Chapter 700 TRIAL PROCEDURE AND INTRODUCTION OF EVIDENCE

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701 Time of Trial

37 CFR § 2.116

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

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

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

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

37 CFR § 2.121 ***Assignment of times for taking testimony and presenting evidence.***

(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any subsequent remaining periods may remain as set. 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. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.*

* * * *

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

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

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

(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 through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

(e) … *[N]o later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123. Pretrial disclosure of a witness under this paragraph (e) does not substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure.*

On receipt of a properly filed notice of opposition or petition to cancel (or at the time described in 37 CFR § 2.92 for an interference, *see* TBMP § 1003, or 37 CFR § 2.99(c) for a concurrent use proceeding which is not based on a court decision or a prior Board decision, *see* TBMP § 1106.04), the Board serves the complaint to the defendant in the form of a link to, or web address for, the Board's electronic case file system (''TTABVUE'') in the notice advising the parties of the institution of the proceeding. The notice includes a trial order setting deadlines for the answer, discovery conference, initial and expert disclosures, discovery, and each party's required pretrial disclosures, and assigning each party's time for taking testimony and introducing other evidence in the case. [Note 1.] *See* TBMP § 310.01 (oppositions and cancellations); TBMP § 1007 (interferences) and TBMP § 1106.04 (concurrent use proceedings). *See also* TBMP § 403.01.

In the trial order, the Board schedules a 30-day testimony period for the plaintiff to present its case in chief, a 30-day testimony period for the defendant to present its case and to meet the case of the plaintiff, and a 15-day testimony period for the plaintiff to present rebuttal evidence. [Note 2.] The plaintiff's period for presenting its case in chief is scheduled to open 60 days after the close of the discovery period; the defendant's testimony period is scheduled to open 30 days after the close of the plaintiff's testimony period in chief; and the plaintiff's rebuttal testimony period is scheduled to open 30 days after the close of the defendant's testimony period. [Note 3.] The trial order also schedules the time for pretrial disclosures of witnesses: each party must make pretrial disclosures no later than fifteen days prior to the opening of its testimony period. [Note 4.]

If there is a counterclaim, or if proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or if there is an interference or a concurrent use registration proceeding involving more than two parties, the Board schedules testimony periods as specified in 37 CFR § 2.121(b)(2), i.e., giving each plaintiff a period for presenting its case in chief as against each defendant, giving each defendant a period for presenting its case and meeting the case of each plaintiff, and giving each plaintiff a period for rebuttal. The testimony periods are separated from the discovery period by a 60-day interval, and from each other by 30-day intervals. [Note 5.] In an interference or concurrent use proceeding, a junior party is in the position of plaintiff and a senior party is in the position of defendant. [Note 6.] *See* TBMP § 1005, TBMP § 1007 and TBMP § 1108.

A party may not take testimony or present evidence outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 7.]

Testimony periods may be rescheduled, extended, shortened or reopened by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board. [Note 8.] *See* TBMP § 501 and TBMP § 509 regarding stipulations and motions to extend or reopen. A stipulation or consented motion to reschedule a deadline for pretrial disclosures and subsequent testimony periods or to reschedule the closing date for discovery and to reschedule subsequent deadlines for pretrial disclosures and testimony periods must be submitted to the Board through ESTTA and must be presented in the form used in a trial order with the relevant dates set forth, specifying the deadline for each subsequent period, including, as applicable, the deadline for initial, expert and pretrial disclosures, the closing date for discovery and testimony periods, and an express statement that the parties agree to the new dates. [Note 9.] It is preferable, where such a motion is unconsented, that the motion request that the new deadlines be determined, and any period or periods be set to run, from the date of the Board's decision on the motion. *See* TBMP § 509.02.

The resetting of the closing date for discovery results in the automatic rescheduling of pretrial disclosure deadlines and testimony periods, without action by any party. Likewise, the resetting of a party's testimony period results in the automatic rescheduling of the remaining pretrial disclosure deadlines without action by any party. [Note 10.] For information regarding extensions of the discovery period and time to respond to discovery requests *see* TBMP § 403.04

In Board inter partes proceedings, the submission of evidence and testimony during the parties' assigned testimony periods corresponds to the trial in court proceedings. [Note 11.] The trial period commences with the opening of the first testimony period. [Note 12.] *See* TBMP § 504.01. *Cf.* TBMP § 528.02. An oral hearing, if requested, corresponds to oral summation in court proceedings. [Note 13.] *See* TBMP §802.

The Board may sua sponte enter judgment for the defendant in cases where the plaintiff has not submitted evidence or taken testimony during its assigned testimony period where it is clear that the plaintiff has not offered any other evidence. [Note 14.]

NOTES:

1. *See* 37 CFR § 2.120(a) and 37 CFR § 2.121.

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

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

4. *See* 37 CFR § 2.121(e).

5. *See* 37 CFR § 2.121(b)(2) and 37 CFR § 2.121(c). Sample trial schedules can be found in the Appendix of Forms.

6. *See* 37 CFR § 2.96 and 37 CFR § 2.99(e).

7. 37 CFR § 2.121(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (the Office is amending § 2.121(a) to clarify that evidence must be presented during a party's testimony period, codifying current Office practice.). *See*

also Baseball America Inc. v. Powerplay Sports, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (documentary evidence submitted outside assigned testimony period given no consideration); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1072 (TTAB 1990) (untimely deposition stricken); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (opposer's discovery deposition of non-party witness treated as testimony deposition taken by stipulation prior to trial); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979) (discovery deposition of non-party inadmissible as evidence under a notice of reliance filed by one party without express or implied consent of adverse party; should have taken deposition during trial period or at least moved to take trial testimony prior to assigned testimony period). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, but applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

8. Fed. R. Civ. P. 6(b); 37 CFR § 2.121(a), 37 CFR § 2.121(c) and 37 CFR § 2.121(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(c) to add that testimony periods may be shortened by stipulation of the parties approved by the Board or may be extended on motion granted by the Board or order of the Board."). *See, e.g.*, *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (motion to extend testimony filed on last day with vague references to settlement and no detailed information concerning apparent difficulty in identifying and scheduling its witnesses for testimony denied); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999) (motion to extend denied where sparse motion contained insufficient facts on which to find good cause); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (motion to reopen to submit new evidence denied); *Pumpkin Ltd v. The Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997) (motion to reopen filed over three months after close of testimony period, due to a docketing error, denied).

9. *See* 37 CFR § 2.121(d). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(d) to add that stipulations to reschedule the deadlines for the closing date of discovery, pretrial disclosures, and testimony periods must be submitted through ESTTA with the relevant dates set forth and an express statement that all parties agree to the new dates. These amendments codify current Office practice.").

10. *See* 37 CFR § 2.121(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(a) to clarify that evidence must be presented during a party's testimony period. The Office is further amending § 2.121(a) to add that the resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. These amendments codify current Office practice.").

11. *See* 37 CFR § 2.116(e). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69959 (October 7, 2016) ("The Office is amending § 2.116(e) to add that the submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions, during the testimony period corresponds to the trial in court proceedings. The revision codifies current Office practice and is consistent with amendments relating to declarations and affidavits."); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (Board proceedings approximate the proceedings in a courtroom trial); *Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (trial in a Board proceeding takes place during the testimony periods).

12. 37 CFR § 2.121(a).

13. 37 CFR § 2.116(f).

14. 37 CFR § 2.132(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (October 7, 2016) ("The Office is amending § 2.132(a) to clarify that, if a plaintiff has not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant sua sponte.").

702 Pretrial Disclosures; Manner of Trial; and Introduction of Evidence

37 CFR § 2.121 ***Assignment of times for taking testimony and presenting evidence.***

(a) *... The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.*

(e) *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123. Pretrial disclosure of a witness under this paragraph (e) does not substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. A party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike, as provided in §§ 2.123 and 2.124.*

37 CFR § 2.123(e)(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

Fed. R. Civ. P. 26(a)(3) Pretrial Disclosures.

(A) ***In General.*** *In addition to the disclosures required by Rule 26(a)(1) and (2), a party must provide to the other parties and promptly file the following information about the evidence that it may present at trial other than solely for impeachment:*

(i) *the name and, if not previously provided, the address and telephone number of each witness — separately identifying those the party expects to present and those it may call if the need arises;*

(ii) *the designation of those witnesses whose testimony the party expects to present by deposition and, if not taken stenographically, a transcript of the pertinent parts of the deposition; and*

(iii) *an identification of each document or other exhibit, including summaries of other evidence — separately identifying those items the party expects to offer and those it may offer if the need arises.*

702.01 Pretrial Disclosures

Pretrial disclosures are governed by 37 CFR § 2.121(e) and Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). [Note 1.] Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses. [Note 2.]

Because the trial schedule in a Board proceeding employs alternating testimony periods with gaps between them, the due dates for pretrial disclosures will be different for each party and will be specified in the Board's notice instituting the proceeding. [Note 3.] Under 37 CFR § 2.121(e), the party scheduled to present evidence must make pretrial disclosures no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board. Witnesses who are expected to or may testify must be disclosed under Fed. R. Civ. P. 26(a)(3)(A). [Note 4.]

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises. [Note 5.] The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. [Note 6.]

Pretrial disclosure of a witness under 37 CFR § 2.121(e) does not substitute for issuance of a proper notice of examination under 37 CFR § 2.123(c) or 37 CFR § 2.124(b). [Note 7.]

If a party does not plan to take testimony from any witnesses in any form, it must so state in its pretrial disclosure. [Note 8.]

When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. [Note 9.]

A party may object to improper or inadequate pretrial disclosures. [Note 10.] *See* TBMP § 533.02(b).

The pretrial disclosure requirement cannot simply be ignored because some information about a testifying individual may be known by the adverse party or parties. [Note 11.]

A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. [Note 12.] Thus, each document or other exhibit that a party plans to introduce at trial

does not need to be disclosed to the other party. [Note 13.] A party planning to introduce an adverse party's discovery deposition, or part thereof, need not disclose such plans. [Note 14.] For further information regarding the submission of discovery depositions under notice of reliance *see* TBMP § 704.09.

If pretrial disclosures or the notice of examination of witnesses served pursuant to 37 CFR § 2.123(c) are improper or inadequate with respect to any witness, an adverse party may move to quash a noticed testimony deposition of that witness before the deposition occurs. [Note 15.] The adverse party may also cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all relevant circumstances. [Note 16.] When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike. [Note 17.] A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with 37 CFR § 2.121(e). [Note 18.] On the other hand, a motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony. [Note 19.]

If the deficiencies in the pretrial disclosure are technical in nature the parties are encouraged to resolve the matter between themselves or to bring the matter to the Board's attention promptly for resolution for judicial economy and before the parties incur the expense associated with taking a testimonial deposition. The Board allows parties to cure timely, but technically deficient matters. [Note 20.]

A party making a pretrial disclosure is not required to file routinely a copy of such disclosure with the Board. In this regard, the Board's practice varies slightly from that set forth in Fed. R. Civ. P. 26(a)(3)(A). Alerting the Board to a party's witness list is not a purpose of the pretrial disclosure requirement as the Board does not preside at the taking of testimony or at a pretrial conference. [Note 21.]

Parties may stipulate to waive the requirement for pretrial disclosures in ACR cases. [Note 22.]

The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. [Note 2.]

For information on pretrial disclosure of expert witnesses, see TBMP § 401.03 or for motions to strike the testimony of an expert witness, see TBMP § 533.02(b).

NOTES:

1. *See* 37 CFR § 2.121(e).

2. *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015) (both parties are required to serve initial disclosures identifying witnesses having discoverable information and to serve pretrial disclosures naming the witnesses expected to testify at trial); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655 (TTAB 2014) (identity of trial witnesses may not be designated as confidential), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. January 15, 2016); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372 (TTAB 2011); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (citing MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42257-58 (August 1, 2007)). *See also Spier Wines*

(PTY) Ltd. v. Shepher, 105 USPQ2d 1239, 1246 (TTAB 2012) (witness first identified in pretrial disclosure and not previously identified in initial disclosures, discovery responses or supplements resulted in unfair surprise and was neither harmless nor substantially justified); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011) (failure to identify witnesses during discovery but named in pretrial disclosures resulted in unfair surprise to adversary).

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

4. 37 CFR § 2.121(e). *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371-72 n.1 (TTAB 2011) ("A party is expected to disclose all witnesses it expects to call as well as those that it may call if the need arises").

5. 37 CFR § 2.121(e). *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371 (TTAB 2011) (pretrial disclosure adequate and sufficient); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444-45 (TTAB 2009) (under Trademark Rules, petitioner is required to name any witnesses from whom it intended to take testimony, or even might take testimony, if needed; 37 CFR § 2.121(e) contemplates that contact information of a witness may previously have been provided to the party receiving a disclosure and need not be repeated).

6. 37 CFR § 2.121(e). *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015) (respondent's pretrial disclosures defective to the extent that they fail to summarize the types of documents and things respondent intended to introduce as exhibits to his testimony; all forty-six exhibits attached thereto and all portions of respondent's testimony referring to the attached exhibits not considered); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371 (TTAB 2011) (pretrial disclosure adequate and sufficient).

7. 37 CFR § 2.121(e).

8. 37 CFR § 2.121(e).

9. 37 CFR § 2.121(e).

