Chapter 400 DISCOVERY

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401 Introduction to Disclosures and Discovery

37 CFR § 2.120(a)(1) Wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section. The provisions of Federal Rule of Civil Procedure 26 relating to required disclosures, the conference of the parties to discuss settlement and develop a disclosure and discovery plan, the scope, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form . . . . The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included with the notice of institution of the proceeding.

Through the use of the various disclosures (i.e., initial and expert) and discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in inter partes proceedings before the Board, a party may ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case, may simplify the issues, or may reveal a basis for a motion for summary judgment, an additional claim (in the case of a plaintiff), or an additional defense or counterclaim (in the case of a defendant). At the very least, taking discovery enables the propounding party to propose to the responding party stipulations of fact, stipulations as to procedures for introducing into the record evidence produced in response to discovery requests, and to otherwise prepare for trial. Propounding and responding to discovery may further lead parties to stipulate to narrowing the issues for trial, or to stipulate to expedited determination of their case under the Board's Accelerated Case

Resolution (ACR) process. [Note 1.] *See* TBMP § 528.05(a)(2), TBMP §702.04 and TBMP § 705 for information regarding ACR and stipulations.

The conduct of discovery in Board inter partes proceedings is governed by 37 CFR § 2.120. Discovery before the Board under 37 CFR § 2.120 is similar in many respects to discovery before the federal district courts under the Federal Rules of Civil Procedure. Ordinarily, the discovery provisions of the Federal Rules of Civil Procedure are applicable in Board inter partes proceedings, except as otherwise provided in 37 CFR § 2.120. The provisions of the Federal Rules relating to automatic disclosure and discovery conferences are not applicable in inter partes proceedings commenced prior to November 1, 2007. [Note 2.] However, for inter partes proceedings commenced on or after November 1, 2007, the Board has adopted a modified disclosure and conferencing regime. [Note 3.] For cases commenced on or after November 1, 2007, all involved parties are obliged to (1) conduct a discovery conference to discuss disclosure and discovery plans, and (2) make initial, expert, and pretrial disclosures. The Board adopted the disclosure regime of the Federal Rules in order to promote the early exchange of information and earlier settlement of cases and, for cases that do not settle, "more efficient discovery and trial, [reduction of] incidents of unfair surprise, and [to] increase the likelihood of fair disposition of the parties' claims and defenses." [Note 4.] In addition, the utilization of initial and expert disclosures is intended to "obviate the need to use traditional discovery to obtain 'basic information' about a party's claims or defenses." [Note 5.] In the absence of any express written statement from the parties filed with the Board that they waive their reciprocal rights to obtain disclosures, or agree to restrictions on the use of particular discovery devices, the Board will presume the parties will comply with their obligation to make all required disclosures and will utilize traditional discovery devices, as permitted by the Trademark Rules and Federal Rules of Civil Procedure. [Note 6.]

For more information regarding discovery conferences, see TBMP § 401.01 and TBMP §408.01(a).

For a discussion of when discovery requests, discovery responses, and disclosures should be filed with the Board, see TBMP § 409.

For information regarding pretrial disclosures, see TBMP § 702.01.

For information regarding Accelerated Case Resolution (ACR), see TBMP § 528.05(a)(2) and TBMP § 702.04.

NOTES:

1. For a discussion of the purposes served by discovery, see *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979). *See also Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 250 (TTAB 1978). For a discussion of ACR, see, for example , *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009).

2. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242 (August 1, 2007). *See also Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1437-38 (Fed. Cir. 2012) (pre-2007 procedures did not call for disclosures).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244-47 (August 1, 2007); 37 CFR § 2.120; Fed. R. Civ. P. 26(a)(1)(A); Fed. R. Civ. P. 26(a)(2); Fed. R. Civ. P. 26(a)(3); Fed. R. Civ. P. 26(f).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879-80 n.5 (TTAB 2012) (citing August 1, 2007 final rule); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (disclosures, from initial through pretrial, and discovery responses should be viewed as a continuum of communication designed to avoid unfair surprise and to facilitate a fair adjudication of the case on the merits); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (adoption of disclosure model intended to provide an orderly administration of the proceeding as it moves to trial).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

6. *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008).

401.01 Discovery Conferences

37 CFR § 2.120(a)(1) ... The provisions of Federal Rule of Civil Procedure relating to ... the conference of the parties to discuss settlement and develop a disclosure and discovery plan, ... are applicable to Board proceedings in modified form ... The Board will specify the deadline for a discovery conference ...

37 CFR § 2.120(a)(2) The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Federal Rule of Civil Procedure 26(f) and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate... The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.

Fed. R. Civ. P. 26(f)(2) Conference Content; Parties' Responsibilities. *... In conferring, the parties must consider the nature and basis of their claims and defenses and the possibilities for promptly settling or resolving the case; ... discuss any issues about preserving discoverable information...*

For inter partes proceedings commenced on or after November 1, 2007, the parties are required to hold a discovery conference to discuss the subjects set forth in Fed. R. Civ. P. 26(f) and in the institution order for the case. [Note 1.] As specified in the Board's institution order:

"[T]he parties are required to schedule and to participate with each other in a discovery conference by the deadline in the schedule. For guidance, see Fed. R. Civ. P. 26(f), Trademark Rule 2.120(a)(2), and TBMP § 401.01. In the conference, the parties are required to discuss (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling or at least narrowing the scope of claims or defenses, and (3) arrangements for disclosures, discovery and introduction of evidence at trial, if the parties are unable to settle at this time.

Discussion of amendments of otherwise prescribed procedures can include limitations on disclosures and/or discovery, willingness to stipulate to facts, and willingness to stipulate to more efficient options for introducing at trial information or materials obtained through disclosures or discovery."

The conference is not limited to the subjects listed in Fed. R. Civ. P. 26(f) or in the Board's institution order and "the parties are free to discuss any additional topics that could promote settlement or efficient adjudication of the Board proceeding," including alternative means for adjudication such as the Board's Accelerated Case Resolution (ACR) procedure. [Note 2.] *See* TBMP § 528.05(a)(2) and TBMP § 702.04 for further information on ACR. Because the parties may enter into stipulations altering disclosure obligations, they should continue to discuss their reciprocal obligations, and progress made in satisfying such obligations, even after the discovery conference has been held.

The conference should take place once the pleadings have closed by the deadline set forth in the Board's institution order (or by any extended deadline approved by the Board), and must take place no later than the opening of the discovery period. [Note 3.] In instances, however, where the defendant is in default, or a pleading motion under Fed. R. Civ. P. 12 has been filed, or a counterclaim has been filed, the parties' obligation to have a discovery conference is effectively stayed. [Note 4.] The rationale is that an answer must be filed to all claims and counterclaims, and issues related to the pleadings resolved before the parties can have a meaningful discovery conference. [Note 5.] In such cases, the Board will reset the deadline for the discovery conference as well as all subsequent dates, upon resolution of the default, or Fed. R. Civ. P. 12 motion, or acknowledgement of the counterclaim, which may include setting or resetting the deadline for filing an answer. [Note 6.] Generally after an answer is filed, the Board is unlikely to find good cause to extend the deadline for the discovery conference for settlement negotiations, even upon stipulation or consent. [Note 7.] There is no Fed. R. Civ. P. 16(b) scheduling/conference order.

The parties' discovery conference may be in person or by other means (e.g. telephone). [Note 8.] If any party wants a Board professional to participate in the required discovery conference, the party must call the Board attorney assigned to the case or file such request through ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, no later than ten (10) days prior to the deadline for conducting the discovery conference, so as to facilitate completion of the conference by the deadline. [Note 9.] Board participation is encouraged where pro se litigants are involved. [Note 10.] The participating attorney or judge has discretion to expand or reduce the number or nature of subjects to be discussed during the conference. [Note 11.] For instance, the Board professional may ascertain whether the parties have previously engaged in settlement discussions, explain to the parties the Board's ACR option, and may inquire whether the parties need additional time after the conference to discuss settlement. [Note 12.] Participation by a Board professional will be by telephone. [Note 13.] The conference will not be recorded by the Board and shall not be recorded by the parties.

If a party desires the appearance of more than one counsel on behalf of a party in a discovery conference with Board participation, that party is to designate a lead counsel to represent the party in the conference. With respect to pro se parties, the person who appears on behalf of the party, is one authorized under 37 CFR § 11.14(e). *See* TBMP § 114 (Party May Represent Itself). If a pro se litigant desires to have counsel appear on its behalf strictly for purposes of the discovery conference with Board participation, such counsel shall file a notice of appearance prior to the conduct of the discovery conference for this limited purpose. Subsequently, counsel will file a notice of withdrawal, unless counsel has been retained by the party to take further action on behalf of the party in the case. *See* TBMP § 116.01 regarding termination of representation.

In discovery conferences with Board participation, parties must conduct themselves with appropriate decorum and interruptions are to be avoided. The Board professional participating in the conference generally will signal that a party may make presentation by inviting the party to do so or by inviting a response to a presentation made by another. The Board professional may make other requirements for the orderly conduct of the discovery conference.

If neither party requests Board participation in the discovery conference, the parties still must conference no later than the prescribed deadline, and the Board will operate on the assumption that the conference was held by the deadline. The mere discussion of settlement amongst the parties does not substitute for a full discovery conference of subjects set forth in Fed. R. Civ. P. 26(f) and the Board's institution order. [Note 14.]

Unlike the Federal Rules, the parties do not have to file a disclosure/discovery plan with the Board following their discovery conference, unless they are seeking leave by motion or stipulation to alter standard deadlines or obligations, or unless they were directed to do so by the Board. [Note 15.]

The Board has the authority to order parties to hold a discovery conference, either sua sponte or upon motion. [Note 16.]

For a discussion regarding the duty to cooperate in scheduling and conducting a discovery conference, and the imposition of sanctions for the failure to participate in a discovery conference, see TBMP § 408.01(a).

For general information on the conduct of telephone conferences, participation in telephone conferences, and issuance of rulings resulting from telephone conferences, see TBMP § 502.06(a).

NOTES:

1. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(1); 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f). *See, e.g., Promgirl, Inc. v. JPC Co.*, 94USPQ2d 1759, 1761-62 (TTAB 2009) (mere discussion of settlement does not substitute for full discovery conference of subjects set forth in Fed. R. Civ. P. 26 and Board's institution order).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007). *See Weatherford/Lamb Inc. v. C&J Energy Servs., Inc.*, 96 USPQ2d 1834, 1836 n.4 (TTAB 2010) (parties encouraged to discuss ACR during discovery conference).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008) ("The Board is unlikely to find good cause when such a request is based on the parties' desire to engage in settlement discussions.").

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

9. *See* 37 CFR § 2.120(a)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *But see Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (Board professional can participate in discovery conference with less than ten days notice in instances where parties are at an impasse; conference may take place after deadline in those circumstances).

10. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42252 (August 1, 2007) ("... Board professionals involved in conferences will fill the educator's role [that] would have to be filled by experienced counsel.").

11. 37 CFR § 2.120(a)(2).

12. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42252 (August 1, 2007).

13. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

14. *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761-62 (TTAB 2009).

15. 37 CFR § 2.120(a)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245(August 1, 2007).

16. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1763 (TTAB 2009).

401.02 Initial Disclosures

37 CFR § 2.120(a)(2) *. Initial disclosures must be made no later than thirty days after the opening of the discovery period..*

37 CFR § 2.120(a)(3) *. A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board or by order of the Board...*

Fed. R. Civ. P. 26(a)(1) Initial Disclosures.

(A) ***In General.*** *Except as exempted by Rule 26(a)(1)(B) or as otherwise stipulated or ordered by the court, a party must, without awaiting a discovery request, provide to the other parties:*

(i) *the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;*

(ii) *a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment ...*

Each party involved in an inter partes proceeding is obligated to make initial disclosures to every other party, by the deadline set in the Board's institution order, or as may be reset by stipulation of the parties approved by the Board, or by motion granted by the Board, or by order of the Board. [Note 1.] A party may not seek discovery through traditional devices until after it has made its initial disclosures, absent modification of this requirement by a stipulation or motion of the parties approved by the Board, or upon Board order. [Note 2.] Generally, each party will meet this obligation by complying with the disclosure requirements set forth in Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii); subsections (iii) and (iv) of Rule 26(a)(1)(A) do not apply to Board proceedings. [Note 3.] "Initial disclosures are not intended to substitute for all discovery but, rather, to prompt routine disclosure of names of potential witnesses and basic information about documents and things that a party may use to support a claim or defense." [Note 4.]

Pursuant to Fed. R. Civ. P. 26(a)(1), a party is not obligated to disclose the name of every witness, document or thing that may have or contain discoverable information about its claim or defense, but merely the witnesses, documents and things having or containing discoverable "information that the disclosing party may use to support its claims or defenses." [Note 5.] If, however, a party does identify a trial witness in its initial disclosures, the party must provide the subject matter(s) about which each identified witness is likely to have discoverable information, as well as any known addresses and/or phone numbers for the identified witness. [Note 6.] In addition, a party must either provide the location of all identified documents in its initial disclosures, or, in the alternative, produce them. [Note 7.]

Initial disclosures are not a substitute for taking comprehensive discovery. [Note 8.] Nonetheless, discovery in Board proceedings should be more limited in scope than in district court cases since Board jurisdiction is limited to determining a party's right to obtain or retain a registration. [Note 9.] However, in the spirit of cooperation, parties can, subject to Board approval, stipulate to rely on more expansive use of reciprocal disclosures in lieu of formal discovery, as a more efficient and less costly means of litigating a Board proceeding. [Note 10.]

There is no concept of priority in regard to initial disclosures, and a party is not relieved of its obligation to make or supplement initial disclosures merely because it may not have received such disclosures or supplementation from an adverse party or parties. [Note 11.] For information regarding the duty to supplement initial disclosures, see TBMP § 408.03.

A party making initial disclosures has the option of disclosing information about the existence and location of documents instead of producing copies of documents. [Note 12.] However, the Board encourages parties to actually exchange copies of disclosed documents rather than to merely identify their location. [Note 13.]

Initial written disclosures and initial disclosures of documents are treated like responses to discovery requests insofar as they may be used in support of or in opposition to a motion for summary judgment and may, at trial, be introduced by notice of reliance. [Note 14.] For more information on motions for summary judgment and introduction of disclosures at trial by notice of reliance, see TBMP § 528 and TBMP § 704.14.

Pertinent information under Fed. R. Civ. P.26(a)(1) stored in digital or electronic form must also be identified in initial disclosures. For further information regarding the discovery of electronically stored information, see TBMP § 402.02.

A party failing to make initial disclosures may be subject to a motion to compel, and ultimately, a motion for discovery sanctions. [Note 15.]

In addition, a party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Board. [Note 16.]

For further information regarding the duty to cooperate and remedies for failure to make initial disclosures, see TBMP § 408.01(b) and TBMP § 411.01.

NOTES:

1. 37 CFR § 2.120(a)(1), 37 CFR § 2.120(a)(2) and 37 CFR § 2.120(a)(3).

2. 37 CFR § 2.120(a)(3). *See Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1704-06 (TTAB 2009) (party objecting to discovery due to proponent's alleged failure to make initial disclosures must specifically articulate that objection); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1768 (TTAB 2008) (parties' notice of waiver of initial disclosures approved).

3. *See* 37 CFR § 2.120(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246(August 1, 2007); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (initial disclosures must be signed by party or party's attorney to comply with Fed. R. Civ. P. 26(g)).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (because an exhaustive search for all information or potential witnesses is not required, Board did not exclude the testimony of certain witnesses named for the first time in pretrial disclosures based on the failure to name them in initial disclosures, though the testimony for most witnesses was excluded for other reasons); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 n.1 (TTAB 2009) ("A party need not, through its mandatory initial disclosures, identify particular individuals as prospective trial witnesses, per se, but must identify 'each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses.' . . . Individuals identified through initial disclosures therefore could reasonably be viewed as possible witnesses.")... *But see Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010) (where opposer identifies trial witness in pretrial disclosures who was not identified in initial disclosures, opposer ordered to serve revised pretrial disclosure limiting testimony witness to subjects on which second trial witness that was identified in initial disclosures is expected to testify).

6. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008).

7. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245-46 (August 1, 2007).

10. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

11. Fed. R. Civ. P. 26(a)(1)(E).

12. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42254 (August 1, 2007).

13. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 n.4 (TTAB 2008).

14. 37 CFR § 2.127(e)(2) and 37 CFR § 2.120 (j)(3)(i). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

15. 37 CFR § 2.120(e); 37 CFR § 2.120(g)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42256 (August 1, 2007). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1878-79 (TTAB 2012) (motion to compel is available remedy for failure to serve, or insufficient, initial disclosures).

16. 37 CFR § 2.127(e)(1). *See, e.g., Qualcomm, Inc. v. FLO Corp.*, 93USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures).

401.03 Expert Disclosures

37 CFR § 2.120(a)(2) *... Disclosure of expert testimony must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2), unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board may issue an order regarding expert discovery and /or set a deadline for any other party to disclose plans to use a rebuttal expert…*

Fed. R. Civ. P. 26(a)(2) Disclosure of Expert Testimony.

(A) ***In General*** *. In addition to the disclosures required by Rule 26(a)(1), a party must disclose to the other parties the identity of any witness it may use at trial to present evidence under Federal Rule of Evidence 702, 703, or 705.*

(B) ***Witnesses Who Must Provide a Written Report*** *. Unless otherwise stipulated or ordered by the court, this disclosure must be accompanied by a written report — prepared and signed by the witness — if the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party's employee regularly involve giving expert testimony. The report must contain:*

(i) *a complete statement of all opinions the witness will express and the basis and reasons for them;*

(ii) *the facts or data considered by the witness in forming them;*

(iii) *any exhibits that will be used to summarize or support them;*

(iv) *the witness's qualifications, including a list of all publications authored in the previous 10 years;*

(v) *a list of all other cases in which, during the previous 4 years, the witness testified as an expert at trial or by deposition; and*

(vi) *a statement of the compensation to be paid for the study and testimony in the case.*

(C) ***Witnesses Who Do Not Provide a Written Report*** *. Unless otherwise stipulated or ordered by the court, if the witness is not required to provide a written report, this disclosure must state:*

(i) *the subject matter on which the witness is expected to present evidence under Federal Rule of Evidence 702, 703, or 705; and*

(ii) *a summary of the facts and opinions to which the witness is expected to testify.*

(D) ***Time to Disclose Expert Testimony*** *. A party must make these disclosures at the times and in the sequence that the court orders. Absent a stipulation or a court order, the disclosures must be made:*

(i) *at least 90 days before the date set for trial or for the case to be ready for trial; or*

(ii) *if the evidence is intended solely to contradict or rebut evidence on the same subject matter identified by another party under Rule 26(a)(2)(B) or (C), within 30 days after the other party's disclosure.*

(E) ***Supplementing the Disclosure*** *. The parties must supplement these disclosures when required under Rule 26(e).*

Although not frequently utilized in Board proceedings, experts in Board inter partes proceedings are typically recruited on the basis of experience in the relevant trade or industry and not on the basis of personal knowledge of or on-the-scene involvement in any sequence of events that gave rise to the Board proceedings. [Note 1.] As set forth in Federal Rule of Evidence 702, made applicable to Board proceedings by 37 CFR § 2.122, "a witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if: (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case." [Note 2.] A party generally must decide within the discovery period whether it plans to use an expert to testify at trial since expert disclosure is due 30 days prior to the close of discovery, or by any deadline that may be reset by any order of the Board issued after the initial institution order. [Note 3.]

The extent of the expert disclosure obligation is governed by Fed. R. Civ. P. 26, specifically, Fed. R. Civ. P. 26(a)(2). [Note 4.] Parties are not required to disclose consulting experts. [Note 5.] On the other hand, both retained, specially employed experts, and unretained experts must be disclosed. [Note 6.] Only retained experts are required to provide a report, unless otherwise stipulated. [Note 7.] For unretained experts, a party must provide the subject matter on which the witness is expected to present evidence under Fed. R. Evid. 702, 703, or 705; and a summary of the facts and opinions to which the witness is expected to testify. [Note 8.]

The disclosure of planned or possible expert testimony by any party must be made by the expert disclosure deadline, regardless of whether any other party has made such disclosure. Thus, for example, if a defendant has plans to present, or may present, expert testimony to support an affirmative defense, regardless of whether a plaintiff may use expert testimony in support of a main claim, then the defendant must disclose the planned or possible presentation of such testimony by the deadline set by the Board. [Note 9.] If a party decides after the deadline for expert disclosure that it would like to, or may need to, rely on expert testimony at trial, the party must file a motion for leave to use the expert at trial. [Note 10.] The provisions regarding the timing of expert disclosure are intended to facilitate the taking of any necessary discovery by any party or parties adverse to the disclosing party, in regard to the proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. Parties are expected to cooperate in the process of exchanging information about any testifying experts, and should at least discuss, during the discovery conference, the possibility of entering into stipulations that will facilitate the exchange of such information and/or the presentation of expert testimony. The parties should revisit these discussions whenever it appears that a testifying expert witness may become involved in the case. [Note 11.]

Any party disclosing plans to use an expert must notify the Board that it has made the required disclosure(but should not file with the Board copies of the materials provided to adverse parties) to comply with Fed. R. Civ. P. 26(a)(2). [Note12.] The Board may then suspend proceedings to allow for discovery limited to experts. [Note 13.] The suspension order may leave unchanged the deadline specified in the Federal Rule

for disclosure of plans to use a rebuttal expert, or may reset the deadline, depending upon the circumstances at the time the Board issues the suspension order. Suspension is as to activities unrelated to the exchange of information about, and reports by, expected expert witnesses, and the parties should continue with the expert disclosure procedures specified in the Federal Rule pending issuance of any suspension order by the Board that will specify any actions of the parties required by the Board. If a party discloses plans to use an expert witness early in the discovery period, the Board may choose not to suspend discovery activities unrelated to the expected expert witnesses and may direct that all discovery activities continue concurrently with the disclosures and discovery relative to the experts. [Note 14.] The Board recognizes that there may be cases in which a party may not decide that it needs to present an expert witness at trial until after the deadline for expert disclosure. In such cases, disclosure must be made promptly when the expert is retained and a motion for leave to present testimony by the expert must be filed. [Note 15.] Prompt disclosure after the deadline, however, does not necessarily ensure that the expert's testimony or evidence will be allowed into the record at trial. [Note 16.] The Board will decide on a case-by-case basis how to handle a party's late identification of experts. [Note 17.]

A party has the prerogative of deciding not to use a designated expert for testimony. [Note 18.] In addition, a party may be permitted to withdraw a previously disclosed expert and expert report and substitute a new expert witness and expert report. [Note 19.] However, if the substitution occurs after the expert disclosure deadline, the Board will consider whether the substitution is substantially justified or harmless. [Note 20.] A party may redesignate a testifying expert witness as a non-testifying or consulting expert. [Note 21.] If a party redesignates the designated testifying expert witness as a non-testifying or consulting expert after an expert report has been disclosed, the expert will be subject to deposition only under exceptional circumstances. [Note 22.] If a party discloses an expert report after the expert disclosure deadline, the Board will consider whether the late disclosure is substantially justified or harmless. [Note 23.]

A party may supplement or correct its expert disclosures "if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing." [Note 24.] A party may supplement or correct information included in an expert report and information given in the expert's deposition testimony before a party's pretrial disclosures are due. [Note 25.] Rule 26(e), however, does not allow an expert to bolster previously disclosed opinions or to add new opinions. [Note 26.]

For further information regarding the duty to cooperate and to the duty to supplement with regard to expert disclosures, see TBMP § 408.01(b) and TBMP § 408.03. For information regarding remedies for failure to disclose or inadequate expert disclosures, see TBMP § 411.01.

NOTES:

1. *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1494-95 (TTAB 2013).

2. Fed. R. Evid. 702. *See also* Notes of Advisory Committee on Proposed Rules. *See, e.g., McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1298 n.58 (TTAB 2014) ("While a party is not required to employ an expert to be able to direct criticisms to an opposing party's survey, having a qualified expert confirm that the criticisms reflect the relevant standards employed in the survey field would lend additional weight to such criticisms."); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013) (witness qualified as an expert in the field of travel writing and journalism based on professional experience as a travel writer and editor), *aff'd mem*, 565 F. App'x 900 (Fed. Cir. 2014).

3. *See* 37 CFR § 2.120(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007) (in the absence of an order from

the Board setting a deadline, expert disclosures are governed by Fed. R. Civ. P. 26(a)(2), per 37 CFR § 2.120(a)(2)); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (party is to disclose its plan to use an expert 30 days before the close of discovery).

4. *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1494 (TTAB 2013) (use of testifying expert); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1891-92 (TTAB 2011).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42254 (August 1, 2007). *See also* Fed. R. Civ. P 26(b)(4)(D); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1567 (TTAB 2014) (discussing the differences between testifying and consulting experts in connection with redesignation of a testifying expert as a consulting expert).

6. Fed. R. Civ. P. 26(a)(2)(A).

7. Fed. R. Civ. P. 26(a)(2)(B); Fed. R. Civ. P. 26(a)(2)(C). *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1495 (TTAB 2013) (an expert is retained for purposes of Rule 26(a)(2)(B) and required to provide a written report "[w]here an expert's opinion testimony arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation").

8. Fed. R. Civ. P. 26(a)(2)(C). A witness under Fed. R. Civ. P. 26(a)(2)(C) may testify as both a fact witness and also provide expert testimony under Fed. R. Evid. 702, 703 or 705. Fed. R. Civ. P. 26(a)(2)(C) Advisory committee notes (2010 amendment).

9. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

10. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

11. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 n. 3 (TTAB 2011) (parties expected to cooperate to resolve problems arising from timely but incomplete expert disclosures).

12. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.* , 106 USPQ2d 1492, 1493 n.3 (TTAB 2013) (a party must the notify the Board of its plan to use an expert (without including copies of expert disclosures), and that it has made required expert disclosures to adversary; the best practice is to notify the Board concurrently with the expert disclosures to adverse party). *But see General Council of the Assemblies of God v. Heritage Music Foundation* , 97 USPQ2d 1890, 1893 (TTAB 2011) (37 CFR § 2.120(a)(2) does not mandate that a disclosing party inform the Board that an expert disclosure has been made; disclosing party's failure to notify the Board is not a ground to exclude the testimony).

13. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007); *But see, General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) ("The purpose of informing the Board of such a disclosure is to facilitate discovery," but notification to the Board may not be necessary if expert-related discovery can be concluded by the close of discovery).

14. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (in any given case, suspension of proceedings for expert-related discovery may not be necessary).

15. *See* 37 CFR § 2.120(a)(2).

16. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

17. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See, e.g.*, *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528-29 (TTAB 2015) (after balancing relevant factors, substitution of witness and expert report after expert disclosure deadline due to witness unavailability found to be substantially justified and harmless under circumstances of the case); *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1563-64 (TTAB 2014) (after balancing relevant factors, untimely disclosure of expert opinion found neither substantially justified nor harmless under circumstances of case).

18. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1567 (TTAB 2014).

19. *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528-29 (TTAB 2015).

20. Fed. R. Civ. P. 37(c)(1). *See, e.g.*, *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528 (TTAB 2015) (substitution of expert and expert report after expert disclosure deadline).

21. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1567, 1567 n.9 (TTAB 2014) (noting that a designated expert witness can be redesignated as a non-testifying or consulting expert and shielded from discovery).

22. Fed. R. Civ. P. 26(b)(4)(D)(ii); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014) (showing of exceptional circumstances required in case of noticed deposition (without subpoena) of party's redesignated consulting expert). **Please Note**: The Board has no jurisdiction over depositions of non-parties by subpoena.

23. *See* Fed. R. Civ. P. 37(c)(1). *See, e.g.*, *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528 (TTAB 2015) (substitution of expert and expert report); *Gemological Institute of America, Inc. v. Gemology Headquarters Int'l, LLC*, 111 USPQ2d 1559, 1562 (TTAB 2014) (untimely expert report).

24. Fed. R. Civ. P. 26(e)(1)(A). *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1561-62 (TTAB 2014) (discussing what is proper supplementation of an expert report).

25. Fed. R. Civ. P. 26(e)(2). *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528 n.5 (TTAB 2015); *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1562 (TTAB 2014).

26. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1241 (TTAB 2015).

401.04 Modification of Disclosure Obligations

37 CFR § 2.120(a)(2) *... Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a stipulation or motion for modification is denied, disclosure deadlines and obligations may remain as originally set or reset and obligations may remain unaltered. ...*

Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 1.] Written initial disclosures or disclosed documents, and materials obtained through the disclosure process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period. [Note 2.] The parties may agree to waive or otherwise modify their obligation to make disclosures, but must inform the Board by written stipulation or by motion. [Note 3.] A party who fails to make the required or adequate disclosures may be subject to a motion to compel, and ultimately a motion for sanctions, including possible judgment. [Note 4.] *See* TBMP § 411.01 and TBMP § 523 for further information on motions to compel initial or expert disclosures.

In instances where the defendant is in default, or a pleading motion under Fed. R. Civ. P. 12 or counterclaim has been filed, the parties' obligation to make initial disclosures is effectively stayed. [Note 5.] In such cases, the Board will reset the deadline for making initial disclosures as well as the deadline for the discovery conference and all subsequent dates, after resolving or accounting for the default, motion or counterclaim. [Note 6.] For further information regarding the rescheduling of the discovery conference in these circumstances, see TBMP § 401.01.

Pretrial disclosures are not part of the disclosure and discovery process and, therefore, a motion to compel is not the remedy when a party fails to make, or makes inadequate, pretrial disclosures. *See* TBMP § 702.01 for further information on pretrial disclosures.

For a discussion regarding extensions of time to make disclosures and the impact of extensions of time regarding the close of discovery on disclosure obligations, see TBMP § 403.04.

NOTES:

1. 37 CFR § 2.120(a)(2).

2. 37 CFR § 2.120(j)(8). *See also Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1427 n.6 (TTAB 2013) (documents obtained through disclosure may be offered as exhibits in connection with the taking of an adversary's discovery deposition, and may be introduced as exhibits during the taking of an adversary's testimony).

3. 37 CFR § 2.120(a)(2) and 37 CFR § 2.120(a)(3). *See, e.g., Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 (TTAB 2013) (parties stipulated to waive pretrial disclosures); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (waiver of initial disclosures).

4. 37 CFR § 2.120(e)(1); 37 CFR § 2.120(g)(1) and 37 CFR § 2.120(g)(2); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) (motion to compel is an available remedy for

inadequate expert disclosures); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.2 (TTAB 2009) (motion to compel is remedy when adversary has failed to make or has made inadequate initial disclosures); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (petitioner's motion to compel amended initial disclosures granted where respondent failed to identify the address or telephone number of listed witnesses, the subject matter(s) about which each has information, and the location or production of identified documents).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

401.05 Form of Disclosures

Fed. R. Civ. P. 26(a)(4) Form of Disclosures. *Unless the court orders otherwise, all disclosures under Rule 26(a) must be in writing, signed, and served.*

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

Fed. R. Civ. P. 26(g)

(1) ***Signature Required; Effect of Signature.*** *Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name — or by the party personally, if unrepresented — and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made ...*

(2) ***Failure to Sign.*** *Other parties have no duty to act on an unsigned disclosure, request, response, or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is called to the attorney's or party's attention.*

Disclosures must be in writing, signed by either the party or its attorney, and bear the caption and proceeding number for the case. [Note 1.] The signer's address, email address and telephone number must also be provided. [Note 2.] Signature of a disclosure constitutes certification that the disclosure is complete and correct at the time it was made. [Note 3.] Disclosures also must be served. [Note 4.]

Fed. R. Civ. P. 26 specifically exempts privileged information and work product from disclosure.

For a discussion of the duty to supplement initial disclosures, see TBMP § 408.03.

For a discussion of violations of Fed. R. Civ. P. 26(g), see TBMP § 408.01(c).

NOTES:

1. Fed. R. Civ. P. 26(a)(4); Fed. R. Civ. P. 26(g). *See Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008).

2. Fed. R. Civ. P. 26(g)(1).

3. Fed. R. Civ. P. 26(g)(1)(A).

4. Fed. R. Civ. P. 26(a)(4).

401.06 Other Requirements Under the Board's Disclosure Regime

As noted above, parties are also required to hold a discovery conference discussing the subjects set forth in Fed. R. Civ. P. 26(f) as well as the nature and basis of the involved claims and defenses, the possibility of settlement of the case or modification of the pleadings, and plans for disclosures and discovery and any other subjects that the Board may, in an institution order, require to be discussed. [Note 1.] The parties are free to discuss additional topics besides those outlined in the institution order that could promote settlement or efficient adjudication of the Board proceeding. [Note 2.] Because the parties may enter into stipulations altering disclosure obligations, they should continue to discuss their reciprocal obligations, and progress made in satisfying such obligations, even after the discovery conference has been held.

A party that has not made initial disclosures may not serve discovery requests or file a motion for summary judgment, except for a motion addressing the Board's jurisdiction or claim or issue preclusion. [Note 3.] Under these circumstances, the requirement of service of initial disclosures cannot be waived. [Note 4.] For a further discussion regarding the timing of filing a motion for summary judgment, see TBMP § 528.02. A party that has not made initial disclosures is also precluded from filing a motion to compel. [Note 5.]

Parties are also required to make pretrial disclosures prior to the opening of each testimony period. For further information on pretrial disclosures, see TBMP § 702.01.

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the disclosure and discovery process, and looks with extreme disfavor on those who do not. For further guidance regarding the parties' duty to cooperate, see TBMP § 408.01.

For a discussion of the duty to supplement written discovery responses and disclosures, see TBMP § 408.03.

NOTES:

1. *See* 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

2. *See, e.g.*, *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761(TTAB 2009).

3. 37 CFR § 2.127(e)(1). *See e.g.*, *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had not yet made and served initial disclosures). *See also Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) ("Because the Board does not allow a party to file a motion for summary judgment prior to the moving party's service of initial disclosures on the adverse party, the Board generally will no longer exercise its discretion to convert motions to dismiss that refer to matters outside the pleadings into motions for summary judgment, if such motions are filed before the moving party serves its initial disclosures.").

4. *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010). *But see Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).

5. 37 CFR § 2.120(a)(3) ("a party must make its initial disclosures prior to seeking discovery"). *See Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to compel denied where moving party failed to make initial disclosures).

402 Scope of Discovery

402.01 In General

Fed. R. Civ. P. 26(b)(1) Scope in General. *Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.*

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

(1) ***Signature Required; Effect of Signature.*** *Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name — or by the party personally, if unrepresented — and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made; and*

(B) *with respect to a discovery request, response, or objection, it is:*

(i) *consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;*

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

(iii) *neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.*

(2) ***Failure to Sign.*** *Other parties have no duty to act on an unsigned disclosure, request, response, or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is called to the attorney's or party's attention.*

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

Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery

in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.

