within 10 days of testimony period as last reset).

[90] 37 CFR § 2.124(d)(2). *See also Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) and *Marshall Field & Co. v. Mrs. Field's Cookies*, *supra*.

703.02(d) Depositions on Written Questions: Place of Deposition

A testimony deposition on written questions may be taken at any reasonable place.[91] An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing.

For information concerning the place where a discovery deposition upon written questions is taken, see TBMP §§ 404.03(b), 404.03(c), and 404.04.

703.02(e) Depositions on Written Questions: Notice of Deposition

37 CFR § 2.124(b)*(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(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. ...*

To take a testimony deposition on written questions a party must serve notice thereof on each adverse party within 10 days from the opening date of its testimony period, as originally set or as reset.[92] The notice must state the name and address of the witness; it must be accompanied by the name or descriptive title of the officer before whom the

[91] *Cf.* 37 CFR § 2.123(c), and TBMP § 703.01(d) (Time and Place of Deposition). *Cf. also* 37 CFR § 2.123(b) *regarding stipulations as to place, manner and notice of depositions.*

[92] 37 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, *supra*. *See also*. 37 CFR § 2.123(b) *regarding stipulations as to place, manner and notice of depositions.*

deposition is to be taken, and by the written questions to be propounded on behalf of the deposing party.[93] A copy of the notice, but not of the questions, must be filed with the Board.[94]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition.[95]

For information concerning the notice of deposition in the case of a discovery deposition on written questions, see TBMP § 404.07(d).

703.02(f) Depositions on Written Questions: Securing Attendance of Unwilling Witness

For information concerning securing the attendance of an unwilling witness, see TBMP § 703.01(f) (for a testimony deposition) and 404.03 (for a discovery deposition).

703.02(g) Depositions on Written Questions: Examination of Witness

37 CFR § 2.124(b)*(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(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. 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*

[93] 37 CFR §§ 2.124(b)(1), 2.124(c), and 2.124(d)(1).

[94] 37 CFR § 2.124(b)(1).

[95] 37 CFR § 2.123(b).

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. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.

***(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.*

A party which desires to take a testimony deposition on written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof on each adverse party.[96]

The notice must be accompanied by the written questions to be propounded on behalf of the deposing party.[97] A copy of the notice, but not of the questions, must be filed with the Board.[98]

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

[96] 37 CFR § 2.124(b)(1). *See* TBMP § 703.02(e) (Notice of Deposition on Written Questions).

[97] 37 CFR §§ 2.124(b)(1), 2.124(c), and 2.124(d)(1).

[98] 37 CFR § 2.124(b)(1).

courier--see 37 CFR § 2.119(c)), 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 of them 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 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 that serves recross questions on the deposing party must also serve copies thereof on every other adverse party.[99]

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.[100]

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. Further, on receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions on written questions.[101]

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.[102]

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[99] 37 CFR § 2.124(d)(1). *See Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

[100] 37 CFR § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990).

[101] 37 CFR § 2.124(d)(2). *See* TBMP § 703.02(c) (Deposition on Written Questions – When Taken) and cases cited therein.

[102] 37 CFR § 2.124(e).

An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner. When so taken, the deposition may be used like any other deposition.[103]

703.02(h) Depositions on Written Questions: Form, Signature and 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.*

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question. [104]

For further information on the form for 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).

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

When the transcript has been certified, the officer should mail the transcript and exhibits to the party that took the deposition.[105]

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[103] *See* 37 CFR § 2.123(b).

[104] *See* 37 CFR § 2.124(e).

[105] *See* 37 CFR § 2.124(e).

703.02(i) Depositions on Written Questions: Service, Correction and Filing of Deposition

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). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.*

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party.[106] The party that took the deposition must also assure that the transcript is correct.[107] *For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, see TBMP § 703.01(n).*

If the deposition is a testimony deposition, the original, with exhibits, must be filed promptly with the Board.[108] By "promptly" the Board means that the transcript, with exhibits, may be filed at any time prior to submission of the case for final decision.[109]

703.02(j) Testimony Depositions on Written Questions Must be Filed

While the offering of a discovery deposition in evidence is voluntary, all trial testimony depositions that are taken in a Board inter partes proceeding must be filed in the USPTO, and, when filed, automatically constitute part of the evidentiary record in the proceeding.[110]

See, with respect to making a discovery deposition of record, 37 CFR § 2.120(j) and TBMP § 704.09.

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[106] 37 CFR § 2.124(f). *See* TBMP § 703.01(m) (Service of Deposition).

[107] 37 CFR § 2.124(f) and 2.125(b).

[108] *See* 37 CFR § 2.124(f).

[109] *See* TBMP § 703.01(k) (Certification and Filing of Deposition).

[110] *See* 37 CFR § 2.123(h), and TBMP § 703.01(l) (Testimony Deposition Must be Filed).

703.02(k) Depositions on Written Questions: Objections to Deposition

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 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.[111]

Unless waived, objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board at final hearing.[112]

For further information concerning the raising of objections to trial testimony depositions, see TBMP §§ 707.03 and 533.

For 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.

703.02(l) Depositions on Written Questions: Confidential or Trade Secret Material

For information concerning the protection of confidential or trade secret material forming part of a deposition transcript or exhibits thereto, see 37 CFR § 2.125(e), and TBMP § 703.01(p).

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[111] 37 CFR § 2.124(d)(1). *See* TBMP § 703.02(g) (Deposition on Written Questions – Examination of Witness).

[112] 37 CFR § 2.124(g). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections to questions based on relevancy and materiality will be deferred until final hearing).

703.02(m) Depositions 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 the right to confront the witness and ask follow-up questions on cross examination.[113]

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country.[114] Moreover, the deposition on written questions is generally less expensive than the deposition on oral examination and is usually more convenient for the witness. Thus, even for a deposition to be taken in the United States, a deposing party may prefer to use the deposition on written questions, particularly in those cases where the testimony will be short, simple, straight-forward, and not likely to be disputed, such as to establish for the record examples of third-party usage.[115]

704 Introducing Other Evidence

704.01 In General

As noted earlier in this chapter (*see* TBMP § 702) evidence in an inter partes proceeding before the Board can be introduced in a number of ways. The first part of this chapter discussed the introduction of evidence in the form of testimony depositions with accompanying exhibits. The following sections discuss other forms of evidence and the methods available for their introduction.

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[113] *See* 37 CFR § 2.124(d)(1); TBMP § 703.02(g) (Deposition on Written Questions – Examination of Witness); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (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); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985). *See also Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989) (motion to take discovery deposition in foreign country orally)

[114] *See* 37 CFR §§ 2.120(c)(1) and 2.123(a)(2), and TBMP §§ 404.03(c) (discovery deposition of nonparty residing in foreign country), 703.01(b) (Form of Testimony), and 703.02(a) (Depositions on Written Questions – When Available).

[115] *Cf. Feed Flavors Inc. v. Kemin Industries, Inc.*, *supra*.

704.02 Notice of Reliance – Generally

Certain types of evidence, such as official records and printed publications as described in 37 CFR § 2.122(e), need not be introduced in connection with the testimony of a witness but may instead be made of record by filing the materials with the Board under cover of one or more notices of reliance during the testimony period of the offering party. A notice of reliance is essentially a cover sheet for the materials sought to be introduced. This cover sheet is entitled "notice of reliance" and it serves, as the title suggests, to notify opposing parties that the offering party intends to rely on the materials submitted thereunder in support of its case. The notice of reliance must include a description of the proffered materials and, in some instances, must indicate the relevance of those materials to the case. A discussion of the types of evidence that may be submitted by notice of reliance and the requirements for introduction of such evidence by notice of reliance can be found in the sections that follow.

704.03 Applications and Registrations

704.03(a) Subject of Proceeding

37 CFR 2.122(b) Application files. (1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.*

The file of an application or registration that is the subject of a Board inter partes proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose.[116]

[116] 37 CFR § 2.122(b)(1). *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984); *Cleveland-Detroit Corp. v. Comco (Machinery) Ltd.*, 277 F.2d 958, 125 USPQ 586, 586-87 (CCPA 1960) (application file automatically forms part of record on appeal); *Uncle Ben's Inc. v. Studenberg International Inc.*, 47 USPQ2d 1310, 1311 n.2 (TTAB 1998) (notice of reliance on application file not necessary as it is automatically of record); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB

However, the fact that the subject application or registration file is automatically part of the record in a proceeding does not mean that the allegations made, and the specimens, documents, exhibits, etc., filed therein are evidence on behalf of the applicant or registrant in the inter partes proceeding. Allegations must be established by competent evidence properly adduced at trial. The specimens, documents, exhibits, etc., in an application or registration file are not properly adduced evidence in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period.[117]

For further information concerning the probative value of applications and registrations, see TBMP § 704.01(b).

704.03(b) Not Subject of Proceeding – In General

The file of a particular application or registration that is not the subject of a proceeding may be made of record either in connection with testimony or by notice of reliance as described below.

704.03(b)(1) Registration Not Subject of Proceeding

704.03(b)(1)(A) Registration Owned by Party

37 CFR § 2.122(d) Registrations. *(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office

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1990) (submission of portions of application unnecessary since file is automatically of record), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

[117] *See* 37 CFR § 2.122(b)(2). *See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, *supra* at 1283 (evidence in application file considered by court, but little weight given to applicant's statements before examining attorney); *Kellogg Co. v. Pack'Em Enterprises Inc, supra*; and TBMP § 704.04 (Statements and Things in Application or Registration).

showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party that wishes to rely on its ownership of a Federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it.[118] This may be done in a number of different ways.

A Federal registration *owned by the plaintiff* in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by two copies of the registration prepared and issued by the USPTO showing both the current status of and current title to the registration.[119]

A Federal registration *owned by any party* to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by a copy of the registration prepared and issued by the USPTO showing both the current status of and current title to the registration.[120]

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[118] *See Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978) (plain copies of registrations introduced through testimony which established ownership of the registrations but failed to establish that they were currently subsisting were not considered); *Maybelline Co. v. Matney,* 194 USPQ 438, 440 (TTAB 1977) (pleaded registration was not considered of record where testimony introduced original certificate of registration into evidence but failed to establish current status and title); and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (mere fact that copies show that registration originally issued to opposer does not establish that title still resides in opposer).

[119] *See* 37 CFR § 2.122(d)(1). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (not of record where opposer's copies of registrations submitted with notice of opposition did not show current status or title); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration did not contain status and title information); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate insufficient to show status of registration); and *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979). *For additional case cites, see Appendix of Cases.*

[120] *See* 37 CFR § 2.122(d)(2). *See also Hewlett-Packard Co. v. Olympus Corp.*, *supra; Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (untimely notice of reliance on status and title copy of registration filed after close of testimony period); and *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.3 (TTAB 1986). *For additional case cites, see Appendix of Cases*.

A party's submission, with a notice of reliance on its registration, of an *order* for status and title copies of the registration is not sufficient to make the registration of record. Although that procedure was once permitted, it is no longer allowed.[121] The status and title copies themselves must accompany the notice of reliance.[122] However, the status and title copies need not be certified.[123] Additionally, a party need not submit the original status and title copy; a photocopy is sufficient.[124]

The registration copies "prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by 37 CFR § 2.122(d), are printed copies of the registration on which the USPTO has entered the information it has in its records, at the time it prepares and issues the status and title copies, about the current status and title of the registration. That information includes information about the renewal, cancellation, publication under Section 12(c) of the Act, 15 U.S.C. § 1062(c); affidavits or declarations under Sections 8 and 15 of the Act, 15 U.S.C. §§ 1058 and 1065; and recorded documents transferring title.[125] Plain copies of the registration, and the electronic equivalent thereof, such as printouts of the registration from the electronic records of the USPTO's trademark automated search system, are not sufficient.[126]

Although the status and title copies need not be certified (s*ee* 37 CFR § 2.122(e)), at present all status and title copies prepared and issued by the

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[121] *See* 37 CFR §2.122(d); Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the Patent and Trademark Office *Official Gazette* of June 21, 1983 at 1031 TMOG 13; and *In re Inter-State Oil Co.*, 219 USPQ 1229 (TTAB 1983).

[122] *See Electronic Data Systems Corp. v. EDSA Micro Corp*., 23 USPQ2d 1460, 1461 n.4 (TTAB 1992).

[123] *See* 37 CFR § 2.122(e).

[124] *See* 37 CFR 2.122(d).

[125] *See Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate not sufficient), and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (constitutes prima facie showing of status and title).

[126] *See, for example, Hewlett-Packard Co. v. Olympus Corp.*, *supra* and *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration without status and title information insufficient to establish prima facie showing).

USPTO are certified.[127] For the cost of a copy of a registration showing status and title, *see* 37 CFR § 2.6(b)(4).

The issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. Status and title copies filed under a notice of reliance during the offering party's testimony period must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter.[128] The fact that there have been no changes in the status and title of a party's registration since the date of its issuance does not mean that a plain photocopy thereof may be used by the party as a substitute for the status and title copy.[129]

When it comes to the attention of the Board that there has been a USPTO error in the preparation of a registration status and title copy made of record in an inter partes proceeding, that is, that the status and title copy does not accurately reflect the status and title information which the USPTO has in its records, the Board will take judicial notice of the correct facts as shown by the records of the USPTO.[130] Further, when a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and the status of the registration changes between the

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[127] *See Industrial Adhesive Co. v. Borden, Inc.*, *supra* at 947 (copies do not have to be certified but must contain status and title information).

[128] *See Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, *supra*; *Jean Patou Inc. v.Theon Inc., supra* at 1075 (whether notice of reliance on status and title copy of registration prepared four years earlier is sufficiently recent goes to the competency, not the admissibility, of the registration); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (status and title copies from 1963 not reasonably contemporaneous with filing of opposition in 1986); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) (prepared two months prior to filing of opposition is reasonably contemporaneous); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); and *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976).