10. *See* 37 CFR § 2.123(e)(3) and 37 C.F.R §2.123(e)(3). *See also Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655 (TTAB 2014) (identity of trial witnesses may not be designated as confidential), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. January 15, 2016); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 n.4 (TTAB 2011).

11. *See Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).

12. 37 CFR § 2.121(e). *Accord Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 n.4 (TTAB 2015).

13. 37 CFR § 2.121(e).

14. *See* 37 CFR § 2.120(k)(1) ("The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.").

15. 37 CFR § 2.121(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The amendment codifies current Office practice.").

16. 37 CFR § 2.123(e)(3).

17. 37 CFR § 2.121(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that when testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike…").

18. 37 CFR § 2.123(e)(3)(i). *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015) (respondent's improper service of pretrial disclosures at counsel for petitioner's former address held harmless to the extent the disclosure identified a single witness, respondent himself); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655 (TTAB 2014) (identity of trial witnesses may not be designated as confidential), *appeal* dismissed per stipulation, No. 14-CV-4463 (D. Minn. January 15, 2016); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011) (Opposer's failure to name one witness until original pretrial closures and twenty-six witnesses until supplement to amended pretrial disclosures was neither harmless nor substantially justified and motion to quash granted as to twenty-six witnesses but testimony of one witness, identified months before in original pretrial disclosure, not excluded provided adverse party be given an opportunity to take a discovery deposition); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (failure to disclose testimony witness in initial disclosures considered as a relevant circumstance in determining whether to strike testimony deposition).

19. 37 CFR § 2.123(e)(3)(ii).

20. *See Carl Karcher Enterprise, Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 n.4 (TTAB 2011). *Cf. Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011) (applicant could not cure surprise without moving to quash, or seeking to reopen discovery, or engaging in unplanned preparation to cross examine witnesses identified for the first time in pretrial disclosures).

21. *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 (TTAB 2011).

22. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 n.5 (TTAB 2015) (where neither party served pretrial disclosures and the parties ACR stipulation did not provide for the exchange of pretrial disclosures, motion to strike witness declaration denied).

23. 37 CFR § 2.121(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(a) to add that the resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. These amendments codify current Office practice.").

702.02 Introduction of Evidence

37 CFR § 2.122(a) ***Applicable rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States*

Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

Unless the parties otherwise stipulate, the introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations). [Note 1.] *Cf.* TBMP § 101.01 and TBMP § 101.02. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 2.]

Within the parameters of these rules, there are a number of ways to introduce evidence into the record in a proceeding before the Board. Evidence may be introduced either in the form of testimony depositions taken by a party during its testimony period or in the form of affidavits or declarations subject to the right of the adverse party to conduct cross-examination. Documents and other exhibits may be made of record with appropriate identification and introduction by the witness during the course of the deposition or in an affidavit or declaration. *See generally* TBMP §703.01 regarding affidavits, declarations and oral testimony depositions and TBMP §703.02 regarding testimony depositions on written questions. *See also* TBMP § 704.13 regarding introducing testimony from another proceeding, and TBMP § 530 regarding motions to use testimony from another proceeding. Certain specified types of evidence, including official records and printed publications as described in 37 CFR § 2.122(e) and discovery responses under 37 CFR § 2.120(k), may, but need not, be introduced in connection with the testimony of a witness. Such evidence may instead be made of record by filing the materials with the Board under cover of a notice of reliance during the testimony period of the offering party. [Note 3.] *See generally* TBMP § 704.02 regarding the types of evidence that may be submitted by notice of reliance and the requirements for the introduction of such evidence by notice of reliance. In addition, the parties may enter into a wide variety of stipulations concerning the timing and/or introduction of specified matter into evidence. *See* TBMP § 705 regarding stipulated evidence. For example, the parties may stipulate that matter otherwise improper for a notice of reliance (such as documents obtained by production under Fed. R. Civ. P. 34) may be introduced in that manner, that a party may rely on its own discovery responses or that notices of reliance can be filed after the testimony periods have closed. There may also be circumstances where improperly offered or otherwise noncomplying evidence may nevertheless be deemed stipulated into the record where, for example, no objection to the evidence is raised and/or the nonoffering party treats the evidence as being of record. [Note 4.] *See generally* TBMP § 704 regarding the introduction of other evidence.

A discussion of the time and manner of taking testimony depositions, presenting testimony in affidavit or declaration form, and introducing evidence is presented in the sections that follow.

NOTES:

1. 37 CFR § 2.122(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.122(a) to clarify the heading of the paragraph and to specify that parties may stipulate to rules of evidence for proceedings before the Board.").

2. 37 CFR § 2.122(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (amended effective January 14, 2017 to codify current Board practice). *See, e.g., Nazon v. Ghiorse*, 119 USPQ2d 1178, 1181 n.6 (TTAB 2016) ("Once evidence is properly of record, it may be relied on by any party for any purpose.").

3. *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2001) (notices of reliance must be filed before closing date of party's testimony period).

4. *See, e.g., Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603, n.3 (TTAB 2010), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

702.03 Manner of Trial

Because the Board is an administrative tribunal, its rules and procedures differ in some respects from those prevailing in the federal district courts. [Note 1.] *See* TBMP § 102.03 regarding Board proceedings in general and TBMP § 502.01 regarding motions that may be filed at the Board. For example, in lieu of live testimony, proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based on the written record therein. [Note 2.] The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, by affidavit or declaration, or on oral examination or written questions, and the affidavits, declarations and written deposition transcripts, together with any exhibits thereto, are then submitted to the Board. [Note 3.]

Depositions may be noticed for any reasonable place in the United States. [Note 4.] As a result, parties do not have to travel to the offices of the Board, or to the geographic area surrounding the Board's offices, to take their testimony. Plaintiffs also have the option of presenting witness testimony in affidavit or declaration form subject to the right of any adverse party to elect to take and bear the expense of oral cross examination of that witness. [Note 5.] *See* TBMP § 703.01(h). A party to a proceeding before the Board need never come to the offices of the Board at all, unless the party wishes to argue its case at oral hearing at the offices of the Board, or unless otherwise ordered by the Board.

An oral hearing is held only if requested by a party to the proceeding. [Note 6.] *See* TBMP § 802.02.

Submissions made during the course of an inter partes proceeding are stored in electronic form and are available for viewing on the Board home page of the USPTO website via TTABVUE (**http://ttabvue.uspto.gov**). Filings in Board proceedings are made electronically via ESTTA, and in the rare circumstances that filing in paper form is permitted under the rules, such paper submissions are scanned into the electronic record. The electronic record constitutes the official record of the proceeding. *See* TBMP § 120. No document, exhibit, etc., whether submitted electronically or as paper, will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules, *see* TBMP § 706, [Note 7], or the parties stipulate or otherwise treat the evidence as being of record, *see* TBMP § 702.02.

For a further discussion regarding viewing and obtaining Board records, see TBMP § 121.

If the parties to a proceeding desire to obtain a final resolution of a proceeding prior to the scheduled trial period, they may consider Accelerated Case Resolution ("ACR"). For information on ACR, see TBMP § 528.05(a)(2), TBMP § 702.04 and TBMP § 705.

NOTES:

1. *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). For a general

discussion of inter partes proceedings before the Board, see *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

2. 37 CFR § 2.191. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

3. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976).

4. *See* 37 CFR § 2.123(a)(1) and 37 CFR § 2.123(c).

5. 37 CFR § 2.123(a)(1).

6. *See* 37 CFR § 2.129(a).

7. *See* 37 CFR § 2.123(k).

702.04 Accelerated Case Resolution

702.04(a) In General

Accelerated Case Resolution ("ACR") is an alternative to typical Board inter partes proceedings with full discovery, trial and briefing, in which parties to a Board proceeding can obtain a determination of the claims and defenses in their case in a shorter time period than contemplated in the typical Board proceeding. The form of ACR can vary, but the process generally approximates a summary bench trial or cross-motions for summary judgment and accompanying evidentiary submissions that the parties agree to submit in lieu of creating a traditional trial record [Note 1] and traditional briefs at final hearing. Other approaches to accelerating resolution of a case include simplifying proceedings through the use of fact stipulations and stipulations regarding the admissibility of certain evidence. [Note 2.] Oral hearings generally are available in ACR cases in accordance with 37 CFR § 2.129(a). *See* TBMP § 802. If parties agree to conduct the case as an ACR case and to utilize the bench trial or cross-motions for summary judgment model, and the Board approves trial of the case by ACR, the Board generally will render a final decision within fifty (50) days following the completion of briefing.

By reducing the complexity of a case and total time expended in litigating a case, ACR is a more efficient and economical alternative to the typical Board inter partes proceeding. Not all Board cases involve complicated or disputed facts or require the full discovery and trial periods set out by the Trademark Rules, to arrive at a final determination. Parties may thereby save time and expense by focusing only on those issues genuinely in dispute, and opting for ACR early in the proceeding. For example, if the parties stipulate to facts, no time need be spent proving those facts (although there may be some typical costs involved in preparing and exchanging documents and other materials that illustrate for the involved parties that facts are not genuinely in dispute and therefore can be stipulated). When the issues in a proceeding are limited, savings can be even greater, because all aspects of the proceeding, including discovery, trial and briefing, are focused on such limited matters.

The Board is willing to consider almost any claim under ACR unless the complexity or novelty of the facts and/or legal theory of the case requires a full trial. However, the most appropriate cases for ACR are those in which, for example, little discovery is necessary, the parties are able to stipulate to many facts, each party

expects to rely on the testimony of one or two witnesses, or the overall record will not be extensive. [Note 3.] ACR may not be suited to cases that generate a large record, complicated factual or legal issues, or cases where the parties are unwilling to stipulate to any matters (i.e., limitations on discovery or trial schedules, the absence of any genuine dispute about particular facts, or entry of evidence into the record).

ACR presently can be implemented only by consent of the parties and agreement by a Board attorney or judge, and will not be approved by unilateral motion of one party. ACR can also be implemented by all parties accepting an invitation or suggestion from a Board attorney or judge to participate in the process. [Note 4.] The parties are required to discuss the possibility of using ACR in their discovery conference and may seek the assistance of the Board in structuring their case so that it qualifies for ACR and the Board's objective to render a decision within fifty days (50) from the completion of briefing. [Note 5.]

Parties seeking to optimize their chances for early determination of their case and savings in their resources are advised to opt for ACR early in the proceeding. To opt for ACR, the parties may jointly file a statement indicating their desire to proceed under ACR along with a proposed modified schedule which may include an abbreviated discovery period and/or briefing period under any form of ACR. The assigned attorney may, and likely will, then convene a conference by telephone to discuss the proceeding with the parties and explore how they wish to proceed under ACR. The parties may seek Board assistance when contemplating ACR to determine which form of ACR to follow and/or determine the discovery, trial and briefing schedule. Any modified discovery, trial and briefing schedule, including limits on discovery or discovery devices or trial, must be negotiated by the parties and approved by the Board. If, however, the parties choose to follow the traditional discovery and trial schedule, but merely wish to stipulate to particular facts or that particular items of evidence shall be considered by the Board, they may so agree and file their written agreement with the Board without need of a conference with a Board attorney. While this approach yields efficiency and savings, since prescribed discovery procedures and discovery and trial schedules are unchanged, a conference with a Board attorney typically would not be necessary.

The parties may limit discovery in a number of ways. For example, parties may limit the number of interrogatories, requests for production and requests for admissions as well as the number and duration of discovery depositions. They may exchange more extensive disclosures in lieu of formal discovery, or stipulate to facts and the exchange of certain documents, or propound interrogatory requests only on particular issues. If the parties are unable to agree on discovery limits, they will not have optimized any cost and time savings available through ACR. When discovery devices (e.g., number of depositions, document requests, or interrogatory requests) are limited, practice is necessarily more focused and cost efficient.

Parties which agree to conduct the proceeding under ACR and which have stipulated to limited discovery may still take testimonial depositions or introduce testimony by affidavit or declaration, subject to the right of the nonoffering party to cross-examine the witness. By limiting the number or duration of testimonial depositions, they may realize additional savings in cost and time. They may also agree that the offering party may use discovery depositions at trial.

Parties may also agree under ACR to forego pretrial disclosures. Furthermore, if an ACR stipulation is silent on the issue of pretrial disclosures and no pretrial disclosures were in fact filed by either party, the Board will interpret the stipulation as waiving this requirement. [Note 6.]

The standards of proof in an ACR proceeding are the same as the standards of proof in a traditional Board proceeding. In either an opposition or cancellation, the burden of proof remains with the plaintiff, who must establish its case by a preponderance of the evidence. [Note 7.]

A final decision rendered under ACR may be appealed in the same manner and under the same time frames as non-ACR decisions by the Board. [Note 8.] For further information regarding appeals of inter partes decisions, see TBMP Chapter 900.

Please Note: Some of the cases cited in this section established efficiencies later codified in amended 37 CFR § 2.123(a)(1), effective January 14, 2017, which allows parties to present direct testimony by affidavit or declaration subject to cross-examination by the adverse party.

NOTES:

1. *See, e.g., Bond v. Taylor,* 119 USPQ2d 1049, 1051 (TTAB 2016); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 (TTAB 2015); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 (TTAB 2014); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016 (TTAB 2014); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1950 (TTAB 2014), *vacated and remanded on other grounds, Princeton Vanguard , LLC v. Frito-Lay North. America., Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1827-28 (TTAB 2012); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986). *See also Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 47 USPQ2d 1953, 1954-55 (2d Cir. 1998).