A party may take discovery not only as to matters specifically raised in the pleadings, [Note 2] but also as to any matter which might be reasonably calculated to serve as the basis for an additional claim, defense, or counterclaim. [Note 3.] While the scope of discovery is therefore somewhat broad, parties may not engage in "fishing expeditions" and must act reasonably in framing discovery requests. [Note 4.] The parties are expected to take into account the principles of proportionality with regard to discovery. [Note 5.] The scope of discovery in Board proceedings, though, is generally narrower than in court proceedings, especially those involving infringement and/or where both parties have made extensive use of the marks. [Note 6.] The guidelines set forth in Fed. R. Civ. P. 26(b)(1) also apply to the discovery of information stored in digital or electronic form. A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way. [Note 7.] However, parties are free to discuss agreed limits on discovery as a means of reducing the time and cost associated with discovery. [Note 8.]

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

In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of Fed. R. Civ. P. 26(g), a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. [Note 10.] A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. [Note 11.] For a further discussion regarding discovery guidelines, see TBMP § 408.01 and TBMP § 414.

For a discussion of the scope of required disclosures intended to obviate the need for some basic discovery, see TBMP § 401.

NOTES:

1. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) ("[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence."). *See also Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 856-66 (TTAB 1979); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (relevancy construed liberally). *But see FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) ("scope of discovery in a Board proceeding is governed by Fed. R. Civ. P. 26(b)(1)").

2. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (discussing general scope of discovery); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153, (TTAB 2013) (scope of permissible discovery would have been proportionately narrower if opposer had pleaded only the most relevant marks and clearly and specifically identified the goods and services relevant to this proceeding).

3. *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information concerning possible abandonment, if revealed, may provide basis for counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (the mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, cannot be construed as a collateral attack on the registration); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) ("applicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for an affirmative defense or for a counterclaim."). *But see The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154, 2154 n.5 (TTAB 2013) (opposer's unpleaded registrations are beyond the scope of discovery; party is free to conduct own investigation to determine whether a permissive counterclaim is warranted but should avoid further complicating the case by conducting the investigation through discovery).

4. Fed. R. Civ. P. 26(b). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (parties should seek only discovery which is proper and relevant to the specific issues involved in the case); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) (". . . the right to discovery is not unlimited. Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process."); *Dow Corning Corp. v. The Doric Corp.*, 183 USPQ 377, 378 (TTAB 1974) ("tremendous and prolonged discovery" which lacked specificity and was "too comprehensive in scope" not warranted).

5. *See, e.g.*, *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (Board expects parties to take into account the principles of proportionality with regard to discovery); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (Board applied proportionality principle to interrogatories, document requests and requests for admission); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (discussing principles of proportionality with respect to requests for admissions); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908-10 (TTAB 2011) (Board applied proportionality principles to electronically-stored information).

6. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011).

7. *See Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (scope of discovery limited only by restrictions in Fed. R. Civ. P. 26).

8. 37 CFR § 2.120(a)(2) ("[t]he parties may stipulate to a shortening of the discovery period.").

9. Fed. R. Civ. P. 26(g). *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267-68 (TTAB 2015) (plaintiff's discovery requests were irrelevant and improper because they went beyond what was necessary to prove the claims before the Board and were not appropriately tailored to elicit discoverable information); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (parties are entitled to seek discovery as they may deem necessary to help them prepare for trial, but it is not the practice of the Board to permit unlimited discovery to the point of harassment and oppressiveness); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) ("each party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case."); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984). *Cf. Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (opposer's failure "to conduct an attorney-supervised ESI retrieval, research and review" does not necessarily mean the discovery efforts were inadequate under the circumstances).

10. *See* Fed. R. Civ. P. 26(g). *See also Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (petitioner estopped to challenge respondent's interrogatories as excessive in number having served virtually identical set on respondent); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties who served identical discovery requests on each other in effect waived their right to object and must answer each request completely). *See also Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (applicant, having served 114 interrogatories, is estopped from challenging opposer's 122 interrogatories as excessive); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 623 (TTAB 1974) (each party was estopped from objecting to interrogatory requests served upon them by the opposing party which were essentially the same requests); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477 (TTAB 1974) (opposer must answer applicant's interrogatories which are similar to those which were served by opposer upon applicant). *Cf. Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (no estoppel where opposer served a different, albeit also excessive, set of interrogatories on applicant); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990) (opposer not estopped from arguing that applicant's interrogatories are excessive even though opposer also exceeded the limit because applicant waived its rights to complain because it did not file a motion for a protective order).

11. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (Board was persuaded that certain interrogatories would be burdensome).

402.02 Limitations on Right to Discovery and on Electronically Stored Information

Fed. R. Civ. P. 26(b)(2)(A) When Permitted. *By order, the court may alter the limits in these rules on the number of depositions and interrogatories or on the length of depositions under Rule 30. By order or local rule, the court may also limit the number of requests under Rule 36.*

Fed. R. Civ. P. 26(b)(2)(B) Specific Limitations on Electronically Stored Information. *A party need not provide discovery of electronically stored information from sources that the party identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the party from whom discovery is sought must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.*

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, inter alia, it is unreasonably cumulative or duplicative; or is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive; or "where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information." [Note 1.]

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

In addition, a party will not be permitted to obtain, through a motion to compel, discovery broader in scope than that actually sought in the discovery request(s) to which the motion pertains. [Note 3.]

Discovery of confidential commercial information is subject to the terms of the Board's standard protective order, or an appropriate alternative protective agreement or order. [Note 4.] For a further discussion of protective orders, see TBMP § 412.

Similarly, information protected by the attorney-client privilege is not discoverable unless the privilege has been waived; [Note 5] and documents and things prepared in anticipation of litigation or for trial by or for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means. [Note 6.]

Fed. R. Civ. P. 26(b)(2)(B) also provides for limitations regarding the discovery of electronically stored information(ESI). Specifically, a "party need not provide discovery of [ESI] from sources that the party identifies as not reasonably accessible because of undue burden or cost." [Note 7.] Pursuant to the rule, when an adverse party seeks to compel the production of such material, the party resisting discovery must show that the material sought is "not reasonably accessible because of undue burden or cost." [Note 8.] If that showing is made, the burden shifts to the requesting party to show good cause for the production of the not-reasonably-accessible electronically stored information. [Note 9.] In deciding whether the requisite showing has been made, the Board will consider, as it would in any discovery dispute, whether (i) "the discovery sought is unreasonably cumulative or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive;" (ii) "the party seeking discovery has had ample opportunity to obtain the information by discovery in the action;" or (iii) "the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues." [Note 10.]

With respect to the adequacy of ESI production, there is an increasing focus on the question of proportionality and whether extensive ESI discovery is necessary and justified. [Note 11.] In view of the Board's limited jurisdiction, the narrowness of the issues to be decided by the Board, and the concerns existing with respect to excessive e-discovery, the burden and expense of e-discovery will weigh heavily against requiring production in most cases. Parties are to be precise in their requests and to have as their first consideration how to significantly limit the expense of such production. [Note 12.]

NOTES:

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

2. *See, e.g., Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (Board did not abuse its discretion by refusing to strike plaintiff's evidence where defendant failed to follow up on plaintiff's offer to produce the evidence at a mutually agreeable time and place and in view of defendant's failure to file a motion to compel); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, objection to evidence introduced by applicant at trial was overruled),

aff'd, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (representative samples of documents, including ESI, required for certain requests); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) (production of representative sample was not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985) (representative sample of invoices from identified calendar quarters is sufficient where there are so many items as to make respondent's task unduly burdensome); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (permitted to identify reasonable number of corporate officers most knowledgeable); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (burden of calculating sales and advertising figures in round numbers for six categories of goods for each year since 1936 mitigated by limiting sales figures to five most recent years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (applicant allowed to produce ten representative samples of documents pertaining to the marketing of each copy machine or as alternative, may allow opposer's representative to visit sites where relevant documents are kept); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowed to furnish representative samples of advertisements).

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

4. *See, e.g.* , Fed. R. Civ. P. 26(c); *Red Wing Co. v. J.M. Smucker Co.* , 59 USPQ2d 1861, 1862 (TTAB 2001) (protective agreement would adequately protect against disclosure of trade secret manufacturing and technical information); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.* , 10 USPQ2d 1671, 1675 (TTAB 1988) (unless issue is abandonment or first use, party need not reveal names of its customers, including dealers, it being sufficient to identify classes of customers and types of businesses); *Fisons Ltd. v. Capability Brown Ltd.* , 209 USPQ 167, 170 (TTAB 1980) (need for names of customers, as in case where issue is abandonment, outweighs justification for protecting customer confidentiality); *Neville Chemical Co. v. Lubrizol Corp.* , 184 USPQ 689, 690 (TTAB 1975) (protective order must contain provision that customer names will be revealed only to applicant's attorneys). *See also Sunkist Growers, Inc. v. Benjamin Ansehl Co.* , 229 USPQ 147, 148 (TTAB 1985) (protective orders available for confidential material); *Varian Associates v. Fairfield-Noble Corp.* , 188 USPQ 581, 583 (TTAB 1975) ("While it is the Board's policy not to require the disclosure of customer and mailing lists, a party may be asked to reveal the particular classes of customers or the types of businesses in which they are engaged."); *J.B. Williams Co. v. Pepsodent G.m.b.H.* , 188 USPQ 577, 579 (TTAB 1975) (as a general rule, party need not furnish names of actual customers); *Ortho Pharmaceutical Corp. v. Schattner* , 184 USPQ 556, 557-58 (TTAB 1975) (discussing whether certain interrogatories seek proprietary or confidential matter); *Miller & Fink Corp. v. Servicemaster Hospital Corp.* , 184 USPQ 495, 495-96 (TTAB 1975) (opposer need only reveal the classes of people to whom such goods sold under the mark are distributed and not the actual customer names); *Cool-Ray, Inc. v. Eye Care, Inc.* , 183 USPQ 618, 621 (TTAB 1974) (names of applicant's customers are confidential information and the need to protect customers from harm such as harassment outweighs disclosure). For proceedings pending or commenced on or after August 31, 2007 the Board's standard protective order automatically applies to all cases, absent agreement to, and Board approval of, a substitute. 37 CFR § 2.116(g).

5. Fed. R. Civ. P. 26(b)(5). *See, e.g.*, *In re Seagate Technology LLC*, 497 F.3d 1360, 83 USPQ2d 1865, 1873 (Fed. Cir. 2007) (attorney-client privilege provides absolute protection from disclosure unless waived); *Genentech Inc. v. U.S. International Trade Commission*, 122 F.3d 1409, 43 USPQ2d 1722, 1728 (Fed. Cir. 1997) ("Generally disclosure of confidential communications or attorney work product to a third party, such as an adversary in litigation, constitutes a waiver of privilege as to those items."); *Red Wing Co. v. J. M. Smucker Co.*, 59 USPQ2d 1861, 1864 n.5 (TTAB 2001) (party making claim of privilege must do so expressly and otherwise describe the nature of the withheld information as provided in Fed. R. Civ. P. 26(b)(5)). See

also Fed. R. Evid. 502 and Explanatory Note on Evidence Rule 502 (revised November 28, 2007) regarding attorney-client privilege and limitations on waiver.

6. Fed. R. Civ. P. 26(b)(3) and 26(b)(5). *See, e.g.*, *In re Seagate Technology LLC*, 497 F.3d 1360, 83 USPQ2d 1865, 1874 (Fed. Cir. 2007) (work product protection is qualified and absent waiver may be overcome by a showing of need and undue hardship but a higher burden must be met to obtain that pertaining to mental processes); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (the fact that an attorney may have given an opinion to a client is not in and of itself privileged information; only the substance of the communication is considered privileged); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (opposer must provide discovery of matters, not privileged, relevant to the subject matter of the Board proceeding). *See also Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975) ("search reports, per se do not fall within the attorney-client privilege . . . [h]owever any comments or opinions provided by opposer's attorney in relation thereto are privileged"); *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974) (trademark search report not privileged; comments or opinions of attorney relating thereto fall within attorney-client privilege); *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372, 374-75 (TTAB 1974) (discussing attorney-client privilege and work product rule). See also Fed. R. Evid. 502 and Explanatory Note on Evidence Rule 502 (revised November 28, 2007) regarding work product and limitations on waiver.

7. Fed. R. Civ. P. 26(b)(2)(B).

8. Fed. R. Civ. P. 26(b)(2)(B). *See, e.g.*, *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (opposer established that all of the specific materials applicant sought in response to specified requests were not reasonably accessible because of undue burden or costs).

9. Fed. R. Civ. P. 26(b)(2)(B). *See, e.g.*, *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (applicant established that some of the requested documents should be produced before taking depositions).

10. Fed. R. Civ. P. 26(b)(2)(B) and (C).

11. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011).

12. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1909 (TTAB 2011) (opposer not required to start its document production over where parties did not agree on ESI discovery protocol, applicant failed to show opposer's methods were insufficient, and given the nature of the requests and issues involved).

403 Timing of Discovery

403.01 In General

37 CFR § 2.120(a)

(1) …*The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included with the notice of institution of the proceeding.*

(2) …*The discovery period will be set for a period of 180 days. … The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.*

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

When a timely opposition or petition to cancel in proper form has been filed, and the required fee has been submitted (or at the time described in 37 CFR § 2.92 for an interference and 37 CFR § 2.99(c) for a concurrent use proceeding), the Board sends out a notice advising the parties of the institution of the proceeding. [Note 1.] *See also* TBMP § 310, TBMP § 1003 and TBMP § 1106. The notice includes a trial order setting the opening and closing dates for the discovery period, assigning each party's time for taking testimony, and for those cases commenced on or after November 1, 2007, the deadlines for the discovery conference and disclosures. [Note 2.] For such cases, the opening of discovery coincides with the deadline for the discovery conference. The date set for the close of discovery is 180 days after the opening of discovery.

Parties may modify the discovery and trial schedule, including the deadline for making disclosures, if the parties file, and the Board approves, a stipulation or motion to that effect. [Note 3.] Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. [Note 4.] In addition to stipulating to extend the discovery period, parties may stipulate to a shortening of the discovery period. [Note 5.]

The traditional discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period. [Note 6.] A party has no obligation to respond to an untimely request for discovery, nor is a party obliged to respond to discovery when initial disclosures have not been served, although a party should object on that basis. [Note 7.]

For further information regarding the timing of initial, expert and pretrial disclosures for inter partes proceedings commenced on or after November 1, 2007, see TBMP § 401 and TBMP § 702.01.

NOTES:

1. 37 CFR § 2.105 and 37 CFR § 2.113.

2. 37 CFR § 2.120(a)(1) and 37 CFR § 2.121(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

3. 37 CFR § 2.120(a)(2). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).

4. 37 CFR § 2.120(a)(2). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008).

5. 37 CFR § 2.120(a)(2). *See H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 n.55 (TTAB 2008).

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

7. *See Dating DNA, LLC v. Imagini Holdings*, LLC, 94 USPQ2d 1889, 1893 (TTAB 2010) (service of initial disclosures is a prerequisite to taking discovery); *Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1704-06 (TTAB 2009) (opposer's mistaken belief that applicant failed to serve initial disclosures does not excuse opposer's failure to respond to or properly object to applicant's interrogatories and document requests on the basis of failure to serve initial disclosures).

403.02 Time for Service of Discovery Requests and Taking of Depositions

37 CFR § 2.120(a)(3) *… Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.*

A party may serve written interrogatories, requests for production and things, and requests for admissions on an adversary during the discovery period in an inter partes proceeding before the Board; however, for cases commenced on or after November 1, 2007, the serving party must have already made its initial disclosures, absent a stipulation or a granted motion or upon order of the Board to the contrary. [Note 1.] Written discovery may be served concurrently with initial disclosures. [Note 2.] Additionally, for cases commenced on or after November 1, 2007, a party cannot notice depositions until it has served its initial disclosures, unless such disclosures are waived. [Note 3.] Discovery depositions must be not only noticed but also taken during the discovery period (unless the parties stipulate or the Board orders that the deposition may be taken outside of the period). [Note 4.]

NOTES:

1. 37 CFR § 2.120(a)(3). ("A party must make its initial disclosures prior to seeking discovery ..."); *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889 (TTAB 2010) (motion to compel denied where moving party failed to make initial disclosures; service of initial disclosures is a prerequisite to taking discovery). For proceedings commenced prior to November 1, 2007, see *Luemme Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978); *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606, 607 (TTAB 1974); *AMP Inc. v. Raychem Corp.*, 179 USPQ 857, 858-59 (TTAB 1973); *Deere & Co. v. Deerfield Products Corp.*, 176 USPQ 422, 422 (TTAB 1973).

2. 37 CFR § 2.120(a)(3). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 n.2 (TTAB 2012) (initial disclosures may be served concurrently with discovery requests).

3. 37 CFR § 2.120(a)(3).

4. 37 CFR § 2.120(a)(3). *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008) (motion to quash granted where deposition noticed during discovery but scheduled after close of discovery); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (discovery may not be taken outside the discovery period); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (motion to quash granted where party noticed deposition for a date subsequent to the expiration of the discovery period).

403.03 Time for Service of Discovery Responses

37 CFR § 2.120(a)(3) *… Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests.*

Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days after the date of service of the request for discovery. [Note 1.] If service of the request for discovery is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the request. [Note 2.] *See* TBMP § 113.05. If the parties agree to electronic service (e.g., by email, facsimile) the five extra day grace period does not apply. [Note 3.]

Discovery in proceedings before the Board is not governed by any concept of priority of right to take discovery or depositions. That is, a party which is the first to serve a request for discovery does not thereby gain an absolute right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Rather, each party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery. [Note 4.] Thus, in the absence of objections or extensions, a party that is the first to serve discovery requests can be expected to receive responses first, and parties are always encouraged to initiate any necessary discovery early, but because the ability and/or willingness of an adverse party to respond to discovery can vary, there is no guarantee that the first party to serve discovery will be the first party to receive responses.

Because interrogatories, requests for production and requests for admissions may be served until the closing date of discovery, a responding party may not object to such discovery requests on the ground that responses would be due after the close of discovery. [Note 5.] However, a responding party may serve appropriate objections when timely responding to discovery requests served late in the discovery period, even though well-taken objections may result in the inquiring party not receiving responses. [Note 6.]

A party which fails to respond to interrogatories or document requests during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. [Note 7.] For requests for admissions, a party may either (1) move to reopen its time to respond to the admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B), or (2) move to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b). [Note 8.] For a further discussion regarding admission requests, see TBMP § 407. Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence. [Note 9.] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. [Note 10.]

NOTES:

1. 37 CFR § 2.120(a)(3); Fed. R. Civ. P. 33(b)(2), 34(b)(2)(A), and 36(a)(3). *See Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (opposer's mistaken belief that applicant failed to serve initial disclosures does not excuse opposer's failure to respond to or properly object to applicant's interrogatories

and document requests); *MySpace Inc. v. Donnell Mitchell*, 91 USPQ2d 1060, 1061 n.2 (TTAB 2009) (requirement to serve responses by particular date means having service copies in the mail by that date).

2. 37 CFR § 2.119(c). *See also Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (period for service of discovery responses was enlarged by five days pursuant to Trademark Rule 2.119(c) as the discovery requests were served by mail).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42250 (August 1, 2007).

4. Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) (discovery in Board proceeding not governed by any concept of priority of discovery); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) (no priority of discovery; "it is not the prerogative . . . for parties or their counsel to unilaterally impose conditions upon the sequence and timing of discovery which are not provided by the rules governing practice before the Board").

5. 37 CFR § 2.120(a)(3).

6. *See Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (applicant was not required to inform opposer earlier that it would not be responding to discovery requests based on objection that opposer failed to serve initial disclosures as "this was a function of opposer choosing to serve discovery requests late in the discovery period;" opposer received applicant's objection two days after discovery closed). *See also H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 n.13 (TTAB 2008) (under the Trademark Rule, responses to written discovery may be served after the close of discovery).

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

8. *See Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (discussing reopening time to respond to requests for admissions under Fed. R. Civ. P. 6(b)(1)(B) and withdrawal and amendment of admissions under Fed. R. Civ. P. 36(b)). *See also Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (amending admissions under Fed. R. Civ. P. 36(b)).

9. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

10. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (party will generally not be found to have waived the right to make these objections).

403.04 Extensions of Discovery Period, Time to Respond to Discovery Requests and Disclosures

37 CFR § 2.120(a)(2) *… The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.*

37 CFR § 2.120(a)(3) *... The time to respond [to interrogatories, requests for production of documents and things, and requests for admission] may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.*

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

* * * *

37 CFR § 2.121(d) *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board.*

The closing date of the discovery period may be extended by stipulation of the parties approved by the Board, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. An extension of the closing date for discovery will result in a corresponding resetting of the pretrial disclosure deadlines and testimony periods without action by any party. [Note 1.] Also, when the parties stipulate to an extension of the closing date for discovery, or a motion for such an extension is granted, or the Board orders such an extension, the Board ordinarily will, as a matter of course, reset the deadline for expert disclosure. However, if the time for serving expert disclosures has passed and it is clear from the record that such expert disclosures have been served or the parties have made it clear that they do not intend to use experts, the Board may not reset the time for expert disclosures. A stipulation or consented motion to extend discovery, pretrial disclosure and trial dates must be filed with the Board and should be presented in the form used in a trial order. [Note 2.] For information concerning stipulations to extend, see TBMP § 501.03. For information concerning motions to extend, see TBMP § 509.

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. [Note 3.] Thus, a party which waits until the waning days of the discovery period to serve interrogatories, requests for production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto near the end of, or after the close of the discovery period, that it needs an extension or reopening of the discovery period in order to take "follow-up" discovery. [Note 4.]

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, deprive its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party)

so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion. [Note 5.]

The time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. However, an extension of a party's time to respond to an outstanding request for discovery will not automatically result in a corresponding extension of the deadline for expert disclosures, close of discovery, or any subsequent deadlines (including pretrial disclosures and the close of the parties' testimony periods). [Note 6.] Such periods will be rescheduled only on stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.

A stipulation to extend or reopen only the time for responding to a request for discovery (that is, a request that does not also seek to extend or reopen the closing date for the discovery period and/or other subsequent deadlines) does not always have to be filed with the Board, but may be required in certain circumstances. If the stipulation to extend or reopen the time for responding to a discovery request interferes with the orderly completion of discovery or the opening of trial, the parties must first obtain Board approval. [Note 7.] Further, to avoid any misunderstanding between the parties as to the existence and terms of such a stipulation, it is recommended that the stipulation be reduced to writing, even if it is not one which need be filed with the Board.

A party's time to make initial or expert disclosures may be reset upon a motion granted by the Board, or by order of the Board. The resetting of a party's time to make initial disclosures (that is, a request that does not also seek to extend or reopen subsequent deadlines) will not result in an automatic rescheduling of the deadline for expert disclosure or of the close of discovery or any subsequent deadlines. Such dates will be rescheduled upon approval of an appropriate stipulation of the parties, or motion of a party, or by order of the Board. However, when the parties stipulate to an extension of the deadline for expert disclosure, or a motion seeking such an extension is granted, or the Board orders such an extension, the Board may extend the closing date of discovery because expert disclosure generally and discovery activities related thereto are expected to occur within the discovery period.

For a discussion regarding modification of disclosure obligations, see TBMP § 401.04.

NOTES:

1. 37 CFR § 2.121(a).

2. 37 CFR § 2.121(d).

3. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1854-55 (TTAB 2008) (opposers' motion to extend discovery period denied where opposers did not serve written discovery requests until final day of discovery, and did not attempt to depose applicant during prescribed discovery period, and evidence does not support opposers' claim that they delayed discovery because parties were engaged in settlement discussions); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed).

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

5. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) (Board will, upon motion, reopen or extend discovery solely for benefit of party who was unfairly deprived of

follow-up discovery by opponent who wrongfully refused to answer or delayed responses to discovery); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (granting motion to extend time to restore amount of time remaining in discovery to the day when applicant's interrogatories were served).

6. 37 CFR § 2.120(a) and 37 CFR § 2.121(a). *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).

7. Fed. R. Civ. P. 29(b). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1768 n.2 (TTAB 2008) (written stipulations to extend period to respond to discovery requests need only be filed with the Board when the extension may interfere with the orderly completion of discovery or the opening of trial).

403.05 Need for Early Initiation of Discovery

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

If a party wishes to have an opportunity to take "follow-up" discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and serve additional discovery requests prior to the expiration of the discovery period. *See* TBMP § 403.04.

403.05(b) To Facilitate Introduction of Produced Documents

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

37 CFR § 2.122(e) ***Printed publications and official records.*** *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered, and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the [United States]Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

Documents produced in response to a request for production of documents or through disclosures may not be made of record by notice of reliance alone, except to the extent that the documents are otherwise admissible by notice of reliance, for example, as printed publications or official records under 37 CFR § 2.122(e). However, there are a number of different methods by which documents produced in response to a request for production of documents that do not qualify for submission under 37 CFR § 2.122(e) may be made of record. *See* TBMP § 704.09 and TBMP § 704.11. The most straightforward way is for the parties to stipulate that any party may introduce by notice of reliance documents produced by any other party, subject only to

objections as to relevance and competence, materiality, or weight. [Note 1.] Three other methods are available for use only if the request for production of documents is served relatively early in the discovery period.

First, if the discovery period has not yet expired, a party that has obtained documents from another party through a request for production of documents or through disclosures may serve on its opponent a request for admission of the genuineness of the subject documents, which should be attached as exhibits to the request for admission. [Note 2.] Then, during its testimony period, the propounding party may file a notice of reliance, pursuant to 37 CFR § 2.120(j)(3)(i), on the request for admission, the exhibits thereto, and its adversary's response.

Second, if the discovery period has not yet expired, the party which obtained the documents may make them of record by taking a discovery deposition of its adversary, marking the documents as exhibits thereto, and having the witness identify the documents during the deposition. The propounding party may then submit the deposition and identified exhibits during its testimony period under a notice of reliance. [Note 3.]

Third, the request for production of documents may be combined with a notice of the taking of the adversary's discovery deposition; that is, the combined request and notice may ask that the deponent bring the requested documents to his or her deposition. However, a party served with a request for production of documents has thirty days from the date of service of the request in which to respond thereto, plus an extra five days if service of the request was made by first-class mail, Priority Mail Express®, or overnight courier. *See* TBMP § 403.03. Moreover, in proceedings before the Board, a discovery deposition must be both noticed and taken before the end of the discovery period. *See* TBMP § 403.02. Thus, a combined notice of deposition and request for production of documents normally must be served at least thirty-five days prior to the close of the discovery period.

For a full discussion of making evidence of record in a Board proceeding, see TBMP Chapter 700.

NOTES:

1. *See, e.g.*, *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 n.6 (TTAB 2007) (opposer filed notice of reliance on applicant's response to request for admission and exhibits thereto that all documents it produced in response to opposer's discovery requests were authentic for purposes of admission into evidence during the testimony period in this opposition proceeding); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103-04 (TTAB 2007) (because respondent availed itself of Fed. R. Civ. P. 33(d) to provide documents in response to petitioner's interrogatories and admitted via a request for admission that the documents it produced were true and correct copies of authentic documents, the documents could be introduced by way of notice of reliance).

2. Fed. R. Civ. P. 36(a).

3. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1427 n.6 (TTAB 2013).

404 Discovery Depositions

404.01 When Permitted and By Whom

Discovery depositions must be both noticed and taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). [Note 1.] *See* TBMP § 403.02. Discovery depositions generally may be taken by any party, of any adverse party or any relevant non-party.

As a matter of convenience and courtesy and to avoid scheduling conflicts, the parties should attempt to schedule depositions by agreement rather than have the deposing party unilaterally set a deposition date. [Note 2.] However, it is not unusual for the deposing party to notice a deposition and subsequently discuss alternative dates with the party to be deposed.

See TBMP § 408 regarding the parties' duty to cooperate in discovery.

NOTES:

1. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008). *See also Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (it is clear from the language of Fed. R. Civ. P. 30 and 33 that while interrogatories need only be "served" during the discovery period, depositions must be "taken" during the discovery period).

2. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (parties ordered to work out a mutually agreeable schedule for taking of discovery depositions).

404.02 Who May be Deposed

Fed. R. Civ. P. 30(a). Depositions by Oral Examination. When a Deposition May Be Taken.

(1) ***Without Leave.*** *A party may, by oral questions, depose any person, including a party, without leave of court except as provided in Rule 30(a)(2). The deponent's attendance may be compelled by subpoena under Rule 45.*

(2) ***With Leave.*** *A party must obtain leave of court, and the court must grant leave to the extent consistent with Rule 26(b)(1) and (2):*

(A) *if the parties have not stipulated to the deposition and:*

(i) *the deposition would result in more than 10 depositions being taken under this rule or Rule 31 by the plaintiffs, or by the defendants, or by the third-party defendants;*

(ii) *the deponent has already been deposed in the case; or*

(iii) *the party seeks to take the deposition before the time specified in Rule 26(d), unless the party certifies in the notice, with supporting facts, that the deponent is expected to leave the United States and be unavailable for examination in this country after that time; or*

(B) *if the deponent is confined in prison.*

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

(1) If the person to be examined is confined in prison; or

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

Deposition of a non-party witness residing in the United States may be taken by subpoena under Fed. R. Civ. P. 45 or, or on notice alone, if the non-party witness agrees to appear voluntarily. *See* TBMP § 404.03(a)(2).

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

NOTES:

1. *See* Fed. R. Civ. P. 30(a).

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

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

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

The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. ...

The discovery deposition of a person shall be taken in the federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. [Note 1.] The deposition may be taken either orally, or on written questions in the manner described in 37 CFR § 2.124. [Note 2.]

For information on the taking of a discovery deposition on written questions, see TBMP § 404.07.

NOTES:

1. 37 CFR § 2.120(b). *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (general rule in federal district court that a plaintiff is required to make itself available for examination in district where suit is brought does not apply in Board proceedings).

2. *See* Fed. R. Civ. P. 30 and 31.

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

If a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, the deposition may be taken on notice alone. [Note 1.] When such a proposed deponent fails to appear for a noticed deposition, the deposing party may seek to compel attendance by a motion to compel. *See* TBMP § 523.

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

For information concerning testimonial depositions of adverse party witnesses residing in the United States, seeTBMP § 703.01(f)(2).

NOTES:

1. 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976).

404.03(a)(2) Person Residing in the United States – Non-party

35 U.S.C. § 24 Subpoenas, witnesses.

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

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

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

The responsibility rests wholly with the deposing party to secure the attendance of a proposed deponent residing within the United States unless the proposed deponent is a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party. [Note 1.] If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45. [Note 2.]

The subpoena must be issued from the United States district court in the federal judicial district where the deponent resides or is regularly employed. [Note 3.]

If a person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States District Court that issued the subpoena; the Board has no jurisdiction to enforce the subpoena. [Note 4.]

For information regarding the taking of a non-party testimonial deposition of a non-party witness residing in the United States, see TBMP § 703.01(f)(2).

NOTES:

1. 37 CFR § 2.120(b).

2. Fed. R. Civ. P. 30(a)(1) and Fed. R. Civ. P. 45; *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2048-49 (TTAB 1988) (deposition of former employee can only be taken by voluntary appearance or by subpoena). *Cf.* regarding testimony depositions, *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (testimony deposition on written questions of adverse party); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (testimony deposition of adverse witness).

Please Note: To the extent that Fed. R. Civ. P. 45(a)(2) and 45(f), as amended in 2013, conflict with the provisions of 35 U.S.C. § 24, the statute is controlling. *See* 37 CFR § 2.116(a) ("Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.").

3. *See generally* cases cited in preceding Note 2.

4. *See, e.g., Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (notice of deposition of unwilling non-party witness must include subpoena, and related motions must be filed with district court that issued subpoena, not Board); *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942 n.4 (TTAB 2013) (Board cannot modify or quash a subpoena issued by a district court); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (motion to quash subpoenaed third-party depositions due to scheduling problems denied). *See also In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201 (D. Del. 1973) (asserting jurisdiction to enforce subpoenas for TTAB proceeding); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318, 319 n.3 (TTAB 1971).

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

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

(1) *The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.*

The discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party may be taken on notice alone. [Note 1.]

However, if the discovery deposition of such a person is taken in a foreign country, it must be taken on written questions, in the manner described in 37 CFR § 2.124, unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. [Note 2.] Similarly, a testimony deposition taken in a foreign country must be taken by deposition on written questions, as described in 37 CFR § 2.123(a)(2) unless the Board, on motion for good cause orders the deposition taken by oral

examination, or the parties so stipulate. *See* TBMP § 703.01(b). It should be noted, however that some countries 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. A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

For information concerning the procedure for taking discovery depositions on written questions, see TBMP § 404.07.

For information on a motion to take a foreign deposition orally, see TBMP § 520. For information on taking the testimony deposition of a willing or unwilling adverse party or non-party witness in a foreign country through the letter rogatory procedure or by procedures provided under the Hague convention or other applicable treaties, see TBMP § 703.01(g).

The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. [Note 3.]

Parties seeking to take the discovery deposition of a natural person residing in a foreign country should be aware that the laws of some foreign countries may serve to preclude the taking of such depositions. [Note 4.] In determining when it is appropriate to impose sanctions for non-compliance with discovery due to a conflict with foreign laws, the following factors are considered: (1) the good faith of the non-complying party; (2) whether the non-complying party would incur foreign criminal liability; and (3) whether alternative sources of information are available. [Note 5.]

NOTES:

1. *See* 37 CFR § 2.120(c) and 37 CFR § 2.124.

2. 37 CFR § 2.120(c)(1). *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). *See also Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1925 (TTAB 1989) (by motion); *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (by stipulation).

3. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978) (deposition may only be taken by written questions unless otherwise stipulated, or unless the party is present in the U.S.). *See also Miller v. N. V. Cacao-En Chocoladefabrieken Boon*, 142 USPQ 364, 365-66 (E.D.N.Y. 1964); *Cf. Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises, Ltd*, 511 F.3d 437, 85 USPQ2d 1385, 1391 (4th Cir. 2007) (foreign corporation party required to obey a subpoena issued by the district court, pursuant to Rule 30(b)(6) notice, to appear in the United States to give trial testimony).

4. *Cf. Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197, 200-01 (1958) (Swiss government ordered Swiss plaintiff in U.S. court proceeding not to produce certain documents).

5. *Cf. Cochran Consulting Inc. v. Uwatec USA Inc.*, 102 F.3d 1224, 41 USPQ2d 1161, 1163-67 (Fed. Cir. 1996) (citing *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197 (1958)).