[129] *See*, *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 949 (TTAB 1983) (it is not sufficient that status and title copies might have shown the same facts indicated by a photocopy of an original registration which had recently issued or even if time for filing Sections 8 and 15 affidavits had not yet occurred since ownership could have changed or other events affecting ownership may have occurred); *Acme Boot Co. v. Tony and Susuan Alamo Foundation Inc.*, 213 USPQ 591, 592 (TTAB 1980); *Maybelline Co. v. Matney,* 194 USPQ 438 (TTAB 1977); and *Marriott Corp. v. Pappy's Enterprises, Inc.*, *supra.*

[130] *See Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846, 847 n.5 (TTAB 1978) (USPTO error in identification of owner).

time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the USPTO.[131]

A Federal registration *owned by any party* to a Board inter partes proceeding may be made of record by that party by appropriate identification and introduction during taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the current status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party.[132]

A Federal registration *owned by a plaintiff* (including a counterclaimant) will be deemed by the Board to be of record in an inter partes proceeding if the defendant's answer to the complaint contains admissions sufficient for the purpose.[133]

Similarly, a registration *owned by any party* to the proceeding may be deemed by the Board to be of record in the proceeding, even though the registration was not properly introduced in accordance with the applicable

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[131] *See Time Warner Entertainment Company v. Jones.* 65 USPQ2d 1650 (TTAB 2002) (review of Office automated records subsequent to filing of status and title copy of registration revealed that Section 8 and 15 affidavits had been accepted and acknowledged); *Ultratan Suntanning Centers Inc. v. Ultra Tan International AB*, 49 USPQ2d 1313, 1314, n.6 (TTAB 1998) (same): *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB 1979) (status and title copy need not be updated after it is submitted; judicial notice of filing of Sections 8 and 15 affidavits); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846 (TTAB 1978); and *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 80 n.3 (TTAB 1979).

[132] *See* 37 CFR § 2.122(d)(2); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985) (no probative value where testimony established opposer's ownership of registration, but not current status); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (identification by witness as having come from opposer's files insufficient to establish ownership and status); and *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980). *For additional case cites, see Appendix of Cases.*

[133] *See Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) (Board erred in refusing to consider registrations of record when applicant admitted "the registrations referred to in the notice of opposition" in its answer); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (applicant effectively admitted active status and ownership of certain specifically identified registrations); *Hewlett-Packard Co. v. Olympus Corp.*, *supra* (admission only of ownership and not validity was not sufficient); and *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (not of record where although applicant admitted that copies attached to opposition were "true copies" applicant did not admit to status and title of those registrations).

rules, if the adverse party in its brief, or otherwise, treats the registration as being of record.[134]

Finally, a registration *owned by any party* to the proceeding may be made of record in the proceeding by stipulation of the parties.[135]

When a subsisting registration on the Principal Register has been properly made of record by its owner in a Board inter partes proceeding, the certificate of registration is entitled to certain statutory evidentiary presumptions.[136]

In contrast, a subsisting registration on the *Supplemental Register*, even when properly made of record by its owner, is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued.[137]

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[134] *See Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) (after filing its answer, respondent filed a "paper" in which respondent admitted existence of petitioner's registration; admission was sufficient to overcome respondent's Rule 2.132 motion for default judgment); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1157 (TTAB 1990) (applicant conceded ownership and validity in trial brief); *Floralife, Inc. v. Floraline International Inc.,* 225 USPQ 683, 684 n.6 (TTAB 1984) (applicant's treatment of pleaded registrations as properly of record in its trial brief was deemed a stipulation as to current status and title); and *Industrial Adhesive Co. v. Borden, Inc.,* 218 USPQ 945, 948 (TTAB 1983) (admission in brief). *See also Jockey International, Inc. v. Frantti*, 196 USPQ 705 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976).

[135] *See* 37 CFR § 2.123(b); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979).

[136] *See, for example*, Section 7(b) of the Act, 15 U.S.C. § 1057(b); *CTS Corp. v. Cronstoms Manufacturing, Inc.*, 515 F.2d 780, 185 USPQ 773, 774 (CCPA 1975) (prima facie evidence of registrant's right to use the mark on the identified goods); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 274 (CCPA 1974) (prima facie evidence of validity of registration, ownership of mark and exclusive right to use it); and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (prima facie evidence of registrant's continuous use of the mark). *See also* Section 7(c) of the Act, 15 U.S.C. § 1057(c) (conferring, contingent on the registration of a mark on the Principal Register, and subject to certain specified exceptions, constructive use priority dating from the filing of the application for registration of the mark); *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216, 1217 n5 (TTAB 1992) (opposer's constructive use date on ITU application was subsequent to applicant's); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991) (constructive use dates intended to give ITU applicants superior rights to others who adopt the mark after filing date). *For additional case cites, see Appendix of Cases.*

[137] *See McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966) (registration on Supplemental Register is not evidence of constructive notice of ownership nor evidence of exclusive right to use); *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978). *For additional case cites, see Appendix of Cases.*

Expired or Cancelled Registrations. Although an expired or cancelled registration may be made of record by any of the methods described above, such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used.[138]

State Registrations. A state registration owned by a party to a Board inter partes proceeding may be made of record therein by notice of reliance under 37 CFR § 2.122(e), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.[139] However, a state registration (whether owned by a party, or not) is incompetent to establish that the mark shown therein has ever been used, or that the mark is entitled to Federal registration.[140]

Foreign Registrations. A foreign registration owned by a party to a Board inter partes proceeding may be made of record in the same manner as a state registration, but a foreign registration is not evidence of the use, registrability, or ownership of the subject mark in the United States.[141]

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[138] *See Action Temporary Services inc. v. Labor Force Inc*., 10 USPQ2d 1307 (Fed. Cir. 1989) (does not provide constructive notice of anything); *Time Warner Entertainment Company v. Jones,* 65 USPQ2d 1650, 1653 n.6 (TTAB 2002) (status and title copy of expired registration); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746-47 (TTAB 1987) (parties stipulated to introduction of photocopy of expired registration having no probative value other than that it issued); *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 818 n.7 (TTAB 1986) (expired "Act of 1920" registration had no probative value); *Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc.*, 191 USPQ 292, 294 (TTAB 1976) (lapsed registration of affiliated company is not evidence of use of mark at any time); and *Bonomo Culture Institute, Inc. v. Mini-Gym, Inc.*, 188 USPQ 415, 416 (TTAB 1975) (expired registration is incompetent evidence of any existing rights in mark). *For additional case cites, see Appendix of Cases.*

[139] *See* TBMP § 704.05 (Official Records).

[140] *See, for example, Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976) (state registrations do not establish use); *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981) (although parties stipulated to introduction of state registration, said registration is incompetent to prove anything material to opposition proceeding); *Plak-Shack, Inc. v. Continental Studios of Georgia, Inc.*, 204 USPQ 242, 246 (TTAB 1979) (incompetent as evidence of use of a mark); and *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 352 (TTAB 1978) (incompetent evidence to establish use of the mark), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982). *For additional case cite, see Appendix of Cases.*

Cf., with respect to ex parte appeals, In re Anania Associates, Inc., 223 USPQ 740, 742 (TTAB 1984) (argument that applicant's state registration for the mark must be taken as prima facie evidence of distinctiveness rejected); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984); and *In re Illinois Bronze Powder & Paint Co.*, 188 USPQ 459 (TTAB 1975).

[141] *See Societe Anonyme Marne et Champagne v. Myers*, 250 F.2d 374, 116 USPQ 153, 156 (CCPA 1957); and *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610, 1618 (TTAB 1988). *See also Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Barash Co. v. Vitafoam*

Making the file history of the registration of record. If a party owns a registration which is not the subject of the proceeding and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, it may do so by 1) filing, during its testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e) (see TBMP § 704.05); or 2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or 3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof.

The file history of a registration owned by another party, but not the subject of the proceeding, may be made of record in the same manner.[142] Copies of official records of the Patent and Trademark Office need not be certified.[143]

704.03(b)(1)(B) Third-Party Registration

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 record of the 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.*

Ltd., 155 USPQ 267 (TTAB 1967), *aff'd*, 427 F.2d 810, 166 USPQ 88 (CCPA 1970). *Cf. In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967).

[142] *See Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of petitioner's registration not of record where respondent noticed it but failed to file a copy of it).

[143] *See* 37 CFR § 2.122(e).

A party to an inter partes proceeding before the Board may introduce as part of its evidence in the case, a registration owned by a party not involved in the proceeding.[144]

A party that wishes to make such a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration together with a notice of reliance thereon specifying the registration and indicating generally its relevance.[145]

A party to a Board inter partes proceeding may also make a third-party registration of record by introducing a copy of it as an exhibit to testimony, or by stipulation of the parties.

It is not necessary that the copy of the third-party registration submitted with a notice of reliance (or with testimony or a stipulation) be certified, nor need it be a current status and title copy prepared by the USPTO; a plain copy (or legible photocopy) of the registration itself, or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the USPTO's trademark automated search system is all that is required.[146]

As stated in TBMP § 704.01(b)(1) above, a current status and title copy of a registration prepared by the USPTO (or other appropriate proof of current status and title) is necessary when the owner of a registration on the Principal Register seeks to make the registration of record for the

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[144] *See* J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297 (1982).

[145] *See* 37 CFR § 2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (printouts of third-party registrations obtained from private search reports are neither printed publications nor official records); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 309 n.5 (TTAB 1976) (reference to third-party registrations in answer, without filing copies with a notice of reliance, was insufficient to make them of record); and J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982).

[146] *See* 37 CFR § 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete excerpts of registrations from TRAM system was insufficient); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); and *Weyerhaeuser Co. v. Katz*, *supra*. *See also Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977); J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977).

purpose of relying on the presumptions accorded to a certificate of registration pursuant to Section 7(b) of the Act, 15 U.S.C. §1057(b). However, the Section 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner, or when the registration is cited by a Trademark Examining Attorney (in an ex parte case) as a reference under Section 2(d) of the Act, 15 U.S.C. § 1052(d), against a mark sought to be registered.[147]

Thus, when third-party registrations are made of record, the party offering them may not rely on the Section 7(b) presumptions; normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose.[148]

On the other hand, a party may *not* make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned; or by filing a printout, from a private company's data base, of information about the registration; or by filing a notice of reliance together with a reproduction of the mark as it appeared in the *Official Gazette* for purposes of publication; or by referring to the registration in its brief or pleading. The Board does not take judicial notice of registrations in the USPTO.[149]

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[147] *See* Section 7(b) of the Act, 15 U.S.C. § 1057(b); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1144 (TTAB 1986) (wholly owned subsidiary of owner of registrations may not rely on registrations to prove priority); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (claim that mark in cited registration is not in use is an impermissible collateral attack on the validity of the registration in an ex parte proceeding); *In re H & H Products*, 228 USPQ 771, 773 (TTAB 1986) (entitled to presumption that marks have overcome any inherent nondistinctiveness); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701, 702 (TTAB 1979) (opposer could not rely on 7(b) presumptions where registration is owned by its parent company); *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473, 475-76 (TTAB 1972) (although petitioner can rely on its wholly owned subsidiary's use of a mark, petitioner cannot rely on the registrations owned by its wholly owned subsidiary for statutory presumptions); and *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394, 395 (TTAB 1968) (opposer cannot rely on registrations owned by its parent or its parent's subsidiaries).

[148] *See Hiram Walker & Sons, Inc. v. Milstone*, 130 USPQ 274, 276 (TTAB 1961) and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977).

[149] *See, for example, In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (listings from commercial trademark search reports); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (search report from private company's database); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1885 (TTAB 1993) (trademark search report wherein registrations are mentioned); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (trademark search reports from private companies are neither printed publications nor official records); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990) (search report), *aff'd*, 951

Even when a third-party Federal registration has been properly made of record, its probative value is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in the registration.[150] Nevertheless, third-party registrations may be entitled to some weight to show the meaning of a mark, or a portion of a mark, in the same manner as a dictionary definition.[151]

F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 532 (TTAB 1986) (reference to third-party registrations in a brief)*;* and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977). *For additional case cites, see Appendix of Cases.*

Cf. TBMP § 528.05(d) (for purposes of responding to a summary judgment motion only, a copy of a trademark search report may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation).

[150] *See AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (not evidence of what happens in the market place or consumer familiarity); *Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1798 (TTAB 2001) (not evidence of use or that consumers have been exposed to them); and *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988) (not evidence of use to show public awareness of the marks).

See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (may not be given any weight in determining strength of a mark); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 n.12 (CCPA 1977) (little evidentiary value in determining scope of protection); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (little weight on likelihood of confusion); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975) (little weight on question of likelihood of confusion); *Spice Islands, Inc. v. Frank Tea and Spice Co.*, 505 F.2d 1293, 184 USPQ 35, 38 (CCPA 1974) (do not control determination of whether marks are so similar that they are likely to cause confusion); and *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983) (third-party registration only establishes what appears on its face, that application was made claiming adoption and use and that registration was granted), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). *See, in addition,* J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982).

Cf. In re Alpha Analytics Investment Group LLC, 62 USPQ2d 1852, 1856 (TTAB 2002) (registrations under Section 2(f) or on the Supplemental Register, although not conclusive evidence, may be probative evidence of mere descriptiveness). *Cf. also In re Mucky Duck Mustard Co., Inc.,* 6 USPQ2d 1467 (TTAB 1988) (third-party registrations may have some probative value to the extent that they may serve to suggest that goods or services are of a type which may emanate from the same source).