2. *See, e.g., Bond v. Taylor,* 119 USPQ2d 1049, 1051 (TTAB 2016) (parties' stipulated to forgo reply briefing and that they could rely on the materials submitted in connection with previously filed motions for summary judgment); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 (TTAB 2015) (parties filed ACR stipulation to present all testimony by declaration and to submit discovery responses and documents produced in discovery as exhibits without the need for accompanying testimony); *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that testimony could be submitted by declaration or affidavit subject to cross-examination upon request, and all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. January 15, 2016); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of produced documents and waiver of objections based on authenticity or hearsay); *Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 (TTAB 2013) (parties stipulated under ACR that they could rely on the materials submitted in support of and against opposer's previously filed motion for summary judgment, that testimony could be submitted by declaration, that pretrial disclosures were not required, and that all evidence may be submitted through declarations or notices of reliance); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to the entire record: 13 paragraphs of facts, including applicant's dates of first use, channels of trade for applicant, extent and manner of applicant's use, recognition by others of applicant's use, as well as the dates, nature and extent of descriptive use by the opposer's parent company; the admissibility of business records, government documents, marketing materials and Internet printouts and to forgo trial).

3. *See Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1828 (TTAB 2012) (claim of likelihood of confusion, stipulated to standing, priority, pleaded registration, "lawn seed" and "grass seed" legally identical descriptions of goods).

4. *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Hewlett-Packard Development Co. v. Vudu Inc,*, 92 USPQ2d 1630, 1634 n.6 (TTAB 2009) (in granting partial summary judgment, the Board suggested the parties may seek to use ACR on the remaining disputed issues without the need for a formal trial).

5. *See Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (early election of ACR, no motion practice, utilized conference with Board attorney for dispute re: stipulation, from notice to briefing less than a year, resulting in clean and concise record); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 n.3 (TTAB 2014) (ACR proceeding experienced delay in issuing decision due to precedential nature of decision and the number and nature of objections), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. January 15, 2016); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829-30 n.9 (TTAB 2012) (although the parties crafted and proceeded with their own ACR approach, better practice is to contact the assigned Board attorney when the parties elect to pursue ACR); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

6. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 n.5 (TTAB 2015) ("While parties are obligated to identify trial witnesses in their pretrial disclosures, there is no indication in the record that either party served pretrial disclosures in this ACR case (and the parties' ACR Stipulation does not provide for the exchange of pretrial disclosures." No basis for motion to strike and declaration at issue considered).

7. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049, 2056 (2015) (party opposing registration bears the burden of proof); *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979); Bond v. Taylor, 119 USPQ2d 1049, 1051 (TTAB 2016).

8. *See* 37 CFR § 2.145.

702.04(b) ACR using Summary Judgment Briefs

For a case prosecuted on the summary judgment model of ACR, the trial and briefing periods occur in one phase. That is, the summary judgment briefs and accompanying evidentiary submissions encompass both the trial and briefing periods. Because the parties have, in essence, agreed to create the record for the case by their summary judgment submissions, testimony will be presented by affidavit or declaration, and any exhibits referenced by the affiants or declarants.

In addition to filing summary judgment briefs, the parties should file a joint stipulation of undisputed facts, and, as attachments or exhibits to their briefs, any materials that, in a typical trial, could be submitted by notice of reliance (the notice of reliance itself need not be filed). [Note 1.] The parties are free to enter into other stipulations regarding the submission of evidence. [Note 2.] For example, they may agree that documents and things produced in response to requests for production may be submitted as exhibits without the need for accompanying testimony. The stipulations regarding the submission of evidence remove any question about the admissibility of the evidence, but the parties may reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality, or the weight to be accorded particular items of evidence. A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 3.]

ACR summary judgment briefs may be presented either as cross motions for summary judgment or as a single motion for summary judgment. If the parties stipulate to ACR and file cross motions for summary judgment, each party is entitled to file a response to the other's motion and a reply in support of its own motion. [Note 4.] If the parties stipulate to ACR and the summary judgment motion is in the form of a single motion by plaintiff, then defendant may file a brief in response and only plaintiff is entitled to file a reply. [Note 5.] In the absence of a stipulation to the contrary, the parties are limited to 25 pages for the ACR summary judgment briefs, inclusive of table of contents and cases, index of cases, description of the record, statement of the issues, recitation of facts, argument and summary. [Note 6.] Reply briefs are limited to 10 pages unless otherwise stipulated [Note 7.] and arguments should be restricted to rebuttal of the adverse party's case in chief.

In using the summary judgment form of ACR, the parties must provide a stipulation that the Board may resolve any genuine disputes of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing. [Note 8.]

If the parties decide early in the case to use the ACR motion for summary judgment model, they should file a stipulation with the Board selecting the ACR summary judgment model and setting forth the negotiated schedule for discovery and any limitation on discovery, submission of stipulations, and briefing. [Note 9.]

For more information regarding ACR motions for summary judgment, see TBMP § 528.05(a)(2).

NOTES:

1. *See, e.g., Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016).

2. *See, e.g., Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016).

3. *See Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating to introduction of affidavit and its exhibits into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (SDNY December 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013) .

4. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1).

5. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1).

6. 37 CFR § 2.127(a). *But see Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement provided that "the page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b).").

7. 37 CFR § 2.127(a). *But see Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement provided that "the page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b).").

8. *See, e.g., Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016).

9. *See e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (pursuant to their ACR stipulation, parties agreed to forgo discovery and reliance on expert testimony).

702.04(c) ACR Conversion - Summary Judgment Briefs

In circumstances where the parties have already filed summary judgment briefs, the Board may, in appropriate cases, invite the parties to agree to the Board's treatment of the summary judgment briefs and evidence as the final records and briefs. [Note 1.] Alternatively, the parties may stipulate to treating the summary judgment briefs and evidence as the record and final briefs on the case, even in the absence of an invitation to do so extended by the Board. [Note 2.]

In either case, the parties must stipulate that the Board may resolve any genuine disputes of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing.

For more information regarding ACR motions for summary judgment, see TBMP § 528.05(a)(2).

NOTES:

1. *See, e.g., Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1147 and 1147 n.5 (TTAB 2016); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1950 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated and remanded on other grounds, Princeton Vanguard , LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015).

2. *See, e.g., Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002) (parties stipulated that case would be decided on petitioner's motion for summary judgment and respondent's response); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986) (parties stipulated that cross motions for summary judgment would be treated as testimony, evidence and briefs at final hearing).

702.04(d) ACR using Stipulated Record and Trial Briefs

Under the stipulated record and trial briefs ACR model, the case proceeds to final decision on an evidentiary record that has been stipulated to, in whole or in substantial part. Thus, the parties must be prepared to stipulate to the admissibility of most of the record. They may, however, reserve the right to object in trial briefs on substantive grounds to particular evidence such as on the grounds of competency, relevancy or materiality. Testimony periods may not be needed for cases prosecuted on the stipulated record model (with or without stipulated facts), if the evidentiary record has been stipulated to by the parties. [Note 1.] Essentially, the parties are agreeing to an abbreviated trial on the merits.

Just as with any non-ACR case, the Board will decide disputed facts as part of the final decision.

The Board has found that cases that proceed along the ACR stipulated record model, involving many stipulated facts and stipulated evidence, yield highly effective records because evidentiary submissions are focused on the disputed facts. Stipulations of fact are useful but are not required in an ACR case prosecuted on a stipulated record.

Parties which agree to conduct the proceeding under ACR and which have stipulated to limited discovery may still take testimonial depositions or introduce testimony by affidavit or declaration, subject to the right of the nonoffering party to cross-examine the witness. However, by limiting the number or duration of

testimonial depositions or testimony in affidavit or declaration form, they may realize additional savings in cost and time. They may also agree to use discovery depositions at trial.

Parties using this form of ACR and who agree to forgo the testimony period should file a stipulation indicating such an intention, along with their stipulations to the record with respect to facts, evidence and testimony (e.g., using discovery depositions in lieu of testimonial depositions). [Note 2.]

Stipulations regarding the submission of evidence promote efficiency by removing any question about the admissibility of the evidence, while still allowing the parties to reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality. [Note 3.] A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 4.]

As with regular trial briefs, the parties are limited to 55 pages for the ACR trial briefs under the stipulated record model, inclusive of table of contents, index of cases, description of the record, statement of issues, recitation of the facts, argument and summary. [Note 5.] Unless counterclaims are involved, only the plaintiff may file a reply brief, and it is limited to 25 pages consisting solely of a rebuttal of the adverse party's case in chief. [Note 6.] *See* TBMP § 801.

For additional information regarding stipulated evidence and ACR, see TBMP § 705.

NOTES:

1. *See, e.g., Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties selected ACR and agreed to forgo trial by stipulating to use evidence submitted in support of opposer's motion for summary judgment as trial evidence and allowing for any additional evidence to be submitted with their trial briefs on the case); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entirety of the record and agreed to forgo trial).

2. *See, e.g., Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (early election of ACR, no motion practice, utilized conference with Board attorney for dispute re stipulation, from notice to briefing less than a year, resulting in clean and concise record); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *appeal* dismissed per stipulation, No. 14-CV-4463 (D. Minn. January 15, 2016); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts and a stipulation to seek a determination through ACR); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties agreed to forgo trial by stipulating to use evidence submitted in support of opposer's motion for summary judgment as trial evidence and allowing for any additional evidence to be submitted with their trial briefs on the case); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entirety of the record and stipulated to forgo trial); *Zimmerman v. National Association of Realtors*, 70 USPQ2d 1425, 1427 (TTAB 2004) (in addition to reliance on a discovery deposition of one of the parties, the parties stipulated that the evidentiary record from an earlier Board case would be considered); *Devries v. NCC Corporation*, 227 USPQ 705, 708 (TTAB 1985) (parties stipulated to waive trial periods and stipulated to the following: petitioner's pleaded registration; each party's responses to certain interrogatories and requests for production of documents served upon it by the other party; and stipulated facts and affidavit testimony, with attached exhibits).

But see Lebanon Seaboard Corp. v. R&R Turf Supply Inc., 101 USPQ2d 1826, 1830 (TTAB 2012) (parties who stipulated to certain facts and issues, yet also submitted evidence to prove these points, have gone to needless effort and expense and the Board unnecessarily must review this evidence).

3. *See Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties agreed to reserve the right to object to facts and documents on the bases of relevance, materiality and weight).

4. *See Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating affidavit and exhibits thereto into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv- 10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013).

But see Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC, 111 USPQ2d 1559, 1561 (TTAB 2014) (parties' stipulation provided for the admission into evidence of specific dated expert reports and accompanying exhibits and an expert discovery deposition transcript, but did not provide for the admission into evidence of any supplemental expert reports or additional expert testimony by affidavit or declaration, in view thereof, supplemental expert report not admissible on this basis).

5. 37 CFR § 2.128(b).

6. 37 CFR § 2.128(b).

702.04(e) Utilizing Stipulations in Non-ACR Board cases

37 CFR § 2.123(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.*

37 CFR § 2.127(e)(2) . *If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.*

Parties may utilize stipulations of facts and evidence to realize cost efficiencies in non-ACR cases. For example, they may stipulate to the entire record, to portions of the record, or to particular facts. [Note 1.] If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial. [Note 2.] Parties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule.

See TBMP § 705 regarding stipulated evidence.

Please Note: Some of the cases cited in this section established principles later codified in amended 37 CFR § 2.123(a)(1), effective January 14, 2017, which allows parties to unilaterally present direct testimony by affidavit or declaration subject to cross-examination by the adverse party.

NOTES:

1. *See* 37 CFR § 2.123(b) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.123(b) … to clarify that parties may stipulate to any relevant facts."). *See e.g.*, *Noble House Home Furnishings, LLC v. Floorco Enterprises*, LLC, 118 USPQ2d 1413, 1416 (TTAB 2016) (parties stipulated that testimony may be introduced by affidavit or declaration in lieu of testimonial depositions and that the documents exchanged during discovery are authentic and may be made of record by either party); *Ayoub, Inc. v. ACS Ayoub Carpet Services*, 118 USPQ2d 1392, 1394 (TTAB 2016) (parties stipulated to submission of testimony by declaration, to the use of any Fed. R. Civ. P. 30(b)(6) discovery deposition transcripts in their case-in-chief or rebuttal, and to the authenticity of all documents produced by either party during discovery); *N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1500 (TTAB 2015) (parties stipulated that witness testimony would be submitted solely by declaration and without cross-examination); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1426 (TTAB 2014) (stipulation to submission of witness declarations and discovery depositions, the authenticity of certain documents, retail prices of opposers' goods, the fact that advertisements and news articles refer to opposers, and press clippings are representative of the media in which opposers advertise); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that testimony could be submitted by declaration or affidavit subject to cross-examination upon request, and all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of certain produced documents and waiver of objections based on authenticity or hearsay as to those documents); *Miller v. Miller*, 105 USPQ2d 1615, 1617 n.6 (TTAB 2013) (parties stipulated to testimony by affidavit and provided a stipulation of undisputed facts); *Blackhorse v. Pro-Football Inc.*, 111 USPQ2d 1080, 1084-85 (TTAB 2014) (parties stipulated that the record of a prior proceeding may be submitted into evidence under notice of reliance reserving the right to object based on relevance) *aff'd* 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *on appeal*, No. 15-1874 (4th Cir. Aug. 6, 2015); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (parties stipulated to authenticity of produced documents and to the introduction of testimony in affidavit or declaration form, with certain guidelines), on appeal, No. 11-3684 (D.N.J. June 2016); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1915 (TTAB 2011) (parties stipulated to authenticity of produced documents); *Brooks v. Creative Arts by Calloway*, LLC, 93 USPQ2d 1823, 1824-25 (TTAB 2010) (parties stipulated to admission of various testimony declarations and to facts), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv- 10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1044 (TTAB 2009) (parties stipulated to introduce testimony by declaration and to live cross-examination); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1585 (TTAB 2008) (parties stipulated to testimony by declaration, with exhibits); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1847 n.5 (TTAB 2008) (stipulation to use discovery depositions as trial testimony); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (stipulation to use evidence and exhibits submitted in connection with a motion for summary judgment at trial); *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1360 (TTAB 1988) (stipulations to facts by applicant, testimony by affidavit by opposer, and use of certain testimonial depositions taken in prior civil action); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1013 (TTAB 1984) (stipulated to the filing of facts and exhibits on behalf of each party during each party's testimony period); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 635 (TTAB 1983) (parties stipulated to facts, legal conclusions and testimony, including cross-examination and redirect examination with respect to stipulated testimony).