404.03(c) Person Residing in a Foreign Country – Non-party

404.03(c)(1) Willing Non-party

The discovery deposition of a natural person who resides in a foreign country, and is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party, i.e., in the manner described in TBMP § 404.03(b). [Note 1.] It should be noted, however that some countries 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. A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

NOTES:

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

404.03(c)(2) Unwilling Non-party – The Hague Convention and Letter Rogatory Procedure

28 U.S.C. § 1781 Transmittal of letter rogatory or request.

(a) *The Department of State has power, directly, or through suitable channels—*

(1) *to receive a letter rogatory issued, or request made, by a foreign or international tribunal, to transmit it to the tribunal, officer, or agency in the United States to whom it is addressed, and to receive and return it after execution; and*

(2) *to receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution.*

(b) *This section does not preclude—*

(1) *the transmittal of a letter rogatory or request directly from a foreign or international tribunal to the tribunal, officer, or agency in the United States to whom it is addressed and its return in the same manner; or*

(2) *the transmittal of a letter rogatory or request directly from a tribunal in the United States to the foreign or international tribunal, officer, or agency to whom it is addressed and its return in the same manner.*

There is no certain procedure for obtaining, in an inter partes proceeding before the Board, the discovery deposition of a natural person who resides in a foreign country, is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, and does not agree to appear voluntarily to be deposed. However, a party may be able to obtain the discovery deposition of such a person through the letter rogatory procedure, whereby an unwilling non-party witness in a foreign country sometimes may be compelled to respond to questions routed through diplomatic channels to an appropriate judicial authority in the foreign country. [Note 1.]

The term "letter rogatory"or "letter of request" is defined in Black's Law Dictionary (9th edition 2009) as follows:

letter of request. 1. A document issued by one court to a foreign court, requesting that the foreign court (1) take evidence from a specific person within the foreign jurisdiction or serve process on an individual or corporation within the foreign jurisdiction and (2) return the testimony or proof of service for use in a pending case. See Fed. R. Civ. P. 28. — Also termed letter rogatory; rogatory letter; requisitory letter.

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

A party that wishes to have the Board issue a letter rogatory should file a written request therefor with the Board. [Note 2.] The party must also submit an original and two copies of the proposed letter rogatory, and an original and two copies of the questions to be propounded to the non-party witness. If the official language of the foreign country is not English, the propounding party must submit an original and two copies of the letter rogatory and questions in English, and an original and two copies thereof translated into the official language of the country in which the witness will be deposed. In addition, the propounding party must serve on each adverse party a copy of every paper submitted to the Board. [Note 3.]

If the request by the Board is granted (i.e. it is willing to issue the letter once all questions are exchanged and translations are provided) each adverse party will be given an opportunity to submit cross questions, a copy of which must also be served on the propounding party. If an adverse party does submit cross questions, the propounding party, in turn, will be given an opportunity to submit redirect questions, a copy of which must be served on each adverse party. [Note 4.] As in the case of the initial questions, an original and two copies of any cross questions and redirect questions must be submitted to the Board; if the official language of the foreign country is not English, an original and two copies of the questions in English, and an original and two copies thereof translated into the official language, must be submitted.

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

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

Further information concerning the letter rogatory process may be obtained from the U.S. Department of State, Office of American Citizen Services, SA-17, 10th Floor, 2201 C Street NW, Washington, D.C. 20522-1710 or at the U.S. Department of State's website at **http//travel.state.gov/law/judicial/judicial683.html**.

Once the appropriate foreign judicial authority has received the letter rogatory, it may or may not be executed. As indicated above, the letter rogatory "rests entirely upon the comity of courts towards each other." Some countries refuse or are reluctant to lend assistance in the taking of a discovery deposition in their country through the letter rogatory procedure, and compliance with the procedural requirements for a letter rogatory does not ensure that the requested deposition will be completed. [Note 5.] Before a request for issuance of a letter rogatory is filed with the Board, the requesting party should examine the law and policy of the involved foreign country, and consult with the Office of American Citizen Services, Department of State, in order to determine whether the country in question is likely to honor a letter rogatory, particularly a letter rogatory issued by the Board. The likelihood that the Board will agree to issue the letter rogatory may be influenced by any information the requesting party is able to provide about the likelihood that the foreign country will execute the letter.

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

If a letter rogatory is honored, its probative value may be limited. In executing the letter rogatory, the foreign judicial tribunal will follow its customary procedures for taking discovery or testimony. The fact that these procedures may differ from those normally followed in proceedings before the Board does not mean that the deposition must necessarily be excluded. Rather, any such differences are matters to be considered by the Board in determining the probative value of the deposition. [Note 6.]

A party considering the filing of a request for issuance of a letter rogatory should bear in mind not only the complexity and uncertain outcome of the procedure, but also its time-consuming nature. The entire process, from the filing of the initial request for issuance of a letter rogatory, to receipt by the Board either of the completed deposition, or of notification that the letter rogatory will not be honored; will consume months, if not years. During the interim, proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory. [Note 7.]

The Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (commonly known as the "Hague Convention"), opened for signature March 18, 1970, 23 U.S.T. 2555, T.I.A.S. No. 7444, prescribes procedures under which a judicial authority in one member country may request evidence located in another. The Convention offers another possible method by which a party to an inter partes proceeding before the Board may attempt to obtain the discovery deposition of an unwilling non-party witness residing in a foreign country, if the foreign country is a member of the Convention. [Note 8.]

The Hague Convention provides for the compulsion of evidence (including the deposition of an unwilling witness) in a member country pursuant to a "letter of request," which is very similar in nature to a letter rogatory. [Note 9.] However, the Board has been advised by the Department of State that foreign countries are more likely to lend assistance in the taking of a discovery deposition if the request therefor is made under the more formal letter rogatory procedure. Before filing a motion for issuance of a letter of request under

the Hague Convention, the moving party should consult with the Office of American Citizen Services, Department of State, in order to determine whether the foreign country in question is likely to honor a letter of request, particularly a letter of request issued by the Board.

NOTES:

1. *Cf. DBMS Consultants Ltd. v. Computer Associates International, Inc.*, 18 Fed. R. Serv. 3d 33, 131 F.R.D. 367 (D. Mass. 1990) (court granted application for issuance of a letter rogatory finding that it would be unjust and inappropriate to require oral examination and that opposing party has shown no good reason to deny the application).

2. *See* Fed. R. Civ. P. 28(b).

3. 37 CFR § 2.119(a). *Cf* . 37 CFR § 2.124(b)(2).

4. *Cf* . 37 CFR § 2.124(d)(1).

5. *See* Fed. R. Civ. P. 28(b) Advisory Committee's notes (1963 amendment) and 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2083 (2015)**.**

6. *See* Fed. R. Civ. P. 28(b) Advisory Committee's notes (1963 amendment); and 8A C.WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2083 (2015).

7. *Cf* . 37 CFR § 2.124(d)(2).

8. *See, e.g.*, *Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522, 533-40 (1987) (although Hague Convention not exclusive discovery procedure, it may apply even if Federal Rules of Civil Procedure are available); *In re Anschuetz & Co.*, 838 F.2d 1362, 1364 (5th Cir. 1988) (U.S. district courts have discretion to resolve discovery conflicts between Federal Rules of Civil Procedure and Hague Convention); 8 C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2005.1 (2015). For general information concerning the Hague Convention, see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) (applicant failed to establish necessity of using Hague procedures). [NOTE: This case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

9. For information concerning the letter of request procedure under the Hague Convention, *see* Chapter 1 of the Convention. *See also Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991).

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

37 CFR § 2.120(e)(2) *Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking*

discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

Whenever a natural person who is a foreign party, or an officer, director, or managing agent, of a foreign party, or some other person who consents to testify on a foreign party's behalf, is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination on notice pursuant to 37 CFR § 2.120(c)(2). Indeed, this option was available even before the adoption of 37 CFR § 2.120(c)(2). [Note 1.]

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

NOTES:

1. *See Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373-74 (TTAB 1978). *Cf.* J *onergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (parties may agree to take oral deposition of foreign domiciliary in U.S.).

2. 37 CFR § 2.120(c)(2).

404.03(e) Foreign Person Present Within the United States – Non-party

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

404.04 Persons Before Whom Depositions May be Taken

Fed. R. Civ. P. 28(a)(1). Persons Before Whom Depositions May Be Taken Within the United States. In General. *Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, a deposition must be taken before:*

(A) *an officer authorized to administer oaths either by federal law or by the law in the place of examination; or*

(B) *a person appointed by the court where the action is pending to administer oaths and take testimony.*

Fed. R. Civ. P. 28(a)(2) Definition of "Officer." *The term "officer" in Rules 30, 31 and 32 includes a person appointed by the court ... or designated by the parties under Rule 29(a).*

Fed. R. Civ. P. 28(b)(1) In a Foreign Country. In General. *A deposition may be taken in a foreign country:*

(A) *under an applicable treaty or convention;*

(B) *under a letter of request, whether or not captioned a "letter rogatory";*

(C) *on notice, before a person authorized to administer oaths either by federal law or by the law in the place of examination; or*

(D) *before a person commissioned by the court to administer any necessary oath and take testimony.*

Fed. R. Civ. P. 28(b)(2) Issuing a Letter of Request or a Commission. *A letter of request, a commission, or both may be issued:*

(A) *on appropriate terms after an application and notice of it; and*

(B) *without a showing that taking the deposition in another manner is impracticable or inconvenient.*

Fed. R. Civ. P. 28(b)(3) Form of a Request, Notice, or Commission. *When a letter of request or any other device is used according to a treaty or convention, it must be captioned in the form prescribed by that treaty or convention. A letter of request may be addressed "To the Appropriate Authority in [name of country]."A deposition notice or a commission must designate by name or descriptive title the person before whom the deposition is to be taken.*

Fed. R. Civ. P. 28(b)(4) Letter of Request –Admitting Evidence. *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.*

Fed. R. Civ. P. 28(c) Disqualification. *A deposition must not be taken before a person who is any party's relative, employee, or attorney; who is related to or employed by any party's attorney; or who is financially interested in the action.*

Discovery depositions in Board inter partes proceedings may be taken before the persons designated by Fed. R. Civ. P. 28.

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a discovery deposition in a Board proceeding "must be taken before an officer authorized to administer oaths either by federal law or by the law in the place of examination; or a person appointed by the court where the action is pending to administer oaths and take testimony." [Note 1.] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter that is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a discovery deposition in a Board proceeding may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that discovery deposition in a Board proceeding, 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. [Note 2.] A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

NOTES:

1. Fed. R. Civ. P. 28(a).

2. *See* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2083 (2015).

404.05 Notice of Deposition

Fed. R. Civ. P. 30(b) Notice of Deposition; Other Formal Requirements.

(1) ***Notice in General.*** *A party who wants to depose a person by oral questions must give reasonable written notice to every other party. The notice must state the time and place of the deposition and, if known, the deponent's name and address. If the name is unknown, the notice must provide a general description sufficient to identify the person or the particular class or group to which the person belongs.*

(2) ***Producing Documents.*** *The notice to a party deponent may be accompanied by a request under Rule 34 to produce documents and tangible things at the deposition.*

(6) ***Notice or Subpoena Directed to an Organization.*** *In its notice or subpoena, a party may name as the deponent a public or private corporation, a partnership, an association, a governmental agency, or other entity and must describe with reasonable particularity the matters for examination. The named organization must then designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on its behalf; and it may set out the matters on which each person designated will testify. A subpoena must advise a nonparty organization of its duty to make this designation. The persons designated must testify about information known or reasonably available to the organization. This paragraph (6) does not preclude a deposition by any other procedure allowed by these rules.*

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

37 CFR § 2.124(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party may be taken on notice alone.

Prior to the taking of a discovery deposition on notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party. [Note 1.] Whether notice is reasonable depends upon the individual circumstances of each case. [Note 2.] The elements to be included in the notice are specified in Fed. R. Civ. P. 30(b)(1), for a deposition on oral examination, and in 37 CFR § 2.124(b)(2) and 37 CFR § 2.124(c), for a deposition on written questions. [Note 3.] It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually

convenient time for the deposition. The closing of a party's discovery period does not constitute a compelling need for failing to provide reasonable notice of deposition. [Note 4.]

A party may request from a party deponent the production of documents at a deposition under Fed. R. Civ. P. 34. [Note 5.] Proceeding under this rule facilitates discovery when the documents are few and simple and closely related to the oral examination. [Note 6.] In requesting documents, the deposing party must allow at least 30 days between the date of the request and the deposition (or 35 days if served by first-class mail Priority Mail Express®, or overnight courier) to comply with Fed. R. Civ. P. 34. [Note 7.] For information concerning the procedure for combining a notice of taking a discovery deposition with a request for production of documents, see TBMP § 406.01. A deposition must be taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). [Note 8.]

In noticing the deposition of a corporation, partnership, association, governmental agency, or other juristic person, the deposing party may, in lieu of naming a person to be deposed, simply name as the deponent the corporation, partnership, association, governmental agency, or other juristic person, and describe with reasonable particularity the matters on which examination is requested. The named organization must, in turn, designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may state, for each person designated, the matters on which he or she will testify. Each designated person must testify not only as to those matters within his or her knowledge, but also as to matters known or reasonably available to the organization. [Note 9.]

For information regarding notice of testimonial deposition, see TBMP § 703.01(e).

For information regarding the time for service of discovery requests, see TBMP § 403.02.

For information regarding a motion to quash a notice of deposition or for protective order, see TBMP § 521 and TBMP § 410.

NOTES:

1. Fed. R. Civ. P. 30(b)(1); 37 CFR § 2.124(b)(2); 37 CFR § 2.124(c). *See* Fed. R. Civ. P. 31(a)(3) and 37 CFR § 2.120(c). *Cf.* 37 CFR § 2.123(c).

2. *Gaudreau v. American Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007).

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

4. *Cf. Gaudreau v. American Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007).

5. Fed. R. Civ. P. 30(b)(2).

6. Fed. R. Civ. P. 30(b), Advisory Committee's notes (1970 amendment).

7. Fed. R. Civ. P. 34(b)(2)(A).

8. *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (granting motion to quash opposer's notice of Fed. R. Civ. P. 30(b)(6) deposition noticed on the last day of discovery but setting date of deposition to take place after close of discovery).

9. Fed. R. Civ. P. 30(b)(6); Fed. R. Civ. P. 31(a)(4).

404.06 Taking a Discovery Deposition

Fed. R. Civ. P. 30(b)(4) By Remote Means. *The parties may stipulate — or the court may on motion order — that a deposition be taken by telephone or other remote means. For the purpose of this rule and Rules 28(a), 37(a)(2), and 37(b)(1), the deposition takes place where the deponent answers the questions.*

The manner of taking a discovery deposition in an inter partes proceeding before the Board is very similar to taking a testimony deposition. [Note 1.]

For information concerning the procedure for taking a testimony deposition (including the examination of witnesses, the form of a deposition, and the protection of confidential information or trade secret material forming part of a deposition transcript or exhibits thereto), see TBMP § 703.01 and TBMP § 703.02. For a discussion of significant differences between discovery depositions and testimony depositions, see TBMP § 404.09. For information concerning the procedure for taking a discovery deposition on written questions, see TBMP § 404.07.

On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone or other remote means, such as video conferencing. [Note 2.] A deposition taken by telephone or other remote means is regarded as taken in the federal judicial district and at the place where the witness is to answer the questions propounded to him or her. A discovery deposition taken by remote means (such as by video conference) must be transcribed if submitted as evidence at trial. *See* TBMP § 703.01(i).

NOTES:

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

2. *See* Fed. R. Civ. P. 30(b)(4); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (to resolve conflict in scheduling a deposition where travel is involved, parties may stipulate or the Board may order upon motion that deposition be taken by telephone or other remote means); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991) (leave to take telephonic depositions should be liberally granted in appropriate cases as current federal practice favors use of technological benefits).

404.06(a) Fed. R. Civ. P. 30(b)(1) Depositions by Oral Examination of a Natural Person

Fed. R. Civ. P. 30(b)(1) Notice in General. *A party who wants to depose a person by oral questions must give reasonable written notice to every other party. The notice must state the time and place of the deposition and, if known, the deponent's name and address. If the name is unknown, the notice must provide a general description sufficient to identify the person or the particular class or group to which the person belongs.*

Fed. R. Civ. P. 30(b)(1) provides for the taking of a discovery deposition of a natural person. An individual witness deposition under Fed. R. Civ. P. 30(b)(1) seeks information regarding an individual's personal knowledge of facts. If the party is a corporation, organization, partnership association or other juristic person, Fed. R. Civ. P. 30(b)(1) allows an adverse party to notice the deposition of a particular officer, director, or managing agent of a party organization. [Note 1.] Taking a deposition of a party's officer, director or managing agent in his or her individual capacity under Fed. R. Civ. P. 30(b)(1) is different from taking a deposition of a party's officer, director or managing agent in his or her organizational capacity under Fed.

R. Civ. P. 30(b)(1) or as an organization's representative under Fed. R. Civ. P. 30(b)(6). The deposition of a party's officer, director or managing agent in his or her individual capacity probes that individual deponent's personal knowledge of the facts and not that of the party organization. [Note 2.] On the other hand, a Fed. R. Civ. P. 30(b)(1) deposition of a named officer, director, or managing agent of the party organization in his or her organizational capacity, just like a Fed. R. Civ. P. 30(b)(6) deposition taken of a representative of an organization, is testimony of the organization. Assuming that the organization is a party, the testimony elicited from a Fed. R. Civ. P. 30(b)(1) deposition of a named officer, director, or managing agent of the organization in his or her organizational capacity may be used at trial by the adverse party for any purpose. [Note 3.] *See* TBMP § 412.06(a) regarding the taking of a deposition of a high-level official or executive of a corporation. *See* TBMP § 404.06(b) regarding the taking of a deposition of a corporation, organization, partnership, association or other juristic person under Fed. R. Civ. P. 30(b)(6).

An employee or agent of an organization who does not qualify as an officer, director, or managing agent is not subject to deposition by notice under Fed. R. Civ. P. 30(b)(1). [Note 4.] If a person does not qualify as an officer, director, or managing agent, he or she must be treated as a non-party witness. [Note 5.]

It is possible for a witness to be deposed in his or her individual capacity under a Fed. R. Civ. P. 30(b)(1) notice of deposition and in his or her representative capacity as a Fed. R. Civ. P. 30(b)(6) designee under a Fed. R. Civ. P. 30(b)(6) notice of deposition. [Note 6.]

For more information regarding depositions of natural persons, both parties and non-parties, see TBMP § 404.03.

NOTES:

1. *United States v. One Parcel of Real Estate at 5860 North Bay Road, Miami Beach, Fla.*, 121 F.R.D. 439, 440 (S.D. Fla. 1988).

2. *See* 8A C.WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2103 (2015) (discussing differences between a Fed. R. Civ. P. 30(b)(6) deposition and a "normal deposition")**.**

3. *United States v. One Parcel of Real Estate at 5860 North Bay Road, Miami Beach, Fla.*, 121 F.R.D. 439, 440 (S.D. Fla. 1988).

4. *JSC Foreign Economic Association Technostroyexport v. International Development and Trade Services., Inc.*, 220 F.R.D. 235, 238 (S.D.N.Y 2004).

5. *JSC Foreign Economic Association Technostroyexport v. International Development and Trade Services, Inc.*, 220 F.R.D. 235, 238 (S.D.N.Y 2004). *See, e.g.*, *HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1906 (TTAB 2008) (expert witness in employ of opposer for Board opposition proceeding was not an officer, director or managing agent of opposer and was "technically a non-party witness" subject to deposition by subpoena).

6. *See* Fed. R. Civ. P. 30(b)(6) ("This paragraph (6) does not preclude a deposition by any other procedure authorized under these rules."); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1673 (TTAB 2005) (noting that Board granted motion to continue deposition of an officer in his capacity as Fed. R. Civ. P. 30(b)(6) witness and in his individual capacity).

404.06(b) Fed. R. Civ. P. 30(b)(6) Deposition of a Corporation, Organization, Partnership, Association or Other Juristic Person

Fed. R. Civ. P. 30(b)(6) Notice or Subpoena Directed to an Organization. *In its notice or subpoena, a party may name as the deponent a public or private corporation, a partnership, an association, a governmental agency, or other entity and must describe with reasonable particularity the matters for examination. The named organization must then designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on its behalf; and it may set out the matters on which each person designated will testify. A subpoena must advise a nonparty organization of its duty to make this designation. The persons designated must testify about information known or reasonably available to the organization. This paragraph (6) does not preclude a deposition by any other procedure allowed by these rules.*

The preferred method for deposing a corporation, organization, partnership, association or other juristic person is through a deposition under Fed. R. Civ. P. 30(b)(6). [Note 1.] A Fed. R. Civ. P. 30(b)(6) deposition provides a party an efficient way to find out details about the organization as well as learn information that might warrant further exploration through individual depositions of natural persons.

The deponent at a Fed. R. Civ. P. 30(b)(6) deposition is the organization, and the organization speaks through the representative appearing at the deposition. [Note 2.] A Fed. R. Civ. P. 30(b)(6) witness is responsible for providing all the relevant information known or reasonably available to the organization and his or her answers bind the organization. [Note 3.] A party may notice a Fed. R. Civ. P. 30(b)(6) deposition of an organization without naming a specific person to be deposed, instead describing the information sought. The organization then must designate one or more individuals to testify on the organization's behalf. [Note 4.] A party seeking to depose the adverse party organization through a particular officer, director, or managing agent may notice the deposition of that officer, director, or managing agent, in their organizational capacity, under Fed. R. Civ. P. 30(b)(1). [Note 5.] See TBMP § 404.03 and TBMP § 404.06(a) regarding depositions of natural persons, both parties and non-parties.

When an organization is named by a party seeking discovery as a deponent, the subject matter of the deposition is to be described with reasonable particularity in the notice. [Note 6.] An organization served with a Fed. R. Civ. P. 30(b)(6) notice of deposition has an obligation not only to pick and produce persons that have knowledge of the subject matter identified in the notice [Note 7] but also to prepare those persons so that they can give complete, knowledgeable, and binding answers as to matters known or reasonably available to the organization. [Note 8.] The organization may either produce as many deponents as are necessary to respond to the areas of inquiry in the notice if there is no witness with personal knowledge of all areas of inquiry [Note 9], or alternatively, may produce a witness who reviews the organization's records to become familiar with the topics for the deposition so that he or she may give knowledgeable and binding answers for the organization. [Note 10.] If more than one Fed. R. Civ. P. 30(b)(6) witness will be designated, those individuals should be identified and the areas on which each person will testify be described. [Note 11.] Even if no current employees have knowledge of matters identified in the notice, an organization is not relieved of preparing a Fed. R. Civ. P. 30(b)(6) designee for deposition to the extent that such matters are reasonably available to the organization from past documents, past employees or other sources. [Note 12.]

If it becomes obvious during the course of a Fed. R. Civ. P.30(b)(6) deposition that the organization's designee is deficient regarding his or her knowledge of matters reasonably known to the organization, the organization is obliged to provide a substitute and to prepare a designee to provide testimony in areas as to which its other representatives were uninformed. [Note 13.]

A party may be subject to a motion to compel for failure to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or if such designated person fails to appear for deposition or fails to answer any question propounded in a discovery deposition. [Note 14]. A party may be subject to sanctions for failure of a designated person to attend the Fed. R. Civ. P. 30(b)(6) discovery deposition if after being served with proper notice, the party informs the party seeking the deposition that no response will be made. [Note 15.] The production of an unprepared witness is tantamount to a failure to appear. [Note 16.]

For more information regarding motions to compel and motions for sanctions, see TBMP § 523 and TBMP § 527.

Even though more than one person may be designated to testify under Fed. R. Civ. P. 30(b)(6) on various topics identified in the deposition notice, for purposes of the ten deposition limit under Fed. R. Civ. P. 30(a)(2)(A)(i), the Fed. R. Civ. P. 30(b)(6) deposition is treated as a single deposition. [Note 17.] For purposes of the time limitation under Fed. R. Civ. P. 30(d)(1) limiting a deposition to "1 day of 7 hours," the deposition of each designated person under a Fed. R. Civ. P. 30(b)(6) notice of deposition is considered a separate deposition. [Note 18.]

Prior deposition testimony from an individual witness on a particular topic does not relieve a party organization of its responsibility to designate a witness in response to a Fed. R. Civ. P. 30(b)(6) notice of deposition on that topic as individual witness testimony under Fed. R. Civ. P. 30(b)(1) is not binding on the organization. [Note 19.]

NOTES:

1. *Folwell v. Hernandez*, 210 F.R.D. 169, 173 (M.D.N.C. 2002). *See also City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 n.4 (TTAB 2013) ("one purpose of this rule is that it 'will curb the 'bandying' by which officers or managing agents of a corporation are deposed in turn but each disclaims knowledge of facts that are clearly known to persons in the organization and thereby to it."') (citing Fed. R. Civ. P. 30(b)(6) Advisory Committee Notes).

2. Fed. R. Civ. P. 30(b)(6); *see Pioneer Drive, LLC v. Nissan Diesel America, Inc.*, 262 F.R.D. 552, 558 (D. Mont., 2009) (Fed. R. Civ. P. 30(b)(6) designee speaks for the organization as a whole and must make efforts to be able to do so). 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2103 (2015).

3. Fed. R. Civ. P. 30(b)(6); 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2103 (2015).

4. *Folwell v. Hernandez*, 210 F.R.D. 169, 172 (M.D.N.C. 2002). ("One of the important consequences of Rule 30(b)(6) is that under it, only the [organization] selects the persons who will testify.")

5. *See JSC Foreign Economic Association Technostroyexport v. International Development and Trade Services, Inc.*, 220 F.R.D. 235, 238 (S.D.N.Y. 2004). (A corporate officer, director, or managing agent may be subject to deposition by notice under Fed. R. Civ. P. 30(b)(1); however a corporate employee or agent who does not qualify as an officer, director, or managing agent of the corporation is not subject to deposition by notice under Fed. R. Civ. P. 30(b)(1)); *see, e.g., HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1906 (TTAB 2008) (expert witness in employ of opposer for Board opposition proceeding was not an officer, director or managing agent of opposer and was "technically a non-party witness" subject to deposition by subpoena).

6. Fed. R. Civ. P. 30(b)(6).

7. *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 n.4 (TTAB 2013) ("Rule 30(b)(6) anticipates that a party's designated witness will not necessarily have personal knowledge of all matters but will nonetheless offer testimony regarding information that the 'party' should be able to provide."); *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 n.5 (TTAB 1988). *See also Mattel Inc. v. Walking Mountain Productions*, 353 F3d 792, 69 USPQ2d 1257, 1260 n.4 (9th Cir. 2003) ("Rule 30(b)(6) depositions ... are often referred to as 'persons most knowledgeable' or 'persons most qualified' depositions because 'the notice of deposition or subpoena is directed at the entity itself' and '[t]he entity will then be obligated to produce the 'most qualified' person [or persons] to testify on its behalf.").

8. *A&E Products Group L.P. v. Mainetti USA Inc.*, 70 USPQ2d 1080, 1086 (S.D.N.Y. 2004) (and cases cited therein).

9. *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).

10. *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).

11. Fed. R. Civ. P. 30(b)(6).

12. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998).

13. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998). *See Tulip Computers International B.V. v. Dell Computer Corp.*, 63 USPQ2d 1527, 1533 (D. Del. 2002) (purported failure to produce an adequately prepared Fed. R. Civ. P. 30(b)(6) witness may require a second deposition of that or another Fed. R. Civ. P. 30(b)(6) witness and payment of costs for second deposition).

14. 37 CFR § 2.120(e). *See United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1063 (E.D. Mich. 1998) (motion to compel due to unprepared 30(b)(6) witness); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297-98 (TTAB 1997) (motion to compel appearance at Fed. R. Civ. P. 30(b)(6) deposition due to refusal to appear).

15. 37 CFR § 2.120(g).

16. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1061 (E.D. Mich. 1998).

17. Fed. R. Civ. P. 30(b)(6) Advisory Committee's notes (1993 amendment).

18. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

19. *Cf. Foster-Miller Inc. v. Babcock & Wilcox Canada*, 210 F.3d 1, 54 USPQ2d 1193, 1205 (1st Cir. 2000) (fact that examining party had previously taken individual depositions of employees who were regarded as most knowledgeable on certain topics identified in a Fed. R. Civ. P. 30(b)(6) notice of deposition does not obviate responsibility of responding party to designate and produce those individuals as witnesses competent to testify on those topics on behalf of corporation).

404.06(c) Time for Deposition

Fed. R. Civ. P. 30(d)(1) Duration. *Unless otherwise stipulated or ordered by the court, a deposition is limited to 1 day of 7 hours. The court must allow additional time consistent with Rule 26(b)(1) and (2) if needed to fairly examine the deponent or if the deponent, another person, or any other circumstance impedes or delays the examination.*

A deposition is limited to one day of seven hours unless stipulated by the parties or otherwise authorized by Board order. [Note 1.] Only actual deposition time counts against the presumptive limit; reasonable lunch and other breaks do not count against the seven hours. [Note 2.] For Fed. R. Civ. P. 30(b)(6) depositions, the deposition of each designated person is considered a separate deposition for purposes of the durational limit. [Note 3.]

The party seeking an order extending the examination or otherwise altering the time limitation is expected to show good cause. [Note 4.] Fed. R. Civ. P. 30(d)(1) allows for additional time consistent with Fed. R. Civ. P. 26(b)(2) if needed for fair examination of the deponent. [Note 5.] If the deponent or other person impedes or delays examination, additional time must be allowed. [Note 6.] Additional time for deposition should be allowed if examination is delayed by "other circumstance" which might include "a power outage, health emergency, or other event." [Note 7.] Orders directing shorter depositions or limited periods on several days are permitted. [Note 8.]

The parties are expected to make reasonable accommodations to obviate the need for motion practice before the Board regarding deposition time limits. However, a party who requires Board intervention may wish to contact the Board attorney by telephone for assistance. *See* TBMP § 413.01.

NOTES:

1. Fed. R. Civ. P. 30(d)(1).

2. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

3. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

4. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

5. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

6. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

7. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment).

8. Fed. R. Civ. P. 30(d) Advisory Committee's notes (2000 amendment); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005) (limiting depositions of three deponents to three hours per deponent and conducted consecutively over one and one half days).

404.06(d) Re-Deposing a Witness

Fed. R. Civ. P. 30(a)(2)(A)(ii) With Leave. *A party must obtain leave of court, and the court must grant leave to the extent consistent with Rule 26(b)(1) and (2): (A) if the parties have not stipulated to the deposition and: … (ii) the deponent has already been deposed in the case.*

When a person has already been deposed in the case, a party must seek leave of the Board to take a second deposition if the parties have not stipulated thereto. [Note 1.]

The decision to grant or deny leave to re-depose a witness is at the discretion of the Board and is guided by Fed. R. Civ. P. 26(b)(1) and (2). [Note 2.]

In deciding the motion, the Board will consider whether the discovery sought is unreasonably cumulative or duplicative, or is obtainable from some other source that is more convenient, less burdensome, or less expensive; the party seeking discovery has had ample opportunity by discovery in the action to obtain the information sought; and the burden or expense of the proposed discovery outweighs its likely benefit. [Note 3.]

The requirement to seek leave does not apply if the deposition is temporarily recessed for the convenience of counsel or the deponent or to enable additional materials to be gathered for review or discussion during the deposition. [Note 4.] If significant travel costs would be incurred to resume the deposition, the parties should consider the possibility of conducting the remaining examination by telephonic or other remote means, if feasible. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 30(a)(2)(A)(ii).

2. Fed. R. Civ. P. 30(a)(2).

3. Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002) (denying motion to take a second Fed. R. Civ. P. 30(b)(6) witness deposition when a designated Fed. R. Civ. P. 30(b)(6) witness had already testified at length on the same noticed topics).

4. Fed. R. Civ. P. 30(a)(2)(A)(ii) Advisory Committee's notes (1993 amendment). *Cf. Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1673 (TTAB 2005) (noting that Board had previously granted motion to compel continued deposition of officer in individual and corporate capacity because original deposition had been adjourned to enable completion of document production).

5. Fed. R. Civ. P. 30(a)(2)(A)(ii) Advisory Committee's notes(1993 amendment).

404.07 Discovery Depositions on Written Questions

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

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

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

A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28. [Note 1.] TBMP § 404.04.

NOTES:

1. 37 CFR § 2.124(a).

404.07(b) Depositions on Written Questions: When Taken

37 CFR § 2.120(a)(3) ... Discovery depositions must be taken, ...on or before the closing date of the discovery period as originally set or as reset..

Discovery depositions must be both noticed and taken during the discovery period. [Note 1.] TBMP § 404.01. Thus, it is recommended that a party, which desires to take a discovery deposition on written questions, initiate the procedure early in its discovery period. The question whether to suspend discovery activities unrelated to a proposed discovery deposition on written questions, or to allow other discovery activities to proceed, is a matter left to the Board's exercise of its discretion to schedule matters before it. [Note 2.]

NOTES:

1. 37 CFR § 2.120(a)(3).

2. 37 CFR § 2.124(d)(2).

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

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

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

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

37 CFR § 2.124(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.

37 CFR § 2.124(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition.

A party that desires to take a discovery deposition on written questions must serve notice thereof on each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. [Note 1.]

The notice must state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the person is to be provided so the responding party can designate one or more persons to be deposed. The notice must also be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken. [Note 2.] Copies of the notice served on adverse parties must be accompanied by the written questions to be propounded on behalf of the deposing party. [Note 3.]

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

NOTES:

1. 37 CFR § 2.124(b)(2).

2. 37 CFR § 2.124(b)(2) and 37 CFR § 2.124(c).

3. 37 CFR § 2.124(d)(1).

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

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

37 CFR § 2.124(d)(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. ...

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.

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, Priority Mail Express®, or overnight courier [Note 1]) any adverse party may serve cross questions on the deposing party. A party that serves cross questions on the deposing party must also serve copies thereof on every other adverse party. Within 10 days from the date of service

of the cross questions (15 days, if service of the cross questions was made by first-class mail, Priority Mail Express®, 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, Priority Mail Express®, or overnight courier), any party that served cross questions may serve recross questions on the deposing party. A party which serves recross questions on the deposing party must also serve copies thereof on every other adverse party. [Note 2.]

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, Priority Mail Express®, or overnight courier). The substitute questions must also be served on every other adverse party. [Note 3.]

As all discovery depositions must be completed within the discovery period, including depositions on written questions, on motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 CFR § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions to allow for the orderly completion of the depositions on written questions. [Note 4.]

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. *See* TBMP § 310.03(b) (five-day addition under 37 CFR § 2.119(c) does not apply to deadlines set by Board). 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. [Note 5.]

NOTES:

1. 37 CFR § 2.119(c).

2. 37 CFR § 2.124(d)(1). *See Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (discussing the procedure for deposition on written questions under 37 CFR § 2.124(d)); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

3. 37 CFR § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990).

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

5. 37 CFR § 2.124(e).

404.07(f) Depositions on Written Questions: Objections

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

* * * *

37 CFR § 2.124(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. [Note 1.] For information regarding objections to testimony depositions on written questions, see TBMP § 703.02(k).

Objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board (unless waived) at final hearing. [Note 2.] If a party's objections have been overcome by service of revised questions, the objecting party should file and serve notice of which objections no longer need be considered by the Board. Further, objections not maintained in a brief at final hearing may be considered waived by the Board. *See* TBMP § 707.03(c) and TBMP § 707.04.