[151] *See Tektronix, Inc. v. Daktronics, Inc*., 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) and *Conde Nast Publications, Inc. v. Miss Quality, Inc*., 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975). *See also Sports Authority Michigan Inc. v. PC Authority Inc., supra* at 1798 (that a term is adopted to convey a particular suggestive meaning); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992) (to show the sense in which the term is employed in the marketplace); *United Foods Inc. v. J.R. Simplot Co.,* 4 USPQ2d 1172, 1174 (TTAB 1987) (to show ordinary usage of a term and descriptive or suggestive significance); and *Bottega Veneta, Inc. v. Volume Shoe Corp.,* 226 USPQ 964, 968 (TTAB 1985) (to show geographic significance of terms).

A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board.[152]

Making file history of third-party registration of record. The file history of a third-party registration (rather than just the certificate of registration), or a portion thereof, may be made of record by 1) filing, during the offering party's testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e) (*see* TBMP § 704.05); or 2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or 3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof.

It is not necessary that the copy of the registration file, or portions thereof, be certified.[153] However, third-party registration histories are of very limited probative value.[154]

704.03(b)(2) Application Not Subject of Proceeding

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 record of the Patent and Trademark Office need not be certified to be*

[152] *See Allstate Insurance Co. v. DeLibro*, 6 USPQ2d 1220, 1223 (TTAB 1988) (third-party state registrations "are of absolutely no probative value" on the question of likelihood of confusion), and TBMP § 704.01(b)(1)(A) (Registration Owned by Party) and cases cited therein.

[153] *See* 37 CFR § 2.122(e).

[154] *See Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that hey have made an impression on the public).

offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party to a proceeding before the Board may introduce, as part of its evidence in the case, a copy of an application that is not the subject of the proceeding, by filing, during its testimony period, a copy of the application file, or of the portions which it wishes to introduce, together with a notice of reliance thereon specifying the application and indicating generally its relevance.[155] It is not necessary that the copy of the application, or portions thereof, filed under a notice of reliance be certified.[156]

An application that is not the subject of the proceeding may also be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.

An application made of record in a Board inter partes proceeding, whether owned by a party or not, is generally of very limited probative value.[157] However, if the application is owned by a party to the proceeding, the allegations made and documents and things filed in the application may be used as evidence against the applicant, that is, as admissions against interest and the like.[158]

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[155] *See* 37 CFR § 2.122(e); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231 (TTAB 1992) (copy of drawing from abandoned application); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (copies of third-party applications); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778, 780 n.4 (TTAB 1977) (file history of petitioner's application).

[156] *See* 37 CFR § 2.122(e).

[157] *See Glamorene Products Corp. v. Earl Grissmer Co.*, *supra* at 1092 n.5 (evidence only of the filing of the application); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979) (claim of ownership of a registration in an application is not competent evidence of ownership of the registration); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978) (petitioner's application file is proof only of filing, not of any facts alleged in the application); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778 (TTAB 1977) (incompetent to prove use). *See also Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that hey have made an impression on the public); *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449 (TTAB 1976); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); and TBMP § 704.04 (Statements and Things in Application or Registration).

[158] *See* TBMP § 704.04 (Statements and Things in Application or Registration) and cases cited therein.

704.04 Statements and Things in Application or Registration

37 CFR § 2.122(b) Application files. (1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.*

While the file of a particular application or registration may be of record in a Board inter partes proceeding, by operation of 37 CFR § 2.122(b) (*see* TBMP § 704.01(a)) or otherwise (*see* TBMP § 704.01(b)) the allegations made, and documents and other things filed, in the application or registration are not evidence in the proceeding on behalf of the applicant or registrant.[159] Allegations must be established by competent evidence, properly adduced at trial, and the documents and other things in an application or registration file are not evidence, in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period.[160] This is because the adverse

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[159] *See, for example, Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1467 (TTAB 1993) (in the absence of proof of use, the filing date of the application, rather than the dates of use alleged in the application, is treated as the earliest use date on which applicant may rely); *Allied Mills, Inc. v. Kal Kan Foods, Inc., supra* at 396 n.10 (an application is not evidence of anything on behalf of applicant except that it was filed); and *Omega SA v. Compucorp,* 229 USPQ 191, 195 (TTAB 1985) (allegations and documents in application file not evidence unless and to the extent they have been identified and introduced in evidence during testimony).

[160] *See* 37 CFR § 2.122(b); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993) (exhibits, affidavits and market survey which had been submitted by applicant in connection with the prosecution of its application are not evidence in subsequent opposition proceeding to establish acquired distinctiveness unless properly introduced), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.4 (TTAB 1989) (notice of reliance referring to declaration signed by applicant in applying for registration); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.7 (TTAB 1986) (claim of ownership of registration in application does not make registration of record); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985) (statements and materials in registration file bearing on respondent's dates of use not evidence on behalf of respondent unless properly introduced); *Sunbeam Corp. v. Battle Creek Equipment Co.,* 216 USPQ 1101, 1102 n.3 (TTAB 1982) (applicant's claim of distinctiveness in its application is an admission by applicant that term is descriptive but 2(f) affidavit in application not admissible evidence of the truth of statements therein in inter partes proceeding); *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in application not evidence on

party has a right to confront and cross-examine the person making the allegations, and to question the authenticity of the specimens, documents, exhibits, etc.[161] Thus, for example, the allegation in an application or registration of a date of use is not evidence on behalf of the applicant or registrant in an inter partes proceeding; to be relied on by the applicant or registrant, a claimed date of use of a mark must be established by competent evidence.[162] Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used.[163] The specimens in the file of an application or registration are not evidence on behalf of the applicant or registrant, in an inter partes proceeding, unless they are identified and introduced in evidence as exhibits during the testimony period.[164] Affidavits or declarations in an application or registration file cannot be relied on by the applicant or registrant, in an inter partes proceeding, as evidence of the truth of the statements contained therein; the statements must be established by competent evidence at trial.[165] Similarly,

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behalf of respondent); *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470, 474 n.3 (TTAB 1978) (claim of ownership of registration in application does not make registration of record); *Dap, Inc. v. Century Industries Corp.*, 183 USPQ 122, 123 (TTAB 1974) (applicant cannot rely on specimens filed with application to delineate nature and use of its goods); *Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315, 316 n.2 (TTAB 1973) (applicant cannot rely on dates of use alleged in application); *ILC Products Co. v. ILC, Inc.*, 175 USPQ 722, 723 n.3 (TTAB 1972); and *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473, 476 (TTAB 1972) (self-serving statements made during prosecution of application are not admissible in cancellation proceeding). *See also W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273 (TTAB 1962).

[161] *See ILC Products Co. v. ILC, Inc.*, *supra* and *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, *supra*. *See also W.T. Grant Co. v. Grant Avenue Fashions, Inc.*, *supra*.

[162] *See* 37 CFR § 2.122(b)(2). *See also Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1467 (TTAB 1993); *Omega SA v. Compucorp*, 229 USPQ 191, 193 n.10 (TTAB 1985) (applicant may rely on presumption that its mark was in use as of filing date of application in absence of any proof of earlier use); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985); *and Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315 (TTAB 1973).

[163] *See* 37 CFR § 2.122(b)(2), and *Alpha Industries, Inc. v. Alpha Microsystems*, 223 USPQ 96, 96 (TTAB 1984) (Board will not take judicial notice of statements made in third-party applications regarding use). *See also, for example, Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (registrations owned by opposer's parent corporation are third-party registrations and opposer cannot rely on those registrations to prove priority); *Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc.*, 224 USPQ 512, 514 (TTAB 1984); and.*Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that hey have made an impression on the public).

[164] *See* 37 CFR § 2.122(b)(2); *Mason Engineering & Design Corp. v. Mateson Chemical Corp*., 225 USPQ 956, 961 n.11 (TTAB 1985); and *Eikonix Corp. v. CGR Medical Corp*., 209 USPQ 607, 613 n.7 (TTAB 1981). *See also Dap, Inc. v. Century Industries Corp.,* 183 USPQ 122 (TTAB 1974).

[165] *See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993) (2(f) affidavits submitted during prosecution of application), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.4 (TTAB 1989) (declaration in support

statements made by counsel, and exhibits filed, in an application or registration do not constitute admissible evidence in the applicant's or registrant's behalf in an inter partes proceeding; the statements must be established by competent evidence, and the exhibits must be properly identified and introduced in evidence, at trial.[166] Further, the fact that the file of an application or registration which is the subject of a Board inter partes proceeding is automatically of record in that proceeding, does not mean that a registration claimed by applicant or registrant in the application or registration is also automatically of record.[167]

Although the allegations made and documents and things filed in an application or registration are not evidence, in a Board inter partes proceeding, on *behalf* of the applicant or registrant (unless they are properly proved at trial), they may be used as evidence *against* the applicant or registrant, that is, as admissions against interest and the like.[168]

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of application), and *Sunbeam Corp. v. Battle Creek Equipment Co.,* 216 USPQ 1101, 1102 n.3 (TTAB 1982) (2(f) affidavit in application).

[166] *See British Seagull Ltd. v. Brunswick Corp., supra* (exhibits and market surveys to show acquired distinctiveness during prosecution were not competent evidence in subsequent opposition proceeding); *W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273, 275 (TTAB 1962) (explanation of applicant's operations by applicant's counsel during ex parte prosecution was not admissible evidence in subsequent opposition).

[167] *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 530 F.2d 1396, 189 USPQ 138, 140 (CCPA 1976); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n. 7 (TTAB 1986); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470, 474 n.3 (TTAB 1978).

[168] *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n.5 and n.11 (TTAB 1985) (date of first use asserted by opposer in its application may be considered as admission against interest; in evaluating "Morehouse" type defense, Board relied on specimens and other materials in applicant's application as evidence of the nature of applicant's services to find that those services were not "substantially identical" to the goods in applicant's subsisting registration): *Sunbeam Corp. v. Battle Creek Equipment Co.,* 216 USPQ 1101, 1102 n.3 (TTAB 1982) (applicant's claim of distinctiveness in its application is an admission by applicant that term is descriptive but 2(f) affidavit in application not admissible evidence of the truth of statements therein in inter partes proceeding);and *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in respondent's registration may be used as admission against interest of relationship between respondent's and petitioner's goods).

See also, for example, Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (applicant which seeks to prove date of first use earlier than that stated in its application must do so by heavier burden of clear and convincing evidence, rather than a preponderance of the evidence, because of the change of position from one "considered to have been made against interest at the time of filing of the application"); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) (applicant's earlier contrary position before the Examining Attorney as to the meaning of its mark as demonstrated by statements in the application illustrating the variety of meanings that may be attributed to, and commercial impression projected by, applicant's mark, may be relevant); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (fact that party took position in its application inconsistent with its position in inter partes proceeding may be considered as evidence "illuminative of shade and tone in the total picture confronting the decision maker"); *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (in application for mark in typed form, specimens in application may be used to illustrate one form in

704.05 Exhibits to Pleadings or Briefs

704.05(a) Exhibits to Pleadings

37 CFR § 2.122(c) Exhibits to pleadings. *Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.*

37 CFR § 2.122(d) Registrations. *(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

With one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits.[169]

The one exception is a current status and title copy, prepared by the USPTO, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff.[170]

704.05(b) Exhibits to Briefs

Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.[171]

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which mark may actually be used in order to show similarity with opposer's mark); and *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 798 (TTAB 1986) (fact that opposer took position in its application regarding descriptiveness of term inconsistent with its position in inter partes proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

[169] 37 CFR § 2.122(c) and TBMP § 317 (Exhibits to Pleadings) and cases cited therein.

[170] *See* 37 CFR §§ 2.122(c) and (d)(1), and TBMP § 704.01(b)(1)(A) (Registration Owned by Party).

[171] *See, for example, Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.5 (TTAB 1986) (third-party registrations attached to brief not considered); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of Canadian Opposition Board decision attached to brief not considered); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983) *; Plus Products v. Physicians Formula Cosmetics,*

If, after the close of the time for taking testimony, a party discovers new evidence that it wishes to introduce in its behalf, the party may file a motion to reopen its testimony period. However, the moving party must show not only that the proposed evidence has been newly discovered, but also that it could not have been discovered earlier through the exercise of reasonable diligence.[172]

704.06 Statements in Pleadings or Briefs

704.06(a) Statements in Pleadings

Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony.[173]

However, statements in pleadings may have evidentiary value as admissions against interest by the party that made them.[174]

704.06(b) Statements in Briefs

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief

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Inc., 198 USPQ 111 (TTAB 1978); *Astec Industries, Inc. v. Barber-Greene Co.*, 196 USPQ 578 (TTAB 1977); and *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976). *For additional case cites, see Appendix of Cases.*

Compare, for example, Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1405 (TTAB 1998) (dictionary definitions attached to applicant's brief were the proper subject of judicial notice); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, n.5 (TTAB 1979) (evidence which had been timely filed was not objectionable when a reproduction of the evidence was later attached to a trial brief); and TBMP § 704.12 *regarding judicial notice*.

[172] *See* TBMP § 509.01 (Nature of Motions to Extend Time or Reopen Time) and cases cited therein.

[173] *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), and *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656, 662 (TTAB 1979) (statements in answer referring to sales of applicant's magazines were not considered).

[174] *See Maremont Corp. v. Air Lift Co*., 463 F.2d 1114, 174 USPQ 395, 396 n.4 (CCPA 1972) (pleadings in prior proceeding available as evidence, although not conclusive evidence, against the pleader); *Bakers Franchise Corp. v. Royal Crown Cola Co.,* 404 F.2d 985, 160 USPQ 192, 193 (CCPA 1969) (admission contained in pleading of one action may be evidence against pleader in another action); *Kellogg Co. v. Pack'Em Enterprises Inc.*, *supra*; *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 196 USPQ 711, 714 (TTAB 1977) (admissions in answer regarding meaning of mark); and *Brown Co. v. American Stencil Manufacturing Co.*, 180 USPQ 344, 345 n.5 (TTAB 1973) (applicant having admitted in its answer that it did not use mark prior to a certain date was estopped from later contending that it has an earlier date of use).

have no evidentiary value, except to the extent that they may serve as admissions against interest.[175]

704.07 Official Records

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 record of the 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.*

A party that wishes to introduce an official record in evidence in a Board inter partes proceeding may do so, if the official record is competent evidence and relevant to an issue in the proceeding, by filing a notice of reliance thereon during its testimony period. The notice of reliance must specify 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.[176]

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[175] *See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992) (additional revenue figures provided in trial brief not considered); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements made in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (factual statements regarding certain scientific matter which cannot be deemed to be public knowledge not considered); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502, 507 (TTAB 1978); and *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3, 113 (TTAB 1978).