2. 37 CFR § 2.123(e)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016) ("The Office is amending § 2.127(e)(2) to add that if a motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial. The revision codifies an approach used by parties in proceedings incorporating ACR-type efficiencies at trial.").

702.05 Overly Large Records

The Board notes that in recent years there has been a trend regarding the introduction of irrelevant and/or cumulative evidence at trial. [Note 1.] The Board views parties who engage in this practice with disfavor. [Note 2.] The introduction of such evidence impedes the orderly administration of the case, and obscures the impact of truly relevant evidence. In addition to diminishing the effectiveness of a party's evidentiary record, "papering" the Board causes delays in rendering a final decision. Parties should submit only relevant, non-cumulative evidence. [Note 3.] For all evidence submitted under notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure to do so, however, is a curable procedural defect. [Note 4.] For a discussion of the requirements for evidence submitted under notice of reliance, see TBMP § 704.02.

The Board may require the parties to take steps to assist with organizing the evidence such as preparing and filing tables summarizing testimony and other evidence and specifying 1) the probative value of particular facts or testimony and 2) the location in the record of such facts or testimony. [Note 5.] Deposition transcripts must contain a word index, listing the pages where the words appear in the deposition. [Note 6.]

Pursuant to 37 CFR § 2.120(j)(2), the Board may require the parties to meet with the Board for a pretrial conference where the Board has determined that the case has the potential to become overly contentious and/or involve the creation by the parties of excessive records. [Note 7.] See TBMP § 502.06(b) for more information about pretrial conferences.

NOTES:

1. *See, e.g., Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013) ("While we commend the parties for agreeing to efficiencies intended to facilitate the introduction of evidence at trial, ideally, [ACR] cases do not merely facilitate introduction of more evidence, but should also limit the amount of evidence placed before the Board."); *Corporacion Habanos S.A. v. Guantanamera Cigars, Co.*, 102 USPQ2d 1085, 1091 (TTAB 2012) (another case which does not warrant a record of this size); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (overly large records tax the resources of the Board and are entirely unnecessary); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591-92 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) (Board expressed frustration with sizeable record and overzealous litigation); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1218 (TTAB 2011) (with its supplemental notice of reliance, plaintiff resubmitted the first 25 items listed in its first notice of reliance, needlessly adding bulk to the record and wasting Board resources); *Stuart Spector Designs Ltd. v. Fender Musical Instruments, Corp.*, 94 USPQ2d 1549, 1552 (TTAB 2009) ("voluminous" evidence of record); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("It is simply inconceivable to the Board that the issues herein warranted either a record of this size or the large number of motions relating thereto."); *Blue Man Productions v. Tarmann*, 75 USPQ2d 1811, 1814 (TTAB 2005) ("[t]here are literally hundreds of documents"), *rev'd on other grounds*, slip. op. 05-2037, (D.D.C. Apr. 3, 2008).

2. *See, e.g., Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013) ("A larger record is not necessarily a better record."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) ("Even counsel at the oral hearing acknowledged that the present record is of a magnitude generally reserved for district court litigation."); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("It is simply inconceivable to the Board that the issues herein warranted either a record of this size or the large number of motions relating thereto.").

3. *See, e.g., Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 n.19 (TTAB 2010) ("It is not necessary for the parties to introduce every document obtained from an Internet search especially when it includes duplicative and irrelevant materials."); *Blue Man Productions v. Tarmann*, 75 USPQ2d 1811, 1814 (TTAB 2005) (foreign language materials submitted with no translation), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).

4. 37 CFR § 2.122(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69652, 69964 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirement for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice.").

5. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) (after oral hearing, Board required parties to submit a joint index and amended briefs with citations to the joint index); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635-36 (TTAB 2011) (tables of evidence required).

6. 37 CFR § 2.123(g)(3). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.123(g)(3) to add that deposition transcripts must contain a word index, listing the pages where the words appear in the deposition.").

7. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("The existing rule for convening a pretrial conference because of the complexity of issues is amended so that it is limited to exercise only by the Board, upon the Board's initiative.").

703 Taking and Introducing Testimony

703.01 Affidavits, Declarations and Oral Testimony Depositions

703.01(a) In General

In addition to submission of evidence under notices of reliance, parties may introduce evidence in the form of testimony depositions taken by a party during its assigned testimony period, or in the form of affidavit or declaration testimony submitted during its testimony period, subject to the right of the adverse party to conduct cross-examination. The submission of evidence and testimony during the parties' assigned testimony periods corresponds to the trial in court proceedings. [Note 1.] For information concerning submission of evidence by notice of reliance, see TBMP § 704

Testimony is taken out of the presence of the Board, by affidavit or declaration, or on oral examination or written questions, and the affidavits, declarations and written deposition transcripts, together with any exhibits thereto, are then submitted to the Board. *See* TBMP § 702. *See also* TBMP §502.01 . During a party's testimony period, testimony is 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.

Testimony affidavits, declarations and depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, but also those documents and other exhibits that may not be made of record by notice of reliance. *See generally* TBMP § 704 describing types of evidence admissible by notice of reliance. However, only evidence admissible under the applicable rules of evidence may properly be adduced during a testimony deposition or presented by affidavit or declaration; inadmissibility is a valid ground for objection. [Note 2.] *See* TBMP § 707.03. In addition, once evidence has properly been made of record, any party may refer to it for any purpose permitted by the Federal Rules of Evidence. [Note 3.]

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

NOTES:

1. 37 CFR § 2.116(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69959 (October 7, 2016) ("The Office is amending § 2.116(e) to add that the submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions, during the testimony period corresponds to the trial in court proceedings. The revision codifies current Office practice and is consistent with amendments relating to declarations and affidavits."). For a general discussion of Board inter partes proceedings, see *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

2. *See* 37 CFR § 2.122(a) and 37 CFR § 2.123(l).

3. 37 CFR § 2.122(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a) consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice."). *See, e.g., Nazon v. Ghiorse*, 119 USPQ2d 1178, 1181 n.6 (TTAB 2016) ("Once evidence is properly of record, it may be relied on by any party for any purpose.").

703.01(b) Form of Testimony

37 CFR § 2.123

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section or by deposition upon written questions as provided by § 2.124.*

(2) *Testimony deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken by affidavit, declaration or on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124. [Note 1.] For information concerning testimony depositions on written questions, see TBMP § 703.02.

A party may unilaterally choose to submit the trial testimony of any witness or witnesses of any party in the form of an affidavit or declaration pursuant to 37 CFR § 2.20 and in conformance with the Federal Rules of Evidence, subject to the right of any adverse party to cross-examine the witness orally if the witness is within the jurisdiction of the United States, or by written questions pursuant to 37 CFR § 2.124 if the witness is not within the jurisdiction of the United States. [Note 2.] The affidavit or declaration must be under oath and subject to cross-examination. [Note 3.] In addition, the offering party must make the witness available for cross-examination if elected. [Note 4.] As with cross-examination at oral testimony depositions, the party cross-examining the affiant or declarant must pay its own travel and attorney expenses. The proffering party has and continues to bear the expense of producing its witness. However, the party seeking oral cross-examination of an affiant or declarant must cover the expense of the court reporter. Any redirect and recross is to be taken at the same time as the oral cross-examination, with the party who originally sought oral cross-examination bearing the cost of the court reporter. [Note 5.]

The testimony of a witness ordinarily may also be taken by deposition on written questions. [Note 6.] However, testimony taken in a foreign country must be taken: by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. [Note 7.] *See* TBMP § 404.03(b), TBMP § 520, TBMP § 531 and TBMP § 703.02.

In addition, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory that is under the control and jurisdiction of the United States), any adverse party may, within 20 days from the date of service of the notice, file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. [Note 8.] What constitutes good cause to take an oral deposition is determined on a case-by-case basis. [Note 9.] *See* TBMP § 531.

The parties may also stipulate in writing any relevant facts in the case, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony. [Note 10.]

NOTES:

1. *See* 37 CFR § 2.123(a)(1) and 37 CFR § 2.123(a)(2). Effective January 14, 2017, the Office amended these rules by allowing a unilateral option for trial testimony by affidavit or declaration subject to the right of oral cross-examination by the adverse party or parties. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

2. 37 CFR § 2.123(a)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.123(b) to remove the requirement for written agreement of the parties to submit testimony in the form of an affidavit, as provided in amendments to § 2.123(a)(1), and to clarify that parties may stipulate to any relevant facts.").

3. *See* 37 CFR § 2.123(a)(1); *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015) (Supreme Court focused on fact that Board proceedings require testimony to be under oath and subject to cross-examination); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (concerning the unilateral option of permitting submission of witness testimony by affidavit or declaration, "The new procedure retains what the Supreme Court focused on in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015): That testimony be under oath and subject to cross-examination. The ability to elect cross-examination of the witness in the new unilateral procedure maintains the fairness and weightiness of Board proceedings.").

4. 37 CFR § 2.123(a)(1)

5. *See* 37 CFR § 2.123(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("Any redirect and recross is to be taken at the same time, with the party the originally sought cross-examination bearing the cost of the court reporter. The goal of the final rule is to minimize the ability of a party seeking cross-examination to thwart the other party's efforts to rein in the cost of litigation by opting for testimony by affidavit or declaration.").

6. *See* 37 CFR § 2.123(a)(1) and 37 CFR § 2.124

7. 37 CFR § 2.123(a)(2). With respect to discovery depositions, see 37 CFR § 2.120(c)(1); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause shown to take oral deposition of witness in England under the circumstances and since fares to England were not that much greater than fares within the United States and no translation was required).

8. 37 C.F.R §2.123(a)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is further amending § 2.123(a)(1) to move to § 2.123(a)(2) a provision permitting a motion for deposition on oral examination of a witness in the United States whose testimonial deposition on written questions has been noticed.").

9. *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected at* 19 USPQ2d 1479 (TTAB 1990) (good cause shown to take oral deposition of expert witness, during rebuttal testimony period); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (good cause shown where deponents were former employees of respondent and present employees of petitioner and were being deposed for first time during rebuttal period).

10. 37 CFR § 2.123(b). *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (discovery deposition may be filed by notice of reliance if parties have stipulated to introduction of the deposition); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (stipulation for use of discovery deposition as testimony deposition); *Oxy Metal Industries Corp. v. Transene Co.*, 196 USPQ 845, 847 n.20 (TTAB 1977) (litigation expenses can be saved where parties agree to introduce all uncontroverted facts by affidavit or stipulated facts and provide balance through deposition testimony).

703.01(c) Time for Taking Trial Testimony

37 CFR § 2.121 ***Assignment of times for taking testimony and presenting evidence.*** *(a) The Trademark Trial and appeal Board will issue a trial order … assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. …*

A party may take trial testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 1.] *See* TBMP § 701.

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

NOTES:

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

703.01(d) Time and Place of Oral Testimony Deposition

37 C.F.R §2.123

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.*

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

* * * *

(c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election.*

An oral testimony deposition upon direct examination may be noticed for any reasonable time during the deposing party's testimony period. [Note 1.] When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. [Note 2.] A testimony deposition may not be taken outside the deposing party's testimony period except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 3.] *See* TBMP § 701.

An oral testimony deposition to be taken in the United States may be noticed for any reasonable place. [Note 4.] A party may not take oral testimony depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. [Note 5.]

A testimony deposition may not be noticed for a place in a foreign country, unless the deposition is to be taken on written questions as provided by 37 CFR § 2.124, or unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. [Note 6.] *See* TBMP § 703.01(b).

If the parties so stipulate in writing, a testimony deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 7.]

NOTES:

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

2. 37 CFR § 2.123(c).

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

4. *See* 37 CFR § 2.123(c).

5. *See* 37 CFR § 2.123(c).

6. *See* 37 CFR § 2.123(a), 37 CFR § 2.123(a)(2) and 37 CFR § 2.123(c).

7. 37 CFR § 2.123(b).