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

NOTES:

1. 37 CFR § 2.124(d)(1).

2. 37 CFR § 2.124(g); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy deferred until final hearing). *See also Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (discussing objections on depositions on written questions under 37 CFR § 2.124(d)(1)).

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

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

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question. [Note 1.]

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

NOTES:

1. 37 CFR § 2.124(e).

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

37 CFR § 2.124(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of

all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. When the transcript has been certified, the officer shall mail the transcript and exhibits to the party that took the deposition. [Note 1.]For further information concerning certification of a deposition taken in an inter partes proceeding before the Board, see TBMP § 703.01(k).

NOTES:

1. 37 CFR § 2.124(e). *See* 37 CFR § 2.123(f).

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

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

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party.[Note 1.] *See also* TBMP § 703.01(m) regarding service of a testimony deposition transcript. The party that took the deposition must also assure that the transcript is correct. [Note 2.] For information concerning correction of errors in a testimony deposition taken in a Board inter partes proceeding, see TBMP § 703.01(n).

If the discovery deposition is to be made of record, the same procedures provided by 37 CFR § 2.120(j) are to be followed. [Note 3.] With respect to making a discovery deposition of record, see TBMP § 704.09.

NOTES:

1. 37 CFR § 2.124(f).

2. 37 CFR § 2.124(f) and 37 CFR § 2.125(b). *Cf. Hollywood Casino LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988. 1994-97 (TTAB 2015) (while a party may submit an errata sheet correcting typographical errors to a deposition transcript, such party may not submit or rely upon an errata sheet which substantively changes the deposition testimony)

3. 37 CFR § 2.124(f). *See also Fischer Gesellschaft M.b.H. v. Molnar and Co., Inc.*, 203 USPQ 861, 866 n.6 (TTAB 1979).

404.07(j) Deposition on Written Questions: Utility

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

confrontation and the opportunity to ask follow-up questions based on answers to previous questions. [Note 1.] For information regarding the utility of taking testimony depositions on written questions, see TBMP § 703.02(m).

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

NOTES:

1. 37 CFR § 2.124(d)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected at* 19 USPQ2d 1479; *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).

404.08 Discovery Deposition Objections

Objections made to the taking of a discovery deposition include errors and irregularities to the notice of deposition, the manner of taking the deposition, the form of a question or answer, the oath or affirmation or a party's conduct, and the disqualification of an officer. [Note 1.] Objections may also be made as to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 30(c)(2); Fed. R. Civ. P. 32(d)(1)-(2); Fed. R. Civ. P. 32(d)(3)(B).

2. Fed. R. Civ. P. 30(c)(2); Fed. R. Civ. P. 32(d)(3)(A).

404.08(a) Objections to Notice

Objections to errors and irregularities in a notice of the taking of a discovery deposition must be promptly served, in writing, on the party giving the notice; any such objections that are not promptly served are waived. [Note 1.] For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP § 707.02 and TBMP § 532. For information regarding a motion to quash a notice of deposition or for a protective order, see TBMP § 521 and TBMP § 410.

NOTES:

1. *See* Fed. R. Civ. P. 32(d)(1). *Compare S. Industries Inc. v. Lamb-Weston Inc.* , 45 USPQ2d 1293, 1298 (TTAB 1997) (Board will not rule in advance of deposition as to whether information sought is confidential or otherwise objectionable); *Neville Chemical Co. v. Lubrizol Corp.* , 183 USPQ 184, 189 (TTAB1974) (objections to subject matter of deposition may only be raised during, not prior to, the deposition), with *Red Wing Co. v. J.M. Smucker Co.* , 59 USPQ2d 1861, 1864 (TTAB 2001) (objections to subject matter of Fed. R. Civ. P. 30(b)(6) deposition raised prior to deposition). *Cf.* with regard to notice of testimony depositions, 37 CFR § 2.123(j); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1652 and 1655 (TTAB 2007) (overruling objections that notice of deposition was facially deficient and noting that a ruling on sufficiency of notice could have been made prior to the deposition by seeking a telephone conference with a Board attorney); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (premature taking

of testimony deposition could have been corrected upon seasonable objection); *Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony deposition excluded where notice did not name witness and objection was timely made and consistently maintained), *reconsideration granted on other grounds*, 3 USPQ2d 1708 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982).

404.08(b) Objections as to Disqualification of Officer

An objection to the taking of a discovery deposition because of a disqualification of the officer before whom the deposition is to be taken is waived unless it is made before the deposition begins, or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence. [Note 1.]

NOTES:

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

404.08(c) Objections During Deposition

Fed. R. Civ. P. 30(c)(2) Objections. ... *An objection must be stated concisely in a nonargumentative and nonsuggestive manner. A person may instruct a deponent not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the court, or to present a motion under Rule 30(d)(3).*

Fed. R. Civ. P. 32(d)(3)(A)Objection to Competence, Relevance, or Materiality. *An objection to a deponent's competence—or to the competence, relevance, or materiality of testimony--is not waived by a failure to make the objection before or during the deposition, unless the ground for it might have been corrected at that time.*

Fed. R. Civ. P. 32(d)(3)(B)Objection to an Error or Irregularity. *An objection to an error or irregularity at an oral examination is waived if*:

(i) *it relates to the manner of taking the deposition, the form of a question or answer, the oath or affirmation, a party's conduct, or other matters that might have been corrected at that time; and*

(ii) *it is not timely made during the deposition.*

Objections to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time. [Note 1.]

In the case of a discovery deposition taken on oral examination, objections to errors and irregularities occurring at the deposition in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and objections to errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonably made at the deposition. [Note 2.]

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

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Objections should be made concisely and in a nonargumentative manner. [Note 3.] Objections should ordinarily be limited to those that under Fed. R. Civ. P. 32(d)(3) might be waived if not made at that time. [Note 4.] Questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or not otherwise subject to disclosure under the terms of either the Board's standard protective order or, if the parties have made modifications thereto, the parties' agreed and approved protective order. [Note 5.] If a witness, having stated an objection to a discovery deposition question, answers the question subject to the objection, and the deposition is subsequently made of record in the proceeding pursuant to the provisions of 37 CFR § 2.120(j)(1), 37 CFR § 2.120(j)(2), 37 CFR § 2.120(j)(3)(i), and 37 CFR § 2.120(j)(4) ,the propriety of the objection will be considered by the Board at final hearing when the objections are preserved in the final briefs; that is, the Board will evaluate the testimony in light of the stated objection. [Note 6.]

For information concerning the propounding party's options if a witness not only objects to, but also refuses to answer, a particular question during a discovery deposition, see TBMP § 411.04. [Note 7.]

NOTES:

1. Fed. R. Civ. P. 32(d)(3)(A). *Cf* . 37 CFR § 2.123(k); *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (in unusual circumstance involving testimonial deposition on written questions where adverse party had opportunity to review deponent's answers before drafting its cross-questions, procedure was akin to an oral deposition and adverse party's failure to object at the time of service of cross-questions when defect could have been cured resulted in waiver).

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

3. Fed. R. Civ. P. 30(c)(2).

4. Fed. R. Civ. P. 30(d); Fed. R. Civ. P. 30(d) Advisory Committee's notes (1993 amendment).

5. *See* 37 CFR § 2.116(g) and 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b), 30(c)(2), and 37(a); Fed. R. Evid. 501; 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2113 (2015). *See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (Board, upon motion to compel, allowed parties time to work out protective order under which confidential information would be provided).

6. 37 CFR § 2.120(j)(3)(i); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979) (objections to discovery deposition questions should be preserved and argued in the briefs at final hearing); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974). *Cf. Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (objections made during testimonial deposition waived due to failure to preserve the objections by renewing them in brief); *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1746-47 (TTAB 2006) (while objections made at time of testimonial deposition were renewed in brief on case, Board deemed objections insufficiently preserved because brief failed to identify the objections with specificity).

7. *See also Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (if party objects to and refuses to answer certain deposition questions, party deposing may seek subpoena from court to compel responses or file motion with Board to compel answers).

404.09 Discovery Depositions Compared to Testimony Depositions

A discovery deposition, like a testimony deposition, may be taken either on oral examination or on written questions. [Note 1.] In fact, the actual taking of a discovery deposition is very similar to the taking of a testimony deposition. Nevertheless, there are substantial differences between the two, stemming from the differences between the discovery and trial stages of a proceeding. Some of the most significant differences are discussed below. A discovery deposition is a broad discovery device used by a party to obtain from an adversary information about the adversary's case, or to obtain from a non-party information that may be helpful to the deposing party's case. The discovery deposition is taken of the adversary or a non-party, or an official or employee of the adversary or a non-party. A testimony deposition, on the other hand, is a narrower device used by a party to present evidence in support of its own case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party. [Note 2.]

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time. *See also* TBMP § 403.02. [Note 3.] A party may only take a testimony deposition during the party's assigned testimony period; each party has an assigned testimony period, and only the party to which a particular testimony period is assigned may take testimony therein. [Note 4.]

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence. [Note 5.] In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection. [Note 6.]

In both types of depositions, questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged or not otherwise subject to disclosure under the terms of either the Board's standard protective order or if the parties have made modifications thereto, the parties' agreed and approved protective order. [Note 7.] Both types of depositions are taken out of the presence of the Board, and if a witness not only objects to, but also refuses to answer a particular question, and if the deposition is being taken pursuant to a subpoena, issued pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, the propounding party may attempt to obtain an immediate ruling on the propriety of the objection only by adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. [Note 8.]

In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the Board to compel the witness to answer the unanswered question. [Note 9.] A motion to compel is not available, however, in the case of a testimony deposition taken in a proceeding before the Board, nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. [Note 10.]

Accordingly, in those cases where the witness in a testimony deposition refuses to answer a particular question, no court action is sought, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness testimony. [Note 11.]

A discovery deposition does not form part of the evidentiary record in a case unless a party entitled to offer it into evidence files, during the party's testimony period, the deposition together with a notice of reliance thereon. [Note 12.] TBMP § 704.09. That is, the offering of a discovery deposition in evidence is voluntary, not mandatory. [Note 13.] *See* TBMP § 704.09 regarding introducing discovery depositions into evidence.

Every testimony deposition taken must be filed, and, when filed, becomes part of the record; a notice of reliance thereon is not necessary. [Note 14.] TBMP § 703.01(l).

The discovery deposition of an adverse party may be taken on notice alone. TBMP § 404.03. However, the testimony deposition of an adverse party, unless obtained voluntarily, may only be taken pursuant to a subpoena issued by a United States district court. [Note 15.] *See* TBMP § 703.01(f) regarding securing attendance of an adverse party or non-party and TBMP § 707.03(d) regarding the refusal of a party to answer testimony deposition question.

NOTES:

1. *See* Fed. R. Civ. P. 30 and Fed. R. Civ. P. 31.

2. *See Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865-66 (TTAB 1979); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978). *Cf. Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) ("The purpose of discovery is to provide information which may aid a party in the preparation of its own case or in the cross-examination of its adversary's witnesses.").

3. *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (deposition notices served before discovery period ended for depositions but scheduled after discovery period ended are untimely).

4. 37 CFR § 2.121(a).

5. *See* Fed. R. Civ. P. 26(b)(1).

6. *See* 37 CFR § 2.122(a) and 37 CFR § 2.123(k).

7. *See* 37 CFR § 2.116(g); 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b)(5), 30(c)(2), and 37(a)(3)(B); Fed. R. Evid. 501; 8A C.WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2113 (2015).

8. *See Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

9. 37 CFR § 2.120(e); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

10. *See* J *ain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431-32 (TTAB 1998) (motion to compel not available for testimonial depositions); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983) (should have applied to district court for order compelling answers).

11. *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (a refusal to answer, if found to be unjustified, may be construed against the objecting party).

12. *See, e.g.*, *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (motion granted allowing opposer to offer into evidence discovery deposition of non-party witness residing in a foreign country via notice of reliance because witness unavailable during trial phase and not willing to appear voluntarily); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1831 (TTAB 2013) (parties stipulated that either party "may use any and all discovery depositions" as testimonial depositions); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1847 n.5 (TTAB 2008) (parties stipulated in notice of reliance to use of discovery depositions as trial testimony); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1014 (TTAB 2007) (applicant's discovery deposition submitted by applicant by way of notice of reliance with consent of opposer). *But see Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1901 (TTAB 2006) (discovery deposition of adverse party's president, although not submitted properly via notice of reliance was treated as being of record by the parties and therefore considered to have been stipulated into the record).

13. *See, e.g.* , *Fischer Gesellschaft m.b.H. v. Molnar & Co.* , 203 USPQ 861, 867 (TTAB 1979); 37 CFR § 2.120(j)(1), 37 CFR § 2.120(j)(2), and 37 CFR § 2.120(j)(3)(i).

14. *See generally* 37 CFR § 2.123.

15. *See* 35 U.S.C. § 24; 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b) and Fed. R. Civ. P. 45; *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976). For further information concerning differences between discovery and testimony depositions, see *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865-67 (TTAB 1979)(discovery deposition of non-party is not admissible as evidence under a notice of reliance absent compelling circumstances or consent of the adverse party given the functional and historical differences between discovery and trial); and *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 250 (TTAB 1978) (discovery and testimony depositions are "quite distinguishable").

Please Note: Fed. R. Civ. P. 45(a)(2) and 45(f), as amended in 2013, are not applicable as 35 U.S.C. § 24 is controlling. *See* 37 CFR § 2.116(a) ("Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.").

405 Interrogatories

405.01 When Permitted and By Whom

For inter partes proceedings commenced on or after November 1, 2007, a party may only serve written interrogatories on any other party during the discovery period if the serving party previously served or concurrently serves therewith its initial disclosures, absent a stipulation or a granted motion, or upon order of the Board to the contrary. [Note 1.] *See* TBMP § 403.01. Interrogatories may be served on an adversary from the opening of the discovery period through the last day of the discovery period, even though the answers to later served interrogatories will not be served until after the discovery period has closed. TBMP § 403.02. Interrogatories may not be served on a non-party. [Note 2.]

NOTES:

1. 37 CFR § 2.120(a)(3).

2. *See* Fed. R. Civ. P. 33; 37 CFR § 2.120(d)(1).

405.02 Scope

Interrogatories may seek any information that is discoverable under Fed. R. Civ. P. 26(b). [Note 1.] An interrogatory that is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 33(a)(2).

2. Fed. R. Civ. P. 33(a)(2). *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (query whether opposer believes marks in question to be confusingly similar must be answered even though it requires opposer to draw legal conclusion). *See also Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) ("interrogatories may relate to any matters which can be inquired into under FRCP 26(b)").

405.03 Limit on Number

405.03(a) Description of Limit

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

The total number of interrogatories which a party may serve on another party, in a proceeding, may not exceed 75, counting subparts, except that the Board, may allow additional interrogatories on motion therefor showing good cause, or on stipulation of the parties. [Note 1.] *See* TBMP § 519. Parties may also stipulate that the limit on interrogatories shall be fewer than 75.

NOTES:

1. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 n.5 (TTAB 1990) ("good cause will generally be found only where a legitimate need for further discovery by means of interrogatories is shown . . . the fact that the additional interrogatories served by opposer may be relevant and narrowly drawn to a single issue is insufficient, in and of itself, to demonstrate good cause.")..

405.03(b) Application of Limit: Sets of Interrogatories

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

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

NOTES:

1. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990).

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

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

405.03(d) Application of Limit: Counting Interrogatories

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

If an interrogatory includes questions set forth as numbered or lettered subparts, each separately designated subpart will be counted by the Board as a separate interrogatory. The propounding party will, to that extent, be bound by its own numbering system, and will not be heard to complain that an interrogatory, although propounded with separately designated subparts, should nevertheless be counted as a single interrogatory because the interrogatory concerns a single transaction, set of facts, etc., or because the division was made for clarification or convenience. [Note 2.]

On the other hand, if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory. [Note 3.] For example, if two or more questions are combined in a single compound interrogatory, and are not set out as separate subparts, the Board will look to the substance of the interrogatory, and count each of the combined questions as a separate interrogatory. [Note 4.]

If an interrogatory contains both an initial question, and follow-up questions to be answered if the first is answered in the affirmative, the initial question and each follow-up question will be counted as separate interrogatories. [Note 5.]

Similarly, if an interrogatory begins with a broad introductory clause ("Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:") followed by several subparts ("Applicant's date of first use of the mark on the goods listed in the application," "Applicant's date of first use of the mark on such goods in commerce," etc.), the Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated. [Note 6.]

If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests "all relevant facts and circumstances" concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory. [Note 7.]

The introductory instructions or preamble to a set of interrogatories will not be counted by the Board as interrogatories or subparts for purposes of determining whether the limit specified in 37 CFR § 2.120(d)(1) has been exceeded. On the other hand, the Board's determination, on a motion to compel, of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble; the Board is not bound by the instructions or preamble, and will make its own independent determination of the adequacy of the answer, without regard to the instructions or preamble. [Note 8.]

NOTES:

1. *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

2. *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990).

3. *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990).

4. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

5. *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

6. *See* J *an Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990).

7. *See* NOTICE OF FINAL RULEMAKING, 54 Fed. Reg. 34886 (August 22, 1989).

8. *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992).

405.03(e) Remedy for Excessive Interrogatories

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

If a party on which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. [Note 1.] A party should not answer what it considers to be the first 75 interrogatories and object to the rest as excessive. [Note 2.]

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of 37 CFR § 2.120(e), including the requirement that a motion to compel be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement. [Note 3.] It is further recommended that the moving party set out its counting method showing that the number of interrogatories does not exceed 75. For further information concerning motions to compel discovery, see TBMP § 523.

If, on determining a motion to compel filed in response to a general objection to interrogatories on the ground of excessive number, the Board finds that the interrogatories are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not exceeding the numerical limit. The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. [Note 4.]

However, if the revised set is not served until after the close of the discovery period, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information beyond the scope of the excessive set. [Note 5.]

Although there are no limitations on the number of document requests that may be served, a party may properly refuse to respond to a document request seeking all documents identified or referred to in response to interrogatories if the number of interrogatories is believed to be excessive. [Note 6.]

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

NOTES:

1. 37 CFR § 2.120(d)(1). *Cf. Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

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

3. 37 CFR § 2.120(d)(1) and 37 CFR § 2.120(e).

4. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990). *See also Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1398-99 (TTAB 1990) (excusing obligation to answer excessive set); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1468 n.6 (TTAB 1990) (opposer may seek answers by taking discovery deposition of applicant).

5. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

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

405.04 Responses to Interrogatories

405.04(a) Time for Service of Responses

37 CFR § 2.120(a)(3) *… Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests.*

Fed. R. Civ. P. 33(b)(2) Time to Respond. *The responding party must serve its answers and any objections within 30 days after being served with the interrogatories. ...*

Responses to interrogatories must be served within 30 days after the date of service of the interrogatories. TBMP § 403.03. If service of the interrogatories is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the interrogatories. [Note 1.] TBMP § 113.05 and TBMP § 403.03. In instances where the parties have agreed to electronic service, e.g. service by facsimile or email, no additional time is allowed for responding to the interrogatories. [Note 2.] TBMP § 403.03.

A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits. [Note 3.] Objections going to the merits of an interrogatory or other discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence. [Note 4.] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. [Note 5.] Objections based on confidentiality are

expected to be extremely limited because the Board's standard protective order is in place for all Board inter partes proceedings. [Note 6.]

NOTES:

1. 37 CFR § 2.119(c).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission (email or fax) under § 2.119(b)(6).").

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

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

5. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (party will generally not be found to have waived the right to make these objections).

6. 37 CFR § 2.116(g).

405.04(b) Nature of Responses

Fed. R. Civ. P. 33(b)(3) Answering Each Interrogatory. *Each interrogatory must, to the extent it is not objected to, be answered separately and fully in writing under oath.*

Fed. R. Civ. P. 33(b)(4) Objections. *The grounds for objecting to an interrogatory must be stated with specificity. Any ground not stated in a timely objection is waived unless the court, for good cause, excuses the failure.*

Fed. R. Civ. P. 33(d) Option to Produce Business Records *. If the answer to an interrogatory may be determined by examining, auditing, compiling, abstracting, or summarizing a party's business records (including electronically stored information), and if the burden of deriving or ascertaining the answer will be substantially the same for either party, the responding party may answer by:*

(1) *specifying the records that must be reviewed, in sufficient detail to enable the interrogating party to locate and identify them as readily as the responding party could; and*

(2) *giving the interrogating party a reasonable opportunity to examine and audit the records and to make copies, compilations, abstracts, or summaries.*

Ordinarily, a party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer. [Note 1.] If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. [Note 2.] TBMP § 405.03(e).

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

In some cases, pursuant to Fed. R. Civ. P. 33(d), the information sought in an interrogatory may be derived or ascertained from the business records of the responding party, or from an examination, audit, or inspection of those business records (including a compilation, abstract, or summary thereof) and the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party. In those cases, the responding party may answer the interrogatory by itself providing, in its written answer to the interrogatory, the information sought. Alternatively, the responding party may answer the interrogatory by specifying the records from which the information may be derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts, or summaries. If the responding party elects to answer an interrogatory by specifying and producing business records, the specification must be in sufficient detail to permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained. [Note 3.] A party seeking to invoke Fed. R. Civ. P. 33(d) with regard to electronic information may be required to provide some combination of technical support, information on application software or other assistance to the requesting party. [Note 4.] If direct access to its electronic information system is necessary to afford the requesting party an adequate opportunity to derive or ascertain the answer to an interrogatory, the answering party may determine that its need for privacy or confidentiality requires it to derive or ascertain the answer itself rather than invoke Fed. R. Civ. P. 33(d). [Note 5.]

A responding party cannot simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents. [Note 6.]

It is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those interrogatories that it believes to be proper and stating its objections to those that it believes to be improper. TBMP § 410.

For information regarding a party's duty to supplement responses to interrogatories, see TBMP § 408.03.

NOTES:

1. Fed. R. Civ. P. 33(b)(2), 33(b)(4).

2. 37 CFR § 2.120(d)(1).

3. Fed. R. Civ. P. 33(d); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS,"* 95 USPQ2d 1567, 1570 (TTAB 2010) (responding party not entitled to invoke Fed. R. Civ. P. 33(d) by producing business records in Russian language with no English translation); *No Fear Inc. v. Rule*, 54 USPQ2d 1551,

1555 (TTAB 2000) (responding party may not merely agree to provide access to voluminous records which may contain responsive information); *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1435 (TTAB 1998) (identifying prerequisites for exercising the option to produce business records in lieu of answering interrogatories).

4. Fed. R. Civ. P. 33 Advisory Committee's notes (2006 Amendment Rule 33(d)).

5. Fed. R. Civ. P. 33 Advisory Committee's notes (2006 Amendment, Rule 33(d)).

6. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2178 (2015).

405.04(c) Signature of Responses and Authority of Signer

Fed. R. Civ. P.33(b)(1) Responding Party. *The interrogatories must be answered:*

(A) *by the party to whom they are directed; or*

(B) *if that party is a public or private corporation, a partnership, an association, or a governmental agency, by any officer or agent, who must furnish the information available to the party.*

Fed. R. Civ. P. 33(b)(5) Signature. *The person who makes the answers must sign them, and the attorney who objects must sign any objections.*

Interrogatories must be answered by the party served. If the party served is a corporation, partnership, association, or governmental agency, the interrogatories must be answered by an officer, partner or agent, who must furnish whatever information is available to the party served. [Note 1.]

The term "agent" includes an attorney, who may answer even though he has no personal knowledge of the facts stated in the answers; the attorney's answers, like an officer's or partner's answers, must contain the information available to the party served. [Note 2.] However, an attorney who answers interrogatories on behalf of a corporation, partnership, association, or governmental agency may thereafter be exposed to additional discovery and possibly even disqualification. [Note 3.]

Responses to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. [Note 4.]

NOTES:

1. Fed. R. Civ. P. 33(b)(1)(B).

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

3. *See* 37 CFR § 11.307; *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663 n.4 (TTAB 1988).

4. Fed. R. Civ. P. 33(b)(5).

406 Requests for Production of Documents and Things and Electronically Stored Information

406.01 When Permitted and By Whom

For inter partes proceedings commenced on or after November 1, 2007, a party may serve discovery, including requests for the production of documents and things, on any other party only during the discovery period and provided that the serving party has either previously served or is serving concurrently therewith its initial disclosures, absent a stipulation or a granted motion or upon order of the Board to the contrary. [Note 1.] TBMP § 403.02. Requests for production may be served through the last day of the discovery period, even though the responses thereto may not be served until after the discovery period has closed. [Note 2.] TBMP § 403.03 (Time for Service of Discovery Responses). If requests for production are combined with a notice of taking a discovery deposition (i.e., if it is requested that the deponent bring designated documents to the deposition), the requests for production must be served at least 35 days prior to the scheduled date of the deposition if service of the requests for production is made by first-class mail, Priority Mail Express®, or overnight courier, and at least 30 days prior to the deposition if service of the requests for production is made by one of the other methods specified in 37 CFR § 2.119(b). [Note 3.] TBMP §113.04 (Manner of Service), TBMP § 113.05 (Additional Time for Service by Mail), and TBMP § 403.03 (Time for Service of Discovery Responses).

Requests for production may not be served on a non-party.[Note 4.] However, if a discovery deposition deponent is a non-party witness residing in the United States, production of designated documents by the witness at the deposition may be obtained by means of a subpoena duces tecum. [Note 5.] *See* TBMP § 404.03(a)(2). A subpoena is unnecessary, however, if the non-party witness is willing to produce the documents voluntarily.

Parties seeking to serve document production requests on a natural person residing in a foreign country should be aware that the laws of some foreign countries may serve to preclude such discovery. [Note 6.] In determining when it is appropriate to impose sanctions for non-compliance with discovery due to a conflict with foreign laws, the following factors are considered: (1) the good faith of the non-complying party; (2) whether the non-complying party would incur foreign criminal liability; and (3) whether alternative sources of information are available. [Note 7.]

NOTES:

1. 37 CFR § 2.120(a)(3).

2. *See* Fed. R. Civ. P. 34(a); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978).

3. 37 CFR § 2.119(c).

4. *See* Fed. R. Civ. P. 34(a).

5. 35 U.S.C. § 24; Fed. R. Civ. P. 45. *But see Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942-43 (TTAB 2013) (discussing notice requirement to adverse party under Fed. R. Civ. P. 45(b)(1) for a subpoena duces tecum (without deposition) issued to non-party and noting that respondent could have sought its own subpoena of the non-party to obtain additional documents and/or a discovery deposition).

6. *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197, 200-01 (1958) (Swiss government ordered Swiss plaintiff in U.S. court proceeding not to produce certain documents).

7. *Cochran Consulting Inc. v. Uwatec USA Inc.*,102 F.3d 1224, 41 USPQ2d 1161, 1163 (Fed. Cir. 1996) (citing *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197 (1958)).

406.02 Scope

Fed. R. Civ. P. 34(a) In General. *A party may serve on any other party a request within the scope of Rule 26(b):*

(1) *to produce and permit the requesting party or its representative to inspect, copy, test, or sample the following items in the responding party's possession, custody, or control:*

(A) *any designated documents or electronically stored information — including writings, drawings, graphs, charts, photographs, sound recordings, images, and other data or data compilations — stored in any medium from which information can be obtained either directly or, if necessary, after translation by the responding party into a reasonably usable form; or*

(B) *any designated tangible things; or*

(2) *to permit entry onto designated land or other property possessed or controlled by the responding party, so that the requesting party may inspect, measure, survey, photograph, test, or sample the property or any designated object or operation on it.*

The scope of a request for production, in an inter partes proceeding before the Board, is governed by Fed. R. Civ. P. 34(a), which in turn refers to Fed. R. Civ. P. 26(b). *See* TBMP § 402 (discussion of scope of discovery permitted under Fed. R. Civ. P. 26(b)).

Generally, a party does not have an obligation to locate documents that are not in its possession, custody or control and produce them during discovery. [Note 1.] However, a party may not mislead its adversary by stating that it will produce documents and then fail to do so and claim the documents are not in its possession or control. [Note 2.] A party also is not under an obligation to create or prepare documents that do not already exist in response to a discovery request. [Note 3.]

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

NOTES:

1. *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009).

2. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).

3. 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2210 (2015) ("A document or thing is not in the possession, custody, or control of a party if it does not exist. Production cannot be required of a document no longer in existence nor of one yet to be prepared.").

406.03 Elements of Request for Production

Fed. R. Civ. P. 34(b)(1) Contents of the Request. *The request:*

(A) *must describe with reasonable particularity each item or category of items to be inspected;*

(B) *must specify a reasonable time, place, and manner for the inspection and for performing the related acts; and*

(C) *may specify the form or forms in which electronically stored information is to be produced.*

A request for production must include the elements specified in Fed. R. Civ. P. 34(b)(1)(A)-(B), as set forth above. Fed. R. Civ. P. 34(b)(1)(C) allows but does not require a requesting party to specify in its requests the preferred data format(s) for production of electronically stored information. Parties are expected to discuss the format for production during their mandatory discovery conference. [Note 1.] For more information regarding discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

NOTES:

1. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f). *See also Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (parties agreed only to the form of their ESI production).

406.04 Responses to Requests for Production

Fed. R. Civ. P. 34(b)(2)(A) Time to Respond. *The party to whom the request is directed must respond in writing within 30 days after being served or — if the request was delivered under Rule 26(d)(2) — within 30 days after the parties' first Rule 26(f) conference. A shorter or longer time may be stipulated to under Rule 29 or be ordered by the court.*

(B) ***Responding to Each Item.*** *For each item or category, the response must either state that inspection and related activities will be permitted as requested or state with specificity the grounds for objecting to the request, including the reasons. The responding party may state that it will produce copies of documents or of electronically stored information instead of permitting inspection. The production must then be completed no later than the time for inspection specified in the request or another reasonable time specified in the response.*

(C) ***Objections.*** *An objection must state whether any responsive materials are being withheld on the basis of that objection. An objection to part of a request must specify the part and permit inspection of the rest.*

(D) ***Responding to a Request for Production of Electronically Stored Information.*** *The response may state an objection to a requested form for producing electronically stored information. If the responding party objects to a requested form — or if no form was specified in the request — the party must state the form or forms it intends to use.*

(E) ***Producing the Documents or Electronically Stored Information.*** *Unless otherwise stipulated or ordered by the court, these procedures apply to producing documents or electronically stored information:*

(i) *A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request;*

(ii) *If a request does not specify a form for producing electronically stored information, a party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms; and*

(iii) *A party need not produce the same electronically stored information in more than one form.*

Responses to requests for production should comply with the provisions of Fed. R. Civ. P. 34(b). Documents produced in electronically stored form not kept in the ordinary course of business must be organized and labeled to correspond to the categories in each request. [Note 1.]

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(E). *See, e.g., Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) (for documents produced on DVD, opposer ordered to serve a complete index to all 31,144 pages of produced documents, cross-referencing the categories of documents and the discovery requests to which they are responsive, with no category in the index to exceed 300 pages).

406.04(a) Time for Service of Responses

Fed. R. Civ. P. 34(b)(2)(A) Time to Respond. *The party to whom the request is directed must respond in writing within 30 days after being served.*

37 CFR § 2.120(a)(3) … *Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests.*

Responses to requests for production must be served within 30 days after the date of service of the requests, unless otherwise stipulated by the parties or ordered by the Board. [Note 1.] TBMP § 403.03. If service of the requests is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. [Note 2.] TBMP § 113.05. In instances where the parties have agreed to electronic service, e.g. facsimile or email, no additional time is allowed for responding to the requests. [Note 3.] TBMP § 403.03.

A party which fails to respond to requests for production during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the requests on their merits. [Note 4.] TBMP § 403.03 and TBMP § 405.04(a).

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(A); 37 CFR § 2.120(a).

2. 37 CFR § 2.119(c).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission (email or fax) under § 2.119(b)(6).").

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (applicant, having waived its right to object to discovery requests on their merits was not entitled to raise objection regarding place of production of documents).

406.04(b) Place and Form of Production

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

Fed. R. Civ. P. 34(b)(2)(E) Producing the Documents or Electronically Stored Information. *Unless otherwise stipulated or ordered by the court, these procedures apply to producing documents or electronically stored information:*

(i) *A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request;*

(ii) *If a request does not specify a form for producing electronically stored information, a party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms; and*

(iii) *A party need not produce the same electronically stored information in more than one form.*

The place of production is governed by 37 CFR § 2.120(d)(2). [Note 1.] A party is only obliged to make documents and materials available for inspection and copying, where the documents are stored, and as they are kept in the ordinary course of business, [Note 2] or as organized and labeled to correspond to the requests. [Note 3.] However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party at the requesting party's expense. [Note 4.] Indeed, the Board believes this is more efficient and thus encourages this method of producing documents. [Note 5.] Parties are expected to discuss such arrangements in their mandatory discovery conference. [Note 6.] For more information regarding discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

Electronically stored information may be produced in the form specified by the request. If no specification is made, the party must produce the electronically stored information in the form in which it is ordinarily maintained, or in a reasonably usable form. [Note 7.] Fed. R. Civ. P. 34(a) "requires that, if necessary, a responding party 'translate' information it produces into a 'reasonably usable' form."[Note 8.] However, the option to produce in a reasonably usable form does not mean that a responding party is free to convert electronically stored information from the form in which it is maintained to a different form that makes it more difficult or burdensome for the requesting party to use the information efficiently in the litigation. [Note 9.] A party does not have to produce electronically stored information in more than one format. [Note 10.] Electronically stored information produced during discovery can be used during depositions to question witnesses and may come in as exhibits thereto.

On motion pursuant to 37 CFR § 2.120(d)(2), the Board may by order specify the place and the manner in which the documents are to be produced, and in situations involving electronically stored information, the form of production. The Board may, for example, order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party when the responding party has unreasonably refused to produce documents. [Note 11.]

NOTES:

1. *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1015 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976).

2. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

3. Fed. R. Civ. P. 34(b)(2)(E)(i).

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998).

5. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (most efficient means of making initial disclosures of documents and the option the Board encourages parties to use is to actually exchange copies of disclosed documents rather than merely identifying location).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f).

7. Fed. R. Civ. P. 34(b)(2)(E)(ii). *See* Fed. R. Civ. P. 34 Advisory Committee's notes (2006 Amendment). *Cf. Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (where the parties only agreed as to form of production, not as to other aspects such as a protocol for identifying and segregating potentially responsive ESI, applicant cannot insist that opposer start its ESI search and production over).

8. Fed. R. Civ. P. 34 Advisory Committee's notes (2006 Amendment Rule 34, Subdivision (b)).

9. Fed. R. Civ. P. 34 Advisory Committee's notes (2006 Amendment Rule 34, Subdivision (b)).

10. Fed. R. Civ. P. 34(b)(2)(E)(iii).

11. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (at the responding party's expense as a discovery sanction); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1998) (at responding party's expense, as a discovery sanction); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983) (at the requesting party's expense).