Cf. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) (without copies of relevant documentation including relevant portions of application file, not possible to determine validity of opposer's allegations that applicant took inconsistent position in its application) and *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975).

[176] *See* 37 CFR § 2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports are not official records); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on official records is untimely when filed after oral hearing), *aff'd sub nom.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (sufficiently indicated relevance of third-party registrations); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (official records are records prepared by a public officer); *Plus*

The term "official records" as used in 37 CFR § 2.122(e) refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer.[177] These official records are considered self-authenticating, and as such, require no extrinsic evidence of authenticity as a condition to admissibility.[178]

For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 CFR § 2.122(e), see cases cited in the note below.[179]

Products v. Natural Organics, Inc., 204 USPQ 773, 775 n.5 (TTAB 1979) (submission of duplicate copies of third-party registrations with brief was not untimely where the evidence had been timely filed during course of proceeding); and *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (untimely notice of reliance on official records filed after expiration of testimony period not considered).

[177] *See Black's Law Dictionary* (Fifth Edition, 1979); *Weyerhaeuser Co. v. Katz*, *supra* at 1223 (party's own file copies of documents from a Board proceeding are not official records); and *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, *supra* at 580 n.5 (official records are records prepared by a public officer). *See also* Fed. R. Evid. 902(4).

[178] *See Conde Nast Publications Inc. v. Vogue Travel, Inc.*, *supra* at 580 n.5. *See also Raccioppi v. Apogee Inc*., 47 USPQ2d 1368, 1369 (TTAB 1998).

[179] *Hard Rock Café International (USA) Inc. v. Elsea,* 56 USPQ2d 1504, 1508 (TTAB 2000) (copy of Board's decision on summary judgment in prior opposition – yes; purported copy of brief in support of summary judgment motion in prior proceeding which did not reflect that it was received by the Board but appeared to be merely applicant's file copy of the document – no); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (trademark search report --no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports--no); *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157, 1159 n.3 (TTAB 1992), *aff'd*, 28 USPQ2d 1687 (Fed. Cir. 1993) (trademark search report -- no; third-party registrations--yes); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 90, 906 n.5 (TTAB 1985) (copy of cancellation proceeding file--yes; party's file copies of documents filed in the PTO--no); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.3 (TTAB 1985) (letters between counsel for parties, and list of party's licensees--no); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (third-party registrations--yes); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (portions of an agreement between applicant and a third party, press release, list of foreign trademark registrations, and a shipping document for applicant's product--no); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (copy of letter from Amtrak to applicant congratulating applicant for having an appointment as an Amtrak agent, copy of a "Passenger Sales Agency Agreement" between the International Air Transport Association and applicant, etc.--no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (brochures and other promotional literature--no); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (certified copies of corporate records maintained by Secretary of State of Missouri --yes); *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 663 n.3 & 664 (TTAB 1977) (plat plan, deed of realty, and confirmatory assignment--not admissible by notice of reliance as official record because not properly authenticated); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 654 n.9 (TTAB 1976) (third-party registrations--yes); *Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of party's registration--yes); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (drawings from Federal trademark applications--yes); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) (certificate of good standing from a United States district court--yes).

For information concerning establishing the authenticity, under the Federal Rules of Evidence, of an official record, see Fed. R. Evid. 901(a), 901(b)(7), and 902(4*)*. The latter rule provides, in effect, that extrinsic evidence of authenticity as a condition precedent to admissibility is not required with respect to a properly certified copy of an official record, and describes the requirements for proper certification. However, a copy of an official record of the USPTO need not be certified to be offered in evidence by notice of reliance.[180]

In lieu of the actual "official record or a copy thereof," the notice of reliance may be accompanied by an electronically generated document (or a copy thereof) which is the equivalent of the official record, and whose authenticity is established under the Federal Rules of Evidence.[181]

Although official records may be made of record by notice of reliance under 37 CFR § 2.122(e), they be introduced this way. They may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.[182] These latter two methods may also be used to introduce types of official records that are not admissible by notice of reliance under 37 CFR § 2.122(e).[183]

For information concerning the raising of objections to notices of reliance and materials filed there under, see TBMP §§ 533 and 707.02.

Materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record.[184]

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[180] *See* 37 CFR § 2.122(e*).*

[181] *See Weyerhaeuser Co. v. Katz*, *supra* at 1232. *Cf.* TBMP § 704.08 (Printed Publications).

[182] *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 637 n.3 (TTAB 1983); and *Regent Standard Forms, Inc. v. Textron Inc.*, 172 USPQ 379, 380-81 (TTAB 1971).

[183] *See, for example*, *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (an agreement between applicant and a third party, press releases, and a shipping document, although not acceptable for a notice of reliance may be introduced in connection with competent testimony); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (since adverse party did not object to notice of reliance on annual reports, treated as stipulated into the record), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990), and *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (while annual reports and booklets and brochures do not constitute printed publications and are therefore not appropriate for introduction by notice of reliance, they may be introduced in connection with testimony of someone who is familiar with them and can explain the nature and use of such materials).

[184] *See, for example, U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (improper subject matter but adverse party expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, *supra* (neither party objected to the notice of reliance on annual reports by the

704.08 Printed Publications

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 record of the 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.*

Certain types of printed publications may be introduced in evidence in a Board inter partes proceeding by notice of reliance. Specifically, 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, if the publication is competent evidence and relevant to an issue in the proceeding, may be introduced in evidence by filing a notice of reliance thereon during the testimony period of the offering party.[185] The notice must specify the printed publication, including information sufficient to

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other); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered where no objection was raised); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 nn.3 & 4 (TTAB 1984) (improper subject matter deemed stipulated into record where no objection was raised); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (improper subject matter deemed stipulated into record where adverse party did not object and specifically referred to the matter in its brief); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely notice of reliance filed prior to testimony period considered where no objection was raised and error was not prejudicial). *Cf. Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where although there was no objection, no agreement could be inferred) and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (improper subject matter excluded, although adverse party did not object to the material).

[185] *See Hunter Publishing Co. v. Caulfield Publishing Ltd.* 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (while subject matter may be of interest to the general public such materials are not necessarily in general circulation); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 n.5 (TTAB 1984) (objection that applicant failed to indicate relevance of materials overruled); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on printed material filed after oral hearing untimely), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (duplicates of printed publications submitted with brief which had been properly filed by notice of reliance during testimony period considered); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (rule provides safeguard that party against whom evidence is offered is readily able to corroborate or refute authenticity of what is proffered); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB

identify the source and the date of the publication, and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the printed publication or a copy of the relevant portion thereof.[186]

In lieu of the actual "printed publication or a copy of the relevant portion thereof," the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion, as, for example, by a printout from the NEXIS computerized library of an article published in a newspaper or magazine of general circulation.[187] In case of reasonable doubt as to whether printed publications submitted by notice of reliance under 37 CFR § 2.122(e) are "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 the proceeding, the burden of showing that they are so available lies with the offering party.[188]

1976) (plaintiff's catalogs and house publications not considered because it was not shown they are "available to the general public in libraries or in general circulation"; advertisements permitted if publication in which they appeared and dates are provided to allow party to verify authenticity); and *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (publication shown to be available in public library properly submitted under 2.122(e), even though it may constitute hearsay or be of dubious relevance).

[186] *See* 37 CFR § 2.122(e). *See also Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.50 (TTAB 1999) (excerpts that were unidentified as to either source or date were not considered, as the extent to which such material is genuine and available to the public could not be ascertained); *Hard Rock Cafe Licensing Corp. v. Elsea,* 48 USPQ2d 1400, 1405 (TTAB 1998) (finding it sufficient that copies of the excerpted articles contained notations either on the copies themselves or in the notice of reliance as to the source and date of the copied articles, but noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (printed advertisement not identified with the specificity required to be considered a printed publication); and *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (notice of reliance received without appended copy of printed publication).

[187] *See Weyerhaeuser Co. v. Katz*, *supra* and *International Ass'n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 USPQ 940, 942 n.6 (TTAB 1985) (NEXIS printout of excerpted stories published in newspapers, magazines, etc. are admissible because excerpts identify their dates of publication and sources and since complete reports, whether through the same electronic library or at a public library, are available for verification), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Cf. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (electronic excerpts are not hearsay because articles were not used to support the truth of the statements therein but to show descriptive usage of term); *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 174-75 (TTAB 1985) (printouts from databases which themselves comprise abstracts or syntheses of published documents unlike the actual text of the documents, are hearsay as to the context of a term); and TBMP § 707 (Objections to Evidence).

[188] *See Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (private promotional literature is not presumed to be publicly available within the meaning of the rule).

For examples of cases concerning the admissibility of specific materials, by notice of reliance, as "printed publications" under 37 CFR § 2.122(e), see cases cited in the note below.[189]

Printed publications made of record by notice of reliance under 37 CFR § 2.122(e) are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters.[190]

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[189] *Harjo v. Pro-Football Inc*., *supra* at 1722 n.54 (TTAB 1999) (advertisements in newspapers or magazines available to the general public in libraries or in general circulation – yes); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 (TTAB 1998) (press releases, press clippings, studies prepared for a party, affidavits or declarations, or product information -- no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 n.5 (TTAB 1992) (trademark search reports--no); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (annual reports--no); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (conference papers, dissertations, and journal papers--no); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (press releases--no); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (annual reports--no); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (annual report even if in some libraries, or available on request--no; magazine articles--yes); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (promotional literature--no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (promotional literature--no); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (catalogs and other house publications--no); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232, 234 (TTAB 1976) (annual reports, promotional brochures, price list, reprints of advertisements, and copies of advertising mats--no); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (telephone directory pages, indexes from United States Code Annotated, and dictionary pages--yes); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (annual reports--no); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (credit card applications, handouts, and flyers--no; articles from trade publications and other magazines--yes); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets, and product brochures--no); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.2 (TTAB 1973) (article from "Memoirs of the University of California"--no, since publication not shown to be available to the general public).

[190] *See, for example, In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles are not used to support the truth of the statements therein but to show descriptive usage of term); *Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 469 F.2d 1397, 176 USPQ 123, 123 (CCPA 1972) (advertisement from newspaper only showed promotion of the product on the day the publication issued); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report considered stipulated into evidence only for what it showed on its face), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Harjo v. Pro-Football Inc*., *supra* at 1721 n.50 (evidence of the manner in which the term is used in the articles and of the fact that the public has been exposed to the articles and may be aware of the information contained therein); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (magazine article limited to what it showed on its face); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 404, 410 (TTAB 1978) (advertisement submitted with notice of reliance only showed that advertisement appeared on that date in that journal and does not show customer familiarity with marks nor actual sales); *Food Producers, Inc. v. Swift & Co.*, 194 USPQ 299, 301 n.2 (TTAB 1977) (publications limited to their face value because no opportunity to ascertain basis for information or confront and cross-examine individuals responsible therefor); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (advertisements were only probative of fact that opposer advertised its goods under the mark in the publications on those dates); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (even if annual reports were admissible as printed publications, they would only

Although the types of printed publications described above may be made of record by notice of reliance under 37 CFR § 2.122(e), they may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.[191] These latter two methods may also be used for the introduction of printed publications which are not admissible by notice of reliance under 37 CFR § 2.122(e).[192]

For information concerning the raising of objections to notices of reliance and materials filed there under, see TBMP §§ 533 and 707.02.

Materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record.[193]

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be probative of fact that they are opposer's annual reports for the years shown thereon); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310, 312 n.4 (TTAB 1975) (magazine article showed only that the goods under the mark were the subject of the article in that publication); and *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (articles from trade publications admissible to show that they appeared in the publication on a certain date and that they contained certain information, but not that the information is true).

[191] *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 846 (TTAB 1984) (objection on ground that no notice of reliance was filed was not well taken where party had introduced the materials in connection with testimony), and *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 635 n.3 (TTAB 1983) (same).

[192] *See, for example, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, *supra* (annual reports); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (copies of agreements, press releases, shipping documents and foreign registrations); and *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets and brochures).

[193] *See, for example, Plyboo America Inc. v. Smith & Fong Co.,* 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (plaintiff did not object to introduction of curriculum vitae, advertising literature, printout of page from website by notice of reliance and treated materials as of record); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (opposer's improper subject matter considered where applicant expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, *supra* (neither party objected to the annual reports submitted by the other party); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (annual reports improper subject matter considered); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (various documents constituting improper subject matter considered where no objection was raised and adverse party specifically addressed the materials in its brief); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely, but no objection or prejudice).

Cf. Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where adverse party, while not objecting to the improperly offered materials, did not treat the materials as being of record); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection).

Internet evidence and other materials that are not self-authenticating. Certain printed publications qualify for submission by notice of reliance under Trademark Rule 2.122(e) because they are considered essentially self-authenticating.[194] That is, permanent sources for the publications are identified and the nonoffering party is readily able to verify the authenticity of the documents.[195] The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet.[196] Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not "subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered."[197] For this reason, Internet printouts cannot be considered the equivalent of printouts from a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified.[198]

Materials that do not fall within 37 CFR § 2.122(e), that is, materials that are not self-authenticating in nature and thus not admissible by notice of reliance, may nevertheless be introduced into evidence through the testimony of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials.[199] Even if properly made of record, however, such materials, including Internet printouts, would only be probative of what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters.[200]

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[194] *See Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 (TTAB 1999).