703.01(e) Notice of Oral Deposition and Notice of Election of Oral Cross-Examination of Affiant or Declarant

37 CFR §2.123(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the fact may be stipulated in writing.*

37 CFR § 2.123 (c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. Upon motion for good cause by any party, or upon its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).*

Before a party may take the oral testimony deposition upon direct examination of a witness, the party must give due (i.e., reasonable) notice in writing to every adverse party. [Note 1.] *See* TBMP § 533.02(a). *Cf.* TBMP § 404.05. In assessing whether a party gave reasonable notice of a deposition, the Board counts calendar days, not business days. [Note 2.]

The notice must specify the time and place the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. [Note 3.] *Cf.* TBMP § 404.05.

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

If the parties so stipulate in writing, an oral testimony deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 4.]

Unlike a deposition transcript, a notice of oral deposition need not be filed with the Board. [Note 5.] However, if a certified copy of the notice of deposition is, for some reason, required for use before a federal district court, the notice of deposition must be filed with the Board via ESTTA for purposes of certification. [Note 6.] *See* TBMP § 122 and TBMP § 703.01(f)(2).

A party who elects to take oral cross-examination of an affiant or declarant must serve the notice of such election on the adverse party and file a copy of the notice of election with the Board within 20 days from the date of service of the affidavit or declaration, and the party must complete the oral cross-examination within 30 days from the date of service of the notice of election. On motion for good cause, or on its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When a party has elected to take oral cross-examination of an affiant or declarant, but cannot complete the cross-examination within that testimony period, the Board, after the close of that testimony period, will suspend or reschedule proceedings in the matter to allow for the orderly completion of the oral cross-examination(s). [Note 7.] For information concerning taking depositions in foreign countries, *see* TBMP § 703.01

NOTES:

1. 37 CFR § 2.123(c). *See Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (six calendar days is reasonable notice); *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007) (two days notice prior to the close of the testimony period was unreasonable); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time to prepare for deposition); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

2. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007).

3. *See* 37 CFR § 2.123(c). *See also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony not considered where notice failed to specify name of party being deposed), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352, 353 (TTAB 1976) (testimony stricken where notice identified one witness and indicated that "possibly others will testify" and where opposer proceeded to take testimony of unidentified witness, applicant objected, did not cross-examine the witness, and moved to strike testimony).

4. 37 CFR § 2.123(a)(1) and 37 CFR § 2.123(b).

5. *See* 37 CFR § 2.123(f).

6. *See* 37 CFR § 2.126(a) and 37 CFR § 2.126(b).

7. *See* 37 CFR § 2.123(c) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is further amending § 2.123(c) to add that, when a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. The Office is further amending § 2.123(c) to add that the Board may extend the periods for electing and taking oral cross-examination and, when necessary, shall suspend or reschedule proceedings in the matter to allow for the orderly completion of oral cross-examination(s) that cannot be completed within a testimony period.").

703.01(f) Securing Attendance of Unwilling Adverse Party or Non-party for Testimony Deposition

Please Note: This section only pertains to testimony depositions, as a party who takes testimony by affidavit or declaration must make the witness available for cross-examination under 37 CFR § 2.123(a) and 37 CFR § 2.123(a)(2). *See* TBMP § 703.01(b).

703.01(f)(1) In General

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

However, where a party wishes to take the testimony of an adverse party or non-party, or an official or employee of an adverse party or non-party, and the proposed witness is not willing to appear voluntarily to testify, the deposition may not be taken on notice alone. Rather, the party that wishes to take the deposition must take steps, discussed below, to compel the attendance of the witness. [Note 1.] If the witness resides in a foreign country, the party may not be able to take the deposition. *See* TBMP § 703.01(f)(2) (securing attendance of unwilling witness residing in United States), TBMP § 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country), and TBMP § 703.02 (testimony depositions on written questions).

NOTES:

1. *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (after unsuccessfully attempting to take testimony deposition on written questions of adverse party's officer on notice alone, opposer obtained subpoena from U.S. district court ordering appearance); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (it is incumbent on deposing party to have a subpoena issued from the U.S. district court where witness is located and have same properly served on witness with sufficient time to apprise him that he is under order to appear). *See also Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 55 n.7 (TTAB 1983) (no adverse inference can be drawn from adverse party's failure to appear and produce requested documents at testimony deposition where party attempted to secure attendance by notice alone), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

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

If a party wishes to take the trial testimony of an adverse party or non-party (or an official or employee of an adverse party or non-party) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45. [Note 1.] *Cf.* TBMP § 404.03(a)(2) (securing attendance of non-party residing in U.S. at discovery deposition).

The subpoena must be issued, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, from the United States district court in the federal judicial district where the witness resides or is regularly employed. [Note 2.] Occasionally district courts may request a “matter number” for the issuance of a subpoena. If that is the case, the requesting party should obtain one from the court or determine whether the Board’s proceeding number will satisfy the court. If, for any reason, a certified copy of the notice of deposition is required in connection with the subpoena, such as for purposes of a motion to quash the subpoena, or a motion to enforce

the subpoena, the interested party should contact the clerk of the court to determine whether the court will require a formal certified copy (i.e., a certified copy bearing a USPTO seal) of the notice. [Note 3.] A certified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and certified by the USPTO as being a true copy of the notice of deposition filed in the proceeding before the Board. A copy of a notice of deposition cannot be certified by the USPTO unless it has been filed in the Board proceeding. For information relating to USPTO certification of a notice of deposition, see TBMP § 122.

If a person named in a subpoena compelling attendance at a testimony deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States district court that issued the subpoena. Similarly, any request to quash a subpoena must be directed to the United States district court that issued the subpoena. The Board has no jurisdiction over depositions by subpoena. [Note 4.]

NOTES:

1. *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583-84 (TTAB 1976).

2. *Cf.* 37 CFR § 2.120 (b).

Please Note: To the extent that the 2013 amendments to Fed. R. Civ. P. 45(a)(2) and Fed. R. Civ. P. 45(f) conflict with 35 U.S.C. § 24, § 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.").

3. **Please Note:** The Board no longer provides verified copies of filings.

4. *See, e.g., In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201, 201 (D.Del. 1973) (no power to grant protective order with respect to depositions taken by subpoena); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (no authority to quash subpoena); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318, 319 n.3 (TTAB 1971) (opposer's allegation in its brief that applicant defied a subpoena to produce witnesses is a matter opposer should have pursued before the court that issued the subpoena). *Cf. 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).

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

There is no certain procedure for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a non-party (or an official or employee of an adverse party or non-party), and is not willing to appear voluntarily to testify. However, the deposing party may be able to obtain the testimony deposition of such a witness through the letter rogatory procedure or The Hague Convention letter of request procedure. [Note 1.]

For information concerning these procedures, see TBMP § 404.03(c)(2) and TBMP § 703.01(g).

The U.S. Court of Appeals for the Fourth Circuit has held, however, that a district court has the power to issue a subpoena for a trial deposition noticed under Fed. R. Civ. P. 30(b)(6), requiring a foreign corporate

applicant to produce an appropriate representative in the United States for testimony on the subjects identified in the subpoena, regardless of the domicile of the representative. [Note 2.]

NOTES:

1. *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (attendance of non-party witness residing outside the United States could not be compelled).

2. *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385 (4th Cir. 2007), *cert. denied*, 128 S. Ct. 2508 (2008).

703.01(g) Persons Before Whom Depositions May be Taken

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

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

(a) ***Within the United States.***

(1) ***In General.*** *Within the United States or a territory or insular possession subject to United States jurisdiction, 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.*

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

(b) ***In a Foreign Country.***

(1) ***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.*

(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.*

(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.*

(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.*

(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.*

Depositions in Board inter partes proceedings may be taken before the persons described in Fed. R. Civ. P. 28. [Note 1.]

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a testimony 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 before a person appointed by the court where the action is pending to administer oaths and take testimony." [Note 2.] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter who is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a testimony deposition in a Board proceeding may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a testimony deposition in a Board proceeding taken of a willing witness in a foreign country usually may be taken on notice before a U.S. 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 3.] A party which wishes to take a testimony deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of American Citizen Services, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. The testimony of an unwilling adverse party or non-party witness may be taken in a foreign country, if at all, only by the letter rogatory procedure, or by the letter of request procedure provided under the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, or by any other procedure provided for the purpose by any future treaty into which the United States may enter. [Note 4.] *Cf.* TBMP § 404.03(c) (concerning discovery deposition of non-party residing in foreign country) and TBMP § 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country). If the parties so stipulate in writing (and if permitted by the laws of the foreign country, in the case of a deposition to be taken in a foreign country), a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 5.]

NOTES:

1. 37 CFR § 2.123(d).

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

3. *See* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2083 (2016).

4. *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 n.5 (TTAB 2009).

5. 37 CFR § 2.123(b).

703.01(h) Examination of Witnesses

37 CFR § 2.123 (e) ***Examination of witnesses.***

(1) *Each witness before providing oral testimony shall be duly sworn according to law by the officer before whom the deposition is to be taken. Where oral depositions are taken, every adverse party shall have a full opportunity to cross-examine each witness. When testimony is proffered by affidavit or declaration, every adverse party will have the right to elect oral cross-examination of any witness within the jurisdiction of the United States. For examination of witnesses outside the jurisdiction of the United States, see § 2.124.*

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

(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

i *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with 2.121(e).*

ii *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

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

37 CFR § 2.123(g) ***Form of deposition.. (1)*** *The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).*

Fed. R. Civ. P. 30(b)(4) *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.*

Before providing oral testimony, a witness whose testimony deposition is being taken for use in a Board inter partes proceeding must be duly sworn, according to law, by the officer before whom the deposition is to be taken. [Note 1.] *See* TBMP § 703.01(g).

Testimony by affidavit or declaration pursuant to 37 CFR § 2.20 must be made in conformance with the Federal Rules of Evidence. The testimony affidavit is a sworn statement, while the declaration permits a comparable alternative unsworn statement. Both options are under penalty of perjury, and statements in Board proceedings are subject to 18 U.S.C. § 1001. [Note 2.]

The deposition is taken in answer to questions, and the questions and answers are recorded in order by the officer, or by some other person (who is subject to the provisions of Fed. R. Civ. P. 28) in the presence of the officer, except when the officer's presence is waived on the record by agreement of the parties. The deposition testimony is recorded and transcribed, unless the parties present agree otherwise. [Note 3.]

The Board does not accept videotape testimony. [Note 4.] An affidavit, declaration or testimony deposition must be submitted to the Board in written form via ESTTA, unless ESTTA is unavailable due to technical problems, or under extraordinary circumstances. [Note 5.]

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. [Note 6.] A deposition taken by telephone or other remote means is taken in the district and at the place where the witness is to answer the questions propounded to him or her. [Note 7.]

Exhibits which are marked and identified at the deposition will be deemed to have been offered in evidence, even if no formal offer thereof is made, unless the intention of the party marking the exhibits is clearly to the contrary. [Note 8.]

Regardless of the form of the direct testimony, every adverse party must be given an opportunity to cross-examine the witness. [Note 9.] For information concerning cross-examination of witnesses on written questions, see TBMP § 703.02. If pretrial disclosures or the notice of deposition served by a party is improper or inadequate with respect to the witness, an adverse party may file a motion to quash before the deposition is scheduled to take place, or alternatively, cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. [Note 10.] When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike. [Note 11.] For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate pretrial disclosures or notice, *see* 37 CFR § 2.121(e), 37 CFR § 2.123(e)(3), TBMP § 533.02, TBMP § 707.03(b)(2) and TBMP § 707.03(b)(3).

All objections made at the time of the taking of a testimony deposition as to the qualifications of the officer taking the deposition, the manner of taking the deposition, the evidence presented, the conduct of any party, or any other objection to the proceedings, are noted by the officer upon the deposition. Evidence objected to is taken subject to the objections. [Note 12.] *See* TBMP § 707.03.

Questions to which an objection is made ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged, trade secret or otherwise protected from disclosure by the protective order in place for the case. *See* TBMP § 404.09. For information concerning the propounding party's recourse if a witness not only objects to, but also refuses to answer, a particular question, *see* TBMP § 404.09 and TBMP § 707.03(d).

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

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 13.]

For information concerning depositions of witnesses in foreign countries, see TBMP § 703.01(g)

NOTES:

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

2. *See*28 U.S.C. 1746. *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (in response to a comment, "the Office has adopted language in the final rule directed to the concerns expressed regarding affidavit testimony by explicitly requiring that the affidavit or declaration pursuant to § 2.20 be made in conformance with the Federal Rules of Evidence. Regarding the concern raised about affidavit or declaration testimony being 'duly sworn' and under penalty of perjury, the testimony affidavit is a sworn statement, while the declaration permits a comparable alternative unsworn statement. *See*28 U.S.C. § 1746. Either option is under penalty of perjury, and statements in Board proceedings are subject to 18 U.S.C. § 1001.").

3. 37 CFR § 2.123(e)(2).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (Board considered but rejected suggestion of allowing videotape depositions: "The Board has never accepted video testimony …. The current online filing system is not able to accept video testimony however, this possibility may be considered in subsequent rulemakings as TTAB's online systems are enhanced.").

5. 37 CFR § 2.123(g) and 37 CFR § 2.126.

6. *See* Fed. R. Civ. P. 30(b)(4); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (noting parties may resolve conflict concerning the scheduling of deposition where travel for one party is involved, by conducting deposition by telephone or other electronic means); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552-53 (TTAB 1991) (Board granted request to attend deposition by telephone, noting that trademark rules do not specifically provide for or prohibit depositions by telephone and that federal court practice favors use of technological benefits).