406.04(c) Nature of Responses

Fed. R. Civ. P. 34(b)(2)(B) Responding to Each Item. *For each item or category, the response must either state that inspection and related activities will be permitted as requested or state with specificity the grounds for objecting to the request, including the reasons. The responding party may state that it will produce copies of documents or of electronically stored information instead of permitting inspection. The production must then be completed no later than the time for inspection specified in the request or another reasonable time specified in the response.*

Fed. R. Civ. P. 34(b)(2)(C) Objections. *An objection must state whether any responsive materials are being withheld on the basis of that objection. An objection to part of a request must specify the part and permit inspection of the rest.*

Fed. R. Civ. P. 34(b)(2)(D) Responding to a Request for Production of Electronically Stored Information. The response may state an objection to a requested form for producing electronically stored information. If the responding party objects to a requested form — or if no form was specified in the request — the party must state the form or forms it intends to use.

Fed. R. Civ. P. 37(e) Failure to Preserve Electronically Stored Information. *If electronically stored information that should have been preserved in the anticipation or conduct of litigation is lost because a party failed to take reasonable steps to preserve it, and it cannot be restored or replaced through additional discovery, the court:*

(1) *upon finding prejudice to another party from loss of the information, may order measures no greater than necessary to cure the prejudice; or*

(2) *only upon finding that the party acted with the intent to deprive another party of the information's use in the litigation may:*

(A) *presume that the lost information was unfavorable to the party;*

(B) *instruct the jury that it may or must presume the information was unfavorable to the party; or*

(C) *dismiss the action or enter a default judgment.*

A response to a request for production of documents and things must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated with specificity, as well as whether any responsive material is being withheld on the basis of that objection. [Note 1.] For any item or category of documents which is not subject to a stated objection, a proper response should state whether or not there are responsive documents and, if there are responsive documents, whether they will be produced at a specified reasonable time or withheld on a claim of privilege. [Note 2.] If accurate, a party may respond that the requested documents are not in existence (e.g., lost or destroyed or that the documents are not within its possession, custody, or control). [Note 3.] If objection is made to only part of an item or category, the part must be specified. A party may not redact portions of responsive documents on the ground that the non-disclosed information is not relevant or responsive where the information appears in a document that contains otherwise relevant or responsive information. [Note 4.] A party may object to a requested form of data production for electronically stored information ("ESI"). [Note 5.] If no form for the ESI is specified in the request, the party must state the form it intends to use. A party that produces documents for inspection must produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request. [Note 6.] A party that produces ESI must produce the information in the form specified by the request, if no objection is made. It is contemplated that the parties will attempt to resolve such issues, i.e., the manner in which ESI will be produced, during their discovery conference. [Note 7.] If no specification is made as to form in the request, a party must produce the ESI in the form in which it is ordinarily maintained, or in a reasonably usable form. [Note 8.] Aspects of ESI production other than form that should be discussed during the discovery conference, or when it becomes apparent that ESI will be produced, include a protocol for identifying and segregating potentially responsive ESI, who should review the ESI to determine whether the production of particular documents or information would be appropriate, and methods of searching the ESI, such as the use of "keywords," to identify documents and information responsive to the discovery requests. [Note 9.]

A party has an obligation to take reasonable steps to preserve ESI in the anticipation or conduct of litigation. [Note 10]. A duty to preserve electronically stored information arises not only during litigation but also extends to that period before litigation when a party reasonably should know that the evidence may be relevant to the litigation. [Note 11]. As amended on December 1, 2015, Fed. R. Civ. P. 37(e) provides that if electronically stored information that should have been preserved in the anticipation or conduct of litigation

is lost because a party failed to take reasonable steps to preserve it, and it cannot be restored or replaced through additional discovery, the court: (1) upon finding prejudice to another party from loss of the information, may order measures no greater than necessary to cure the prejudice; or (2) only upon finding that the party acted with the intent to deprive another party of the information's use in the litigation may, among other things: presume that the lost information was unfavorable to the party or dismiss the action or enter a default judgment. For more guidelines regarding the application of remedies in the event of lost ESI, see Fed. R. Civ. P. 37(e) Advisory Committee's note (2015 Amendment Rule 37(e)).

A party withholding responsive documents on the basis of a claim of privilege must "(i) expressly make the claim; and (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed--and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim." [Note 12.]

Fed. R. Civ. P. 26(b)(5) does not specify exactly how the party asserting privilege/protection must particularize its claim. The most common way is by using a privilege log, which identifies each document withheld, information regarding the nature of the privilege/protection claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document's general subject matter. [Note 13.]

It is generally inappropriate for a party to respond to requests for production by filing a motion attacking them, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by indicating, with respect to those requests that it believes to be proper, that inspection and related activities will be permitted, and by stating reasons for objection with respect to those requests that it believes to be improper. *See* TBMP § 410.

For information regarding a party's duty to supplement responses to requests for production, see TBMP § 408.03.

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(B) and 34(b)(2)(C).

2. Fed. R. Civ. P. 34(b)(2)(B); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

3. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).

4. *Intex Recreation Corp. v. The Coleman Co.*, 117 USPQ2d 1799 (TTAB 2016).

5. Fed. R. Civ. P. 34(b)(2)(D).

6. Fed. R. Civ. P. 34(b)(2)(E)(i); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (party may not simply dump large quantities of documents containing responsive as well as unresponsive documents).

7. Fed. R. Civ. P. 26(f)(3)(c). *See also* Fed. R. Civ. P. 34 Advisory Committee's note (2006 Amendment Rule 34, Subdivision (b)).

8. Fed. R. Civ. P. 34(b)(2)(E)(ii).

9. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1905 (TTAB 2011).

10. *See generally Zubulake v. UBS Warburg LLC*, 220 F.R.D. 212, 216-18 (S.D.N.Y. 2003) (discussing the obligation to preserve electronically stored information).

11. *Leon v. IDX Systems Corp.*, 464 F.3d 951, 956 (9th Cir. 2006); *Silvestri v. General Motors Corp.*, 271 F.3d 583, 591 (4th Cir. 2001).

12. Fed. R. Civ. P. 26(b)(5)(A)(i)-(ii).

13. Fed. R. Civ. P. 26(b)(5) Advisory committee notes (1993 amendment); *see Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251, 264-65 (D. Md. 2008) (discussing form of privilege logs under Fed. R. Civ. P. 26(b)(5)).

407 Requests for Admissions

407.01 When Permitted and By Whom

For cases commenced on or after November 1, 2007, like interrogatories and requests for production of documents, absent a stipulation or granted motion or order of the Board to the contrary, requests for admission may be served on an adversary after service of or contemporaneously with initial disclosures, through the last day of the discovery period, even though the answers thereto will not be due until after the discovery period has closed. TBMP § 403.01 and TBMP § 403.02. During the discovery period in an inter partes proceeding before the Board, any party may serve written requests for admissions on any other party. [Note 1.]

NOTES:

1. Fed. R. Civ. P. 36(a); 37 CFR § 2.120(a).

407.02 Scope and Nature of Requests for Admission

Fed. R. Civ. P. 36(a) Requests for Admission.

Fed. R. Civ. P. 36(a)(1) Scope. *A party may serve on any other party a written request to admit, for purposes of the pending action only, of the truth of any matters within the scope of Rule 26(b)(1) relating to:*

(A) *facts, the application of law to fact, or opinions about either; and*

(B) *the genuineness of any described documents.*

Fed. R. Civ. P. 36(a)(2) Form; Copy of a Document. *Each matter must be separately stated. A request to admit the genuineness of a document must be accompanied by a copy of the document unless it is, or has been, or otherwise furnished or made available for inspection and copying.*

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

For a discussion of the scope of discovery permitted under Fed. R. Civ. P. 26(b)(1) and electronically stored information, see TBMP § 402.01 and TBMP § 402.02.

Requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters that must be tried. These requests are also useful as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents. [Note 1.] TBMP § 403.05(b).

NOTES:

1. *See, e.g., ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 n.6 (TTAB 2007) (opposer filed notice of reliance on applicant's response to request for admission and exhibits thereto that all documents it produced in response to opposer's discovery requests were authentic for purposes of admission into evidence during the testimony period in the opposition proceeding); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 (TTAB 2007) (documents produced in response to petitioner's interrogatories under Fed. R. Civ. P. 33(d) for which respondent admitted via a request for admission were true and correct copies of authentic documents could be introduced by way of notice of reliance).

407.03 Responses to Requests for Admission

407.03(a) Time for Service of Responses

37 CFR § 2.120(a)(3) **…** *Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests.*

Fed. R. Civ. P. 36(a) Requests for Admission.

Fed. R. Civ. P. 36(a)(3) Time to Respond; Effect of Not responding. *A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney.*

Fed. R. Civ. P. 6(b) Extending Time.

Fed. R. Civ. P. 6(b)(1)(B) *When an act may or must be done within a specified time, the court may, for good cause, extend the time: …on motion made after the time has expired if the party failed to act because of excusable neglect.*

Responses to requests for admission must be served within 30 days after the date of service of the requests. [Note 1.] TBMP § 403.03. If service of the requests is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. [Note 2.] TBMP § 113.05 and TBMP § 403.03. In instances where the parties have agreed to electronic service, e.g. service by facsimile or email, no additional time is allowed for responding to the requests. [Note 3.] TBMP § 403.03

Under Fed. R. Civ. P. 36, a requested admission is deemed admitted unless a written answer or objection is provided to the requesting party within thirty days after service of the request, or within such time as the parties agree to in writing. [Note 4.]

If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted by operation of law [Note 5] unless the party is able to show that its failure to timely respond was the result of excusable neglect [Note 6] or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board. [Note 7.] It is not necessary to file a motion to deem requests for admissions admitted when no response is served, since the admissions are deemed admitted by operation of Fed. R. Civ. P. 36(a).

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

NOTES:

1. Fed. R. Civ. P. 36(a)(3); 37 CFR § 2.120(a)(3).

2. 37 CFR § 2.119(c).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission (email or fax) under § 2.119(b)(6).").

4. Fed. R. Civ. P. 36(a)(3).

5. *Fram Trak Industries v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) (requests for admissions deemed admitted by respondent's failure to respond to petitioner's requests for admissions); *Pinnochio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 n.5 (TTAB 1989) (same).

6. Fed. R. Civ. P. 6(b)(1)(B); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (counsel's mistaken belief that opposing counsel would grant an extension for responding to admissions did not constitute excusable neglect to reopen time to respond under Fed. R. Civ. P. 6(b)); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2064 n.1 (TTAB 1990) (to the extent applicant by its motion sought to be relieved of the untimeliness of its response, motion was not well taken because the reasons for failing to timely respond did not constitute excusable neglect).

7. Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (finding merits of action subserved by withdrawal of admissions and replacement with later served responses and finding no prejudice to petitioner under Fed. R. Civ. P. 36(b)); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) ("...where failure to timely respond to a request for admission has harsh result, Rule 36(b) provides method for obtaining relief."). *See also American Automobile Association (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by relieving opposer of admission on relevant issue and prejudice avoided by allowing applicant limited discovery as to the amended answer; *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979) (motion to withdraw admissions by default denied, but to extent admissions are contradicted by evidence, they will not be relied on for purposes of deciding whether entry of summary judgment is appropriate); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.2 (TTAB 1978) (by failing to answer requests for admissions,

opposer admitted that it abandoned use of certain registered marks), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

407.03(b) Nature of Responses

Fed. R. Civ. P. 36(a) Requests for Admission.

Fed. R. Civ. P. 36(a)(4) Answer. *If a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter; and when good faith requires that a party qualify an answer or deny only a part of a matter, the answer must specify the part admitted and qualify or deny the rest. The answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.*

Fed. R. Civ. P. 36(a)(5) Objections. *The grounds for objecting to a request must be stated. A party must not object solely on the ground that the request presents a genuine issue for trial.*

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested. [Note 1.]

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

An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny. [Note 2.]

If the responding party objects to a request for admission, the reasons for objection must be stated. If a responding party believes that a matter of which an admission has been requested presents a genuine issue for trial, the party may not object to the request on that ground alone. Rather, the party may deny the matter; alternatively, the party may set forth reasons why it cannot admit or deny the matter. [Note 3.]

It is generally inappropriate for a party to respond to requests for admission by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those requests that it believes to be proper and stating its reasons for objection to those that it believes to be improper. *See* TBMP § 410. For information regarding a party's duty to supplement requests for admissions, see TBMP § 408.03

For information regarding excessive requests for admissions requiring relief by protective order, see TBMP § 412.06(b).

NOTES:

1. Fed. R. Civ. P. 36(a).

2. Fed. R. Civ. P. 36(a).

3. Fed. R. Civ. P. 36(a).

407.03(c) Signature of Responses

Answers and objections to requests for admission may be signed either by the responding party, or by its attorney. [Note 1.] However, an attorney who signs answers or objections to requests for admission risks becoming a witness or disqualification from representation. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 36(a)(3).

2. *See* 37 CFR § 11.307. *Cf. Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1666 n.4 (TTAB 1988).

407.04 Effect of Admission

Any matter admitted (either expressly, or for failure to timely respond) under Fed. R. Civ. P. 36(a) is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission or the Board permits a reopening of the time for responding to the admission requests. [Note 1.]

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

An admission made by a party under Fed. R. Civ. P. 36(a) is only for the purpose of the pending proceeding. It is not an admission for any other purpose, nor may it be used against that party in any other proceeding. [Note 2.]

The denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial. [Note 3.]

NOTES:

1. Fed. R. Civ. P. 36(b); Fed. R. Civ. P. 6(b)(1)(B). *See Texas Department of Transportation v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010) (admission conclusively establishes matter that is the subject of request for admission, subsequent argument to the contrary in response brief insufficient to raise genuine issue of material fact); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 n.8 (TTAB 2007) ("An admission in response to a request for admission 'conclusively establishe[s]' the matter that is subject of that request . . . . However, a denial in response to a request for admission is merely a refusal to stipulate to certain matter"). *See also American Automobile Association, v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1144 (5th Cir. 1991) (an admission not withdrawn or amended cannot be rebutted by contrary testimony at trial); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.7 (TTAB 2004) (because proceedings were deemed suspended prior to service of requests for admissions, Board declined to treat requests for admissions as having been admitted by applicant for failure to timely

respond, considering only those requests applicant expressly admitted; *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 63, 65 n.4 (TTAB 1981) (anything not admitted is not established).

2. Fed. R. Civ. P. 36(b).

3. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008).

408 Duties to Cooperate, Search Records, Supplement

408.01 Duty to Cooperate

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, [Note 1] and looks with extreme disfavor on those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. [Note 2.] Discovery before the Board is not governed by the concept of priority of discovery - that is, a party is not relieved of its discovery obligations, including its duty to cooperate, in spite of the fact that an adverse party wrongfully may have failed to fulfill its own obligations. [Note 3.]

NOTES:

1. *See Cadbury UK Ltd. v. Meenaxi Enter., Inc.*, 115 USPQ2d 1404, 1407 (TTAB 2015) (The Board will not allow a party to avoid its discovery obligations due to an obvious typographical error in opposing party's written discovery requests); *Panda Travel Inc. v Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary."); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) ("In order for the meet and confer process to be meaningful and serve its intended purpose, 'the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions.'") (quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993)). *See also Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 n.1 (TTAB 2014) (simply ignoring deadlines to serve discovery responses or seek an extension of time to do so is inconsistent with the Board's expectation that the parties and their attorneys cooperate in the discovery process); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions).

2. Fed. R. Civ. P. 26(g). *See, e.g.*, *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (parties expected to cooperate in the meet and confer process by presenting to each other the merits of their respective positions with candor, specificity and support); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was "uncooperative" and "improper" and that any further misconduct may result in the imposition of the estoppel sanction); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (in view of parties' impasse, Board was burdened with resolving numerous requests for discovery); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (both parties failed to cooperate, thus saddling Board with needless motions); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984) (failure to cooperate in discovery and comply with Board order resulted in the entry of sanctions in the form

of judgment); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (it was clear from number and nature of opposer's discovery requests and applicant's blanket objections thereto that neither party was cooperating). *See also C. H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506, 507 (TTAB 1980) (opposer's "voluminous" discovery requests were "oppressive and nothing short of harassment" to applicant); *C. H. Stuart Inc. v. S. S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (Board granted applicant's motion for protective order; opposer's "boiler-plate" discovery requests designed for an infringement action deemed harassment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 584 (TTAB 1975) (applicant's motion to compel denied due to lack of good faith effort to resolve dispute); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 624 (TTAB 1974); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477-78 (TTAB 1974).

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

408.01(a) Obligation to Conduct Discovery Conference

In the interest of promoting among other things, cooperation in the discovery process, parties involved in inter partes proceedings commenced on or after November 1, 2007, are required to hold a conference to discuss settlement and plans for discovery. [Note 1.] The purpose of the conference for the parties is to discuss the "nature and basis of the involved claims and defenses, the possibility of settlement of the case or modification of the pleadings, and plans for disclosures and discovery," as well as the subjects set forth in Fed. R. Civ. P. 26(f) and any other subjects that the Board requires to be discussed in the institution order for the case, including alternative means for case resolution such as Accelerated Case Resolution (ACR). [Note 2.] *See* TBMP § 528.05(a)(2) and TBMP § 702.04 for further information on ACR. The parties are free to discuss additional topics besides those outlined in Fed. R. Civ. P 26(f) and the institution order that could promote settlement or efficient adjudication of the Board proceeding. [Note 3.] Mere discussion of settlement does not substitute for a full discovery conference addressing the issues outlined in Fed. R. Civ. P. 26 and the Board's institution order. [Note 4.] Thus, the parties are *required* to discuss their plans relating to disclosures, discovery and trial evidence unless they are successful in settling the case.

All parties to a proceeding have a duty to cooperate and conduct the discovery conference in a timely fashion. [Note 5.] If a party refuses to cooperate in scheduling the discovery conference, it is recommended that the party seeking to schedule the conference contact the assigned Board attorney via telephone to facilitate the matter prior to the deadline for the conference. [Note 6.] In such instances, the Board professional will contact the non-cooperating party directly to schedule the conference. If the uncooperative party fails to respond to Board communications within a reasonable time frame, the Board will issue an order setting a date for the conference, and warning the uncooperative party that the conference will be held as scheduled, and that any party that has not participated may be subject to a motion for sanctions under 37 CFR § 2.120(g). In certain instances, the Board may also order the uncooperative party to show cause why judgment should not be entered against it for failure to participate in the discovery conference. Alternatively, in instances where the party seeking to schedule the conference did not engage the Board, the party may file a motion for sanctions pursuant to 37 CFR § 2.120(g). The Board may, upon grant of a motion for sanctions for failure of a party to participate in a discovery conference, impose any of the sanctions provided in Fed. R. Civ. P. 37(b)(2), including judgment. [Note 7.] A motion to compel a party to participate in a discovery conference is not a prerequisite to filing a motion for sanctions under 37 CFR § 2.120(g) because of an adverse party's unwillingness to participate in the required conference; however, the moving party must provide evidence of a good faith effort to schedule the conference in order to be able to prevail on a motion for such sanctions. [Note 8.]

For a more detailed discussion of discovery conferences, see TBMP § 401.01.

For general information on the conduct of telephone conferences, participation in telephone conferences, and issuance of rulings resulting from telephone conferences, see TBMP § 502.06(a).

NOTES:

1. *See* 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

2. *See, e.g., Promgirl, Inc. v. JPC Co.* , 94 USPQ2d 1759, 1761 (TTAB 2009).

3. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

4. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009) (mere discussion of settlement does not substitute for full discovery conference of subjects set forth in Fed. R. Civ. P. 26 and Board's institution order).

5. *See, e.g., Promgirl, Inc. v. JPC Co.*,94 USPQ2d 1759, 1762 (TTAB 2009) (responsibility to schedule a conference and to confer on each of the topics outlined in Fed. R. Civ. P. 26 and the institution order is a shared responsibility); *Guthy-Renker Corp. v. Michael Boyd*, 88 USPQ2d 1701, 1703 (TTAB 2008) ("it is the equal responsibility of both parties to ensure that the discovery conference takes place by the assigned deadline"); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.2 (TTAB 2008) (holding discovery conference is a mutual obligation).

6. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

7. 37 CFR § 2.120(g)(1).

8. *See, e.g., Promgirl, Inc., v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (opposer's motion for sanctions in the form of judgment denied where parties were engaged in settlement discussions and opposer did not broach the subject of scheduling the discovery conference until the deadline date, and only after opposer's settlement offer was rejected); *Guthy-Renker Corp. v. Michael Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008) (motion for sanctions denied; moving party could have made additional efforts with adverse party to schedule discovery conference, including requesting Board participation in the discovery conference, but failed to do so).

408.01(b) Obligation to Make Initial and Expert Testimony Disclosures

As part of the discovery phase of each inter partes proceeding commenced on or after November 1, 2007, all involved parties are obliged to make initial disclosures and, when necessary, expert testimony disclosures. The Board adopted a disclosure regime in order to promote the early exchange of information and settlement and, for cases that do not settle, "more efficient discovery and trial, [reduction of] incidents of unfair surprise, and [to] increase the likelihood of fair disposition of the parties' claims and defenses." [Note 1.] In addition, the utilization of routine disclosures of the types provided for in the Federal Rules of Civil Procedure is intended to "obviate the need to use traditional discovery to obtain 'basic information' about a party's claims or defenses." [Note 2.]

Each party involved in an inter partes proceeding is obligated to make initial disclosures to every other party, by the deadline set in the Board's institution order, or as may be reset by stipulation of the parties approved

by the Board, or by motion granted by the Board, or by order of the Board. [Note 3.] The initial disclosure requirement is intended to provide for the disclosure of names of potential witnesses and basic information about documents and things that a party may use to support a claim or defense. [Note 4.] Parties are encouraged in the spirit of cooperation to stipulate to rely on more expansive use of reciprocal disclosures in lieu of formal discovery, as a more efficient and less costly manner of litigating a Board proceeding, subject to Board approval. [Note 5.]

For a further discussion of initial disclosures, see TBMP § 401.02.

In the event a party decides to use expert testimony in a Board proceeding, pursuant to Fed. R. Civ. P. 26(a)(2), the party must serve expert disclosures 30 days prior to the close of discovery. [Note 6.] The expert disclosure requirement is intended to avoid any unfair surprise during the testimony period. [Note 7.] While the expert disclosure provided for in Fed. R. Civ. P. 26 may be extensive and should not, therefore be filed with the Board, the parties should inform the Board when an expert disclosure is made, so the Board can issue any appropriate order. [Note 8.] The Board may, for example, suspend proceedings to provide for the taking of any necessary discovery of the proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. [Note 9.] Parties are expected to cooperate in the process of exchanging information about any testifying experts, and should discuss during the discovery conference, the possibility of the presentation of expert testimony. The parties should revisit these discussions whenever it appears that a testifying expert witness may become involved in the case. [Note 10.]

Where a party in its disclosures identifies an expert as a possible testifying witness under Rule 26(b)(4)(A), but subsequently re-designates the expert as a non-testifying or consulting expert under Fed. R. Civ. P. 26(b)(4)(D), the opposing party may depose that expert only upon a showing of "exceptional circumstances" under Fed. R. Civ. P. 26(b)(4)(D)(ii). [Note 11.]

For further information regarding expert disclosures, see TBMP § 401.03.

For a discussion regarding the modification of disclosure obligations, see TBMP § 401.04.

NOTES:

1. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES,72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007). *See Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (disclosures, from initial through pretrial, and discovery responses should be viewed as a continuum of communication designed to avoid unfair surprise and to facilitate a fair adjudication of the case on the merits).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

3. 37 CFR § 2.120(a)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

6. 37 CFR § 2.120(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007) (in the absence of an order from the Board setting a deadline, expert disclosures are governed by Fed. R. Civ. P. 26(a)(2), per 37 CFR § 2.120(a)(2)). *See, e.g.*, *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1564 n.2 (TTAB 2014); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1445 (TTAB 2009).

7. *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (disclosures, from initial through pretrial, and discovery responses should be viewed as a continuum of communication designed to avoid unfair surprise).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 n.3 (TTAB 2013); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See e.g.*, *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564-65 (TTAB 2014); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

10. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 n.3 (TTAB 2011) (parties expected to cooperate to resolve problems arising from timely but incomplete expert disclosures).

11. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014).

408.01(c) Duty to Cooperate With Regard to Written Discovery and Disclosures

Fed. R. Civ. P. 26(g)(1) Signature Required; Effect of Signature. *…By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made; and*

(B) *with respect to a discovery request, response, or objection, it is:*

(i) *consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;*

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

(iii) *neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.*

37 CFR § 2.120(e)(1) *A motion to compel initial disclosures, expert testimony disclosures, or discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefore the issues presented in the motion but the parties were unable to resolve their differences.*

The signature of a party or attorney constitutes a certification as to a discovery request, response or objection and disclosure as set forth in Fed. R. Civ. P. 26(g)(1). [Note 1.] Provision is made, in Fed. R. Civ. P. 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule. *See also* TBMP § 106.02 (Signature of Submissions). "The certification duty requires the party or attorney to make a reasonable inquiry into the factual basis of his response, request or objection." [Note 2.]

Because the signature of a party or its attorney to a request for discovery constitutes a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. [Note 3.] Similarly, the signature of a party or its attorney to a discovery response (i.e., response to interrogatory, request to admit, or request for production) or objection is a certification by the party or its attorney that, inter alia, the response or objection is warranted, consistent with the Federal Rules of Civil Procedure, and not interposed for any improper purpose such as to cause unnecessary delay or needlessly increase the cost of litigation. The certification requirement is distinguishable from the signature requirements in rules such as Fed. R. Civ. P. 33 [Note 4] and certifies that the party or lawyer has made a reasonable effort to assure that all available information and documents responsive to the discovery demand have been provided. [Note 5.]

Under Fed. R. Civ. P. 26(g)(1)(A), a signature with respect to a disclosure constitutes certification that the disclosure is complete and correct at the time it was made. For further information regarding the form and signatures of disclosures, see TBMP § 401.06.

In addition, the duty to cooperate is embodied in the prerequisite that prior to filing a motion to compel disclosure or discovery, the moving party must make a good faith effort, by conference or correspondence, to resolve the discovery dispute prior to seeking Board intervention. [Note 6.] *See also* TBMP § 523.02. The motion must be supported by a written statement showing that such a good faith effort was made. [Note 7.] The Board may, as necessary in any particular case, ensure that the parties have engaged in a sufficient effort to resolve their differences regarding discovery by requiring the parties to conference with the Board attorney assigned to the case prior to filing a motion to compel disclosures or discovery. *See* TBMP § 413.01.

NOTES:

1. *See Miss America Pageant v. Petite Productions, Inc.* , 17 USPQ2d 1067, 1069 (TTAB 1990). *Cf.* 37 CFR § 11.18(b); Fed. R. Civ. P. 11.

2. Fed. R. Civ. P. 26 Advisory Committee's notes (1983 Amendment Rule 26, Subdivision (g)).

3. *See, e.g., Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (Board was persuaded that certain interrogatories would be unduly burdensome).

4. Fed. R. Civ. P. 26 Advisory Committee's notes (1983 Amendment Rule 26, Subdivision (g)).

5. Fed. R. Civ. P. 26 Advisory Committee's notes (1983 Amendment Rule 26, Subdivision (g)).

6. 37 CFR § 2.120(e). *See, e.g., Hot Tamale Mama…and More, LLC v. SF Investments., Inc.*, 110 USPQ2d 1080, 1082 (TTAB 2014) (Board found that single email exchange alone was insufficient to satisfy the good faith effort obligation to resolve discovery dispute prior to filing motion to compel); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (parties expected to cooperate in the meet and confer process by presenting to each other the merits of their respective positions with candor, specificity and support).

7. 37 CFR § 2.120(e). *See Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (statement of good faith effort to be supported by recitation of communications conducted including dates, summary of telephone conversations and copies of correspondence exchanged, where applicable). *Cf. International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002) (permission to file motion to compel denied where motion was devoid of good faith effort to resolve dispute prior to seeking Board intervention).

408.02 Duty to Search Records

A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. [Note 1.] With regard to document production requests, a proper written response to each request requires the responding party to state that there are responsive documents and that either they will be produced or will be withheld on a claim of privilege;to state an objection with appropriate reasons; or to state that no responsive documents exist. [Note 2.] With regard to electronically stored information, if no form for the electronically stored information is specified in the request or the party objects to the form, a proper written response includes a statement of the form the party intends to use in its response. [Note 3.] In addition, the responding party has a duty "to select and produce the items requested [and to avoid] simply dumping large quantities of unrequested materials onto the discovering party along with the items actually sought under [Fed. R. Civ. P. 34]." [Note 4.]

A responding party which, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question) unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). [Note 5.] *See also* TBMP § 527.01(e) ("Estoppel Sanction").

NOTES:

1. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

2. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

3. Fed. R. Civ. P. 34(b)(2)(D).

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

5. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791(TTAB 2009); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987).

408.03 Duty to Supplement Disclosures and Discovery Responses

Fed. R. Civ. P. 26(e) Supplementing Disclosures and Responses.

Fed. R. Civ. P. 26(e)

(1) ***In General.*** *A party who has made a disclosure under Rule 26(a)—or who responded to an interrogatory, request for production, or request for admission—must supplement or correct its disclosure or response:*

(A) *in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing; or*

(B) *as ordered by the court.*

(2) ***Expert Witness.*** *For an expert whose report must be disclosed under Rule 26(a)(2)(B), the party's duty to supplement extends both to information included in the report and to information given during the expert's deposition. Any additions or changes to this information must be disclosed by the time the party's pretrial disclosures under Rule 26(a)(3) are due.*

The duty to supplement disclosures and discovery responses in proceedings before the Board is governed by Fed. R. Civ. P. 26(e)(1) and (2). [Note 1.] Under that rule, a party that has made an initial or expert disclosure or has responded to a request for discovery with a response is under a duty to supplement or correct the response in a timely manner to include information under the particular circumstances specified in paragraphs(e)(1) and (2). [Note 2.] However, if the information has otherwise been made known to the propounding party during the discovery process such as through a witness deposition or formal discovery, or was otherwise made known in writing, the answering party need not amend its prior response or previously made disclosure. [Note 3.] This is not an invitation, however, to hold back material items and disclose them at the last minute. [Note 4.] A party who does so may be subject to the preclusion sanction set forth in Fed. R. Civ. P. 37(c)(1). [Note 5.] However, where there is prompt supplementation of the disclosure, either upon the initiative of the disclosing party, or after notification by the adverse party that the disclosure was incomplete, and while the discovery period remains open, the Board's policy is that neither the testimony to be proffered by the expert witness nor the information originally omitted will be excluded. [Note 6.] Subsections (A) and (B) of Fed. R. Civ. P. 37(c)(1) do not apply in Board proceedings.

In addition, a duty to supplement disclosures or responses may be imposed by order of the Board. [Note 7.]

An expert report introduced during trial that contains additional opinions intended to rebut an adverse party's testimony, rather than to correct inaccuracies in the expert's report or deposition or to complete an otherwise incomplete earlier expert report with newly discovered information. does not qualify as a supplemental expert report under Rules 26(e)(1)(A) and 26(e)(2). [Note 8.]

NOTES:

1. *See* 37 CFR § 2.116(a).

2. *See Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242-43 (TTAB 2012) (witness first identified in pretrial disclosure could have been identified in supplementary initial disclosures, discovery responses or supplemental discovery responses); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326-27 (TTAB 2011) (opposer was under a duty to supplement its discovery responses and disclosing for the first time in its pretrial and amended pretrial disclosures the identities of twenty-seven witnesses resulted in

surprise to applicant); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1892 (TTAB 2011) (respondent supplemented its expert disclosures as soon as the deficiencies were brought to its attention so Board did not need to consider question of whether the omissions were substantially justified or harmless); *Vignette Corp. v. Marino*, 77 USPQ2d 1408 (TTAB 2005); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998).

3. *See Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1345 n.7 (TTAB 2013) (party not required to supplement or correct initial disclosures to provide identifying information about witness listed in pretrial disclosures if that information previously has been made known to the other party in writing or during the discovery process); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (opposer's failure to supplement its initial disclosures to identify foreign non-party witness as a potential witness does not preclude introduction of witness' discovery deposition at trial, even though opposer should have supplemented initial disclosures, because applicant was aware of witnesses' identity and subject matter of her testimony and was able to cross-examine the witness during the discovery phase). *See also* Fed. R. Civ. P. 26(e) Advisory Committee Notes (1993 amendment to Rule 26(e)) ("no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process, as when a witness not previously disclosed is identified during the taking of a deposition…"). *Cf. Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB2010) (although identity of witness disclosed through responses to written discovery, pretrial disclosures required to be revised to limit witness testimony to certain subject matter).

4. *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009).

5. *See Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1562-63 (TTAB 2014) (estoppel sanction applies to untimely disclosure of expert opinion); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (estoppel sanction imposed where witness first identified in pretrial disclosure); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326, 1328 (TTAB 2011) (estoppel sanction imposed with respect to the witnesses first disclosed in the amended and supplemental pretrial disclosures); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1177 (TTAB 2010) (party warned during teleconference that it may be subject to the preclusion sanction where it "claimed" to have produced all responsive documents in its possession); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (opposer's request for reconsideration of Board order denying its motion for summary judgment denied; Board properly considered applicant's declaration provided on summary judgment, reasoning that it would be "unfair to foreclose applicant from the opportunity to amplify the assertions made in his previous discovery responses in order to defend against opposer's motion for summary judgment"). *See also Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014) (declining to apply estoppel sanction with regard to opposer's failure to supplement discovery in connection with non-party witnesses and documents, which information was not available until after the close of discovery); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (deficiencies in timely expert disclosures cured promptly, motion to exclude expert testimony denied); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859 (TTAB 2009) (because identity of non-party witness was made known during the discovery phase of the proceeding with more than two months remaining in discovery period and applicant had an opportunity to obtain additional discovery about witness, opposer's failure to supplement its initial disclosures did not preclude introduction of deposition at trial).

6. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1892 (TTAB 2011). *Cf. Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (testimony of witnesses first identified in supplemental pretrial disclosures made five days after service of amended pretrial disclosures made not excluded based on alleged untimeliness).

7. *See Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010) (party ordered to serve revised pretrial disclosures). *Cf. Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 434 n.8 (TTAB 1985); *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60, 62 (TTAB 1982); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801, 805 (CCPA 1978).

8. *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1562 (TTAB 2014).

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

37 CFR § 2.120(j)(6) *Paragraph (j) of this section will not be interpreted to preclude reading or use of written disclosures or documents, 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.*

* * * *

37 CFR § 2.120(j)(8) *Written disclosures or disclosed documents, 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 disclosure or discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

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

(1) With a motion relating to discovery (e.g., motion to compel, motion to determine the sufficiency of an answer or objection to a request for admission, motion for leave to serve additional interrogatories, motion to challenge the sufficiency of initial or expert disclosures);

(2) In support of or in response to a motion for summary judgment;

(3) Under a notice of reliance during a party's testimony period, to the extent that the discovery response or disclosure may properly be submitted by notice of reliance; [Note 1] or

(4) As exhibits to a testimony deposition.