[195] *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

[196] *See Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

[197] *Weyerhaeuser v. Katz*, *supra* at 1232 (TTAB 1992) citing *Glamorene Products Corporation v. Earl Grissmer Company, Inc.*, 203 USPQ 1091, 1092 n.5 (TTAB 1979). *See also Raccioppi v. Apogee Inc.*, *supra* at 1370; *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1134 (TTAB 2000) (introduction of telephone listings retrieved from Internet was improper); and *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (printout of page of website is not proper subject matter for a notice of reliance).

[198] *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (examining attorney's request for judicial notice of on-line dictionary definitions denied because the definitions were not available in printed format). *Cf. In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (judicial notice taken of online dictionary definition where resource was also available in book form).

[199] *See Raccioppi v. Apogee Inc.*, *supra* at 1371 *with respect to introducing Internet evidence in connection with a summary judgment motion*.

[200] *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (not evidence of use but may have some probative value to show the meaning of a mark in the same way as third-party registrations) and *Raccioppi v. Apogee Inc.*, *supra* at 1371 (the reliability of the information becomes a matter of weight or probative value to be given the Internet evidence). *See also In re Remacl*e, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (involving Internet articles from sources outside the United States).

704.09 Discovery Depositions

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

(1) *The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.*

(2) *Except as provided in paragraph (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.*

(3)*(i) A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.*

* * * *

(4) *If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse*

party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

* * * *

(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.*

(7) *When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(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.*

The discovery deposition *of a party* (or of anyone who, at the time of taking the deposition, was 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 offered in evidence *by any adverse party*.[201]

Otherwise, the discovery deposition of a witness, whether or not a party, may not be offered in evidence except in the following situations:

(1) By stipulation of the parties, approved by the Board.[202]

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[201] 37 CFR § 2.120(j)(1). *See Hilson Research Inc. v. Society for Human Resource Management,* 27 USPQ2d 1423, 1427 (TTAB 1993) (deponent was no longer an officer or director at time his deposition was taken); *Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321, 1325 (TTAB 1992) (same); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1630 n.5 (TTAB 1988) (only by adverse party); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (same); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980) (same); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 n.7 (TTAB 1979) (discovery deposition of nonparty taken on written questions inadmissible); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977) (party who takes discovery deposition may place it into evidence); and *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647, 651 n.11 (TTAB 1976) (deposed party may not rely on statements made in discovery deposition if the deposition is not made of record).

[202] 37 CFR § 2.120(j)(2). *See Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of nonparty properly in evidence by stipulation of parties).

(2) By order of the Board, on motion showing that the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The motion must be filed at the time of the purported offer of the deposition in evidence, unless the motion is based on a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion must be filed promptly after the circumstances claimed to justify use of the deposition became known.[203]

(3) If only part of a discovery deposition is submitted and made part of the record by a party entitled to offer the deposition in evidence, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. In such a case, the notice of reliance filed by the adverse party must be supported by a written statement explaining why the adverse party needs to rely on each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.[204]

A discovery deposition that may be offered in evidence under 37 CFR § 2.120(j) may be made of record by filing, during the testimony period of the offering party, the deposition or any part

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[203] 37 CFR § 2.120(j)(2). *See Hilson Research Inc. v. Society for Human Resource Management, supra*; *Marshall Field & Co. v. Mrs. Fields Cookies, supra*; *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (no special circumstances shown by applicant to admit discovery deposition of applicant's president); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, *supra* (mere speculation that nonparty witness would be unavailable is insufficient); and *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691, 692 n.4 (TTAB 1978) (no special circumstances shown to admit discovery deposition of nonparty).

[204] 37 CFR § 2.120(j)(4). *See Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804, 1806 n.2 (TTAB 1990) (adverse party failed to show how portions submitted were misleading), *aff'd*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (Board refused to consider pages of a deposition relied on by applicant in its brief since they were not relied on by opposer and not properly made of record by applicant and since opposer objected thereto); *First International Services Corp. v. Chuckles Inc.*, *supra* (where applicant submitted entire deposition of its president in response to opposer's partial submission, without identifying specific relevant testimony Board refused to consider additional portions); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.6 (TTAB 1986) (pages of additional portions should be clearly marked); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (Board refused to consider additional exhibits since they did not serve to correct misimpression engendered by those of record); *Dynamark Corp. v. Weed Eaters, Inc.*, *supra* (distinguishing mandatory filing of trial deposition in its entirety from discovery deposition where only the portion or portions which are properly introduced are of record); and *Johnson Publishing Co. v. Cavin & Tubiana OHG*, *supra.*

thereof with any exhibit to the part that is filed, together with a notice of reliance.[205] The notice of reliance need not indicate the relevance of the deposition, or parts thereof, relied on.[206] When only part of a deposition is relied on, the notice of reliance must specify the part or parts relied on.[207]

When a discovery deposition has been made of record by one party in accordance with 37 CFR § 2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.[208] If only part of a discovery deposition has been made of record pursuant to 37 CFR § 2.120(j), that part only may be referred to by any party for any purpose permitted by the Federal Rules of evidence. If one party has filed a notice of reliance on a discovery deposition or part thereof and an adverse party has based its presentation of evidence on the belief that the deposition or the part thereof is of record, the notice of reliance may not later be withdrawn.[209]

A discovery deposition not properly offered in evidence under 37 CFR § 2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto, or treats the deposition as being of record, or improperly offers a discovery deposition in the same manner.[210]

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[205] 37 CFR § 2.120(j)(3)(i). *See BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978) (mere presence of discovery responses in the file does not make them of record without a notice of reliance); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, *supra*; *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, *supra*; *Ethicon, Inc. v. American Cyanamid Co.*, *supra*; *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495, 496 n.2 (TTAB 1970) (discovery depositions not in evidence since notice of reliance not filed); and *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition inadmissible where it was timely filed but not accompanied by notice of reliance).

[206] *See* 37 CFR § 2.120(j)(3)(i). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1787 (TTAB 2001) (noting that it is more effective to file only those portions of the deposition that are relevant and explain their relevancy in the notice of reliance).

[207] *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440, 441 n.4 (TTAB 1983) (vague reference to reliance on "only those portions of the deposition pertaining to the descriptive nature of the opposed mark" insufficient).

[208] 37 CFR § 2.120(j)(7). *See Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, *supra* at 955 n.4 (notice of reliance on deposition already made of record by the other party is superfluous); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.6 (TTAB 1985) (stipulation that deposition relied on by opposer may also be considered as part of applicant's case was unnecessary); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984); and *Miles Laboratories, Inc. v. SmithKline Corp.*, 189 USPQ 290, 291 n.4 (TTAB 1975).

[209] *See Exxon Corp. v. Motorgas Oil & Refining Corp*., 219 USPQ 440, 441 n.4 (TTAB 1983) (opposer's notice of reliance as to deposition designation indefinite and given time to clarify; response severely narrowed original designation to applicant's prejudice and not permitted).

[210] *See, for example, Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1737 n.11 (TTAB 1990) (no objection to applicant's introduction of discovery deposition of officer of opposer's parent corporation); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (deposition taken during discovery but treated by both

Requests for discovery, responses thereto, 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; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. The Board may return discovery papers or materials filed under other circumstances.[211]

Nothing in 37 CFR § 2.120(j) will be interpreted to preclude the reading or the use of a discovery deposition as part of the examination or cross-examination of any witness during the testimony period of any party.[212]

For information concerning the taking of a discovery deposition, and the raising of objections thereto, see TBMP §§ 404, 532, and 707.02.

NOTE: *Some of the cases cited in this section established principles later codified in current 37 CFR § 2.120(j), or were decided under rules that were the predecessors to such provisions.*

704.10 Interrogatory Answers; Admissions

37 CFR § 2.120(j)

* * * *

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section*

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parties as a testimonial deposition introduced by deposed party treated as trial deposition taken prior to testimony period pursuant to stipulation); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (deposition of nonparty treated as stipulated into the record since adverse party did not object and referred to it as being of record in its brief); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.7 (TTAB 1982 (discovery deposition of nonparty treated by both parties as properly of record); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (considered of record where although opposer did not file a notice of reliance on discovery depositions, both parties referred to the depositions in their briefs); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (plaintiff's notice of reliance filed during rebuttal testimony period improper where defendant introduced no evidence; but since defendant filed improper notice of reliance in response thereto and because neither party objected to the untimely evidence of the other and moreover addressed each other's evidence, all material was considered); and *Insta-Foam Products, Inc. v. Instapak Corporation*, 189 USPQ 793, 795 n. 4 (TTAB 1976) (discovery deposition of nonparty deemed stipulated into the record where there was no objection and both parties relied on the deposition).

[211] 37 CFR § 2.120(j)(8). *See Electronic Industries Assn v. Potega*, 50 USPQ2d 1775, 1776 n.3 (TTAB 1999); and TBMP § 409 (Filing Discovery Requests and Responses with Board) and authorities cited therein.

[212] 37 CFR § 2.120(j)(6). *Cf. West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (party may testify as to veracity of information contained in interrogatory answers or use such answers to refresh memory of witness during testimony deposition).

may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * * *

(5) *An answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party except that, if fewer than all of the answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance any other answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the inquiring party. The notice of reliance filed by the responding party must be supported by a written statement explaining why the responding party needs to rely upon each of the additional discovery responses listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses.*

(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.*

(7) *When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(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.*

Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party.[213]

[213] *See* 37 CFR § 2.120(j)(5). *See also Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.,* 222 USPQ 1012, 1015 n.7 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.8 (TTAB 1982);

However, if fewer than all of the answers to a set of interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce, under a notice of reliance, any other answers to interrogatories, or any other admissions which should be considered so as to avoid an unfair interpretation of the responses offered by the inquiring party.[214] The notice of reliance must be supported by a written statement explaining why the responding party needs to rely on each of the additional interrogatory answers, or admissions, listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses.[215]

An interrogatory answer (including documents provided as all or part of an interrogatory answer), or an admission to a request for admission, that may be offered in evidence under 37 CFR § 2.120(j) may be made of record by notice of reliance during the testimony period of the offering party. The party should file a copy of the interrogatory and the answer thereto, with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with its notice of reliance thereon.[216]

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and *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981). *For additional case cite, see Appendix of Cases.*

[214] *See* 37 CFR § 2.120(j)(5) and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988).

[215] *See* 37 CFR § 2.120(j)(5). *See also Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.,* 35 USPQ2d 1125, 1128 n.4 (TTAB 1995) (notice of reliance on responses stricken since responses did not clarify answers relied on by inquiring party); *Heaton Enterprises of Nevada Inc. v. Lang*, *supra* at 1844 n.5 (TTAB 1988) (answering party is expected to select only the relevant answers and to inform the Board of the relationship of that answer to those offered by propounding party); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (other answers may be introduced to clarify, rebut or explain responses relied on by inquiring party; opposer failed to indicate the relevance of its interrogatory responses to rebut those relied on by applicant); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (broad statement by answering party that without the additional responses the selected responses would be misleading is insufficient); *Packaging Industries Group, Inc. v. Great American Marketing, Inc.*, 227 USPQ 734, 734 n.3 (TTAB 1985) (applicant did not introduce the additional responses referred to in its brief by notice of reliance); *Holiday Inns, Inc. v. Monolith Enterprises*, *supra* at 950 (may not simply rely on all remaining answers and expect Board to determine which, if any, answers require explanation or clarification); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647 (TTAB 1976).

[216] 37 CFR § 2.120(j)(3)(i). *See BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance must specify and be accompanied by the interrogatory to which each document was provided in lieu of an answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986) (documents provided in lieu of interrogatory answer admissible by notice of reliance); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (notice of reliance filed after close of testimony period untimely); and *Bausch & Lomb Inc. v. Gentex Corp.*, 200 USPQ 117, 119 n.2 (TTAB 1978) (neither party filed notice of reliance on the other party's interrogatories and therefore not of record). *For additional case cites, see Appendix of Cases. Cf.*

The notice of reliance need not indicate the relevance of the discovery responses relied on.[217] Offering interrogatory answers, or admissions, on the record during the taking of a testimony deposition is the equivalent of serving and filing a notice of reliance by mail.[218]

An interrogatory answer may also be made of record by stipulation of the parties, accompanied by a copy of the interrogatory and the answer thereto with any exhibit made part of the answer. Similarly, an admission may be made of record by stipulation of the parties, accompanied by a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto).[219]

When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 CFR § 2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.[220]

An interrogatory answer, or an admission, not properly offered in evidence under 37 CFR § 2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the answer, or admission, as being of record; and/or improperly offers an interrogatory answer, or an admission, in the same manner.[221]

Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on responses which were already made of record by opposer was superfluous).

[217] *See* 37 CFR § 2.120(j)(3)(i), and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (not required to set forth the relevance of interrogatory answers).

[218] *See Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp*., 204 USPQ 945, 947 (TTAB 1979).

[219] *See Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1015 n.7 (TTAB 1984) (although parties stipulated that certain interrogatory answers were part of evidentiary record, because copies of the interrogatories and answers were never submitted to the Board they could not be considered). *See also Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978), and *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977). *Cf. Wella Corp. v. California Concept Corp.*, 192 USPQ 158, 160 n.4 (TTAB 1976) (supplemental answers to interrogatories were not covered by the stipulation), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

[220] 37 CFR § 2.120(j)(7). *See Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on matter already made of record by opposer is superfluous). *See also Henry Siegel Co. v. M & R International Mfg. Co.,* 4 USPQ2d 1154, 1155 n.5 (TTAB 1987); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976) (where party relies on all of adversary's answers to interrogatories, the adversary need not file its own notice of reliance thereon).