7. Fed. R. Civ. P. 30(b)(4).

8. 37 CFR § 2.123(e)(2). *Cf. Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1838 n.4 (TTAB 1989) (decided prior to the rule change which eliminated "formal" introduction of exhibits, but exhibits still not excluded).

9. *See* 37 CFR § 2.123(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (concerning the unilateral option to submit testimony by affidavit or declaration, "The new procedure retains what the Supreme Court focused

on in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015): That testimony be under oath and subject to cross examination. The ability to elect cross-examination of the witness in the new unilateral procedure maintains the fairness and weightiness of Board proceedings.").

10. 37 CFR § 2.121(e) and 37 CFR § 2.123(e)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The amendment codifies current Office practice.").

11. 37 CFR § 2.121(e).

12. 37 CFR § 2.123(e)(4).

13. 37 CFR § 2.123(a)(1) and 37 CFR § 2.123(b).

703.01(i) Form of Deposition and Exhibits

37 CFR § 2.123 ***Trial testimony in inter partes cases.***

(f)(2) Certification and filing of deposition. *If any of the foregoing requirements of paragraph (f)(1) of this section are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he or she has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the nature of an exhibit precludes electronic transmission via ESTTA, it shall be submitted by mail by the party taking the deposition, or its attorney or other authorized representative.*

(g) Form of deposition.

(1) *The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).*

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

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

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

37 CFR § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:*

(1) *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*

(2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*

(3) *If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*

(4) *A paper submission must not be stapled or bound;*

(5) *All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);*

(6) *Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

* * * *

Please Note: As with all submissions to the Board, all forms of testimony and exhibits thereto must be filed via ESTTA except if ESTTA is unavailable due to technical problems, or under extraordinary circumstances. [Note 1.] Although the USPTO has not specified requirements for the form of exhibits attached to affidavit or declaration testimony, parties are encouraged to use as a guide the form requirements set out for exhibits to depositions in 37 CFR § 2.123(g)(2) and the mailing requirements for certain exhibits set out in 37 CFR § 2.123(f)(2). In addition, parties are reminded that documents submitted under affidavit or declaration but not identified therein cannot be considered as exhibits. [Note 2.]

A deposition must be submitted to the Board in written form. [Note 3.] The Board does not accept videotape depositions. [Note 4]

Parties must file depositions and exhibits thereto electronically through ESTTA unless ESTTA is unavailable due to technical problems, or under extraordinary circumstances. [Note 5.] *See* TBMP § 106.03, TBMP § 106.09 and TBMP § 110 for further information about ESTTA. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. [Note 6.] Exhibits pertaining to a paper submission must be filed on paper and must comply with the requirements for a paper submission. [Note 7.]

The pages of a deposition must be numbered consecutively and the name of the witness must be written plainly and conspicuously at the top of each page. Unless the pages have numbered lines, the questions asked of each witness must be numbered consecutively. Each question must be followed by its answer. Deposition transcripts must be submitted through ESTTA in an electronic format (e.g., PDF) that displays the document in full-size with one page per sheet, rather than in condensed format with multiple pages per sheet, [Note 8] and in at least 11-point type and double-spaced. [Note 9.]

Deposition exhibits must be numbered or lettered consecutively, and each exhibit must be marked with the number and title of the case, and the name of the party who is offering the exhibit. The Board may not consider exhibits that are not properly marked. [Note 10.]

Deposition transcripts also must contain a word index listing the pages where the words appear in the deposition, an index of the names of the witnesses listing the pages where witness examination and cross-examination begin, and an index of exhibits with a brief description of the exhibit and the pages where they are introduced and offered in evidence. [Note 11.]

ESTTA exhibits may be in PDF, TIFF or TXT format. PDF is preferred, and should be used, if possible. Files should be formatted in letter size (8.5" x 11"), and should be rendered at 300 dpi resolution. ESTTA will accept either color or black and white PDF documents for uploading.

Exhibits that are large, bulky, valuable, or breakable may be photographed or otherwise reproduced so that an appropriate paper or digitized image of the exhibits can be filed with the Board in lieu of the originals. The originals should, of course, be shown to every adverse party. Exhibits consisting of videotapes or audiotapes of commercials, demonstrations, etc., may be transferred to an appropriate electronic format such as a DVD or CD for submission to the Board. [Note 12.]

Each party is responsible for ensuring that its submissions are clear and legible. [Note 13.] Problems with image quality sometimes arise when poor quality documents are scanned or when the quality of legible documents is degraded in the scanning process; these problems typically arise in documents (or parts of documents) featuring graphical material, as opposed to text. Quality can sometimes be significantly degraded when color documents are scanned in black and white or when contrast settings used in scanning are not appropriate for graphical material. If legibility of material in color or grayscale is important, the party is urged to scan the file in color or adjust the scanner's contrast settings to achieve acceptable results prior to filing. Users can check the quality of their submission in TTABVUE after filing. TTABVUE contains the same images that the Board will use in considering the submission. If the TTABVUE image is not of acceptable quality, the user should not assume that the Board will be able to view and consider it appropriately.

Confidential portions of the deposition and confidential exhibits must be submitted in accordance with 37 CFR § 2.126(c). Confidential materials must be filed through ESTTA using the "CONFIDENTIAL" option or, where appropriate, under separate paper cover. For further information concerning the submission of confidential information, see TBMP § 703.01(p) and TBMP § 703.02(l).

In the unlikely event that a party must file a testimony deposition or exhibits on paper, the party is to follow the requirements set out in 37 CFR § 2.126(b), reproduced at the beginning of this subsection.

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

NOTES:

1. *See* 37 CFR § 2.126(a) and 37 CFR § 2.126(b).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office has not set out in the final rule any specific requirements regarding the form of exhibits. The Board and the parties have experience with such submissions in connection with summary judgment motions and ACR procedures as described in the TBMP at sections 528.05(b) and

702.04, which do not specify requirements for the form of exhibits, and this has not created problems. Notably, documents submitted under an affidavit or declaration but not identified therein cannot be considered as exhibits. The parties are encouraged to be guided by the form requirements set out for exhibits to depositions in § 2.123(g)(2) and the mailing requirements for certain exhibits set out in § 2.123(f)(2).").

3. 37 CFR § 2.123(g)(1).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (Board considered but rejected suggestion of allowing videotape depositions: "The Board has never accepted video testimony …. The current online filing system is not able to accept video testimony however, this possibility may be considered in subsequent rulemakings as TTAB's online systems are enhanced.").

5. *See* 37 CFR § 2.126(a), 37 CFR § 2.126(a)(1), and 37 CFR § 2.126(b).

6. 37 CFR § 2.126(a)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The amendment codifies the use of electronic filing."). *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (citing Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible….")), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014). *See also Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.7 (TTAB 2011) (opposer filed exhibits separately under a notice of reliance but the proper procedure is to attach exhibits to the copy of the transcript being filed), *on appeal*, No. 11-3684 (D.N.J. June 2016); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.9 (TTAB 2011) (same).

7. 37 C.F.R §2.123(g)(2). *See Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.7 (TTAB 2011) (opposer filed exhibits separately under a notice of reliance but the proper procedure is to attach exhibits to the copy of the transcript being filed), *on appeal*, No. 11-3684 (D.N.J. June 2016); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.9 (TTAB 2011) (same).

8. 37 CFR § 2.123(g)(1).

9. 37 CFR § 2.126(a)(1).

10. 37 CFR § 2.123(g)(2). *Cf. Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (these requirements are for the convenience of the Board; improperly marked exhibits considered); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (the Board has discretion to consider improperly marked exhibits).

11. 37 CFR § 2.123(g)(3).

12. *See Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654-55 (TTAB 2014) (parties may not override Trademark Rule 2.126 provisions for form of submissions by agreement; however, video and audio

recordings of evidence such as commercials may be submitted on CD-ROM), appeal dismissed per stipulation, No. 14-CV-4463 (D. Minn. January 15, 2016).

13. *See* 37 CFR § 2.126(a)(2) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The amendment codifies the use of electronic filing."). *See also Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (*citing Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible…."))*, aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

703.01(j) Signature of Deposition by Witness

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

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

Reading and signature cannot be waived by mere agreement of the witness; the agreement of every party is required. [Note 1.]

NOTES:

1. *See* 37 CFR § 2.123(e)(5). *See also Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 5 USPQ2d 1382, 1383 (TTAB 2000) (where witness did not sign his deposition, the defect was curable and party allowed time to file and serve a signed copy). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) (depositions which were not signed and included no waiver were nevertheless considered where no objections were made).

703.01(k) Certification and Filing of Trial Testimony

37 CFR § 2.123(f) ***Certification and filing of deposition.***

(1) *The officer shall annex to the deposition his or her certificate showing:*

(i) *Due administration of the oath by the officer to the witness before the commencement of his or her deposition;*

(ii) *The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his or her presence;*

(iii) *The presence or absence of the adverse party;*

(iv) *The place, day, and hour of commencing and taking the deposition;*

(v) *The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.*

(2) *If any of the foregoing requirements in paragraph (f)(1) are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the nature of an exhibit precludes electronic transmission via ESTTA, it shall be submitted by mail by the party taking the deposition, or its attorney or other authorized representative.*

37 CFR § 2.125 ***Filing and service of testimony.***

(a) *One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.*

(b) *One copy of the transcript of each testimony deposition taken in accordance with § 2.123, or § 2.124 together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

* * * *

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

The certification and filing of a deposition are governed by 37 CFR § 2.123(f). The certified transcript, with exhibits, must be filed promptly with the Board via ESTTA. [Note 1.] See TBMP § 106 and TBMP § 110 for more information about using ESTTA. However, if the nature of the exhibit, such as CDs or DVDs, precludes electronic transmission via ESTTA, the party (or its attorney or other authorized representative) shall mail the exhibit to the Board at its mailing address, i.e., Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, Virginia 22313-1451. [Note 2.]

The Board interprets “promptly file,” in 37 CFR § 2.123(f)(2) which concerns the filing of transcripts and exhibits, as meaning filed at any time prior to the submission of the case for final decision. [Note 3.] Therefore, the Board will accept transcripts of testimony depositions filed at any time prior to the submission of the case for final decision. [Note 4.] In addition, a notice of reliance on the deposition transcript need not (and should not) be filed. [Note 5.] However, notice of the filing of the certified transcript, and accompanying exhibits, with the Board must be served on each adverse party. A copy of each such notice must also be filed with the Board. [Note 6.] In addition, one copy of the deposition transcript, together with copies, duplicates, or photographs of the exhibits thereto, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. [Note 7.]

The filing of an affidavit or declaration prepared in accordance with 37 CFR § 2.123 is governed by 37 CFR § 2.125(a). A party who takes testimony by affidavit or declaration must serve a copy of the declaration or affidavit along with copies of exhibits on each adverse party at the same time the party submits the declaration or affidavit to the Board during the party's assigned testimony period. [Note 8.]

For information concerning the service of trial testimony and the remedy that an adverse party may have if it is not timely served with a copy of the affidavit, declaration or deposition and exhibits, see TBMP § 703.01(m).

NOTES:

1. *See* 37 CFR § 2.123(f)(2) and 37 CFR § 2.125(d) (formerly 37 CFR § 2.125(c)).

Please Note: Although the USPTO has not specified requirements for the form of exhibits attached to affidavit or declaration testimony, parties are encouraged to use as a guide the form requirements set out for exhibits to depositions in 37 CFR § 2.123(g)(2) and the mailing requirements for certain exhibits set out in 37 CFR § 2.123(f)(2). In addition, parties are reminded that documents submitted under affidavit or declaration but not identified therein cannot be considered as exhibits. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016).

2. *See* 37 CFR § 2.123(f)(2). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("If the nature of an exhibit, such as CDs or DVDs, precludes electronic transmission via ESTTA, it shall be submitted by mail.").

3. *See* NOTICE OF FINAL RULEMAKING, 63 Fed. Reg. 48081 (September 9, 1998), and comments and responses published in the *Notice* in regard to amendment of 37 CFR § 2.123(f) and 37 CFR § 2.125(c) and (now 37 CFR § 2.125(d)).

4. *See* NOTICE OF FINAL RULEMAKING, 63 Fed. Reg. 48081 (September 9, 1998), and comments and responses published in the notice in regard to amendment of 37 CFR § 2.123(f) and 37 CFR § 2.125(c) (now 37 CFR § 2.125(d)). *See also* *Syngenta Crop Protection Inc. v. Bio-Chek LLC* , 90 USPQ2d 1112, 1115 (TTAB 2009) (testimony must be taken during the offering party's testimony period, but need not be submitted during the party's testimony period; transcript must be served within thirty days after completion of the taking of that testimony); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.* , 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (the wording "promptly filed" in an earlier version of 37 CFR § 2.125(d) (formerly 37 CFR § 2.125(c)) was construed as meaning filed at any time prior to final hearing).

5. *See, e.g., Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (not appropriate to submit testimony under a notice of reliance); *Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1898 n.2 (TTAB 1988); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.1 (TTAB 1982) (notice of reliance on exhibits introduced in connection with testimony superfluous).

6. *See* 37 CFR § 2.125(d) (formerly 37 CFR § 2.125(c)). *See also Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2001) (testimony depositions are not filed by notice of reliance but instead are filed under cover of notice of filing which must also be served on each adverse party).