While a party that has disclosed to an adverse party or parties that it will or may use expert testimony should not file with the Board copies of the documents and information being disclosed to the adverse party or parties, it should file with the Board a notice that it has made such a disclosure. [Note 2.] "Any party disclosing plans to use an expert must notify the Board that it has made the required disclosure. The Board may then suspend proceedings to allow for discovery limited to experts. The suspension order may anticipate and also provide for discovery regarding any expert that may subsequently be retained for rebuttal purposes." [Note 3.]

Pretrial disclosures, *see* 37 CFR § 2.121(e), are not discovery period disclosures, as are initial disclosures and expert disclosures. However, like the latter, neither pretrial disclosures nor notification of service of pretrial disclosures need be filed with the Board, unless a motion to strike evidence or testimony of a witness has been filed. [Note 4.] For further information on pretrial disclosures, see TBMP § 702.01.

In addition, when a party objects to proffered evidence or files a motion to strike the testimony of a witness on the ground that the name of the witness or the identification of documents or other evidence should have been, but was not, provided in response to a request for discovery or in disclosures (whether initial, expert or pretrial), a copy of the pertinent discovery request(s) and response(s) or disclosures should be submitted in support of the objection or motion to strike.

For more information regarding the filing of discovery material, see the cases cited in the note below. [Note 5.]

NOTES:

1. *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (ordinarily, an answer to an interrogatory may be submitted and made part of the record by only the inquiring party, i.e., a party generally may not rely on his own responses to discovery requests under a notice of reliance; the only produced documents that may be submitted by a notice of reliance under 37 CFR § 2.122(e) are printed publications and official records); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008) (the categories of materials which may be submitted under a notice of reliance are limited, consisting only of an adverse party's discovery deposition, answer to an interrogatory, or admission to a request for admission, 37 CFR § 2.120(j)(3)(i); printed publications and official records, 37 CFR § 2.122(e)); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 n.3 (TTAB 2007) (written response to document requests that no such documents exist can be made of record by notice of reliance); *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 n.6 (TTAB 2007) (opposer filed a notice of reliance, pursuant to 37 CFR § 2.120(j)(3)(i), on the request for admission, the exhibits thereto, and its adversary's response by which adversary admitted that documents produced in response to discovery requests were authentic for purposes of admission into evidence during testimony period of opposition proceeding); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103-04 (TTAB 2007) (because respondent availed itself under Fed. R. Civ. P. 33(d) of the option to provide documents in response to petitioner's interrogatories and admitted via a request for admission that the documents it produced were true and correct copies of authentic documents, the documents could be introduced by way of notice of reliance); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007)(applicant's catalog, produced in lieu of an interrogatory response, is therefore permissibly made of record by opposer's notice of reliance); and *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1266 n.15 (TTAB 2003) (if documents are offered in response to an interrogatory, they are admissible under 37 CFR § 2.120(j)(3)(i)).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007); 37 CFR § 2.120(a)(2). *But see General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (37 CFR § 2.120(a)(2) does not mandate that a disclosing party inform the Board that an expert disclosure has been made).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See also General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (the purpose of informing the Board of such a disclosure is to facilitate discovery, including a suspension of proceedings, but notification to the Board may not be necessary if expert-related discovery can be concluded by the close of discovery).

4. *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 (TTAB 2011) (no reason to file routinely pretrial disclosures with the Board).

5. *See* 37 CFR § 2.120(j)(6) and 37 CFR § 2.120(j)(8). *See also Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473 (TTAB 2014) (rebuttal disclosures are not a means for filing evidence); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1428 (TTAB 2013) (supplemental discovery responses, like all discovery, should not be filed with the Board except under circumstances specified in 37 CFR § 2.120(j)(8)); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1542 n.2 (TTAB 2008) (opposer reminded that initial and expert disclosures are not to be filed with the Board, except under circumstances specified in 37 CFR § 2.120(j)(8)); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479, 1480 (TTAB 1990) (regarding combined sets of interrogatories which are subject to a motion relating to discovery); *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990) (to be considered on summary judgment, responses to discovery requests must be submitted with motion or responsive brief), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1070 (TTAB 1987) (respondent again reminded that discovery materials are not to be filed with the Board except under circumstances specified in 37 CFR § 2.120(j)(8)); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979) (filing of a discovery deposition not required or desired in the absence of a notice of reliance).

410 Asserting Objections to Requests for Discovery, Motions Attacking Requests for Discovery, and Disclosures

The rules governing discovery in proceedings before the Board provide both for the assertion of objections to discovery requests believed to be improper, and a means (namely, the motion to compel, in the case of discovery depositions, interrogatories, and requests for production; and the motion to test the sufficiency of answers or objections, in the case of requests for admission) for testing the sufficiency of those objections.

However, a party which fails to respond to discovery requests during the time allowed therefor and which is unable to show that its failure was a result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery requests on their merits. [Note 1.] *See also* TBMP § 407.01. Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. [Note 2.] In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information. Objections based on the confidentiality of information or matter being sought are expected to be minimal in view of the automatic imposition of the Board's standard protective order for cases pending or commenced as of August 31, 2007. [Note 3.] *See* TBMP § 412. The Board generally is not inclined to hold a party to have waived the right to make these objections, even where the party is otherwise held to have waived its right to make objections to the merits of discovery requests. [Note 4.]

In addition, for proceedings commenced on or after November 1, 2007, failure to serve initial disclosures constitutes a proper ground for objection to discovery requests. [Note 5.] As a corollary, if a party believes it need not respond to discovery requests because the propounding party has not served initial disclosures, it has a duty to object on that basis. [Note 6.]

It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those requests or portions of requests that it believes

to be proper, and stating its objections to those requests or portions of requests that it believes to be improper. [Note 7.]

Further, if a party on which interrogatories have been served, for a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the responding party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number; a motion for a protective order is not the proper method for raising the objection of excessive number. [Note 8.] *See* TBMP § 405.03(e) (Remedy for Excessive Interrogatories).

Nevertheless, there are some situations in which a party may properly respond to a request for discovery by filing a motion attacking it. In cases where a request for discovery constitutes clear harassment, for example, when a clearly unreasonable number of requests for production or requests for admission are served, or on which a request for discovery has been served and the receiving party is not and was not, at the time of the commencement of the proceeding, the real party in interest, the party on which the request was served may properly respond to it by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. [Note 9.]

A party on which a notice of deposition was served may file either a motion to quash the notice of deposition or a motion for a protective order in certain circumstances, for example, if the notice of deposition can be shown to be insufficient, vague or unclear; if the notice would result in the inquiring party exceeding the permitted number of discovery depositions absent a stipulation or upon prior leave granted by the Board; or if the notice would result in a deposition being taken outside the discovery period. [Note 10.] *See also* TBMP § 521 (Motion to Quash Notice of Deposition) and TBMP § 526 (Motion for a Protective Order).

Parties may object to or challenge the sufficiency of initial disclosures or expert disclosures by filing a motion to compel. [Note 11.] Initial disclosures must comply with the requirements set forth in Fed. R. Civ. P. 26(a)(1)(A) and (E) and expert disclosures must comply with the requirements set forth in Fed. R. Civ. P. 26(a)(2). A motion to compel initial disclosures or expert testimony disclosures must be filed prior to the close of the discovery period. [Note 12.] The filing of a motion to compel initial disclosures is a prerequisite to the filing of a motion for sanctions for failure to make initial disclosures or for making insufficient initial disclosures. [Note 13.] For further information concerning disclosures and motions to compel disclosures, see TBMP § 401 and TBMP § 523.

NOTES:

1. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwick Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979); *McMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979); *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975).

2. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

3. *See* 37 CFR § 2.116(g).

4. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

5. *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d1889, 1892 (TTAB2010).

6. *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (opposer's mistaken belief that applicant failed to serve initial disclosures does not excuse opposer's failure to substantively respond to applicant's discovery requests or to assert an objection on that basis).

7. *See Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1863 (TTAB 2001) (burden is on the party seeking the information to establish why it is relevant); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections to interrogatories with particularity); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127, 128 (TTAB 1976) (a motion to strike interrogatories is improper; objections to interrogatories should be served upon the interrogating party); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690, 691 (TTAB 1975) (opposer's motion to be relieved of its obligation to respond to applicant's requests for admissions denied as "manifestly inappropriate;" opposer must either respond to the requests or state its objections thereto); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126, 127 (TTAB 1974); *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606, 607 (TTAB 1974).

8. 37 CFR § 2.120(d)(1).

9. *See, e.g.* , Fed. R. Civ. P. 26(c); 37 CFR § 2.120(f); Fed. R. Civ. P.36 Advisory Committee notes (1970 amendment) ("requests to admit may be so voluminous and so framed that the answering party finds the task of identifying what is in dispute and what is not unduly burdensome. If so, the responding party may obtain a protective order under Rule 26(c)"); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1266 (TTAB 2015) (protective relief granted; service of over 1000 discovery requests the first two days of the discovery period was excessive, unduly burdensome, and harassing); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1566 (TTAB 2014) (protective order sought to prevent deposition of testifying expert redesignated as non-testifying expert); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (party may file request for protective order for harassing and oppressive requests for admissions).

10. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (Board granted motion to quash where deposition was noticed during the discovery period but deposition was to be taken after discovery closed). *See, e.g.*, *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (motion for protective order) and *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash).

11. 37 CFR § 2.120(e); *Influance v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (petitioner's motion to compel amended initial disclosures granted where respondent failed to identify the address or telephone number of listed witnesses, the subject matter(s) about which each has information, and the location or production of identified documents).

12. 37 CFR § 2.120(e).

13. *See Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

411 Remedy for Failure to Provide Disclosures or Discovery

411.01 Initial and Expert Testimony Disclosures

In inter partes proceedings commenced on or after November 1, 2007, if a party fails to provide any adverse party with required initial disclosures or expert testimony disclosures, the adverse party may file a motion to compel. [Note 1.] A motion to compel initial disclosures or expert testimony disclosures must be filed prior to the close of the discovery period. [Note 2.] For further information concerning motions to compel, see TBMP § 523. A party may not seek entry of sanctions against an adverse party that has failed to make required initial or expert disclosures without first pursuing the disclosures by motion to compel. [Note 3.] For further information concerning discovery sanctions and when they are available, see TBMP § 527.01. For information regarding a party's failure to make pretrial disclosures, see TBMP § 702.01.

NOTES:

1. 37 CFR § 2.120(e); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42256 (August 1, 2007) ("A motion to compel is the available remedy when an adversary has failed to make, or has made inadequate, initial disclosures or disclosures of expert testimony. Both of these types of disclosures are made during discovery, and a motion to compel must precede a motion for sanctions."). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012) (motion to compel is available remedy for failure to serve, or insufficient, initial disclosures); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) (motion to compel available for inadequate expert disclosures); *Influance v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (petitioner's motion to compel amended initial disclosures granted where respondent failed to identify the address or telephone number of listed witnesses, the subject matter(s) about which each has information, and the location or production of identified documents).

2. 37 CFR § 2.120(e); *Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1878-79 (TTAB 2012) (motion to compel for failure to serve initial disclosures is to be filed prior to the close of the discovery period).

3. 37 CFR § 2.120(g)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42256 (August 1, 2007) ("A motion for sanctions is only appropriate if a motion to compel these respective disclosures has already been granted."); *Amazon Technologies v. Wax* , 93 USPQ2d 1702, 1706 (TTAB 2009) (motion for sanctions under 37 CFR § 2.120(g)(1) denied as premature where no Board order in place compelling discovery). *But see* 37 CFR § 2.120(g)(2); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (discussing both 37 CFR §§2.120(g)(1) and (g)(2)).

411.02 Interrogatories or Requests for Production

If any party fails to answer any interrogatory, the party seeking discovery may file a motion with the Board for an order to compel an answer. [Note 1.] Similarly, if any party fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion for an order to compel production and an opportunity to inspect and copy. [Note 2.] The party seeking interrogatory responses or production of documents may not seek immediate entry of sanctions for no response unless the responding party has expressly informed the inquiring party that no response will be made to the discovery requests. [Note 3.]

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

NOTES:

1. 37 CFR § 2.120(e).

2. 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a)(3)(B).

3. 37 CFR § 2.120(g)(2). *Cf. Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (regarding disclosures); *HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1906 (TTAB 2008) ("Under Trademark Rule 2.120(g)(2), if a party witness fails to attend a discovery deposition after receiving proper notice, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no such attendance will take place, the Board may enter sanctions against that party.").

411.03 Requests for Admission

If a party on which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board. [Note 1.] *See* TBMP § 407.03(a) (Time for Service of Responses). For information on motions to withdraw or amend admissions, see TBMP § 525.

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response or objection. [Note 2.] If the Board determines that a response does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that a response be served. [Note 3.] In instances, however, where a request for admission is either admitted or denied, such admissions or denials constitute a proper response even if the response also includes objections. [Note 4.] The requesting party therefore should refrain from challenging the sufficiency of the response.

For information on motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.

NOTES:

1. *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (contrasting standard of review for motion to reopen time to respond to requests for admission and for motion to withdraw requests that stand admitted); *Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990).

2. Fed. R. Civ. P. 36(a); 37 CFR § 2.120(h).

3. Fed. R. Civ. P. 36(a).

4. Fed. R. Civ. P.36(a).

411.04 Discovery Depositions

If a party fails to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(4), or if a party or such designated person, or an officer, director or managing agent of a party, fails to attend a discovery deposition, or fails to answer any question propounded in a discovery deposition, the party seeking discovery may file a motion with the Board for an order to compel a designation, or attendance at a deposition, or an answer. [Note 1.] For information concerning motions to compel, see TBMP § 523. Because the Board does not have jurisdiction over a non-party witness, a motion to compel is not available as a remedy when such a witness refuses a request for deposition. However, if the deposing party has secured the non-party's attendance by obtaining a subpoena from an appropriate United States district court, *see*35 U.S.C. § 24, the subpoena may be enforced by returning to the issuing court. *See* TBMP § 404.03(a)(2). Similarly, if a non-party witness has appeared voluntarily for a deposition, but refuses to answer particular questions propounded during the deposition, the deposing party must seek relief from an appropriate United States district court and may not file a motion to compel with the Board.

A discovery deposition is taken out of the presence of the Board. Therefore, if the witness being deposed, or the attorney for the witness, believes a question is improper, an objection may be stated, but the question normally should be answered subject to the stated objection. However, if a witness being deposed objects to, and refuses to answer, or is instructed by counsel not to answer, a particular question, and if the deposition is being taken pursuant to a subpoena, the propounding party may attempt to obtain an immediate ruling on the propriety of the objection by adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. [Note 2.] *See* TBMP § 404.08(c). In the absence of a court order the propounding party's only alternative, if it wishes to compel a response, is to complete the deposition and then file a motion to compel with the Board.[Note 3.]

NOTES:

1. 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a).

2. *See Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

3. 37 CFR § 2.120(e). *See Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (if a party fails or refuses to answer any proper question during the taking of a discovery deposition, the party may file a motion to compel with the Board).

411.05 Sanctions Related to Disclosures and Discovery

In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide disclosures or discovery pursuant to 37 CFR § 2.120(g). [Note 1.] The Board also may impose sanctions against the non-cooperating party for failure to participate in the discovery conference. [Note 2.] *See* TBMP § 408.01(a).The Board's authority to enter sanctions for conduct or misconduct related to disclosures or discovery is rooted in Fed. R. Civ. P. 37, most portions of which are made applicable to Board proceedings by 37 CFR § 2.116 (certain portions of Fed. R. Civ. P.37 are, on their face, irrelevant to Board proceedings). The range of sanctions listed in Fed. R. Civ. P. 37(b)(2), and which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; drawing adverse inferences against uncooperative party; prohibiting the disobedient party from introducing designated matters in evidence; and

entering judgment against the disobedient party. A sanction also "can consist of requiring a party to take an action which it would not otherwise be required to take by applicable rules, or to refrain from taking an action it would otherwise take." [Note 3.] However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 4.]

For further information concerning discovery sanctions and when they are available, see TBMP § 527.01.

For information regarding attorneys' fees in Board proceedings, see TBMP § 502.05.

NOTES:

1. *See, e.g., Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) (Board imposed sanctions pursuant to 37 CFR § 2.120(g)(1)); opposer ordered to serve index of produced documents, supplemental answers to certain interrogatories; discovery reopened for applicant only); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (as a sanction, party required to study certain TBMP sections and to file a statement with the Board certifying completion of the task, to prepare complete set of responses to discovery requests, to consult with opposing counsel to ensure responses are appropriate, and to forward copies to counsel).

2. *Promgirl, Inc., v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009); *Guthy-Renker Corp. v. Michael Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008).

3. *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 n.11 (TTAB 1999).

4. 37 CFR § 2.120(g)(1) and 37 CFR § 2.120(g)(2); 37 CFR § 2.127(f).

412 Protective Orders

37 CFR § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site, or upon request, a copy will be provided. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board.*

Excerpts from Board's Standard Protective Order:

1) Classes of Protected Information.

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

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

Confidential – Attorneys' Eyes Only (Trade Secret/Commercially Sensitive) *- Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraphs 4 and 5, by independent experts or consultants for the parties. Such material may include the following types of information: (1) sensitive technical information, including current research, development and manufacturing information; (2) sensitive business information, including highly sensitive financial or marketing information; (3) competitive technical information, including technical analyses or comparisons of competitor's products or services; (4) competitive business information, including non-public financial and marketing analyses, media scheduling, comparisons of competitor's products or services, and strategic product/service expansion plans; (5) personal health or medical information; (6) an individual's personal credit, banking or other financial information; or (7) any other commercially sensitive information the disclosure of which to non-qualified persons subject to this Order the producing party reasonably and in good faith believes would likely cause harm.*

2) Information Not to Be Designated as Protected.

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

3) Access to Protected Information.

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

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

Parties *are defined as including individuals, officers of corporations, partners of partnerships, members of limited liability companies/corporations, and management employees of any type of business organization.*

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

Independent experts or consultants *include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not current or former employees, officers, members, directors, or partners of any party, affiliates of any party, or the attorneys of any party or its affiliates, or competitors to any party, or employees or consultants of such competitors with respect to the subject matter of the proceeding.*

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

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

Outside counsel, but not in-house counsel, *shall have access to information designated as* ***Confidential – Attorneys' Eyes Only (trade secret/commercially sensitive).***

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

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

Fed. R. Civ. P. 26(c)(1) ***In General.*** *A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending — or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:*

(A) *forbidding the disclosure or discovery;*

(B) *specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;*

(C) *prescribing a discovery method other than the one selected by the party seeking discovery;*

(D) *forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;*

(E) *designating the persons who may be present while the discovery is conducted;*

(F) *requiring that a deposition be sealed and opened only on court order;*

(G) *requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and*

(H) *requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.*

Fed. R. Civ. P. 26(c)(2) ***Ordering Discovery.*** *If a motion for a protective order is wholly or partly denied, the court may, on just terms, order that any party or person provide or permit discovery.*

Protective orders in the context of Board inter partes proceedings refer to (1) the Board's standard protective order governing the exchange of information and materials and modifications thereto, and (2) motions for protective orders pursuant to 37 CFR § 2.120(f). "to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, . . ." Both types of protective orders are discussed below.

412.01 In General – Board Standard Protective Order

For inter partes proceedings pending or commenced on or after August 31, 2007, the Board's standard protective order is automatically in place to govern the exchange of information unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. [Note 1.] The Board's notice of institution will advise parties that the standard protective order applies, and that parties may view the Board's standard protective order at the USPTO website at **www.uspto.gov**. [Note 2.] It is not necessary for the parties to sign copies of the Board's protective order for it to take effect, although it may be desirable to sign for other reasons. *See* TBMP § 412.03. Cases commenced prior to August 31, 2007 in which a protective order has already been approved or imposed by the Board are not affected.

The Board's standard protective order provides for two tiers of protected information (1) Confidential and (2) Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive). Parties and their attorneys shall have access to information designated as confidential, subject to any agreed exceptions. Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive. Parties and those parties or individuals appearing pro se will not have access to information designated as "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)". In cases involving independent experts or consultants, non-party witnesses, or any individual not falling within the definition of a party or attorney, such individuals must sign an acknowledgement form agreeing to be bound by the standard protective order during and after the proceedings, as a condition for obtaining access to protected information. [Note 3.] The Board has the authority to sanction attorneys and individuals determined to be in breach during a proceeding. [Note 4.] *See also* TBMP § 527.

In Board proceedings, access to a party's "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" is not provided as a matter of course, but rather must only be provided in response to a proper and relevant discovery request or when the party chooses to use such information in support of its case at trial. [Note 5.] The Board's standard protective order does not automatically protect all information. [Note 6.] Parties must actively utilize the provisions when seeking to designate protected information. [Note 7.] Thus, the burden falls on the party seeking to designate information as protected. If a party fails to designate a discovery response or submission as confidential under the terms of the protective order and/or redact confidential portions thereof, the confidentiality of the information is deemed waived. [Note 8.] Nonetheless, when responding to discovery or filing submissions before the Board, the party seeking to designate information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" has a duty to make a meaningful effort to designate only that information that warrants the designated level of protection. [Note 9.] For information regarding the designation of material as confidential and procedures regarding redaction at trial, see TBMP § 703.01(p).

Parties cannot withhold properly discoverable information on the basis of confidentiality since the terms of the Board's standard protective order automatically apply. [Note 10.] In instances where a party has refused to provide discoverable information on such grounds, the Board, where appropriate, may order the party to provide such information consistent with the terms of the protective order. [Note 11.]

Parties are free to modify the terms of the Board's standard protective order, and are encouraged to discuss any proposed modifications during their discovery conference. [Note 12.] For further information regarding modifications to the Board's standard protective order upon stipulation,see TBMP § 412.02(a).

Apart from protective orders protecting a party's information, the Board may issue protective orders addressing other issues. On motion pursuant to 37 CFR § 2.120(f), showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (A) through (H) of Fed. R. Civ. P. 26(c). [Note 13.] *See also* TBMP § 527 and TBMP § 703.01(p). To establish good cause, the movant must submit "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." [Note 14.] The moving party seeking a protective order bears the burden of showing good cause. The movant must demonstrate that its ability to litigate will be prejudiced, not merely increase the difficulty of managing the litigation. [Note 15.] Among the types of discovery orders that may be entered, the Board has the discretion to enter a protective order that a discovery deposition not be had or that requests for admissions need not be answered. [Note 16.] The applicability of the Board's standard protective order does not preclude a party, when appropriate, from moving for a protective order under applicable Trademark or Federal Rules, when the Board's standard order does not cover the extant circumstances or is viewed by the moving party as providing insufficient protection. [Note 17.] For further information on motions for protective orders, see TBMP § 410 (Motions Attacking Requests for Discovery), TBMP § 412.02 and TBMP § 526.

NOTES:

1. 37 CFR § 2.116(g); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007). *See, e.g., Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1544 (TTAB 2009).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007). The standard protective order can viewed on the Board's home page of the USPTO website at **www.uspto.gov**.

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42251 (August 1, 2007). *See e.g., Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (while trade secret/commercially sensitive information as to witness identity was protectable during discovery, once party relied on testimony of so designated witness at trial, identity of witness designated as trade secret/commercially sensitive waived), *on appeal*, No. 14-CV-4463 (D. Minn.).

6. 37 CFR § 2.116(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

7. *See* 37 CFR § 2.116(g); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

8. *See, e.g., Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

9. *See, e.g., Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (Board proceedings are designed to be transparent to the public and the contents of proceeding files publicly available; improper designation of materials as confidential thwarts that intention); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (excessive markings of various information as confidential complicates record and often indicates that matter is improperly designated or not useful to case), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (parties to refrain from improperly designating evidence or a show cause order may issue); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (finding that information concerning expert's credentials and background were overdesignated as confidential or highly confidential in expert report and granting motion to redesignate that portion of the expert report as non-confidential); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

10. *See, e.g., Intex Recreation Corp. v The Coleman Co.*, 117 USPQ2d 1799, 1801 (TTAB 2016) (party may not redact confidential information from documents responsive to document requests); *Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009).

11. 37 CFR § 2.120(g).

12. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

13.*See* Fed. R. Civ. P. 26(c)(1); 37 CFR § 2.120(f). *See, e.g., Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005).

14. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (finding opposer's allegations of undue burden and expense "merely conclusory.").

15. *A. Hirsh, Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (citing *A. Hirsh Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987)).

16. *See, e.g., The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (granting protective order with regard to 94 duplicative requests for admissions and those that sought admissions as to unpleaded registrations); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1675 (TTAB 2005) (applicant's motion for protective order to prevent taking of additional discovery depositions is granted as to three out of six employees of applicant who were to be deposed).

17. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

412.01(a) Proper Designation of Confidential Matter

Excerpts from Board's Standard Protective Order:

1) Classes of Protected Information.

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

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

Confidential – Attorneys' Eyes Only (Trade Secret/Commercially Sensitive) *- Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by* ***outside counsel*** *for the parties and, subject to the provisions of paragraphs 4 and 5, by independent experts or consultants for the parties. Such material may include the following types of information: (1) sensitive technical information, including current research, development and manufacturing information; (2) sensitive business information, including highly sensitive financial or marketing information; (3) competitive technical information, including technical analyses or comparisons of competitor's products or services; (4) competitive business information, including non-public financial and marketing analyses, media scheduling, comparisons of competitor's products or services, and strategic product/service expansion plans; (5) personal health or medical information; (6) an individual's personal credit, banking or other financial information; or (7) any other commercially sensitive information the disclosure of which to non-qualified persons subject to this Order the producing party reasonably and in good faith believes would likely cause harm.*

2) Information Not to Be Designated as Protected.

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

14) Challenges to Designations of Information as Protected.

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

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time. The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

37 CFR § 2.27(c) ***Pending trademark application index; access to applications.*** *Decisions of the Director and the Trademark Trial and Appeal Board in applications and proceedings relating thereto are published or available for inspection or publication.*

37 CFR § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site, or upon request, a copy will be provided. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board.*

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

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).*

Fed. R. Civ. P. 26(c) ***Protective Orders.***

(1) *In General. A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending—or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:*

(A) *forbidding the disclosure or discovery;*

(B) *specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;*

(C) *prescribing a discovery method other than the one selected by the party seeking discovery;*

(D) *forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;*

(E) *designating the persons who may be present while the discovery is conducted;*

(F) *requiring that a deposition be sealed and opened only on court order;*

(G) *requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and*

(H) *requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.*

(2) *Ordering Discovery. If a motion for a protective order is wholly or partly denied, the court may, on just terms, order that any party or person provide or permit discovery.*

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

(1) *Signature Required; Effect of Signature. Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name—or by the party personally, if unrepresented—and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made; and*

(B) *with respect to a discovery request, response, or objection, it is:*

(i) *consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;*

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

(iii) *neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.*

The imposition of the Board's standard protective order upon commencement of the Board proceeding [Note 1] is designed to facilitate the exchange of information in connection with disclosures and during pretrial discovery by allowing parties to designate materials as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" without a preliminary showing of good cause under 37 CFR § 2.120(f) and Fed. R. Civ. P. 26(c). The Board's standard protective order is a blanket protective order [Note 2] which does not automatically protect all information [Note 3] but allows parties to designate in good faith only those items a party and/or its counsel believes are subject to protection. [Note 4.]

Parties must actively utilize the provisions in the Board's standard protective order to designate information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)". [Note 5.] Thus, the burden falls on the party seeking to designate information as protected, and if a party fails to designate the information as protected under the terms of the Board's standard protective order and/or redact "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" portions thereof, the confidentiality of the information is deemed waived. [Note 6.]

Because a confidential designation of discovery or deposition testimony or other information limits what an opposing party can do with the materials and is one step removed from filing documents under seal, producing parties or their counsel are expected to act in good faith in designating information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" under the terms of the Board's standard protective order. [Note 7.] The fact that the Board's standard protective order is automatically entered upon commencement in a Board proceeding does not give a party unbridled authority to designate its discovery responses and production as protected. [Note 8.] When responding to discovery, the party seeking to designate information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" has a duty to make a meaningful good faith effort to designate only that

information that warrants the designated level of protection, if any. [Note 9.] It is improper for a party to designate all produced discovery as confidential under the Board's standard protective order. Producing parties should designate only those particular discovery responses, documents, deposition exhibits, and depositions transcript pages as confidential within the scope of and consistent with the protective order entered in the proceeding. See TBMP § 408.01 regarding a party's duty to cooperate with regard to discovery.

The designations "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" should be limited to information that the producing party or their counsel has determined, in good faith, contains, reflects, or reveals non-public, confidential, proprietary or commercial information that is not readily ascertainable through proper means by the public or the receiving party, to the extent that information either is the type of information that the party normally attempts to protect from disclosure or is subject to privacy protection under federal, state or local law. [Note 10.]

The designation "trade secret" should be limited to any information that the producing party or their counsel has determined in good faith "can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others." [Note 11.] Information that is confidential or that imparts private information may require a different level of protection than information that may be considered a trade secret or commercially sensitive. [Note 12.] Information which may not be designated as subject to any form of protection includes information that is or becomes publicly available or information that has been disclosed to the public or a third party, under the circumstances specifically set forth in the Board's standard protective order. [Note 13.]

While there is no preliminary showing of good cause required for designations under the Board's standard protective order, such a showing can be triggered by the receiving party raising an issue with respect to a party's designation as to any documents, information or testimony. Thus, the party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected. [Note 14.]

The parties are expected to make a good faith effort to resolve disputes with regard to the propriety of challenged designations before bringing such matters to the Board. [Note 15.] The Board expects that disputes as to designations that are brought to the Board will be significantly narrow, resulting from the parties' mutual obligation to negotiate the propriety of the challenged designations and come to a resolution under the Board's standard protective order. [Note 16.]

See TBMP § 412.06 regarding the good faith effort required for motions for protective orders. *Cf.* TBMP § 523.02 and TBMP § 524.02 in regard to good faith efforts required for motions to compel and to test the sufficiency of responses to requests for admissions.

The Board's standard protective order is applicable during disclosures, discovery and at trial. [Note 17.] When filing submissions electronically as confidential in connection with motions, briefs or evidence via ESTTA (Electronic System for Trademark Trials and Appeals) or filing on paper, under seal, parties should designate only those particular discovery responses, exhibits, depositions transcript pages, or portions of a motion or brief as confidential consistent with and within the scope of the protective order entered in the proceeding. [Note 18.] A party may not improperly mark its filings as confidential so as to shield them from public view [Note 19] nor may the Board's standard protective order, or any modified protective agreement stipulated to by the parties, be used as a means of circumventing relevant provisions of 37 CFR § 2.27, which provides, that trademark application and registration files, and related TTAB proceeding files, generally should be available for public inspection. [Note 20.]

Any confidential filing must include redacted versions for the public record. *See* 37 CFR § 2.126. For any confidential unredacted version of a submission for which a redacted version must be filed, the parties are encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision.

Please Note: as part of general restyling, effective December 1, 2007, former Fed. R. Civ. P. 26(c)(1)(7) is now Fed. R. Civ. P. 26(c)(1)(G).

The Board's standard protective order is available for viewing at **http://www.uspto.gov**

NOTES:

1. 37 CFR § 2.116(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007); *Standard Form Agreement or Order for Protecting Confidentiality of Information and Documents Disclosed During Proceedings Before the Trademark Trial and Appeal Board*, O.G. Notice (June 20, 2000); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *See also Layne Christensen Co. v. Purolite Co.*, 271 F.R.D. 240, 246–47 (D. Kan. 2010) (tiered protective orders are commonly entered in cases involving intellectual property, trade secrets, and unique technological information, affording fuller protection to particularly sensitive information than is extended to ordinary business information).

2. *See Gillard v. Boulder Valley School District Re.-2*, 196 F.R.D. 382, 385-86 (D. Colo. 2000) (explaining the difference between "particular protective orders," "umbrella protective orders," and "blanket protective orders").

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

4. Fed. R. Civ. P. 26(g)(1) (requiring discovery responses to be "not interposed for any improper purpose"). *See Gillard v. Boulder Valley School District Re.-2*, 196 F.R.D. 382, 386 (D. Colo 2000) ("Normally, a blanket protective order requires that counsel for a producing party review the information to be disclosed and designate the information it believes, in good faith, is confidential or otherwise entitled to protection.").

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

6. 37 CFR § 2.116(g); *see , e.g. , Wet Seal, Inc. v. FD Management, Inc.* , 82 USPQ2d 1629, 1633 n.6 (TTAB 2007) (waiver of confidential designation of settlement agreement as the agreement was not redacted nor made confidential, was introduced as an exhibit during a deposition without mention of its confidential nature, and the parties openly discussed provisions of the agreement in their briefs). *But see* 37 CFR § 2.125(e); *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1189 n.1 (TTAB 2011) (granting opposer's motion to designate as confidential portions of testimony previously submitted without designation and setting aside original opinion in the case on that basis; opinion reissued), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 n.6 (TTAB 2001) (noting parties failed to submit under seal deposition testimony that had been marked as confidential and affording the parties 30 days from date of decision to file, for the record, redacted and confidential versions of those portions of testimony which were confidential).

7. Fed. R. Civ. P. 26(g)(1) (requiring discovery responses to be "not interposed for any improper purpose"). *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (party to be circumspect and to limit the "confidential" designation only to information that is truly confidential or commercially sensitive); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings); *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255, 1253 (N.D. Ill. 1993) (it is counsel's "place and responsibility" to ensure that the proper confidential designations are assigned to documents produced"); *Parkway Gallery Furniture, Inc. v. Kittinger/Pennsylvania House Group, Inc.*, 121 F.R.D. 264, 268 (M.D.N.C. 1988) (party to blanket protective order must invoke confidential designation in good faith). *See also Mancia v. Mayflower Textile Services Co.*, 253 F.R.D. 354, 358 (D. Md. 2008) (discussing Fed. R. Civ. P. 26(g) generally).

8. *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) ("the mere assertion that information is confidential does not make such designation proper."), *on appeal*, No. 14-CV-4463 (D. Minn.); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (excessive markings of various information as confidential often indicates that matter is improperly designated or not useful to case), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). *See, e.g.*, *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (with regard to its document production, party improperly used Attorney Eyes Only designation four times as often as lower confidentiality designation as well as improperly designated non-confidential matter as confidential; court ordered party to de-designate all of the Attorney's Eyes Only documents and reclassify them Confidential' or 'Non-confidential.).

9. Fed. R. Civ. P .26(g)(1); *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (party to be circumspect and to limit the "confidential" designation only to information that is truly confidential or commercially sensitive); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings). *See also THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (nothing prevented the defendants from designating the trade secret pages of a document as "confidential" and the admittedly public pages included therewith or attached thereto as "non-confidential"; some form of redaction along these lines would have indicated a bona fide approach to the court-ordered discovery); *Parkway Gallery Furniture, Inc. v. Kittinger/Pennsylvania House Group, Inc.*, 121 F.R.D. 264, 268 (M.D.N.C. 1988) (party to blanket protective order must invoke confidential designation in good faith). *See also Mancia v. Mayflower Textile Services Co.*, 253 F.R.D. 354, 358 (D. Md. 2008) (discussing Fed. R. Civ. P. 26(g) generally).