[221] *See, for example, Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (no objection to party's reliance on its own answers and moreover the responses set forth facts which were described in the parties' stipulation); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988) (no objection to responding party's notice of reliance on remaining answers and such answers were deemed as explanatory or clarifying); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987) (no objection to party's reliance on its own answers); *Board of Trustees of the University of Alabama*

Requests for discovery, responses thereto, 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; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. The Board may return discovery papers or materials filed under other circumstances.[222]

Nothing in 37 CFR § 2.120(j) precludes reading or using an interrogatory answer, or an admission, as part of the examination or cross-examination of any witness during the testimony period of any party.[223]

For information concerning the taking of discovery by way of interrogatories, see TBMP §§ 405. *For information concerning the taking of discovery by way of requests for admission, see* TBMP §§ 407. *For information concerning the raising of objections to notices of reliance and materials filed there under, see* TBMP §§ 532 and 707.02.

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v. BAMA-Werke Curt Baumann, 231 USPQ 408, 409 n.3 (TTAB 1986) (objection which was raised for first time in brief waived since defect of failing to explain why the additional responses were necessary could have been cured);*Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.4 (TTAB 1979) (no objection to untimely notice of reliance or to failure to submit copies of the discovery requests or responses thereto); *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025, 1027 n.1 (TTAB 1979) (no objection by either party to the other's improper reliance on its own answers; opposer did not object to interrogatories introduced by applicant and in fact referred to answers to other of opposer's interrogatories without benefit of notice of reliance); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (discovery depositions filed without a notice of reliance were treated as being of record where both parties referred to the depositions in their briefs and in view of stipulations concerning marking of exhibits in the depositions); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978) (both parties relied on answers given by each to the other's interrogatories without objection); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977) (same); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976) (neither party objected to improper notice of reliance by the other and each relied on the contents of the other's notice of reliance); and *Plus Products v. Sterling Food Co.*, 188 USPQ 586, 587 n.2 (TTAB 1975) (applicant did not file required notice of reliance on opposer's answers but both parties referred to the answers in their briefs).

[222] 37 CFR § 2.120(j)(8). *See* TBMP § 409 (Filing Discovery Requests and Responses with Board) and authorities cited therein.

[223] 37 CFR § 2.120(j)(6). *See West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (use of interrogatory answers to refresh memory of witness and testifying as to veracity of interrogatory answers permitted). *Cf. Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169-70 (TTAB 1984) (reading answers into record when witness was present at deposition inadmissible because no written copy given to refresh witnesses' memory), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

NOTE: *Some of the cases cited in this section established principles later codified in the cited provisions in current 37 CFR § 2.120(j), or were decided under rules which were the predecessors to such provisions.*

704.11 Produced Documents

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 record of the 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.*

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).*

Documents provided as all or part of an answer to an interrogatory may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR §§ 2.120(j)(3)(i) and 2.120(j)(5).[224]

However, a party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR § 2.122(e) (as official records; or as 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 the proceeding -- *see* TBMP §§ 704.07 and 704.08).[225]

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[224] *See M-Tek Inc. v. CVP Systems Inc.,* 17 USPQ2d 1070, 1073 (TTAB 1990), (notice of reliance failed to indicate that documents were being introduced under Rule 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer) and *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, *supra.*

[225] 37 CFR § 2.120(j)(3)(ii). *See, for example, M-Tek Inc. v. CVP Systems Inc*., *supra* at 1073; *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc*., 1 USPQ2d 1445, 1447 n.9 (TTAB 1986); *Osage Oil & Transportation,*

Listed below are a number of methods by which documents produced in response to a request for production of documents may be made of record:

(1) A party that has obtained documents under Fed. R. Civ. P. 34 may serve on its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under 37 CFR § 2.120(j)(3)(i), on the requests for admission, the exhibits thereto, and its adversary's admissions (or a statement that its adversary failed to respond to the requests for admission). However, if a party wishes to have an opportunity to serve requests for admission after obtaining documents under Fed. R. Civ. P. 34, it must serve its request for production of documents early in the discovery period, so that when it obtains the produced documents, it will have time to prepare and serve requests for admission prior to the expiration of the discovery period.[226]

(2) A party that has obtained documents under Fed. R. Civ. P. 34 may offer them as exhibits in connection with the taking of its adversary's discovery deposition. Again, however, the request for production of documents must be served early in the discovery period, so that there will still be time remaining, after the requested documents have been produced, to notice and take a discovery deposition.[227]

(3) A party that has obtained documents under Fed. R. Civ. P. 34 may introduce them as exhibits during the cross-examination of its adversary's witness.[228] This method is available only if the adversary takes testimony and the documents pertain to matters within the scope of the direct examination of the witness.

(4) A party that has obtained documents under Fed. R. Civ. P. 34 may, during its own testimony period, take the testimony of its adversary as an adverse witness and introduce the obtained documents as exhibits during direct examination.[229]

Inc. v. Standard Oil Co., 226 USPQ 905, 906 n.5 (TTAB 1985) (documents were neither official records nor printed publications); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co*., 221 USPQ 58, 59 n.4 (TTAB 1984) (documents were not printed publications); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977). *For additional case cites see Appendix of Cases.*

[226] *See* TBMP §§ 403.05(a) and 403.05(b) regarding the need for early initiation of discovery.

[227] *See* TBMP §§ 403.05 (Need for Early Initiation of Discovery).

[228] *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976).

[229] *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, *supra.*

(5) A party that has obtained documents under Fed. R. Civ. P. 34 may, during its own testimony period, make of record by notice of reliance, under 37 CFR § 2.122(e), any of the documents which falls into the category of "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."[230]

(6) A party that wishes to obtain documents under Fed. R. Civ. P. 34 may combine its request for production of documents with a notice of taking discovery deposition, and ask that the requested documents be produced at the deposition. However, the combined request for production and notice of deposition must be served well before the date set for the deposition, because a discovery deposition must be both noticed and taken before the close of the discovery period, and because Fed. R. Civ. P. 34(b) allows a party 30 days in which to respond to a request for production of documents (this period is lengthened to 35 days if service of the request is made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)).[231]

(7) Documents obtained under Fed. R. Civ. P. 34 may be made of record by stipulation of the parties.

(8) Documents obtained by request for production of documents under Fed. R. Civ. P. 34, and improperly offered in evidence, may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the documents as being of record; and/or in the same manner improperly offers documents which it obtained under Fed. R. Civ. P. 34.[232]

For information concerning the obtaining of discovery by way of a request for production of documents, see TBMP § 406.

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[230] *See* 37 CFR § 2.120(j)(3)(ii). *See also* TBMP §§ 704.07 (Official Records) and 704.08 (Printed Publications) and cases cited in the first paragraph of this section.

[231] *See* TBMP §§ 403.05 (Need for Early Initiation of Discovery).

[232] *See*, *for example*, *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (improper subject of notice of reliance but no objection raised); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978) (neither party objected to other's offering of Rule 34 documents by notice alone); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 569 n.1 (TTAB 1977) (applicant did not object to documents produced and introduced by notice alone and referred to those documents in its brief); and *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, *supra* (no objection to notice of reliance). *Cf. Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.8 (TTAB 1985).

704.12 Judicial Notice

37 CFR § 2.122(a) Rules of Evidence. *The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.*

Fed. R. Evid. 201. Judicial Notice of Adjudicative Facts
(a) Scope of rule. *This rule governs only judicial notice of adjudicative facts.*

(b) Kinds of facts. *A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.*

(c) When discretionary. *A court may take judicial notice, whether requested or not.*

(d) When mandatory. *A court shall take judicial notice if requested by a party and supplied with the necessary information.*

(e) Opportunity to be heard. *A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken.*

(f) Time of taking notice. *Judicial notice may be taken at any stage of the proceeding.*

In appropriate instances, the Board may take judicial notice of adjudicative facts. *See* 37 CFR § 2.122(a) and Fed. R. Evid. 201.

704.12(a) Kind of Fact That May be Judicially Noticed

The only kind of fact which may be judicially noticed by the Board is a fact which is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."[233]

[233] Fed. R. Evid. 201(b) and *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999). *See, for example, Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999); *Omega SA v. Compucorp*, 229 USPQ 191 (TTAB 1985); and *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977).

For examples of decisions concerning whether particular facts are appropriate subject matter for judicial notice by the Board, see cases cited in the note below.[234]

704.12(b) When Taken

The Board will take judicial notice of a relevant fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), if a party (1) requests that the Board do so, and (2)

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[234] *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (dictionary definition of term as trademark--yes, indicates mark is reasonably famous; also, encyclopedias may be consulted); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (home cold permanent wave kits have for many years been sold directly to nonprofessional consumers through retail outlets--yes); *Boswell v. Mavety Media Group Ltd, supra* (that violations of the rights of members of the African American community, and acts of disrespect to members of said community, by members of the majority community are likely to lead to an antagonistic attitude on the part of many members of the minority community – no); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (that there are thousands of registered marks incorporating the term NEW YORK for goods and services that do not originate there – no) *aff'd* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (dictionary definitions--yes); *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396 (TTAB 1979), *aff'd*, *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc*., 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (frequent use of famous marks on collateral products such as clothing, glassware, trash cans, etc.--yes); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (online dictionary definition where resource was also available in book form – yes); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works – yes); *In re 3Com Corp*., 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (dictionary definitions and technical reference works, e.g., computer dictionary--yes); *Continental Airlines Inc. V. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) (dictionary definitions noticed although not made of record by either party); *In re Total Quality Group Inc.*, 51 USPQ2d 1471, 1476 (TTAB 1999) (on-line dictionaries which otherwise do not exist in printed format-- no); *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1999) ("Physicians' Desk Reference" --yes); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1704 (TTAB 1998) (that "U.S." means the United States, which is a geographic area with defined boundaries--yes); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) (third-party registrations--no); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C.--yes); *Los Angeles Bonaventure Co. v. Bonaventure Associates*, 4 USPQ2d 1882 (TTAB 1987) (whether other companies have expanded from restaurant services to hotel services under a single mark, and, if so, when--no); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (files of applications and/or registrations, where no copies thereof are filed, and where they are not the subject of the proceeding--no); *Hertz System, Inc. v. A-Drive Corp.*, 222 USPQ2d 625 (TTAB 1984) (the numeral "1" is widely used to indicate superiority--yes); Hamilton Burr Publishing Co. v. E.W. Communications, Inc., 216 USPQ 802, 804 n.5 (TTAB 1982) (probation report–no); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819 (TTAB 1981) (use of antimicrobial agents in the floor covering industry--no); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981) (dictionary definitions--yes); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980) (standard reference works--yes); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978) (third-party registrations and listings in trade directories, where no copies thereof are submitted--no); *Quaker Oats Co. v. Acme Feed Mills, Inc*., 192 USPQ 653 (TTAB 1976) (law of any jurisdiction, when a copy thereof is submitted under notice of reliance--yes); *Plus Products v. Sterling Food Co.*, 188 USPQ 586 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products--yes); and *Bristol-Myers Co. v. Texize Chemicals, Inc.*, 168 USPQ 670 (TTAB 1971) (operations of opposer and applicant--no).

supplies the necessary information.[235] The request should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information.[236] The Board, in its discretion, may take judicial notice of a fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), whether or not it is requested to do so.[237]

704.12(c) Opportunity to be Heard

A party to a proceeding before the Board is entitled, on timely request, "to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken."[238] This does not mean, however, that when judicial notice is taken without prior notification, a party is automatically entitled to a hearing on request, even if it makes no offer to show that the taking of judicial notice was improper.[239]

704.12(d) Time of Taking Notice

Judicial notice may be taken at any stage of a Board proceeding, even on review of the Board's decision on appeal.[240] However, the Federal Circuit may decline to consider a request for judicial notice made at the late stage of oral argument on appeal.[241]

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[235] Fed. R. Evid. 201(d). *See United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, *supra*, and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, *supra*.

[236] *See Litton Business Systems, Inc. v. J. G. Furniture Co., supra*. *See also Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985), and *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980).

[237] Fed. R. Evid. 201(c). *See Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999) (declined to take judicial notice of slang dictionary definition when submitted as part of rebuttal testimony when could have been submitted with case in chief); *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977); and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976).

[238] Fed. R. Evid 201(e). *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, *supra*.

[239] *See In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). *See also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

[240] *See, for example*, Fed. R. Evi. 201(f); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (request for judicial notice as to fame of mark made in the briefs on appeal); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (judicial notice of banking business on appeal); *American Security Bank v. American Security and Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 n.1 (CCPA 1978) (judicial notice of absence of listing in local telephone directories); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 n.5 (CCPA 1977) (fact of common knowledge, e.g., of purchasers and channels of trade for home permanent wave kits, appropriate for judicial notice); *Food Specialty Co. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136, 139 n.3 (CCPA 1973)

704.13 Testimony From Another Proceeding

37 CFR § 2.122(f) Testimony from other proceedings. *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

On motion granted by the Board, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or their privies, may be used in a pending Board inter partes proceeding, to the extent that the testimony is relevant and material, subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony."[242]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony,[243] or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

(judicial notice on appeal of general sentiment towards kittens which differs from that toward other small animal pets); and *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999) (judicial notice may be taken at any time).

[241] *See Packard Press Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (Court declined to consider whether to take judicial notice of fame where request for judicial notice was made for first time at oral argument on appeal).

[242] 37 CFR § 2.122(f). *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992) (stating that there is no prerequisite that the Board must have considered the testimony or determined the relevancy in the prior opposition, or that the adverse party have actually attended the deposition when originally taken); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061, 1063 n.2 (TTAB 1988) (motion to use testimony from prior district court proceeding granted as uncontested and right to recall the witness waived since no request to do so was made), *rev'd on other grounds*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989);*Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57, 58 (TTAB 1975) (motion to rely on testimony from prior cancellation proceeding between the parties granted, subject to applicant's right to recall witnesses), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); and *Izod, Ltd. v. La Chemise Lacoste,* 178 USPQ 440 (TTAB 1973).