7. *See* 37 CFR § 2.125(b) (formerly 37 CFR § 2.125(a)).

8. *See* 37 CFR § 2.123(a)(1) and 37 CFR § 2.125(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending §2.125 to renumber paragraphs (a) through (e) as (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period.").

703.01(l) Trial Testimony Must be Filed

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

37 CFR § 2.125 ***Filing and service of testimony.***

(a) *One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.*

All trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. [Note 1.] If a party which took a testimony deposition refuses to file it, the Board, in its discretion, may refuse to further hear or consider the party's case, or may receive and consider a copy of the withheld deposition, attested by such evidence as is procurable. [Note 2.]

A party who takes testimony by affidavit or declaration must serve a copy of the declaration or affidavit along with copies of exhibits on each adverse party at the same time the party submits the declaration or affidavit to the Board during the party's assigned testimony period. [Note 3].

For information concerning the procedure to file trial testimony, see TBMP § 703.01(k).

NOTES:

1. *See* 37 CFR § 2.123(h). *See also e.g., Order Sons of Italy in America v. Memphis Mafia, Inc.*, 52 USPQ2d 1364, 1366 n.4 (TTAB 1999); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (opposer was not prejudiced by transcript of testimony deposition filed for first time with applicant's brief on the case because opposer should have assumed it would become part of the record); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984). *Cf. An Evening at the Trotters, Inc. v. A Nite at the Races, Inc.*, 214 USPQ 737, 738 n.2 (TTAB 1982) (deposition which had not been filed but was not completed and was not referred to by either party was considered terminated and omitted by stipulation).

2. 37 CFR § 2.123(h). *See Motion Picture Association of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (because opposer did not argue that testimony and exhibits which applicant failed to file were adverse to applicant, and case was fully briefed and ready for decision, Board decided case without testimony or exhibits).

3. *See* 37 CFR § 2.123 and 37 CFR § 2.125(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.125 to renumber paragraphs (a) through (e) as (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period.").

703.01(m) Service of Trial Testimony

37 CFR § 2.125 ***Filing and service of testimony.***

(a) *One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.*

(b) *One copy of the transcript of each testimony deposition taken in accordance with § 2.123 or § 2.124, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

A party who takes testimony by affidavit or declaration must serve a copy of the declaration or affidavit along with copies of exhibits on each adverse party at the same time the party submits the declaration or affidavit to the Board during the party's assigned testimony period. [Note 1].

One copy of the transcript of a testimony deposition, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. [Note 2.]

The requirement that a copy of the testimony affidavit, declaration or depositiont transcript, with exhibits, be served on every adverse party within the time specified in 37 CFR § 2.125(a) and 37 CFR § 2.125(b)is intended to ensure that each adverse party will have the testimony before it has to offer its own evidence, or, if the testimony in question is rebuttal testimony, to ensure that each adverse party will have the testimony before it has to prepare its brief on the case. [Note 3.] If a copy of the testimony affidavit, declaration or deposition transcript, with exhibits, is not served on each adverse party within that time, any adverse party that was not served may have remedy by way of a motion to the Board to reset its testimony and/or briefing periods, as may be appropriate, or to compel service of the testimony affidavit, declaration or deposition transcript, with exhibits. [Note 4.]

If a party that took a deposition fails to serve a copy of the transcript, with exhibits, on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may take any of the actions mentioned in 37 CFR § 2.125(b). [Note 5.]

NOTES:

1. *See* 37 CFR § 2.123(a)(1) and 37 CFR § 2.125(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.125 to renumber paragraphs (a) through (e) as (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period.").

2. 37 CFR § 2.125(b)(formerly 37 CFR § 2.125(a)). *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009).

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

4. 37 CFR § 2.125(b) (formerly 37 CFR § 2.125(a)); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (resetting adverse party's testimony and/or briefing periods, or compelling service of transcript); *Techex, Ltd. v. Dvorkovitz*, 220 USPQ 81, 83 (TTAB 1983).

5. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (striking of testimony). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.125(b) to add a cross-reference to § 2.124 and to clarify that the paragraph applies to testimony depositions, including depositions on written questions.").

703.01(n) Correction of Errors in Trial Testimony Deposition

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

A party that takes testimony is responsible for having any errors in the transcript corrected, on notice to each adverse party, prior to the filing of the certified transcript with the Board. [Note 1.]

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

what the witness said during the taking of his or her testimony, material changes in the text are not permitted -- the transcript may not be altered to change the testimony of the witness after the fact. [Note 2.]

If corrections are necessary, the party that took the deposition must serve on every adverse party a copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served. [Note 3.]

If errors are discovered after the transcript has been filed with the Board, a list of corrections, signed by the witness, should be submitted to the Board (and served on every adverse party), together with a request for leave to correct the errors. Alternatively, the parties may stipulate that specified corrections may be made. If the request is granted, or if the parties so stipulate, the party that took the deposition should file a substitute, corrected transcript with the Board.

NOTES:

1. 37 CFR § 2.125(c) (formerly 37 CFR § 2.125(b); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (objection to corrections served four days after filing and less than two weeks prior to due date for reply brief overruled since remedy lies in requesting extension of briefing period rather than having Board exclude the evidence).

2. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1325 (TTAB 1992) (any substantive changes made to testimony deposition on written questions would not be considered); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 333 n.4 (TTAB 1985) (Board gave no consideration to response or corrected response when the correction, which changed the percentage of opposer's business income derived from licensing, was substantive); and *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.2 (TTAB 1982) (change in testimony from "...designing that type of game..." to "...designing that Simon Says type of game..." was substantive in nature and not permitted). *Cf. Hollywood Casino LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988, 1996 (TTAB 2015) (on summary judgment, Board gave no consideration to a Fed. R. Civ. P. 30(b)(6) discovery deposition errata sheet because it resulted in substantive changes to witness' testimony).

3. *See* 37 CFR § 2.125(c) (formerly 37 CFR § 2.125(b). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991).

703.01(o) Objections to Testimony Affidavits, Declarations and Depositions

For information concerning objections to testimony affidavits, declarations and depositions, see TBMP § 707.03 and TBMP § 533.

703.01(p) Confidential or Trade Secret Material

37 CFR § 2.116 (g) The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes 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. 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. The Board may treat as not confidential

that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.

37 C.F.R §2.125(f) Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of an affidavit or declaration or 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(h).

37 CFR § 2.126(c) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(f) must be submitted using the "Confidential" selection available in ESTTA, or, where appropriate, under a separate paper 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 for public viewing with the confidential portions redacted must be submitted concurrently.

Except for materials filed under seal pursuant to a protective order, the files of proceedings before the Board, including all filings by the parties and exhibits thereto are available for public viewing on the USPTO website via TTABVUE at **http://ttabvue.uspto.gov/**. In addition, a link to TSDR, in which reside the records of the files of subject applications and registrations, is available from TTABVUE. [Note 1.] *See* TBMP § 122.02 and TBMP § 412.05. Therefore, only the particular exhibits or deposition transcript pages of the testimony affidavit, declaration or deposition that disclose confidential information should be filed under seal pursuant to a protective order. If a party over-designates material as confidential, the Board will not be bound by the party's designation, and will treat as confidential only testimony and evidence that is truly confidential and commercially sensitivetrade secrets). [Note 2.] *Cf.* TBMP § 801.03. In addition, upon motion by any party, for good cause, the Board may order that any part of an affidavit or declaration or a testimony transcript or any exhibits that directly discloses any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of 37 CFR § 2.27(e). Failure to comply with this order may result in imposition of any of the sanctions authorized by 37 CFR § 2.120(h). [Note 3.] *See* TBMP § 502.02.

In accordance with 37 CFR § 2.126(c), a party who submits testimony or associated exhibits containing confidential information under seal or designated as confidential in ESTTA, must submit the testimony or associated exhibits using the "Confidential" selection in ESTTA or, where appropriate, under separate paper cover. The party must mark both the submission and its cover "confidential," and must identify the case number and parties. The party also must concurrently submit for the public record a redacted version of the testimony or associated exhibit. [Note 4.] A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. [Note 5]. In cases where a redacted version has not been provided, the confidentiality of the information may be deemed waived. [Note 6.] For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the parties should include TTABVUE entry and page numbers for both the redacted and confidential versions of the submission when referencing such material in a brief. [Note 7.] *See* TBMP § 801.03.

In addition, in the confidential submission, parties are strongly encouraged to enclose confidential information in brackets to better mark the specific information to be kept confidential. This facilitates a better comparison between the public and confidential versions of the submissions when the Board is preparing a final decision, and will reduce the likelihood that the Board inadvertently may include confidential matter in a final decision or an order on a motion. For further information regarding the filing of confidential matter and information regarding ESTTA, *see* TBMP § 110 and TBMP § 412.04.

If ESTTA is unavailable due to technical problems, or extraordinary circumstances exist, a party may file an affidavit, declaration or testimony, and associated exhibits, in paper form. A submission made in paper form must include a written explanation of such technical problems or extraordinary circumstances, or it will not be considered. [Note 8.] Paper submissions are scanned into TTABVUE and designated "confidential." After scanning and designating 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. Confidential testimony and exhibits submitted in paper are disposed of shortly after the proceeding is terminated.

If a party submits confidential material 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 an entry will be made on the publicly-available docket sheet in TTABVUE. Electronic filing using ESTTA is preferred for submissions containing confidential material. *See* TBMP § 120.02 and TBMP § 412.04.

The Board's standard protective order is automatically applicable throughout all inter partes proceedings, subject to specified exceptions, unless modified by the parties and approved by the Board. [Note 9.] For further information on protective orders, see TBMP § 412.

For further information regarding confidential materials, see TBMP § 120.02 and TBMP § 412.

NOTES:

1. 37 CFR §2.27(d)("the official records of applications and all proceedings relating thereto are available for public inspection") and 37 CFR §2.27(e) (filing and handling of confidential matter). *See, e.g., Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016) (party allowed time to file redacted version of material marked as "confidential" but not submitted under seal because "it is the general policy of the Board that all papers in a proceeding be public"); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file), *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), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), cert. denied, 130 S. Ct. 631 (2009).

2. 37 CFR § 2.116(g) and 37 CFR § 2.126(c). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69959 (October 7, 2016) ("The purpose of the rule is to codify existing practice to treat improperly designated material that is public information as public. This is narrowly applied and only done when necessary to articulate the Board decision."). *See, e.g., Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014)."); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (in pretrial order, parties reminded to refrain from improperly designating evidence or a show cause order may issue); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008). *See also General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) (although entire deposition was marked confidential, the Board's decision referred to selective portions that appeared to not be truly confidential).

3. *See* 37 C.F.R §2.125(f) (formerly 37 CFR § 2.125(e)). *Cf. ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1237-1238 n. 24 (TTAB 2015) (party that submitted entire discovery deposition designated as confidential was ordered to resubmit separate public and confidential copies), *on appeal sub nom Kraft Heinz Foods Co. v. Boulder Brands USA, Inc.* filed, No. 15-0681 (W.D. Pa. May 26, 2015).

4. 37 CFR § 2.126(c). *See Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016) (party allowed time to file redacted version of material marked as "confidential" but not submitted under seal); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); *Duke University v. Haggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000) (redacted copy deleting confidential matters must be filed). *See also Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (entry of confidential exhibits and briefs in ACR case).

5. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011), judgment set aside on other grounds, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) (excessive markings of various information as confidential complicates record and often indicates that matter is improperly designated or not useful to case).

6. *See, e.g., Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

7. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1468 n.6 (TTAB 2016).

8. *See* 37 CFR § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (October 7, 2016) (discussing the procedure for paper filings)

9. 37 CFR § 2.116(g)

703.02 Testimony Depositions on Written Questions

703.02(a) Depositions on Written Questions: When Available

37 CFR § 2.123

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124.*

(2) *Testimony taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness, If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken by affidavit, declaration or on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124. [Note 1.] For information concerning testimony by affidavit, declaration or oral depositions, see TBMP § 703.01. However, testimony taken in a foreign country must be taken: by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. [Note 2.] *See* TBMP § 703.01(b).

In addition, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 20 days from the date of service of the notice, file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. [Note 3.] *See* TBMP § 703.01(b). What constitutes good cause to take an oral deposition is determined on a case-by-case basis. [Note 4.] See TBMP § 531.

NOTES:

1. 37 CFR § 2.123(a)(1) and 37 CFR § 2.123(a)(2).

2. *See* 37 CFR § 2.123(a)(2). With respect to discovery depositions, *see* 37 CFR § 2.120(c)(1); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause shown to take oral deposition of witness in England under the circumstances and since fares to England were not that much greater than fares within the United States and no translation was required).

3. *See* 37 CFR § 2.123(a)(2) (formerly 37 CFR § 2.123(a)(1)). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is further amending § 2.123(a)(1) to move to § 2.123(a)(2) a provision permitting a motion for deposition on oral examination of a witness in the United States whose testimonial deposition on written questions has been noticed."). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), corrected at 19 USPQ2d 1479 (TTAB 1990) (good cause shown to take oral deposition of expert witness during rebuttal testimony period); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (good cause shown where deponents were former employees of respondent and present employees of petitioner and were being deposed for first time during rebuttal period).

4. *See Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980).