10. *See, e.g.*, *Layne Christensen Co. v. Purolite Co.*, 271 F.R.D. 240, 246 (D. Kan. 2010) (information that is designated as confidential prohibits the disclosure or dissemination of the information to third parties while "attorneys-eyes only" information is usually reserved for more sensitive information such as trade secret information, future product plans, competitive pricing, customer lists or competitive business financial information).

11. Restatement (Third) Unfair Competition § 39 (1995); *see also* Restatement of Torts (First) § 757, cmt. b (1939) (discussing six factors courts have considered in determining whether information is trade secret under the common law). *Black's Law Dictionary* (9th ed. 2009) (A "trade secret" is defined as "[a] formula, process, device, or other business information that is kept confidential to maintain an advantage over competitors; information — including a formula, pattern, compilation, program, device, method, technique, or process — that (1) derives independent economic value, actual or potential, from not being generally known or readily ascertainable by others who can obtain economic value from its disclosure or use, and (2) is the subject of reasonable efforts, under the circumstances, to maintain its secrecy.").

12. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010).

13. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *See e.g.*, *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (publicly available documents including catalogs, patents, books, magazines, technical journals and newspaper articles were non-confidential; confirmation letters regarding employee seminars, responses to business invitations, requests for permission to attend business trips and internal memos regarding public seminars were found non-confidential; memoranda or similar documents predicated upon or relating to public information which may be confidential, were not entitled to "attorneys eyes only" designation; customer documents that were innocuous and far from current were not entitled to "attorneys eyes only" designation but may be confidential); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460 (TTAB 2014) (improper designation of marketing materials that were distributed to respondent's purchasers and potential purchasers not confidential; presentation used to describe program directed to interested employer groups, associations, hospitals, schools that had no warning or legend that the information was trade secret and should be kept confidential, were not confidential); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014) (printout of shopping cart webpage available to the public is not confidential); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (user manuals for opposer's heart monitors distributed to opposer's purchasers and which contained no warning or legend advising they contained trade secrets and should be kept in a secure location were not confidential). *Cf. Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (If party designates more than a minimal amount of evidence as confidential or commercially sensitive and the information is more than 20 years old, party should anticipate an order to show cause why such information should warrant a designation as confidential and be shielded from public view).

14. 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c)(1).

15. Fed. R. Civ. P. 26(c)(1); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding* , O.G. Notice (June 20, 2000). *Cf.* 37 CFR § 2.120(e)(1); *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (good faith effort should be directed to understanding differences and investigating ways in which to resolve dispute); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) ("[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.")).

16. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (nature and the number of discovery requests subject to motion to compel clearly demonstrated that no good faith effort had been made by the parties).

17. 37 CFR § 2.116(g).

18. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (parties must make an attempt to delineate the truly confidential portions by redaction when filing submissions with the Board). *See also Baxter International Inc. v. Abbott Laboratories*, 297 F.3d 544, 63 USPQ2d 1859, 1859 (7th Cir. 2002) ("Secrecy is fine at the discovery stage, before the material enters the judicial record. . . . But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public

inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality.”).

19. *In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (public version of brief contained extensive markings as confidential which ignores the requirements of public access); *Baxter International Inc. v. Abbott Laboratories*, 297 F.3d 544, 63 USPQ2d 1859, 1859 (7th Cir. 2002) (“But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality.”); *United States v. Corbitt*, 879 F.2d 224, 228 (7th Cir. 1989) (citations omitted) (“ . . . the common law right of access creates a ‘strong presumption’ in favor of public access to material submitted as evidence in open court . . . the public’s right to inspect judicial documents may not be evaded by the wholesale sealing of court papers”).

20. *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001).

412.01(b) Challenging the Designation of Confidential Matter

Excerpt from Board’s Standard Protective Order:

14) Challenges to Designations of Information as Protected.

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

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time. The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

37 CFR § 2.116(g) *The Trademark Trial and Appeal Board’s standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office’s Web site, or upon request, a copy will be provided. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board’s standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board.*

Once information is designated as protected, its use and dissemination are circumscribed as provided in the Board’s standard protective order. [Note 1.] A party who disagrees with another party’s designation of protected information under the Board’s standard protective order may challenge the designation (i.e., “Confidential” or “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive)”. [Note 2.]

Circumstances by which a party may challenge a designation include a challenge to information as protected versus unprotected [Note 3], a challenge to the level of classification as protected [Note 4], and challenging the right to use protected information in connection with a dispositive motion or at trial (which could include both redesignation and access to the protected information). [Note 5.] A challenge to right to access protected information differs from a motion in limine which the Board does not consider. *See* TBMP § 527.01(f).

Prior to seeking Board intervention via in camera inspection as to the propriety of the designation of protected information, the parties must first attempt to negotiate in good faith to resolve or narrow the disagreement as to the producing party's designations. [Note 6.] The party challenging the confidentiality designation should initiate the meet and confer process by providing written notice of each challenged designation, i.e., specifically identify the confidential information or restriction on access in dispute, and describe the basis for each challenge in the written notice. [Note 7.] If, despite good faith effort and negotiation, the dispute cannot be resolved by the parties as to the challenged designations, the objecting party may seek relief from the Board by motion. [Note 8.] When a Board determination of the propriety of a designation is sought, the Board expects that any unresolved challenges will be significantly narrowed in scope due to the requirement for good faith negotiations among the parties as set forth in the Board's standard protective order. [Note 9.] During such a challenge, the initial designation would remain in place until the Board determines that it was, in fact, improper.

The Board has wide discretion under Rule 26(c) to "decide when a protective order is appropriate and what degree of protection is required." [Note 10.] Although a party may mark matter as confidential, Fed. R. Civ. P. 26(c)(1) "does not furnish an absolute privilege against disclosure of material that a party might wish to mark confidential." [Note 11.]

A motion to challenge a designation under the Board's standard protective order should be substantially contemporaneous with the designation, or made as soon as practicable after the basis for the challenge is known. [Note 12.] If a challenge is made long after designation, the party will be expected to demonstrate why it could not have made the challenge at an earlier time. [Note 13.] Thus, a designation may remain as designated if the party fails to timely challenge a designation and cannot show cause as to why the challenge as to the propriety of the designation was not made sooner. [Note 14.]

When a designation has been challenged, it is the party seeking protection that bears the burden of demonstrating that its confidentiality designations are appropriate. [Note 15.] To successfully carry the burden of establishing good cause, the producing party must demonstrate a particular need for protection and that a clearly defined and serious injury will result otherwise. [Note 16.] In this regard, the party must provide particular and specific demonstrations of fact, as distinguished from stereotyped and conclusory statements. [Note 17.]

To establish that a document or other information is entitled to protection from disclosure under Fed. R. Civ. P. 26(c)(1)(G), the producing party must show that the information is trade secret or other confidential information and that the disclosure would cause identifiable and serious harm. [Note 18.] Where the producing party seeking protection under Fed. R. Civ. P. 26(c)(1)(G) is a business that seeks to maintain designations related to confidential business information, the producing party must show that disclosure would cause a clearly defined serious injury to its business such as harm to its competitive and financial position. [Note 19.] Such a showing of harm to a party's business requires support, where possible, by affidavits or declarations and concrete, specific examples. [Note 20.]

"At the dispositive motions or trial stage of a proceeding, the showing necessary to justify continued designation of material as confidential increases, as the material at issue transitions from potential evidence produced during discovery to actual evidence to be used in disposition of the case, and a party's interest in

such a designation must be weighed against the traditional public right of access to judicial materials." [Note 21.] While information designated Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) is protectable during discovery from access by the adverse party, it may be no longer be subject to the same level of protection if a party chooses to rely on the information or testimony at trial and such designation has restricted the access of the adverse party to such information. [Note 22.] Use at trial may require that the adverse party have access to material designated as Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) for trial preparation. [Note 23.] An objecting party who seeks to use an adverse party's designated information, in connection with a dispositive motion or at trial, may seek to challenge the designation on that basis. [Note 24.] A party seeking to maintain protection of a confidential designation or the level of designation (i.e., "trade secret/commercially sensitive" versus "confidential") of challenged materials sought to be used by the objecting party in connection with a dispositive motion or at trial must establish with specificity that disclosure of the material will result in some kind of substantial harm to its business, and that such harm outweighs the necessity of the material to the dispositive motion or to trial practice. [Note 25.] In the case where redesignation of challenged material to a non-confidential designation is sought in connection with its use for a dispositive motion or at trial, the party seeking to maintain the designation must establish not only some kind of substantial harm to its business, but also that the harm to the party's business outweighs both the necessity of the material to the dispositive motion or to trial practice and to the traditional right to public access of judicial documents and records. [Note 26.] Nonetheless, information appropriately designated as Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) may remain under seal, even if relied on in connection with a dispositive motion or final decision, as the Board's standard protective order is applicable. [Note 27.]

Please Note: as part of general restyling, effective December 1, 2007, former Fed. R. Civ. P. 26(c)(1)(7) is now Fed. R. Civ. P. 26(c)(1)(G).

NOTES:

1. 37 CFR § 2.116(g); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000).

2. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (Board ordered redesignation of portions of expert report and deposition transcript as non-confidential based on party's challenge to designation).

3. *See e.g., THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (requiring redesignation of publicly available documents marked confidential as non-confidential); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (Board ordered redesignation of portions of expert report and deposition transcript as non-confidential).

4. *See e.g., THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (finding party had used "Attorney Eyes Only" classification four times as often as lower confidentiality designation and ordering party to "de-designate" all of the "Attorney's Eyes Only" documents and reclassify them "Confidential" or "Non-confidential").

5. *Beasley v. John Wiley & Sons, Inc.*, 111 USPQ2d 1623, 1631 (N.D. Ill. 2014) (party moved to provisionally file exhibits which had confidentiality designations with its summary judgment motion and sought leave to file the exhibits publicly, but once defendant withdrew the confidentiality designations for those exhibits, the court deemed the motion moot, allowing plaintiff to file an unredacted version of its summary judgment

motion with a public filing of the exhibits); *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 141 (D. Md. 2011) (plaintiff challenged defendants' designations in advance of the submission of dispositive motions, intending to include some of the challenged documents as exhibits to its summary judgment motion); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (so as to help prepare counsel for cross-examination of applicant's expert, Board required applicant to provide advance notice to opposer of plans to use expert report or to take expert testimony at trial, and in such a case, opposer's in-house technical experts may access portion of expert report and expert deposition transcript, which had been designated by applicant to allow only opposer's outside counsel access). *But see Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656, 1656 n.11 (TTAB 2014) (party unable to raise by motion the issue regarding "trade secret/commercially sensitive" designation of declaration testimony in ACR proceeding in advance of submission of declaration during adverse party's testimony period, as the Board does not entertain motions in limine), *on appeal*, No. 14-CV-4463 (D. Minn.).

6. Fed. R. Civ. P. 26(c)(1); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding* , O.G. Notice (June 20, 2000). *Cf.* 37 CFR § 2.120(e)(1); *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (good faith effort should be directed to understanding differences and investigating ways in which to resolve dispute) *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) ("[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.")).

7. *Cf. Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) ("In order for the meet and confer process to be meaningful and serve its intended purpose, "the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions;" nonmoving party under equal obligation to participate in good faith efforts to resolve the matter).

8. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 n.8 (TTAB 2010) (in connection with motion for sanctions, Board found, based on an in camera inspection, opposer properly designated produced materials as trade secret/commercially sensitive).

9. *Cf. Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (nature and the number of discovery requests subject to motion to compel clearly demonstrated that no good faith effort had been made by the parties).

10. *In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1147 (Fed. Cir. 2011) (Rule 26(c)(1) permits court to "issue limited protective orders to prevent the discovery or disclosure of certain information or to specify the use that may be made of the discovered information."); *R.C. Olmstead Inc. v. CU Interface LLC*, 606 F.3d 262, 94 USPQ2d 1897, 1902 (6th Cir. 2010) (court had discretion to limit access to trade secrets by adverse party's employees, allowing access only by adverse party's experts); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950 (TTAB 2006) (citing Fed. R. Civ. P. 26(c)(7), restyled by amendment, to Fed. R. Civ. P. 26(c)(1)(G)). *See also* Fed. R. Civ. P. 26(c) Advisory Committee's notes (1970 amendment) ("The courts have not given trade secrets automatic and complete immunity against disclosure, but have in each case weighed their claim to privacy against the need for disclosure. Frequently, they have been afforded a limited protection.").

11. *In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1147 (Fed. Cir. 2011).

12. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

13. *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000) ("As between a receiving party which raises a late objection to a designation of confidentiality and a producing party that is forced to move for protection of material previously designated as confidential without objection by the producing party, the Board will look much more favorably on the producing party.").

14. *Compare Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) (because Board does not entertain motions in limine, party could not raise issue regarding confidentiality designation of declaration testimony until defendant filed its declarations during its testimony period in ACR case), *on appeal*, No. 14-CV-4463 (D. Minn.), *with Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1495 n.6 (TTAB 2005) (overruling applicant's objections as to confidentiality designations of brand awareness studies raised for the first time in final brief, finding such objections untimely and the delay a "waiver as to the 'confidential' designation of this evidence.").

15. Fed. R. Civ. P. 26(c)(1); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

16. Fed. R. Civ. P. 26(c)(1); *see, e.g., Deford v. Schmid Products Co.*, 120 F.R.D. 648, 653 (D. Md. 1987)) (citing cases); 8 C. WRIGHT, A. MILLER, M. KANE, R. MARCUS & A. STEINMAN, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2035 (2015).

17. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1762 (TTAB 1999).

18. *Deford v. Schmid Products Co.*, 120 F.R.D. 648, 653 (D. Md. 1987)) (citing cases); *Waelde v. Merck, Sharpe, & Dohme*, 94 F.R.D. 27, 28 (E.D. Mich. 1981) (citing cases); *United States v. IBM Corp.*, 67 F.R.D. 40, 46 (S.D.N.Y. 1975)).

19. *Deford v. Schmid Products. Co.*, 120 F.R.D. 648, 653 (D.Md.1987)) (business will have to show disclosure would cause harm to competitive and financial position); *Waelde v. Merck, Sharpe, & Dohme*, 94 F.R.D. 27, 28 (E.D. Mich. 1981) (citing cases). *See, e.g., Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2057, 2058 (Fed. Cir. 2013) (finding district court erred in denying motion to seal portions of documents that contained product-specific financial information, including costs, sales, profits and profit margins, and market research, where the parties established that disclosure would cause competitive harm); *Baxter International Inc. v. Abbott Laboratories*, 297 F.3d 544, 63 USPQ2d 1859 (7th Cir. 2002) (denying motion to place documents under seal because the parties failed to explain why disclosure would harm their competitive position).

20. *Deford v. Schmid Products Co.*, 120 F.R.D. 648, 653 (D. Md. 1987) (citing cases). *See, e.g., Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2055, 2057 (Fed. Cir. 2013) (finding district court erred in denying motion to seal portions of documents that contained product-specific financial information, including costs, sales, profits and profit margins, which motions to seal were supported by declarations from the parties).

21. *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 141 (D. Md., 2011). *See Seattle Times Co. v. Rhinehart*, 467 U.S. 20, 33 (1984) (pretrial discovery, unlike the trial itself, is usually conducted in private; "restraints placed on discovered, but not yet admitted information are not a restriction on a traditionally public source of information"); *Rushford v. New Yorker Magazine, Inc.*, 846 F.2d 249, 252-53 (4th Cir. 1988)) (discovery, "which is ordinarily conducted in private, stands on a wholly

different footing than does a motion filed by a party seeking action by the court;" when documents that are "the subject of a pretrial discovery protective order ... [are] made part of a dispositive motion, they los[e] their status as being 'raw fruits of discovery'"); 8A C. WRIGHT, A. MILLER, M. KANE, R. MARCUS & A. STEINMAN, FEDERAL PRACTICE & PROCEDURE Civil 3d § 2042 (2015) ("One of the reasons for authorizing broad trial court latitude in restricting dissemination of material garnered through discovery is that the scope of discovery is very broad, often including topics having little bearing on the lawsuit. But when some of those materials are relied upon in a judicial decision, or form the basis for it, the justifications for public access on both First Amendment and common–law grounds increase."). *See, e.g.*, *Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2055, 2057 (Fed. Cir. 2013) (in considering appeal denying motion to seal, court considered the parties' competitive need to keep financial and market research private against right to public access to information regarding judicial process).

22. *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (when identity of individual identified during discovery as "trade secret/commercially sensitive" is named as a witness at trial and party chooses to rely on the testimony of that witness at trial, it has waived the protection provided to "trade secret/commercially sensitive" information, and can no longer shield the witness' identity from adverse party), *on appeal*, No. 14-CV-4463 (D. Minn.); *Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1143 n.6 (TTAB 2013) (Board noted that while a study was submitted under seal "it is hard to understand how Central can maintain that this information is confidential, yet at the same time rely on it in an attempt to establish the previous public perception of its mark for priority purposes"); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (applicant will not be able to restrict access by opposer's in-house technical experts to portions of expert deposition testimony and expert report if using expert as witness at trial); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1713 (TTAB 1999) (in connection with submission of protective order, parties were required to explain why already filed testimony and exhibits proposed to be considered confidential are confidential in nature).

23. *Compare Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655-56 (TTAB 2014) (when a party relies on testimonial evidence at trial its adversary must have meaningful opportunity to confront witness and inquire into his or her credibility and the facts to which the witness testifies; Board struck declaration testimony which over-designated the identifying information of the declarants as "trade secret/commercially sensitive," which restricted access to this information by opposer's in-house personnel and was critical to considering adverse testimony and should not be kept from a party), *on appeal*, No. 14-CV-4463 (D. Minn.), *with Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (so as to help counsel prepare for cross-examination of applicant's expert, applicant required by Board to provide advance notice to opposer of plans to use expert report take expert testimony at trial, and in such a case, opposer's in-house technical experts may access portion of expert report and expert deposition transcript which had been designated to allow only outside counsel to access).

24. *See, e.g.*, *Beasley v. John Wiley & Sons, Inc.*, 111 USPQ2d 1623, 1631 (N.D. Ill. 2014) (party moved to provisionally file exhibits publicly which had confidentiality designations with its summary judgment motion, once defendant withdrew the confidentiality designations for those exhibits, the court deemed the motion moot, allowing plaintiff to file an unredacted version of its summary judgment motion with a public filing of the exhibits); *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 141 (D. Md. 2011) (plaintiff challenged defendants' designations in advance of the submission of dispositive motions in the case, intending to include some of the challenged documents as exhibits to its summary judgment motion). *Cf. Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (seeking redesignation of expert report and expert testimony so that it could determine whether the hiring of a rebuttal expert was necessary for trial).

25. *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 142 (D. Md. 2011).

26. *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 142 (D. Md. 2011).

27. 37 CFR § 2.116(g); *Baxter International Inc. v. Abbott Laboratories*, 63 USPQ2d 1859 (7th Cir. 2002) ("But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality."); *Rushford v. New Yorker Magazine, Inc.*, 846 F.2d 249, 253 (4th Cir. 1988) ("there may be instances in which discovery materials should be kept under seal even after they are made part of a dispositive motion" and the court makes this determination at the time it grants the dispositive motion "and not merely allow[s] continued effect to a pretrial discovery protective order."); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential."). *Cf. Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2056, 2058 (Fed. Cir. 2013) (district court erred in denying motion to seal with regard to a small subset of financial documents as none of the documents were introduced into evidence so the financial information at issue was not considered by the jury and was not essential to the public understanding of the jury's damages award, nor was it essential to district court's rulings on any of the parties' pretrial motions; with regard to market research reports, district court erred in denying motion to seal where party agreed to make public all information actually cited by the district court or the parties, but sought to seal other information neither cited nor discussed by the district court).

412.01(c) Over-designation: Improper designation of confidential filings with the Board

Excerpt from Board's Standard Protective Order:

12) Redaction; Filing Material With the Board.

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

Redaction can entail merely covering or omitting a portion of a page of material when it is copied or printed in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied, or omitting the material, would be appropriate.

In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. ***Occasions when a whole document or motion/brief must be submitted under seal should be very rare.***

37 CFR § 2.27(c) Pending trademark application index; access to applications. *Decisions of the Director and the Trademark Trial and Appeal Board in applications and proceedings relating thereto are published or available for inspection or publication.*

37 CFR § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site, or upon request, a copy will be provided. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board.*

Board proceedings are designed to be conducted in public and transparent to the public. [Note 1.] Records of Board proceedings are open to public view and available for access by the public [Note 2], subject only to the exception of limited submissions (exhibits, testimony portions of a brief, or other documents) which contain information which is truly confidential in nature. [Note 3.] Improper designation of materials filed in Board proceedings as confidential thwarts the intention of allowing the public the right to inspect judicial records and documents [Note 4] and is "an improper casual approach" to a party's good faith requirement to designate only material that is truly confidential as "confidential." [Note 5.] At final decision, improper designation makes it more difficult to make findings of fact, apply the facts to the law, discuss evidence, and write decisions that make sense when the facts may not be discussed. [Note 6.] In granting a dispositive motion or at final decision, the Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions. [Note 7.]

The fact that the Board's standard protective order is automatically entered upon commencement in the proceeding does not give a party unbridled authority to designate its filed submissions to the Board as protected. [Note 8.] A party may not improperly mark its filings as confidential so as to shield them from public view nor may the Board's standard protective order, or any modified protective agreement stipulated to by the parties, be used as a means of circumventing relevant provisions of 37 CFR §2.27, which provides, that trademark application and registration files, and related TTAB proceeding files, generally should be available for public inspection. [Note 9.] Improper designation has been found where parties have filed entire briefs or motions or portions thereof as confidential, [note 10] filed entire depositions or portions thereof as confidential [Note 11], filed publicly disclosed [Note 12] or publicly available [Note 13] documents as confidential, or shielded a testifying witnesses' identity from the adverse party. [Note 14.]

The Board addresses improper designation of filed submissions in a number of ways. The Board may disregard the designation as "confidential" for those matters which are improperly designated [Note 15], it may issue an order to show cause why the submission should not be made open to public view [Note 16], it may require the party to reduce redactions by redesignating as non-confidential the overdesignated information and resubmit a properly designated redacted copy for public view [Note 17], or the Board may not consider the improperly designated matter in rendering its decision [Note 18.] In the case of an order to show cause, or request for resubmission of a filing with proper redaction (i.e., proper designation of confidential matter for public access), if no response is received, the Board will redesignate the confidentially filed material as non-confidential and make it available for public view. [Note 19.]

When filing submissions with the Board, parties should avoid excessive marking of various information as confidential and limit such designations to only those particular discovery responses, exhibits, and deposition transcript pages that are truly confidential, within the scope of and consistent with the protective order entered in the proceeding. [Note 20.] Any confidential filing must include redacted versions for the public record. *See* 37 CFR § 2.126. For any confidential unredacted version of a submission for which a redacted version must be filed, the parties are encouraged to enclose the confidential information in brackets so as

to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision. Occasions when a document or brief or testimony are submitted in their entirety under seal should be rare. [Note 21.] In decisions, the Board refers to properly designated confidential matter in general terms. [Note 22.]

For further information regarding the filing of confidential materials and redaction, see TBMP § 120.02, TBMP § 412.01, TBMP § 412.02(d), TBMP § 412.04 and TBMP § 412.05. For information regarding the designation of material as confidential and procedures regarding redaction at trial, see TBMP § 703.01(p).

NOTES:

1. 37 CFR §2.27(c); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (contents of Board proceedings publicly available; proceedings are meant to be transparent to the public); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) ("except in unusual circumstances, Board proceedings are open to the public"), on appeal, No. 14-CV-4463 (D. Minn.); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) ("record created [in Board] proceeding is entirely or almost entirely public"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). *See also Nixon v. Warner Communications, Inc.*, 435 U.S. 589, 598 (1978) (courts recognize "a general right to inspect and copy public records and documents, including judicial records and documents"); *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469, 492 (1975) ("official records and documents open to the public are the basic data of governmental operations").

2. 37 CFR §2.27(c); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458 (TTAB 2014) (contents of proceeding files publicly available); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1084 n.8 (TTAB 2014) (TTABVUE is the Board's public online database that contains the electronic case file for the proceeding, available at the USPTO website); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (documents which are designated confidential do not appear in the electronic docket, TTABVUE); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011), (TTAB 2014) ("record created [in Board proceeding] is entirely or almost entirely public"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (Board proceedings must be open to the public). *See also Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469, 492 (1975). ("The common law presumes a right to inspect and copy judicial records and documents.").

3. 37 CFR § 2.116(g); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011), ("record created [in Board proceeding] is entirely or almost entirely public"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). *See also Baxter International Inc. v. Abbott Laboratories*, 63 USPQ2d 1859 (7th Cir. 2002) ("But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality."); *Rushford v. New Yorker Magazine, Inc.*, 846 F.2d 249, 253 (4th Cir.1988) ("there may be instances in which discovery materials should be kept under seal even after they are made part of a dispositive motion" and the court makes this determination at the time it grants the dispositive motion "and not merely allow[s] continued effect to a pretrial discovery protective order").

4. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010). *See also Nixon v. Warner Communications, Inc.*, 435 U.S. 589, 598 (1978) (courts recognize "a general right to inspect and copy public records and documents, including judicial records and documents"); *In re Violation of Rule 28(d)*, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (confidentiality markings in this case were so extensive that the non-confidential version of the brief ignored the requirements of public access).

5. *In re Violation of Rule 28(d)*, 635 F.3d 1352 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (counsel took an "improper casual approach" to marking the non-confidential version of the brief making it virtually incomprehensible).

6. *In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (confidentiality markings in non-confidential version of brief were so extensive that it hampered the court's consideration and opinion writing); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (improper confidential designation of testimony and evidence make it "more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed."); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("In order to adequately explain our analysis and the facts on which it is based we must refer to some of the testimony and exhibits, although we have tried to be sensitive about revealing anything that may be truly confidential."); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (improper confidential designations make it "more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed.").

7. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) ("The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decision."); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("In order to adequately explain our analysis and the facts on which it is based we must refer to some of the testimony and exhibits, although we have tried to be sensitive about revealing anything that may be truly confidential."); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) ("Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions."). *Cf. In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (confidentiality markings in non-confidential version of brief were so extensive that it hampered the courts consideration and opinion writing).

8. *See THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255, 1253 (N.D. Ill. 1993) (it is counsel's "place and responsibility" to ensure that the proper confidential designations are assigned); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) ("the mere assertion that information is confidential does not make such designation proper."), *on appeal*, Case No. 14-CV-4463 (D. Minn.); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (in cases where parties have excessively marked information as confidential the Board may require parties to resubmit those documents so that only truly confidential material is redacted, urging parties to limit confidential designations), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings). *Cf.* Fed. R. Civ. P. 26(g)(1)(B)(ii) (requiring discovery responses to be "not interposed for any improper purpose").

9. *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001). *Cf. In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (improper redaction of non-confidential version of brief ignores the requirements of public access).

10. *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (opposer ordered to file redacted brief in which only information which is truly confidential is redacted); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies). *See also In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (improper designations of large portions of appeal brief as confidential including legal argument and case citations and quotations from case; marking of legal argument as confidential under Rule 26(c)(1)(G) cannot be justified unless argument discloses facts or figures of genuine competitive or commercial significance).

11. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460-61 (TTAB 2014) (discussing improper designation as confidential of testimony and exhibits submitted in Board proceeding); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12, 1739 (TTAB 2012) (party submitted entire deposition testimony of witness under seal, and was ordered to resubmit copies of evidence in which only truly confidential material was redacted, failing which deposition testimony would be unsealed); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402-03 (TTAB 2010) (discussing improper designation as confidential testimony and exhibits submitted in Board proceeding including discovery deposition testimony regarding how applicant's mark was selected, products on which applicant intended to use its mark, and to whom applicant makes its initial sales contacts); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) (parties were not "precise in the handling and submission of apparently confidential testimony and documents", noting that "transcripts of testimony depositions have been labeled as previous confidential when it is clear from reading the transcripts that only portions thereof were intended to be shielded from public view.").

12. *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (improper designation as confidential confirmation letters regarding employee seminars, responses to business invitations, requests for permission to attend business trips and internal memos regarding public seminars); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460 (TTAB 2014) (improper designation of marketing materials that were distributed to respondent's purchasers and potential purchasers not confidential; presentation found not confidential where presentation directed to interested employer groups, associations, hospitals, schools and the presentation had no warning or legend that the information in the presentation was trade secret and should be kept confidential); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (where sales figures, advertising expenditures and similar information appeared in publicly available documents or submissions, Board did not treat the information as confidential); *Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1874 (TTAB 2011) (improper designations of whole documents and large amount of non-confidential information improperly designated as confidential).

13. *THK America Inc. v. NSK Co. Ltd.*, 33 USPQ2d 1248 (N.D. Ill. 1993) (improper designation of published, publicly available documents, among which are catalogs, patents, books, magazines, technical journals and newspaper articles); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014) (printout of shopping cart webpage available to the public is not confidential); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (user manuals for opposer's heart monitors distributed to opposer's purchasers and which contained no warning or legend advising they contain trade secrets and should be kept in a secure location were not confidential); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (overdesignation of non-confidential matter with respect to portions of expert report as related to expert's credentials and background, his involvement as an expert or witness in

other matters, how he came to be a witness in this proceeding, the role his assistant played, whether other documents beside the report were reviewed or prepared, information about other tests done outside the context of this proceeding, and knowledge of other persons and tests done outside the context of this proceeding).

14. *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (improper designation of testifying witnesses' identity as "trade secret/commercially sensitive" under Board's standard protective order, as modified by the parties' ACR agreement, opposer's counsel should have been able to share with opposer the names of witnesses testifying against opposer; applicant had identified these witness' names in pretrial disclosures), *on appeal*, No. 14-CV-4463 (D. Minn.).

15. *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696, 1702 (Fed. Cir. 1990) (designation of material as confidential not controlling; court retains authority to decide what materials are deemed confidential and what part of trial shall be in camera); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (Board would not be bound by parties' confidential designations at final decision, treating only evidence and testimony that is clearly of private nature or commercially sensitive as confidential); *Miller v. Miller*, 105 USPQ2d 1615, 1617 n.4 (TTAB 2013) (discussing those portions of testimony and evidence "that truly contain confidential information only in general terms."); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) ("Depositions have been marked confidential, which limit our reference to them. However, in order to render a decision that relates to the relevant facts of this case, we have referred to selective portions of the record that appear to us to be not truly confidential."); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (Board would not bound by parties' designation of confidential matter).

16. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (If party designates more than a minimal amount of evidence as confidential or commercially sensitive and the information is more than 20 years old, party should anticipate an order to show cause why such information should warrant a designation as confidential and be shielded from public view). *Cf. Therrien v. Target Corp.*, 617 F.3d 1242, 1259 (10th Cir. 2010) (sealed portions of the appendices will be unsealed 20 days from the filing of the opinion unless one of the parties files a motion, under seal if necessary, "setting forth precisely what information should be kept confidential and why lesser measures (such as submission of a redacted [appendix]) would not provide effective protection"); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (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).

17. *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 (TTAB 2012) (party submitted certain deposition testimony under seal, and was ordered to resubmit copies of testimony in which only truly confidential testimony was redacted); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (in cases where parties have excessively marked information as confidential the Board may require parties to resubmit those documents so that only truly confidential material is redacted), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (opposer ordered to file redacted brief in which only information which is truly confidential is deleted); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

18. *Hunter Industries., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (improperly designated declaration testimony not considered and stricken from record), *on appeal*, No. 14-CV-4463 (D. Minn.).

19. *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012).

20. *In re Violation of Rule 28(d)*, 635 F.3d 1352 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (parties must confine their confidentiality markings to information covered by a protective order; confidentiality markings in appellant's brief went beyond the scope of the protective order). *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) ("confidential" designation should be limited to information that is truly confidential or commercially sensitive); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (urging parties to limit confidential designations), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (because Board proceeding is open to the public, only truly confidential information should be marked as such); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) ("material should be designated as confidential, and as requiring handling as such, only when absolutely necessary.").

21. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) (Board required a testimonial deposition designated entirely as confidential to be resubmitted with portions truly confidential redacted, otherwise, would be redesignated as non-confidential); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868 (TTAB 2011) (improper designations of whole documents); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

22. *See e.g.*, *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1739 (TTAB 2012) (for information in testimony that is truly confidential, Board will refer to it generally); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1878 (TTAB 2011) (information regarding sales and promotion by parties designated as confidential and the Board referred to this information generally); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1078 n.29 (TTAB 2011) (portions of testimony designated confidential referred to only in general terms); *Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 n.4 (TTAB 2011) (referring to parties' consent agreement generally, due to confidential designation); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402, 1408 (TTAB 2010) (sales and advertising matter designated as confidential and "truly appropriate matter for a confidential designation" so the Board referred to that information in general terms); *Safer Inc. v. OMS Invests. Inc.*, 94 USPQ2d 1031, 1042 (TTAB 2010) (information as to sales figures designated as confidential so Board referred to those figures in general terms); *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) (advertising and revenue figures designated confidential, so referred to only generally in Board's decision); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1514 (TTAB 2009) (discussing only sales and advertising expenditures set forth in the parties' briefs but otherwise referring to the evidence designated "confidential" generally); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1396 n.3 (TTAB 2009) (Board is mindful of the portions of documents and testimony designated as "confidential" and has referred to such matters in general terms).

412.02 Modification of Board's Standard Protective Order Governing the Exchange of Confidential, Highly Confidential and Trade Secret/Commercially Sensitive Information

The terms of the Board's standard protective order may be modified, upon motion or upon stipulation approved by the Board, to govern the exchange of "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" information. The most common kind of order allowing discovery on conditions is an order limiting the persons who are to have access to the information disclosed. [Note 1.]

NOTES:

1. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2043 (2015).

412.02(a) Modification of Board's Standard Protective Order Upon Stipulation

If the parties choose to modify the terms of the Board's standard protective order and enter into their own stipulated protective order, a copy of the executed agreement should be filed with the Board. The Board will acknowledge receipt of the agreement, but the parties should not wait for the Board's acknowledgement to conduct themselves in accordance with the terms of their agreement. The terms of the agreement are binding as of the date the agreement is signed. Such an order may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that except for matter filed under seal pursuant to a protective order issued by a court or by the Board, the file of a published application or issued registration, and all proceedings relating thereto, are available for public inspection. [Note 1.]