[243] *See MarCon Ltd. v. Avon Products Inc.*, 4 USPQ2d 1474, 1475 n.3 (TTAB 1987) (discovery deposition from previous proceeding to which applicant was not a party would not be admissible under this rule but in this case it was made of record by another means) and *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 182 (TTAB 1986) (*cf.* dissent at 182 n.15 contending that discovery deposition should have been admitted as admission against interest).

Testimony from another proceeding between the parties or their privies may be used, on motion granted by the Board, as evidence in connection with a motion for summary judgment, or as evidence at trial.[244] However, when the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken on recall of the same witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, on motion granted by the Board, during the appropriate trial period.[245]

For information on filing a motion for leave to use testimony from another proceeding, see TBMP § 530.

A testimony deposition from another proceeding may also be made of record in a Board proceeding by stipulation of the parties approved by the Board. The same is true of a discovery deposition.

705 Stipulated Evidence

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence. The use of stipulated evidence normally results in savings of time and expense for all concerned. Notwithstanding such a stipulation, a party may reserve the right to object to stipulated evidence on the grounds of competency, relevance, and materiality.[246]

For example, parties may stipulate that a party may rely on specified responses to requests for discovery, or on other specified documents or exhibits; or that the testimony of a witness may be submitted in the form of an affidavit by the witness; or what a particular witness would testify to if called; or to the facts in the case of any party; or that a discovery deposition may be used as testimony; or that evidence from another proceeding may be used as evidence in the proceeding in which the stipulation is filed.[247]

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[244] *See, for example*, *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, *supra* (evidence on the case), and *Oxy Metal Industries Corp. v. Technic, Inc.*, *supra* (summary judgment evidence).

[245] *See* TBMP §§ 528.05(a) (Summary Judgment Evidence in General) and 528.05(f) (Testimony from Another Proceeding).

[246] *See* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397-398 (1985).

[247] *See, for example*, 37 CFR § 2.123(b), and TBMP §§ 704.07-704.11 for a discussion of the various types of evidence and 703.01(b) (Form of Testimony).

706 Noncomplying Evidence

37 CFR § 2.123(l) Evidence not considered. *Evidence not obtained and filed in compliance with these sections will not be considered.*

Evidence not obtained and filed in compliance with the rules of practice governing inter partes proceedings before the Board will not be considered by the Board.[248]

707 Objections to Evidence

707.01 In General

37 CFR § 2.122(a) Rules of Evidence. *The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.*

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations).[249] A party to a Board inter partes proceeding that believes that proffered evidence should, under these rules, be excluded from consideration, may, raise an objection. The procedure for raising an objection to proffered evidence depends on the nature of the evidence and the ground for objection.[250]

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[248] 37 CFR § 2.123(l). *See Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (stating that a party may not reasonably presume evidence is of record when that evidence is not offered in accordance with the rules); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to main brief and not otherwise properly made of record was not considered); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983) (neither a recent photocopy of opposer's claimed registration attached to pleading without status and title notation nor introduction during testimony of original certificate of registration without testimony as to status and title is sufficient); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976) (evidence submitted for first time with brief not considered); *Plus Products v. General Mills, Inc.*, 188 USPQ 520, 521 n.1 (TTAB 1975) (evidence submitted after filing of reply brief not considered); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition timely filed but not accompanied by notice of reliance not considered); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 393 (1985).

[249] 37 CFR § 2.122(a). *Cf.* TBMP §§ 101.01 (Statute and Rules of Practice) and 101.02 (Federal Rules).

[250] *See, for example, Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998).

707.02 Objections to Notices of Reliance

707.02(a) In General

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered.[251] Trademark Rule 2.120(j), 37 CFR § 2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR § 2.122(e). Trademark Rule 2.122(d)(2), 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Trademark Rule 2.122(e), 37 CFR § 2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records.[252]

Some grounds for objection to a notice of reliance are waived unless promptly made (generally errors of any kind which might be obviated or cured if promptly presented) while other grounds that cannot be cured may be raised at any time. The various grounds for objection to a notice of reliance, and the time and procedure for raising them, are discussed in the sections that follow.[253]

707.02(b) On Procedural Grounds

Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike if the defect is one that can be cured.[254] However, if the ground for the objection is one that could not be cured even if raised promptly, the

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[251] *See generally* TBMP §§ 702 (Manner of Trial and Introducing Evidence – In General) and 704 (Introducing Other Evidence).

[252] *See also* TBMP §§ 704.01(b) (Not Subject of Proceeding – In General) and 704.07-704.11 discussing other types of evidence.

[253] *See also* TBMP § 707.04 (waiver of objection).

[254] *See, for example*, *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (objection waived where respondent received notice of reliance without referenced publications appended thereto but did not raise the issue until briefing); and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (objection that notice of reliance did not set forth relevance of appended documents raised for first time in brief waived).

adverse party may wait and raise the procedural objection in or with[255] its brief on the case.[256]

For information concerning motions to strike notices of reliance, see TBMP § 532.

707.02(b)(1) On Ground of Untimeliness

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted there under), in its entirety, as untimely.[257] Alternatively, an adverse party may raise this ground for objection in its brief on the case.[258]

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[255] *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1489, 1492 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief were not untimely and paper did not result in violation of page limitation for final briefs).

[256] *See Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (defect of failing to append copy of printed publication identified in notice of reliance could have been cured); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (petitioner's objection that respondent's justification for reliance on its own discovery responses was insufficient raised for first time in petitioner's brief was untimely since defect is one which could have been cured if raised promptly); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (objection that items submitted by notice of reliance were neither official records nor printed publications raised in brief sustained); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 655 n.9 (TTAB 1976) (objection to notice of reliance as to statement of relevance of third-party registrations untimely); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (objection that notice of reliance failed to indicate relevance of materials was curable and should have been raised when notice was filed); and *Johnson & Johnson v. American Hospital Supply Corporation*, 187 USPQ 478, 479 (TTAB 1975) (Board, on reconsideration, reversed its decision to treat defendant's objection to notice of reliance as motion to strike since opposer did not file a brief in response to objections but instead intended to argue against the objections in its trial brief).

[257] *See, for example, Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (motion to strike untimely supplemental notice of reliance to admit current status and title copy of registration in place of timely but older status and title copy granted) and *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (motion to strike untimely notice of reliance on interrogatory answers and certified copies of corporate records filed with the state granted).

[258] *See, for example, Questor Corp. v. Dan Robbins & Associates, Inc.,* 199 USPQ 358, 361 n.3 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979) and *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976) (respondent's objection to untimely notice of reliance raised for the first time in its brief was not waived), *pet. to Comm'r denied*, 198 USPQ 485 (Comm'r 1977). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

707.02(b)(2) On Other Procedural Grounds

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 CFR § 2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, or does not indicate the general relevance thereof,[259] or that the proffered materials are not appropriate for introduction by notice of reliance.[260]

When, on a motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the relying party time to cure the defect, failing which the notice will stand stricken.[261]

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[259] *See, for example, Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (motion to strike granted where notice of reliance was filed under inapplicable provision of rules in that items did not constitute discovery materials admissible under 2.120(j)(3) and opposer failed to explain relevance of appended copy of notice of opposition from a different case); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance failed to indicate that documents were being introduced under Rule 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (motion to strike notice of reliance granted where opposer failed to indicate how its own answers clarified rebutted or explained those relied on by applicant); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 951 (TTAB 1981) (motion to strike notice of reliance granted in part where applicant failed to identify specific answers sought to be introduced by answering party or indicate how they explained, clarified or rebutted answers relied on by inquiring party); *Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478, 479 (TTAB 1975) (applicant's objection to opposer's notice of reliance on letters between applicant and attorneys for third party well taken because such documents were not printed publications or official records and were not properly identified during deposition so as to lay foundation for introduction into evidence); *Rogers Corp. v. Fields Plastics & Chemicals, Inc.,* 172 USPQ 377, 378-79 (TTAB 1972) (motion to strike notice of reliance on entire remainder of deposition granted); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 124 (TTAB 1971) (motion to strike items in applicant's notice of reliance stricken as they were either duplicative of evidence already made of record**,** not deemed to be printed publications in general circulation, or, in view of the purpose stated by applicant in the notice of reliance, hearsay).

[260] *See, for example, Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance).

[261] *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (allowed 20 days to submit substitute notice of reliance remedying defects including submission of proper official record); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (allowed time to clarify that the documents submitted by notice of reliance were in fact produced in response to interrogatories rather than in response to document requests); and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (documents remained stricken where party did not correct deficiencies).

If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), the Board will defer determination of the motion until final hearing.[262] When determination of a motion to strike a notice of reliance is deferred until final hearing, the parties should argue the matter alternatively in their briefs on the case.

707.02(c) On Substantive Grounds

An adverse party may object to a notice of reliance on substantive grounds, such as that evidence offered under the notice constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial. Objections of this nature normally should be raised in or with[263] the objecting party's brief on the case, rather than by motion to strike, unless the ground for objection is one that could be cured if raised promptly by motion to strike.[264] This is because it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final deliberations in the proceeding.[265] If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing.[266]

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any

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[262] *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992), and *M-Tek Inc. v. CVP Systems Inc., supra* at 1073 (under the circumstances, whether documents were properly admissible under 2.120(j)(3)(i) and/or 2.120(j)(3)(ii) deferred).

[263] *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1489, 1492 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief were not untimely and paper did not result in violation of page limitation for final briefs).

[264] *See*, *in this regard*, 37 CFR § 2.123(k), and Fed. R. Civ. P. 32(d)(3)(A). *See also* Louise E. Frugé, *TIPS FROM THE TTAB: An "Object" Lesson*, 72 Trademark Rep. 211 (1982). *Cf.* TBMP §§ 707.02(b)(2) (Other Procedural Grounds) and 707.03(c) (Other Procedural Grounds and on Substantive Grounds).

[265] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

[266] *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (whether notice of reliance sought to introduce improper rebuttal evidence deferred), and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (whether documents submitted by notice of reliance were properly authenticated and whether they constituted hearsay deferred).

outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing.[267]

Because the parties to an inter partes Board proceeding generally will not know until final decision whether a substantive objection to a notice of reliance has been sustained, they should argue the matter alternatively in their briefs on the case.

707.03 Objections to Trial Testimony Depositions

707.03(a) In General

As in the case of an objection to a notice of reliance, an objection to a testimony deposition must be raised promptly if the defect is one that can be obviated or removed, failing which it is waived. The objections, which are waived unless promptly raised, are basically procedural in nature. Objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, *provided* that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections are basically substantive in nature. The grounds for objection to testimony depositions and the procedures for raising them are discussed below.

707.03(b) On Procedural Grounds

707.03(b)(1) On Ground of Untimeliness

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.[268]

When there is no such approved stipulation, granted motion or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety,

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[267] *See, for example, Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (timely notice of reliance on four-year old status and title copy of pleaded registration was not stricken); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (copies of USPTO drawings are official records and therefore would not be stricken; however, their probative value is limited); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) ("Certificate of Good Standing" from a U.S. district court is admissible as an official record and therefore would not be stricken; however its probative value would be determined at final hearing). *Cf.* TBMP § 707.03(c) (On Other Procedural Grounds and on Substantive Grounds).

[268] 37 CFR § 2.121(a) and TBMP § 701 (Time of Trial).

as untimely.[269] Alternatively, an adverse party may raise this ground for objection in its brief on the case.[270]

On the other hand, when a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, an adverse party which fails to promptly object to the scheduled deposition on the ground of untimeliness may be found to have waived this ground for objection, because the premature scheduling of a deposition is an error which can be corrected on seasonable objection.[271]

707.03(b)(2) On Ground of Improper or Inadequate Notice

37 CFR § 2.123(c) Notice of examination of witnesses. *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.*

* * * *

(e)*(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be*

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[269] *See* TBMP § 533.01 (On Ground of Untimeliness) and authorities cited therein.

[270] *Cf.* TBMP § 707.02(b)(1) (Untimeliness) and cases cited therein.

[271] *See Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (objection to timeliness of testimony deposition taken two days before period opened, but raised for the first time in its brief waived).

decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

Before testimony depositions on oral examination may be taken by a party, the party must give every adverse party due notice in writing of the time when and place where the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be deposed. If the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead.[272]

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record.[273]

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances.[274]

For further information concerning the motion to strike a testimony deposition for improper or inadequate notice, see TBMP § 533.02.

707.03(c) On Other Procedural Grounds and on Substantive Grounds

37 CFR § 2.123(e)*(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to*

[272] 37 CFR § 2.123(c). *See also* TBMP § 703.01(e) (notice of deposition). *Cf.* Fed. R. Civ. P. 30(b)(1).

[273] *See* 37 CFR § 2.123(e)(3) and TBMP § 533.02 (motion to strike testimony deposition on ground of improper or inadequate notice) and cases cited therein. *See also Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (while respondent's objection to notice was raised at the deposition, respondent failed to preserve the objection by moving to strike testimony promptly thereafter).

[274] 37 CFR § 2.123(e)(3).

object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

* * * *

(j) Effect of errors and irregularities in depositions. *Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.*

(k) Objections to admissibility. *Subject to the provisions of paragraph (j) of this section, objection may be made to receiving in evidence any deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections will not be considered until final hearing.*

Fed. R. Civ. P. 32(d) Effect of Errors and Irregularities in Depositions.
(1) As to Notice. *All errors and irregularities in the notice for taking a deposition are waived unless written objection is promptly served upon the party giving the notice.*

(2) As to Disqualification of Officer. *Objection to taking a deposition because of disqualification of the officer before whom it is to be taken is waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence.*

(3) As to Taking of Deposition.