NOTES:

1. *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

412.02(b) Pro Se Litigants and In-House Legal Counsel

While the Board's standard protective order sets forth guidelines for the disclosure of confidential information to pro se litigants and in-house counsel, in some cases, a modification of the Board's standard protective order upon motion or by stipulation of the parties, approved by the Board, may be desirable. Special issues regarding the exchange and disclosure of information during discovery may arise in cases involving pro se litigants and in-house legal counsel. For example, under the terms of the Board's standard protective order, such individuals do not have access to Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) information. [Note 1.] The financial burden of retaining either legal counsel in the case of a pro se litigant or outside legal counsel in the case of in-house counsel does not constitute good cause to amend the Board's protective order to remove the restriction with respect to Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) information. [Note 2.] In instances where in-house counsel moves to amend the Board's protective order to permit access to Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) information, the determining factor is whether in-house counsel is involved in its employer-litigant's "competitive decision making." [Note 3.]

NOTES:

1. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *See Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1867 n.6 (TTAB 2010) (pro se

applicant hired outside attorney solely for purpose of reviewing opposer's "trade secret/commercially sensitive" information and documents pursuant to the protective order).

2. *See A. Hirsh, Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987).

3. *See U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed. Cir. 1984); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1953 (TTAB 2006) (Board applied test to deny opposer's motion to modify protective order to permit in-house counsel access to trade secret or commercially sensitive information where opposers made only minimal showing that their in-house legal counsel was not involved in "competitive decision-making" activities).

412.02(c) In Camera Inspection

In situations where there is a dispute between the parties to a proceeding as to the relevance and/or confidentiality of a document, or portions thereof, sought to be discovered, and the Board cannot determine from the arguments of the parties, on motion to compel production, whether the document is relevant and/or confidential, the Board may request that a copy of the document be submitted to the Board for an in camera inspection. [Note 1.]

See TBMP § 412.05 with regard to the handling of confidential materials that are filed electronically or on paper with the Board.

NOTES:

1. *Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 n.8 (TTAB 2010) (based on an in camera inspection, opposer properly designated produced materials as trade secret/commercially sensitive).

412.02(d) Contents of Protective Order

In some cases, parties may agree to modify the Board's standard protective order, or the standard protective order is modified upon motion approved by the Board. The revised protective order typically may include provisions further clarifying the following:

(1) The definition of the type of material to be considered confidential or trade secret information.

(2) The description of the manner in which confidential or trade secret information is to be handled.

(3) The requirement that a party claiming confidentiality or trade secret protection designate the information covered by the claim prior to disclosure of the information to the discovering party.

(4) The provision that a party may not designate information as confidential or trade secret unless the party has a reasonable basis for believing that the information is, in fact, confidential or trade secret in nature.

(5) The provision that information designated by the disclosing party as confidential or trade secret may not include information which, at or prior to disclosure thereof to the discovering party, is known to or independently developed by the discovering party; or is public knowledge or becomes available to the public without violation of the agreement.

(6) The provision that information designated by the disclosing party as confidential or trade secret may not include information that, after the disclosure thereof, is revealed to the public by a person having the unrestricted right to do so.

(7) The provision that information designated by the disclosing party as confidential or trade secret may not include information which is acquired by the discovering party from a third party, which lawfully possesses the information and/or owes no duty of nondisclosure to the party providing discovery.

(8) The specification of the persons to whom confidential or trade secret information may be disclosed (e.g., outside counsel; in-house counsel; counsel's necessary legal and clerical personnel).

(9) The provision that all persons to whom confidential or trade secret information is disclosed shall be advised of the existence and terms of the protective order.

(10) The provision that the discovering party will not disclose or make use of confidential or trade secret information provided to it under the order except for purposes of the proceeding in which the information is provided.

(11) The means for resolving disputes over whether particular matter constitutes confidential or trade secret information.

(12) In order for material designated as confidential or trade secret to be made of record in the proceeding, it shall be submitted to the Board electronically designated as "CONFIDENTIAL" in ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, or by paper in a separate sealed envelope or other sealed container bearing the proceeding number and name, an indication of the general nature of the contents of the container, e.g. opposer's brief, or applicant's motion with specification of the subject of the brief or motion, and, in large letters, the designation "CONFIDENTIAL." For Confidential or Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) submissions filed either via ESTTA or by paper, two versions are required – a confidential version as well as a redacted version available for public viewing. It is preferable for parties to file Confidential or Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) materials through ESTTA. For confidential submissions, it is preferable for the parties to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision. For further information regarding the filing of confidential materials, see TBMP § 120.02, TBMP § 412.04 and TBMP § 412.05.

(13) The statement that at the end of the proceeding, each party shall return to the disclosing party all confidential information and materials, including all copies, summaries, and abstracts thereof.

The Board's standard protective order can be found on the USPTO website at: **www.uspto.gov**.

For additional information concerning the contents of a protective order, see the cases and authorities cited in the note below. [Note 1.]

NOTES:

1. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (in addition to provisions mandated by Board, protective order may contain other provisions as are agreeable to parties); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (Board required provision that information furnished by opposer would be confined to applicant's attorneys). Note that these cases were decided prior to automatic imposition of the Board's standard protective order.

412.03 Duration of Protective Order

Excerpt from Board's Standard Protective Order

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

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

The parties may agree that archival copies of evidence, memoranda, discovery deposition transcripts, testimony deposition transcripts, affidavits, declarations, and briefs may be retained solely by outside counsel, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, each party and their attorneys, as well as any other persons subject to the terms of this agreement, shall return to each disclosing party (1) all materials and documents, including ESI, containing protected information, (2) all copies, summaries, and abstracts thereof, and (3) all other materials, memoranda or documents embodying data concerning said material, including all copies provided pursuant to paragraphs 4 and 5 of this Order. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned. Additionally, parties to this agreement are precluded from disclosing orally or in writing any protected information provided during the course of a Board proceeding once this Board proceeding is terminated.

Under the Board's protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. [Note 1.] According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties and their attorneys must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is unclear whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. [Note 2.] Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. [Note 3.]Nonetheless, any determination of whether the agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it. [Note 4.]

NOTES:

1. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 n.5 (TTAB 2001) ("the Board's jurisdiction over the parties ends when this proceeding does and the Board will not be involved in enforcing provisions of the [protective] agreement after conclusion of the opposition.").

2. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

3. *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 n.3 (TTAB 2000) (Board's jurisdiction would not extend to third-party signatory); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 n.3 (TTAB 1987) (Board approves stipulated protective orders signed by parties' counsel but both counsel "may wish to have the parties sign themselves . . . so that the parties will clearly realize that they have created a contract that will survive the proceeding"); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1226 n.10 (TTAB 1987) (suggesting that "for the protection of both parties, the parties, as well as their counsel should sign the stipulated protective order so as to create a contract that will survive the proceeding"). *See also* with respect to violation of a Board protective order after the

conclusion of the Board proceeding, *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698, 1702 n.11 (9th Cir. 1991) (bringing confidential business documents into the public record in violation of the Board's protective order established a cause of action in district court).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

412.04 Filing Confidential Materials With Board

37 CFR § 2.27(d) Pending trademark application index; access to applications. *Except as provided in paragraph (e) of this section, the official records of applications and proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by § 2.6.*

37 CFR § 2.27(e) Pending trademark application index; access to applications. *Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.*

37 CFR § 2.126(c) Form of submissions to the Trademark Trial and Appeal Board *To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(e) must be submitted under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must be submitted.*

Excerpt from Board's Standard Protective Order:

12) Redaction; Filing Material with Board

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

Redaction can entail merely covering or omitting a portion of a page of material when it is copied or printed in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied, or omitting the material, would be appropriate.

In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. ***Occasions when a whole document or motion/brief must be submitted under seal should be very rare.***

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

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

If filed electronically by employing the Board's Electronic System for Trademark Trial and Appeals ("ESTTA"), the filing party should comply with the redaction guidelines set forth above and click the "confidential filing" option prior to transmitting the documents electronically. In all situations, a redacted copy must also be filed for public view.

Except for materials filed under seal pursuant to a protective order or designated as confidential in ESTTA, 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 on TTABVUE. [Note 1.] To be handled as confidential pursuant to the Board's standard protective order or the parties' individualized protective order, and kept out of the public record, confidential materials must be so designated at the time of filing. [Note 2.] Paper or electronic submissions in Board proceedings which are not properly designated as confidential will be placed in the Board's public records, available on the Internet. Only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be electronically designated as "CONFIDENTIAL" in ESTTA or filed by paper under seal pursuant to a protective order. If a party submits any brief, pleading, motion or other such filing containing confidential information either electronically via ESTTA or by paper under seal, the party must also submit for the public record a redacted version of said paper. [Note 3.] Thus, for confidential submissions filed either via ESTTA or by paper, two versions are required – a confidential version as well as a redacted version available for public view. For any confidential unredacted version of a submission, the parties are encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision. A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. [Note 4.] In cases where a redacted version has not been provided, the confidentiality of the information may be deemed waived. [Note 5.]

Electronic filing using ESTTA is preferred for submissions containing confidential material. When using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." Filings made using this option will not be made available for public viewing, although entries will be made on the publicly available docket sheet in TTABVUE indicating the Board's receipt of such filings. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information.

For further information regarding the use of ESTTA for confidential filings, see TBMP § 1109 and TBMP § 120.02.

Paper submissions of material designated as confidential should be filed in a separate sealed envelope or other sealed container prominently marked with the word "CONFIDENTIAL." [Note 6.] Many attorneys also like to attach to the sealed envelope or other sealed container a statement, such as the following:

FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER.

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

The envelope or other container must also bear information identifying the proceeding in connection with which it is filed (i.e., the proceeding number and name), [Note 7], and an indication of the nature of the contents of the container (i.e., "Applicant's Answers to Opposer's Interrogatories 8 and 19," "Pages 22-26 From the Discovery Deposition of John Doe," "Opposer's Exhibits 3-5 to the Discovery Deposition of John Smith," etc.).

NOTES:

1. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (documents which are designated confidential do not appear in the electronic docket, TTABVUE); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1084 n.8 (TTAB 2014) (TTABVUE is the Board's public online database that contains the electronic case file for the proceeding, available at the USPTO website).

2. *See* 37 CFR § 2.116(g).

3. *See* 37 CFR § 2.27(d) and 37 CFR § 2.27(e), and 37 CFR § 2.126(c); *Duke University v. Haggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

4. *See, e.g.*, *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460-61 (TTAB 2014) (discussing improper designation as confidential of testimony and exhibits submitted in Board proceeding); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 (TTAB 2012) (party submitted all evidence under seal, and was ordered to resubmit copies of evidence in which only truly confidential material was redacted); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402-03 (TTAB 2010) (discussing improper designation as confidential testimony and exhibits submitted in Board proceeding); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (opposer ordered to file redacted brief in which only information which is truly confidential is deleted); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

5. *See, e.g.*, *Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

6. *See* 37 CFR § 2.126(c).

7. *See* 37 CFR § 2.126(c).

412.05 Handling of Confidential Materials By the Board

A confidential filing submitted via ESTTA, and properly designated as confidential, will not be made available for public viewing, although an entry will be made on the publicly-available docket sheet in TTABVUE, indicating the Board's receipt of such filings. If a confidential filing is not properly designated as confidential when submitted via ESTTA, the submission will be placed in the Board's public records,

available on the Internet. The Board will retain electronic versions of all submissions, including confidential filings, pursuant to USPTO document retention policies. Thus, confidential matter submitted via ESTTA is retained in the Board's electronic records and will not be deleted from the electronic records after the proceeding is finally determined.

Confidential materials submitted in non-electronic, i.e, paper or physical form (including trade secret information), and filed under seal subject to a protective order are stored by the Board in a secure location, and are disclosed only to the Board and to those people specified in the protective order as having the right to access. Confidential paper submissions are scanned into TTABVUE and designated "confidential." After scanning and designation as "confidential," the Board retains the confidential paper submissions for a short period of time before disposing of the confidential paper submissions in an appropriate manner. Following the conclusion of a proceeding, including any appeal period, any physical confidential materials submitted will be disposed of by the Board in an appropriate manner. *See* TBMP § 806 (Termination of Proceeding).

For further information regarding the handling of paper, physical materials, and confidential materials by the Board, see TBMP § 119.03 and TBMP § 120.02. For information concerning access to protective order materials during an appeal from the decision of the Board, see TBMP § 904.

412.06 Protective Orders Limiting Discovery

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

Fed. R. Civ. P. 26(c)(1) ***In General.*** *A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending — or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:*

(A) *forbidding the disclosure or discovery;*

(B) *specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;*

(C) *prescribing a discovery method other than the one selected by the party seeking discovery;*

(D) *forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;*

(E) *designating the persons who may be present while the discovery is conducted;*

(F) *requiring that a deposition be sealed and opened only on court order;*

(G) *requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and*

(H) *requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.*

Although it is generally inappropriate to respond to a request for discovery by filing a motion for a protective order, in certain situations, on motion pursuant to 37 CFR § 2.120(f), a party may properly move for a protective order that the disclosure or discovery not be had, or be had only on specified terms and conditions. [Note 1.]

A party must establish good cause to obtain a protective order. [Note 2.] To establish good cause, a movant must provide "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." [Note 3.] The existence of good cause for a protective order is a factual matter to be determined from the nature and character of the information sought by deposition or interrogatory request or request for production or request for admission weighed in the balance of the factual issues involved in the Board proceeding. The moving party seeking a protective order bears the burden of showing good cause. The movant must demonstrate that its ability to litigate will be prejudiced, not merely that the difficulty of managing the litigation will increase. [Note 4.]

When the Board grants a motion for a protective order it may direct either the disclosing party, or the parties together, to prepare an order with terms that are mutually agreeable to them, [Note 5] may approve the protective order proffered by a party, may order the parties to adhere to the Board's standard protective order, or may provide whatever relief the Board deems appropriate.

The parties should confer in good faith before seeking Board intervention for a protective order. [Note 6.]

For additional information regarding motions for protective order, see TBMP § 412 and TBMP § 526.

NOTES:

1. *See, e.g., Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (granting protective order with regard to 980 discovery requests and limiting the overall total discovery requests (interrogatories, including subparts, document requests and requests for admission) to be propounded to 150); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (protective order granted with regard to duplicative requests for admissions and admissions directed to opposer's unpleaded registrations); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high level executive granted); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where party who was served with discovery (assignor) is not and was not at the time of commencement of proceeding the real party in interest).

2. 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c)(1).

3. *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152-53 (TTAB 2013); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

4. *A. Hirsh, Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013).

5. *See, e.g., Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

6. Fed. R. Civ. P. 26(c)(1). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (finding good faith effort to resolve the discovery dispute prior to filing the motion for protective order). *Cf. Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (good faith effort in connection with motion to compel should be directed to understanding differences and investigating ways in which to resolve dispute); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) ("[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.")).

412.06(a) Depositions

Although issuance of a protective order totally prohibiting a deposition occurs only in extraordinary circumstances, the Board has the discretion to limit a deposition or order a deposition not to be had if it determines that the discovery sought is obtainable from other sources that are more convenient and less burdensome or duplicative. [Note 1.] The party seeking a protective order to limit a deposition or for a deposition not to be had bears the burden to show good cause therefor. [Note 2.] To establish good cause, the movant must submit "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." [Note 3.]

As general rule, a lack of personal knowledge is an insufficient basis for obtaining a protective order that a discovery deposition not be had, as a party seeking discovery may test a witness' asserted lack of knowledge. [Note 4.] On the other hand, a motion for protective order may be granted if it is shown that the party has no unique or superior personal knowledge of the facts and that discovery may be obtained from other individuals with equivalent or greater knowledge. [Note 5.] A party may file a motion for a protective order (or alternatively, a motion to quash) if, for example, absent a stipulation of the parties or leave of the Board, the notice of deposition would result in the inquiring party exceeding the permitted number of ten discovery depositions or if it would result in a second deposition of an individual or if the notice would result in a deposition being taken outside the discovery period. An assertion that the deponent is too busy, or that the examination would cause undue labor, expense or delay is generally an insufficient basis for obtaining a protective order. [Note 6.]

If a party moves for a protective order to prohibit the deposition of a very high-level official or executive of a large corporation, the movant must demonstrate through an affidavit or other evidence that the high-level official has no direct knowledge of the relevant facts or that there are other persons with equal or greater knowledge of the relevant facts. [Note 7.]

If the movant meets this initial burden, then the burden shifts to the party seeking the deposition to show that the official has unique or superior personal knowledge of relevant facts. [Note 8.] If the party seeking the deposition does not satisfy this showing, then the Board will grant the motion for protective order and require the party seeking the deposition to attempt to obtain discovery through less intrusive methods. [Note 9.] Depending upon the circumstances of the case, these methods should include the depositions of lower-level employees, Fed. R. Civ. P. 30(b)(6) depositions, requests for admissions, or interrogatories and requests for production of documents directed to the corporation. [Note 10.]

If, after making a good faith effort to utilize less intrusive methods of discovery, the party is unable to obtain the information it seeks, a party may file a motion to vacate or modify the protective order. Such a motion should include a showing (1) that there is a reasonable indication that the high-level official's deposition may or will lead to the discovery of admissible evidence, and (2) that the less intrusive methods of discovery

are unsatisfactory, insufficient or inadequate. [Note 11.] In granting the motion to vacate or modify the protective order, the Board may limit the topics and duration of the deposition. [Note 12.]

A party moving for a protective order to delay, limit or prevent a deposition on the basis of medical grounds or health concerns has the burden of making a specific and documented factual showing. [Note 13.]

A party opposing a motion for protective order with respect to taking the deposition of a non-testifying or consulting expert on notice alone has the burden of establishing exceptional circumstances. [Note 14.]

Please Note: the Board has no jurisdiction over depositions by subpoena, and in such a case, a motion for protective relief would be filed in the district court for which the subpoena issued and not with the Board.

NOTES:

1. Fed. R. Civ. P. 26(c)(1); 37 CFR § 2.120(f); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761-62 (TTAB 1999).

2. Fed. R. Civ. P. 26(c)(1); 37 CFR § 2.120(f).

3. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

4. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2037 (2015).

5. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1675 (TTAB 2005).

6. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1762 (TTAB 1999).

7. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

8. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

9. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

10. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

11. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

12. *Cf. Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005) (denying a motion for protective order that depositions not be had with regard to certain individuals but limiting the depositions to three hours in duration and to one particular topic).

13. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2037 (2015) and cases cited therein.

14. Fed. R. Civ. P. 26(b)(4)(D)(ii); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014) (motion to take deposition of consulting expert denied because opposer did not establish exceptional circumstances).

412.06(b) Other Discovery

Except in those cases where it is readily apparent that propounded discovery requests are so oppressive as to constitute clear harassment, it is generally improper to respond to a request for discovery by filing a motion for protective order. [Note 1.] *See* TBMP § 405 and TBMP § 406, for proper responses to discovery and TBMP § 412 and TBMP § 526 regarding motions for protective orders. It is also improper to move for a protective order for the purpose of delaying responses to discovery or for purposes of harassment of one's adversary. [Note 2.] The remedy for excessive interrogatories is service of a general objection, rather than a motion for protective order. [Note 3.] For more information regarding excessive interrogatories, see TBMP § 405.

Where appropriate, the Board may under Fed. R. Civ. P. Rule 26(c)(1) order that the discovery requested not be had with regard to interrogatories and requests for production and requests for admission. [Note 4.] The Board must determine whether there is a need for protection against a particular interrogatory or request for admission or production of a particular document or category of documents due to their nature or whether the volume of improper requests for production or requests for admission renders them harassing and oppressive. [Note 5.] The parties are expected to take into account the principles of proportionality with regard to document requests and requests for admission such that the volume of requests does not render them harassing and oppressive and are expected to consider the scope of the requests as well as confer in good faith about the proper scope of discovery pursuant to 37 CFR § 2.120(a) and Fed. R. Civ. P. 26(f) so as to minimize the need for these motions. *See* TBMP §402 and TBMP § 408 regarding the scope of discovery, the parties' discovery conference obligations and the duty to cooperate.

NOTES:

1. *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984).

2. *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1553 (TTAB 1987).

3. 37 CFR § 2.120(d).

4. *See, e.g., Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (granting protective order with regard to 707 requests for admission, 247 document requests, and 26 enumerated interrogatories); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (granting protective order with regard to 94 duplicative requests for admissions and those that sought admissions as to unpleaded registrations); Fed. R. Civ. P. 36 Advisory Committee notes (1970 amendment) ("requests to admit may be so voluminous and so framed that the answering party finds the task of identifying what is in dispute and what is not unduly burdensome. If so, the responding party may obtain a protective order under Rule 26(c)").

5. *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (when only one registration was at issue in cancellation, granting protective order with regard to 707 requests for admission, 247 document requests, and 26 enumerated interrogatories (some with subparts) and limiting the overall total discovery requests (interrogatories, including subparts, document requests and requests for admission) to be propounded to 150); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013)

(granting protective order with regard to 94 duplicative requests for admissions and those that sought admissions as to unpleaded registrations but denying protective order with regard to 282 requests for admissions finding them relevant to allegations and claims as pleaded, where opposer made broad claims of ownership of twenty-six registered and common law marks in its notice of opposition, and applicant's admission requests related only to fourteen of opposer's pleaded marks); *Weatherford/Lamb Inc. v. C&J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 n.3 (TTAB 2010) (noting that during discovery and prior to service of petitioner's discovery responses, the Board granted motion for protective order that petitioner need only produce limited or representative samples of responsive documents); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (granting motion for protective order with respect to discovery relating to foreign activities; denying motion for protective order with respect to applicant's use in commerce in U.S.); *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (denying motion for protective order with respect to nineteen discovery requests which were suitably tailored to the issues in the opposition); *C. H. Stuart Inc. v. S.S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (granting protective order due to oppressive and harassing discovery requests where the requests served were "boiler-plate" requests designed for use in an infringement action, discovery was not tailored to issues in Board proceeding, and requests sought included those seeking information regarding whether officers of applicant had been convicted of a crime or subject to a proceeding before the U.S. government). *See also Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where obligation to respond to discovery requests rested with assignee nor assignor).

413 Telephone and Pretrial Conferences

413.01 Telephone Conferences for Motions Relating to Discovery

37 CFR § 2.120(i)(1) *Whenever its appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that its approval or resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, address the stipulation or resolve the motion by telephone conference.*

37 CFR § 2.127(a) *. . . Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board.*

When appropriate and necessary, a motion or stipulation relating to discovery may be resolved by telephone conference involving the parties and/or their attorneys and a Board attorney or judge. [Note 1.] Motions relating to discovery include, but are not limited to, motions to compel, motions to quash, and motions for protective orders. Telephone conferences with regard to discovery motions allow for expedient resolution of disputes and encourage greater cooperation amongst the parties by requiring the parties to discuss with a Board professional the issues in dispute. In appropriate cases, the Board may indicate that the filing of a responsive brief to a motion is not necessary since the non-moving party will have an opportunity to present its arguments during the telephone conference. [Note 2.] The Board may in its discretion also require the parties to contact the attorney assigned to a case prior to filing any motion relating to discovery, and the Board attorney may hold a conference to determine whether filing of a motion is warranted. [Note 3.]

The telephone conference procedure is not limited to motions or stipulations relating to discovery. For more information concerning the conduct and arrangement of telephone conferences, see TBMP § 502.06.

NOTES:

1. *See, e.g., Weatherford/Lamb Inc. v. C &J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 n.3 (TTAB 2010) (motion for protective order decided by teleconference); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d1175, 1177(TTAB 2010) (motion to compel decided by teleconference).

2. *See* 37 CFR § 2.127(a). *See e.g., Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1177 n.7 (TTAB 2010).

3. *See* 37 CFR § 2.120(i). *See also International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1603 n.24 (TTAB 2002) (party prohibited from filing further motions to compel without first obtaining Board permission).

413.02 Pretrial Conferences

37 CFR § 2.120(i)(2) *Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would be likely to be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a disclosure, discovery or pre-trial conference.*

While rarely utilized, the Board has the discretion to order the parties to meet in person at the Board's offices to resolve complex disputes surrounding disclosures and discovery for a pretrial conference. [Note 1.] For further information concerning pretrial conferences, see TBMP § 502.06(b).

NOTES:

1. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011) (Board exercised its authority under 37 CFR § 2.120(i)(2) and ordered the parties to appear in person at the office of the Board); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.5 (TTAB 2011) ("where the Board identifies overly contentious advocacy or the potential for the creation of excessive records, it may in the future exercise its authority under Trademark Rule 2.120(i)(2) to order a pretrial conference in person at the office of the Board"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Amazon v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) ("under Trademark Rule 2.120(i)(2), where resolution of discovery or other interlocutory issues 'would likely be facilitated by a conference in person of the parties or their attorneys,' the Board may 'request that the parties or their attorneys … meet with the Board at its offices' for a conference. If the parties remain unwilling or unable to work together cooperatively and efficiently, the Board will not hesitate to invoke this Rule in the future.").

414 Selected Discovery Guidelines

Listed below are a variety of discovery determinations, with case citations, relating to the discoverability of various matters. This list is illustrative, not exhaustive.

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

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

(3) The classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers (including dealers) constitute confidential information, and generally are not discoverable, even under protective order. [Note 3.] However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order. [Note 4.]

(4) Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant). [Note 5.]

(5) Information concerning a party's first use of its involved mark is discoverable. [Note 6.]

(6) Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived). [Note 7.]

(7) For proceedings commenced on or after November 1, 2007, a party is required, in its pretrial disclosures, to name the witnesses it expects will testify, or may testify if the need arises, by oral testimony or affidavit and must provide general identifying information about the witness(es), as well as the witness(es)' telephone number and address. [Note 8.] In addition, a party must provide a general summary or list of subjects about which the witness(es)are expected to testify and a general summary or list of documents and things that may be introduced during the testimony of the witness(es). [Note 9.] If a party expects to call no witnesses during its assigned testimony period, it must so state in its pretrial disclosures. [Note 10.] Consequently, the identity of such witnesses is discoverable. [Note 11.] Such witnesses may have been named in a party's initial or supplemental initial disclosures,but a party is not required to supplement or correct its initial disclosures to provide identifying information about a witness listed in pretrial disclosures if that information previously has been made known to the other party in writing or during the discovery process. [Note 12.] *See* TBMP § 408.03. For proceedings commenced prior to November 1, 2007, a party need not, in advance of trial, identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. [Note 13.] Regardless of when proceedings commenced (i.e., before or after November 1, 2007), a party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce. [Note 14].

(8) A party's plans for expansion may be discoverable under protective order. [Note 15.]

(9) Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence. [Note 16.]

(10) Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. [Note 17.] However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). [Note 18.]

(11) A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion for purposes of establishing the relationship between the goods or services of the parties. [Note 19.]

(12) The names and addresses of a party's officers are discoverable. However, if a party has a large number of officers, it need only provide the names and addresses of those officers most knowledgeable of its involved activities. [Note 20.]

(13) Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purpose of forestalling a foreign user's expansion into the United States, or where the foreign mark is "famous," albeit not used, in the United States. [Note 21.]

(14) Generally, the names and addresses of the stockholders of a corporate party or other entities owned or controlled by the party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related companies" within the meaning of Trademark Act § 5, 15 U.S.C. § 1055. [Note 22.]

(15) The locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its involved mark, are discoverable. [Note 23.]

(16) Information relating to the areas of distribution for a party's involved goods or services sold under its involved mark is discoverable. [Note 24.]

(17) The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion. [Note 25.]

(18) Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order. [Note 26.]

(19) Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable. [Note 27.]

(20) Information concerning the technical expertise of the purchasers of a party's products is relevant to the issue of likelihood of confusion, and is discoverable. [Note 28.]

(21) A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact. [Note 29.]

(22) The mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, is not objectionable on the basis that it constitutes a collateral attack on the registration. [Note 30.]

(23) Where it is asserted that the mark or term is generic, or merely descriptive and without acquired distinctiveness, the following categories of information and documents are discoverable: 1) those assessing, evaluating, or considering any methods of describing the "product category"; 2) those relating to the decision to offer the product at issue to the extent such information and documents refer to the "product category" or any marks used or considered for use containing the purportedly generic term; 3) those assessing, evaluating, or considering how to categorize, describe or define the product; 4) those reflecting any consumer views or comments about the product offered. [Note 31.]

(24) Where it is asserted that the mark or term is generic, or merely descriptive and without acquired distinctiveness, information and documents relating to the choice of a particular product name need not be provided unless that name includes the term at issue. [Note 32.]

NOTES:

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

2. *See, e.g.*, *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (where hundreds of thousands of dollars spent, and tens of thousands of documents produced, opposer required to produce only a representative sample with respect to the specific requests at issue); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987) (production of representative sample not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (allowed to provide representative samples of invoices from each calendar quarter); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579-80 (TTAB 1975) (opposer need not identify dollar value and number of units of product held in inventory but may indicate only whether it does in fact carry such products in stock); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 689-90 (TTAB 1975) (sales and advertising figures for six different categories of goods since 1936 limited to five-year period and a statement that there have been sales for the other years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (production limited to ten representative samples of documents pertaining to selection of each type of copy machine); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (representative samples of advertisements permitted). *Compare British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (if opposers believed the limited information provided by applicant in response to interrogatories was insufficient and that applicant's objections on grounds that the interrogatories were unduly broad, burdensome, etc., were unfounded, opposers could have moved to compel more complete responses), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *The Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468, 471 (TTAB 1976) (if applicant believed documents produced by opposer were not truly representative, applicant could have filed motion to compel).

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

4. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (need for customer names does not outweigh possible harm, such as harassment of customers); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 169 (TTAB 1980) (possible harm outweighed where issue is abandonment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (name and address of first customer may be revealed to verify date of first use); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (must identify class of customers who purchase products under mark, but not names of customers). *See also Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556, 557 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123-24 (TTAB 1974).

5. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (must identify knowledgeable employees); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (whether applicant received opinions concerning adoption of mark is not privileged and applicant must identify person, date and documents relating thereto); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (identification of persons who suggested use of involved mark on involved goods is not improper). *Cf. Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1974) (applicant's request for writings relating to selection of mark to show what third parties'

marks may have been considered and extent to which opposer believed its mark conflicted therewith not permitted).

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

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

8. 37 CFR § 2.121(e).

9. 37 CFR § 2.121(e).

10. 37 CFR § 2.121(e).

11. *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010) (in the event opposer serves revised pretrial disclosures naming witness, discovery reopened for applicant only for the limited purpose of allowing applicant to take named witness' discovery deposition).

12. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245-46 (August 1, 2007). *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (opposer's failure to supplement its initial disclosures to identify foreign non-party witness as a potential witness does not preclude introduction of witness' discovery deposition at trial, even though opposer should have supplemented initial disclosures, because applicant was aware of witness' identity and subject matter of her testimony and was able to cross-examine the witness during the discovery phase).

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

14. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

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

16. *See Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013) (a party need not investigate third-party use to respond to discovery requests); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011) (a party has no duty to conduct an investigation of third-party uses in response to discovery requests); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001) (no obligation to search for third-party uses); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (investigation not necessary); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not investigate); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show mark is weak). *See also Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1363 n.9 (TTAB 1988) (relevant to show purchaser perception of the marks).

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

18. *See Interbank Card Association v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975) (need not reveal reasons for dismissal of prior opposition against third party) and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (need not identify all documents pertaining to such litigation).

19. *See TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (where goods of parties differ, determining whether parties market goods of same type is relevant to establishing relationship between goods); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (questions concerning specific goods on which opposer uses mark are proper to extent scope of inquiry is limited to those goods identified in application, or involve goods of type marketed by applicant, or mentioned by opposer during discovery); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 n.2 (TTAB 1985) (information regarding goods other than those in involved application and registration is irrelevant); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 584 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1979) (applicant's use of mark on goods other than those in application irrelevant); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (interrogatory too broad, requiring identity of products having no relevance to opposition); *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493, 493 (TTAB 1973) (applicant need not provide information as to its other marks or its other products, or as to whether involved mark is used on other products). *See also Wella Corp. v. California Concept Corp.*, 192 USPQ 158, 163 (TTAB 1976) (although the goods are not the same, they are of the type often made by the same manufacturer), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977); *Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649, 652 (CCPA 1975) (in the absence of any showing that manufacturers never

use same mark on the two involved classes of goods, the fact that the goods are often made by the same manufacturer, even if under different marks, may be relevant).

20. *See J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (may identify reasonable number of those most knowledgeable of adoption, selection or day-to-day uses of mark); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (identification of vice-president as most familiar with use held sufficient). *Cf. Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1243 n.10 (TTAB 2012) (plaintiff not faulted for not originally identifying witness in response to an interrogatory because it is unclear from witness' title whether she was an "officer or managing agent," which was the information sought by discovery request).

21. For general rule, see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991); *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.). *See also Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481, 489 n.7 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff'd, Miller Brewing Co. v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976). Concerning possible exceptions,see Article 6 *bis* of the Paris Convention; *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (knowledge of foreign use, in itself, does not preclude good faith adoption and use in U.S.); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991); *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 702 (TTAB 1986) (in view of applicant's knowledge of opposer's claim to mark in foreign countries and of opposer's intention to enter U.S. market, it appears that applicant intended to preclude opposer from entering U.S. market); *Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A.*, 228 USPQ 589, 595 (TTAB 1985) (presale publicity including providing clothing with mark to competitive skiers insufficient to popularize mark as identifying source to U.S. purchasers and to create priority rights in the U.S.); *Davidoff Extension S.A. v. Davidoff International, Inc.*, 221 USPQ 465, 468 (S.D. Fla. 1983) (foreign corporation with U.S. registration based on foreign registration had rights in mark superior to individual who attempted to use the name in the U.S.); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 77-78 (TTAB 1983) (prior use and advertising in connection with goods marketed in foreign country, whether advertising occurs inside or outside U.S., creates no prior rights in U.S. against one who adopts similar mark prior to foreigner's first use on goods sold in U.S., unless foreign party's mark was famous); *All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc.*, 220 USPQ 1069, 1072 (TTAB 1983) (opposer acquired rights to famous mark in U.S. for competitions held in England prior to adoption of mark by applicant for any goods/services); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 662 (TTAB 1983) (claim of fame in France and existence of pending U.S. application based on foreign registration insufficient to establish that fame extended to U.S.). *See also Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046, 1048 (TTAB 1983); *Johnson & Johnson v. Diaz*, 339 F. Supp. 60, 172 USPQ 35, 37 (C.D. Cal. 1971).

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

23. *See Varian Associates v. Fairfield-Noble Corp., Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (locations of "all places of business" overly broad); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974).

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

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

26. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of likelihood of confusion and abandonment; response that these figures have been "substantial" is insufficient); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (sales and advertising expenditures have bearing on registrability); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (relevant to issue of abandonment); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to provide figures for each of last five years and a statement that there have been sales for the other years); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (money expended in advertising to be confined to goods in application); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (required to furnish round figures concerning sales under mark for period of five years as well as advertising expenditures relating thereto).

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

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

29. *See* Fed. R. Civ. P. 33(a)(2); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671,1676 (TTAB 1988); *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) (question of whether opposer believes marks to be confusingly similar is relevant).

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

31. *See Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011).

32. *See Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1911 (TTAB 2011).