> *(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.*

An adverse party may object to a testimony deposition not only on the grounds of untimeliness[275] and improper or inadequate notice,[276] but also on the ground that the deposing party has not complied with one or more of the other procedural requirements specified in the rules governing the taking of testimony in Board inter partes proceedings. In addition, objection may be made to a testimony deposition on one or more substantive grounds, such as that the witness is incompetent to testify, or that the testimony is irrelevant or constitutes hearsay or improper rebuttal. The time and procedure for raising these objections is described below.

As noted in TBMP § 707.03, some objections to testimony depositions must be raised promptly, or they are waived. The objections, which are waived unless raised promptly, are basically procedural in nature. They include:

> (1) Objections to errors and irregularities in the notice for taking a deposition (waived unless written objection is promptly served on the party giving the notice, in the case of an objection based on improper or inadequate notice, waived unless the provisions of 37 CFR § 2.123(e)(3) are followed);[277]
>
> (2) Objections to taking a deposition because of disqualification of the officer before whom the deposition is to be taken (waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence);
>
> (3) Objections based on 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

[275] *See* TBMP § 707.03(b)(1) (Untimeliness).

[276] *See* TBMP § 707.03(b)(2) (Improper or Inadequate Notice).

[277] *See* TBMP § 707.03(b)(2).

(4) Errors of any kind that might be obviated, removed, or cured if promptly presented (waived unless seasonable objection thereto is made at the taking of the deposition).[278]

Moreover, notice will not be taken of merely formal or technical objections, unless they were timely raised, and appear to have caused substantial injury to the party raising them.[279] This applies not only to errors and irregularities in the taking of a deposition, but also in the form of a deposition transcript (such as, improperly numbered pages or questions, improperly marked exhibits, etc.).[280]

Other objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, *provided* that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections, which are basically substantive in nature, include objections

(1) to the competency of a witness, or

(2) to the competency, relevance, or materiality of testimony, or

(3) that the testimony constitutes hearsay or improper rebuttal.[281]

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[278] *See* 37 CFR §§ 2.123(e)(3) and 2.123(j), and Fed. R. Civ. P. 32(d)(1),(2), and (3)(A) and (B). *See also Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1271 n.4 (TTAB 1999) (objection raised for the first time in brief to manner in which testimonial depositions were filed, waived since purported defect could have been cured if promptly raised); *Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389, 391 (TTAB 1985) (foundation objections to a survey submitted by opposer raised for the first time in brief waived); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (objection on grounds of improper identification or authentication of exhibits waived since defects could have been cured if made during the deposition); and TBMP § 707.03(b)(1).

Cf. TBMP § 707.02(b)(2) (Other Procedural Grounds), and *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977) (objection to untimeliness of notice of reliance raised for first time in brief was not waived since defect could not have been cured or remedied).

[279] *See* 37 CFR § 2.123(j). *See also, for example*, *Pass & Seymour, Inc. v. Syrelec*, s*upra* (regarding technical deficiencies in marking exhibits). *See also* Fed. R. Civ. P. 61 and*, with respect to notices of reliance, Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1292 n.1 (TTAB 1986) (noting precept of Fed. R. Civ. P. 61, Board stated that plaintiff's failure to serve notice of reliance was not fatal per se to the notice of reliance).

[280] *See* Fed. R. Civ. P. 61, and, *for example, Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (improperly marked exhibits considered) and *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Board has discretion to consider improperly marked exhibits).

[281] *See* 37 CFR § 2.123(k); Fed. R. Civ. P. 32(d)(3)(A); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, *supra*; and *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 769 n.4 (TTAB 1985) (objection that testimony is immaterial because it is outside scope of pleading is not waived).

When an objection of this type could not have been obviated or removed if presented at the deposition, the Board will consider it even if the objection is raised for the first time in or with[282] a party's brief on the case.[283]

Substantive objections to testimony (that is, objections going to such matters as the competency of a witness, or the competency, relevance, or materiality of testimony, or the asserted hearsay or improper rebuttal nature of the testimony) are not considered by the Board prior to final hearing.[284] This is because depositions are taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to deliberations on the final decision.[285] Further, testimony regularly taken in accordance with the applicable rules ordinarily will not be stricken on the basis of a substantive objection; rather, any such objection (unless waived) will be considered by the Board in its evaluation of the probative value of the testimony at final hearing.[286]

Similarly, if the propriety of a procedural objection to a testimony deposition (such as an objection to the form of a question) cannot be determined without reading the deposition, or examining other trial evidence, it generally will not be considered by the Board until final hearing.[287]

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[282] *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1489, 1492 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief were not untimely and paper did not result in violation of page limitation for final briefs).

[283] *See* Louise E. Frugé, *TIPS FROM THE TTAB: An "Object" Lesson*, 72 Trademark Rep. 211 (1982). *Cf. Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Objection on ground of hearsay with no foundation for establishing an exception waived since defect could have been cured if objection was raised during the deposition).

[284] *See, for example, Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy and materiality deferred); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 307 n.1 (TTAB 1979) (objections to relevance and materiality of exhibits offered at a deposition deferred); *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPQ 44, 47-48 (TTAB 1978) (objection on hearsay grounds or that witness offered opinion testimony without adequate foundation deferred); and *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as lacking foundation deferred). *Cf.* TBMP § 707.02(c) (Substantive Grounds).

[285] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

[286] *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992); *Liqwacon Corp. v. Browning-Ferris Industries, Inc., supra*; *Primal Feeling Center of New England, Inc. v. Janov, supra*; and *Globe-Union Inc. v. Raven Laboratories Inc., supra*. *Cf.* TBMP § 707.02(c) (Substantive Grounds).

[287] *See, for example, Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as based on leading questions deferred). *Cf.* TBMP § 707.02(b)(2) (Other Procedural Grounds).

For the foregoing reasons, the objections described in this section (as opposed to the objection to testimony as late-taken, which may be raised by motion to strike--*see* TBMP §§ 533.01 and 707.03(b)(1); and the objection based on improper or inadequate notice of the taking of a deposition, which is the subject of the motion to strike procedure described in 37 CFR § 2.123(e)(3), and TBMP §§ 533.02 and 707.03(b)(2)), generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the rules cited above, or orally "on the record" at the taking of the deposition, as appropriate. These objections, if properly asserted and not waived or rendered moot, normally will be considered by the Board in its determination of the case at final hearing.[288]

Additionally, in order to preserve an objection that was seasonably raised at trial, a party should maintain the objection in its brief on the case.[289]

When a deposition is taken on written questions pursuant to 37 CFR § 2.124, written objections to questions (that is, the direct questions, cross questions, redirect questions, and recross questions) may be served on the party propounding the subject questions. A party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party.[290] Objections to questions and answers in depositions on written questions generally are considered by the Board (unless waived) at final hearing.[291]

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[288] *See* 37 CFR § 2.123(k). *Cf.* TBMP § 707.02(c) (Substantive Grounds).

[289] *See Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Donut Shops Management Corporation v. Mace,* 209 USPQ 615 (TTAB 1981); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections in its brief and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977). *See also* TBMP § 707.04 (Waiver of Objection)

[290] *See* 37 CFR § 2.124(d)(1), and TBMP § 703.02(g) (Depositions on Written Questions -- Examination of Witness).

[291] *See* TBMP § 703.02(k) (Depositions on Written Questions – Objections to Deposition).

Because parties that have raised objections to testimony depositions generally will not know the disposition thereof until final decision, they should argue the matters alternatively in their briefs on the case.

707.03(d) Refusal to Answer Deposition Question

When an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. However, a witness may properly refuse to answer a question asking for information that is, for example, privileged or confidential.[292]

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 the unwieldy process of 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.[293]

There is no 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.[294] Accordingly, 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.[295]

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[292] *See* TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

[293] *See* TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions) and authorities cited therein.

[294] *See* TBMP §§ 404.02 (Discovery Depositions Compared to Testimony Depositions) and 707.03(c) ([Objections on] Other Procedural Grounds and Substantive Grounds) and authorities cited therein.

[295] *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer's objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer's position); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346 (TTAB 1983); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982); *Data Packaging Corp. v. Morning Star, Inc.,* 212 USPQ 109 (TTAB 1981); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615 (TTAB 1981); *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). *Cf. Land v. Regan*, 342 F.2d 92, 144 USPQ 661 (CCPA 1965). *But see University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983).

For information concerning refusal to answer a discovery deposition question, see TBMP §§ 404.03(a)(2) regarding deposition of nonparty residing in U.S., 404.08(c) (Objections During Deposition), 404.09 (Discovery Depositions Compared to Testimony Depositions), 411.03 (Discovery Depositions [Remedy for Failure to Provide Discovery]), and 523 (Motion to Compel Discovery).

707.04 Waiver of Objection

A party may waive an objection to evidence by failing to raise the objection at the appropriate time.[296]

For example, an objection to a notice of reliance on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted generally should be raised promptly. If a party fails to raise an objection of this nature promptly, the objection may be deemed waived, unless the ground for objection is one that could not have been cured even if raised promptly.[297]

Similarly, an objection to a testimony deposition on the ground that it does not comply with the applicable procedural rules generally is waived if not raised promptly, unless the ground for objection is one which could not have been cured even if raised promptly.[298]

On the other hand, objections to a notice of reliance, or to a testimony deposition, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly.[299]

If testimony is submitted in affidavit form by stipulation of the parties pursuant to 37 CFR §2.123(b), any objection, which is waived if not made at deposition, must be raised promptly after receipt of the affidavit submission, failing which it is waived.[300]

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[296] *See* 37 CFR §§ 2.123(e)(3), 2.123(j), and 2.123(k); Fed. R. Civ. P. 32(d)(1),(2), and (3)(A) and (B); and TBMP §§ 707.02 (Objections to Notices of Reliance) and 707.03 (Objections to Trial Testimony Depositions).

[297] *See* TBMP §§ 707.02(b)(1) (Untimeliness) and 707.02(b)(2) (Other Procedural Grounds) and authorities cited therein.

[298] *See* TBMP §§ 707.03(b)(1) (Untimeliness) and 707.03(c) (On Other Procedural Grounds and on Substantive Grounds) and authorities cited therein.

[299] *See* TBMP §§ 707.02(c) (On Substantive Grounds) and 707.03(c) (On Other Procedural Grounds and on Substantive Grounds) and authorities cited therein.

[300] *See Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389 (TTAB 1985).

If a party fails to attend a testimony deposition, any objection, which is waived if not made at the deposition, is waived.[301]

Additionally, by failing to preserve the objection in its brief on the case, a party may waive an objection that was seasonably raised at trial.[302]

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[301] *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, at 23132, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, at 22; *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 274 (1984).

[302] *See Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977). *See also* TBMP § 707.03(c) (On Other Procedural Grounds and on Substantive Grounds).

APPENDIX OF CASES

Section 704.03(b)(1)(A) Registration Owned by a Party

n.119 *Vita-Pakt Citrus Products Co. v. Cerro*, 195 USPQ 78 (TTAB 1977); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498 (TTAB 1976); *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976); *Fort Howard Paper Co. v. Georgia-Pacific Corp.*, 189 USPQ 537 (TTAB 1975); *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647 (TTAB 1975); and *A.R.A. Manufacturing Co. v. Equipment Co.*, 183 USPQ 558 (TTAB 1974). *Cf. Hollister Inc. v. Downey*, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977).

n.120 *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); and *W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118 (TTAB 1973).

n.132 *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979); *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742 (TTAB 1978); *Groveton Papers Co. v. Anaconda Co.*, 197 USPQ 576 (TTAB 1977); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976).

n.136 *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *David Crystal, Inc. v. Glamorise Foundations, Inc.*, 189 USPQ 740 (TTAB 1975); *Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 USPQ 790 (TTAB 1974); and *Gates Rubber Co. v. Western Coupling Corp.*, 179 USPQ 186 (TTAB 1973).

n.137 *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *Aloe Creme Laboratories, Inc. v. Johnson Products Co.*, 183 USPQ 447 (TTAB 1974); *Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970).

n.138 *See also Borden, Inc. v. Kerr-McGee Chemical Corp.*, 179 USPQ 316 (TTAB 1973), *aff'd without opinion*, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); *Unitec Industries, Inc. v. Cumberland Corp.*, 176 USPQ 62 (TTAB 1972); and *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506 (TTAB 1972).

n.140 *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976); *Old Dutch Foods, Inc. v. Old Dutch Country House, Inc.*, 180 USPQ 659 (TTAB 1973); and *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240 (TTAB 1963).

Section 704.03(b)(1)(B) Third-Party Registration

n.149 *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976);

Section 704.05(b) Exhibits to Briefs

n.171 *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *American Crucible Products Co. v. Kenco Engineering Co.*, 188 USPQ 529 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 61 (TTAB 1975), *aff'd,* 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

Section 704.10 Interrogatory Answers; Admissions

n.213 *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025, 1027 n.1 (TTAB 1979) ; *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978; *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.4 (TTAB 1978); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.6 (TTAB 1977) ; *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 660 n.2 (TTAB 1977) ; *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340 (TTAB 1976); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 309 n.6 (TTAB 1976) ; and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976).

n.216 *E. I. du Pont de Nemours & Co. v. G. C. Murphy Co.*, 199 USPQ 807, 808 n.2 (TTAB 1978); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977); *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439, 440 n.2 (TTAB 1976); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976); and *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340, 341 n.3 (TTAB 1976).

Section 704.11 Produced Documents

n.225 *BAF Industries v. Pro-Specialties, Inc.*, 206 USPQ 166, 168 n.1 (TTAB 1980); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 568 n.1 (TTAB 1977); *Dow Corning Corp. v. Doric Corp.*, 192 USPQ 106, 108 n.1 (TTAB 1976); *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.3 (TTAB 1976); and *MRI Systems Corp. v. Wesley-Jessen Inc.*, 189 USPQ 214, 215 n.3 (TTAB 1975).