703.02(b) Depositions on Written Questions: Before Whom Taken

37 CFR § 2.142 (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.] For further information, see TBMP § 703.01(g).

NOTES:

1. *See* 37 CFR § 2.124(a). *See, e.g., Corporacion Habanos S.A. v. Anncas, Inc.*, 88 USPQ2d 1785, 1789 (TTAB 2008) (testimony deposition of opposer's vice president taken upon written questions).

703.02(c) Depositions on Written Questions: When Taken

37 CFR § 2.121 ***Assignment of times for taking testimony and presenting evidence.*** ***(a)*** *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party the time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. ...*

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

37 C.F.R §2.124(b)(3) A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration 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.

* * * *

37 CFR §2.124(d)(1) … Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross-questions upon the party who proposes to take the deposition. …

37 CFR § 2.124(d)(2) ... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.

A party may take trial testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 1.] *See* TBMP § 701. For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, *see* TBMP § 509 and TBMP § 701.

A party that desires to take a testimony deposition on written questions must serve notice thereof on each adverse party within 10 days from the opening date of the deposing party's testimony period, as originally set or as reset. [Note 2.]

A party that desires to take cross-examination, by written questions, of a witness who has provided affidavit or declaration testimony must serve notice thereof on each adverse party, and file a copy of the notice (but not a copy of the questions) with the Board, within twenty days from the date of service of the affidavit or declaration . [Note 3.]

On receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will generally suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions on written questions. [Note 4.]

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

NOTES:

1. 37 C.F.R §2.121(a). *See Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1454 n.1 (TTAB 1998) (parties stipulated that testimony deposition of applicant's witness could be taken prior to its testimony period on the same day as opposer's witness to achieve efficiencies in time and cost). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised a timeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

2. 37 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notice of testimony depositions on written questions, while served eight months after testimony period originally opened, were nonetheless timely, having been served within 10 days of "opening" of testimony period as last reset).

3. 37 C.F.R §2.124(b)(3) and 37 CFR § 2.124(d)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is adding new § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board.") and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES: CORRECTION, 81 Fed. Reg. 89382 (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

4. 37 CFR § 2.124(d)(2). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

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

A testimony deposition on written questions may be taken at any reasonable place. [Note 1.] *Cf.* TBMP § 703.01(d). An adverse party may attend the taking of the deposition and the party who proffered affidavit or declaration testimony may attend the cross-examination on written questions if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, redirect questions, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing.

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

NOTES:

1. *Cf.* 37 CFR § 2.123(c). *Cf. also* 37 CFR § 2.123(b) regarding stipulations as to place, manner and notice of depositions.

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

37 CFR § 2.124 (b) (1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period

of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

* * * *

(b)(3) *A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration 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.*

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

(d)(1) *Every notice served on any adverse party under the provisions of paragraphs (b))(1) and (2) of this section for the taking of direct examination shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross questions upon the party who proposes to take the deposition.. ...*

To take a testimony deposition on written questions a party must serve notice thereof on each adverse party within 10 days from the opening date of its testimony period, as originally set or as reset. [Note 1.] The notice must state the name and address of the witness; it must be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken, and by the written questions to be propounded on behalf of the deposing party. [Note 2.] A copy of the notice, but not of the questions, must be filed with the Board. [Note 3.]

A party desiring to take cross-examination, by written questions, of an affiant or declarant must serve on each adverse party notice of the cross-examination within 20 days from date of service of the affidavit or declaration. [Note 4.] The notice must state the name or descriptive title of the officer before whom the deposition will be taken, and must include a copy of the written questions to be propounded at cross-examination. [Note 5.] The party must file a copy of the notice, but not the questions, with the Board. [Note 6.]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 7.]

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

NOTES:

1. 37 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

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

3. 37 CFR § 2.124(b)(1).

4. 37 C.F.R §2.124(b)(3) and 37 CFR §2.124(d)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board."), and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES: CORRECTION, 81 Fed. Reg. 89382 (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

5. 37 CFR §2.124(c) and 37 CFR §2.124(d)(1).

6. 37 CFR §2.124(b)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board.").

7. 37 CFR § 2.123(b).

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

A party who takes testimony by affidavit or declaration must make the witness available for cross-examination under 37 CFR §2.123(a)(1) and 37 CFR §2.123(a)(2). *See* TBMP §703.01(b).

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

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

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

* * * *

(b)(3 *A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration 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.*

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

(d)(1) *Every notice served on any adverse party under the provisions of paragraphs (b)(1) and (2) of this section, for the taking of direct examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross questions upon the party who proposes to take the deposition.; Any party who serves cross questions, whether in response to direct examination questions or under paragraph (b)(3) of this section, 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, or who earlier offered testimony of the witness by affidavit or declaration 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 or who earlier offered testimony of the witness by affidavit or declaration ; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) *Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.*

(3) *Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).*

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

A party which desires to take a testimony deposition on written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof on each adverse party. [Note 1.] *See* TBMP § 703.02(e).

The notice must be accompanied by the written questions to be propounded on behalf of the deposing party. [Note 2.] A copy of the notice, but not of the questions, must be filed with the Board. [Note 3.]

Within 20 days from the date of service of the notice of taking direct examination on written questions, any adverse party may serve cross questions on the deposing party. Likewise, a party desiring to take cross-examination, by written questions, of an affiant or declarant must serve on each adverse party notice of the cross-examination within 20 days from the date of service of the testimony affidavit or declaration. [Note 4.] The notice of cross-examination by written questions must state the name or descriptive title of the officer before whom the deposition will be taken, and must include a copy of the written questions to be propounded at cross-examination. [Note 5.] The party must file a copy of the notice, but not the questions, with the Board. [Note 6.]

Any party who serves cross questions, whether in response to direct examination questions, or on cross-examination of a witness who has provided affidavit or declaration testimony, must also serve copies of them on every other adverse party. Within 10 days from the date of service of the cross questions, the deposing party, or the party who had offered affidavit or declaration testimony, may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions, any party that served cross questions may serve recross questions on the deposing party or the party who earlier provided affidavit or declaration testimony. A party that serves recross questions on the deposing party must also serve copies thereof on every other adverse party. [Note 7.]

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 . The substitute questions must also be served on every other adverse party. [Note 8.]

On motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 CFR § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions. Further, on receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions on written questions. [Note 9.] *See* TBMP § 703.02(c).

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

Service of written questions, responses, and cross-examination questions must be by email unless the parties stipulate to another method, or under certain other limited circumstances. [Note 11.] For information concerning alternative methods of service under those limited circumstances, see 37 CFR §2.119(b) and TBMP §113.04.

An adverse party may attend the taking of the deposition and the party who proffered affidavit or declaration testimony may attend the cross-examination on written questions if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, redirect questions,, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing. Any attempt to engage the witness during the deposition or cross-examination may constitute sanctionable conduct.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner. When so taken, the deposition may be used like any other deposition. [Note 12.]

NOTES:

1. 37 CFR § 2.124(b)(1).

2. 37 CFR § 2.124(d)(1).

3. 37 CFR § 2.124(b)(1).

4. 37 C.F.R §2.124(b)(3) and 37 CFR § 2.124(d)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board."), and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE; CORRECTION, 81 Fed. Reg. 89382 (further clarification

necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

5. 37 CFR § 2.124(c) and 37 CFR § 2.124(d)(1).

6. 37 CFR § 2.124(b)(3) *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board.").

7. 37 CFR § 2.124(d)(1). *See Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE; CORRECTION, 81 Fed. Reg. 89382 (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

8. 37 CFR § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990).

9. 37 CFR § 2.124(d)(2).

10. 37 CFR § 2.124(e).

11. *See* 37 CFR § 2.119(b) and 37 CFR § 2.124(d)(3). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is adding new § 2.124(d)(3) to provide that service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).").

12. *See* 37 CFR § 2.123(b).

703.02(h) Depositions on Written Questions: Form, Signature and Certification of Deposition

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

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

For further information on the form for a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(g) and 37 CFR § 2.126, and TBMP § 703.01(i).

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

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. *See* 37 CFR § 2.124(e). For information concerning certification of a deposition taken in an inter partes proceeding before the Board, see 37 CFR § 2.123(f), and TBMP § 703.01(k).

When the transcript has been certified, the officer should mail the transcript and exhibits to the party that took the deposition. [Note 2.]

NOTES:

1. *See* 37 CFR § 2.124(e).

2. *See* 37 CFR § 2.124(e).

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

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

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

If the deposition is a testimony deposition upon written questions, the original, with exhibits, must be filed promptly with the Board. [Note 3.] By "promptly" the Board means that the transcript, with exhibits, may be filed at any time prior to submission of the case for final decision. *See* TBMP § 703.01(k).

NOTES:

1. 37 CFR § 2.124(f). *Cf.* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office has not set out in the final rule any specific requirements regarding the form of exhibits. The Board and the parties have experience with such submissions in connection with summary judgment motions and ACR procedures as described in the TBMP at sections 528.05(b) and 702.04, which do not specify requirements for the form of exhibits, and this has not created problems. Notably, documents submitted under an affidavit or declaration but not identified therein cannot be considered as exhibits. The parties are encouraged to be guided by the form requirements set out for exhibits to depositions in § 2.123(g)(2) and the mailing requirements for certain exhibits set out in § 2.123(f)(2).").

2. 37 CFR § 2.124(f) and 37 CFR § 2.125(c) (formerly 37 CFR § 2.125(b)).

3. *See* 37 CFR § 2.124(f).

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

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

While the offering of a discovery deposition in evidence is voluntary, all trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. [Note 1.] *See* TBMP § 703.01(l).

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

NOTES:

1. *See* 37 CFR § 2.123(h).

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

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

* * * *

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

Written objections to questions propounded for a deposition on written questions may be served on the party that propounded the questions. Any party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party. [Note 1.] *See* TBMP § 703.02(g).

Unless waived, objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board at final hearing. [Note 2.]

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

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

NOTES:

1. 37 CFR § 2.124(d)(1).

2. 37 CFR § 2.124(g). *See Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1628 (TTAB 2014) (objections to written cross-examination questions sustained on ground they exceed scope of direct testimony on written questions), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and*

remanded 819 F.3d 697 (4th Cir. 2016); *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (objections to portions of depositions on written questions deemed waived), *aff'd* 112 F. Supp. 3d 383 (E.D. Va. 2015); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections to questions based on relevancy and materiality will be deferred until final hearing).

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

For information concerning the protection of confidential or trade secret material forming part of a testimony affidavit or declaration or oral deposition transcript or exhibits thereto, see 37 CFR § 2.125(f) and 37 CFR § 2.126(c); TBMP § 703.01(p). The Board's standard protective order is automatically applicable throughout all inter partes proceedings, subject to specified exceptions, unless modified by the parties and approved by the Board. [Note 1.] For further information on protective orders, see TBMP § 412.

NOTES:

1. 37 CFR § 2.116(g).

703.02(m) Depositions on Written Questions: Utility

A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. Moreover, it deprives an adverse party of the right to confront the witness and ask follow-up questions on cross examination. [Note 1.] *See* TBMP § 703.02(g).

Nevertheless, depositions on written questions have some utility. They may be the only means by which a deposition may be taken in a foreign country. [Note 2.] *See* TBMP § 404.03(c) (discovery deposition of non-party residing in foreign country), TBMP § 703.01(b) (Form of Testimony), TBMP § 703.01(f)(3) (Unwilling Witness Residing in a Foreign Country), and TBMP § 703.02(a) (Depositions on Written Questions – When Available). Moreover, the deposition on written questions is generally less expensive than the deposition on oral examination and is usually more convenient for the witness.

NOTES:

1. *See* 37 CFR § 2.124(d)(1). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980); *Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1926 (TTAB 1989) (motion to take discovery deposition in foreign country orally).

2. *See* 37 CFR § 2.120(c)(1), 37 CFR § 2.123(a)(1) and 37 CFR § 2.123(a)(2). *Cf. Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385 (4th Cir. 2007), *cert. denied*, 128 S. Ct. 2508 (2008) (district court has the power to issue a subpoena for a trial deposition noticed under Fed. R. Civ. P. 30(b)(6), requiring a foreign corporate applicant to produce an appropriate representative in the United States for testimony on the subjects identified in the subpoena, regardless of the domicile of the representative).

704 Introducing Other Evidence

704.01 In General

As noted earlier in this chapter, evidence in an inter partes proceeding before the Board can be introduced in a number of ways. The first part of this chapter discusses the introduction of testimony with accompanying exhibits. The following sections discuss other forms of evidence and the methods available for their introduction. Parties are cautioned, however, not to submit cumulative evidence in support of their pleaded claims. *See* TBMP § 702.05 (Overly Large Records).

704.02 Notice of Reliance – Generally

37 CFR § 2.122(g) ***Notices of reliance.*** *The types of evidence admissible by notice of reliance are identified in paragraphs (d)(2) and (e)(1) and (2) of this section and § 2.120(k). A notice of reliance shall be filed during the testimony period of the party that files the notice. For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order.*

Certain types of evidence, such as official records and printed publications as described in 37 CFR § 2.122(e), need not be introduced in connection with the testimony of a witness but may instead be made of record by filing the materials with the Board under cover of one or more notices of reliance during the testimony period of the offering party. A notice of reliance is essentially a cover sheet for the materials sought to be introduced. As the title suggests, the notice of reliance serves to notify opposing parties that the offering party intends to rely on the materials submitted thereunder in support of its case. A party needs not disclose the evidence it intends to submit under notice of reliance in its pretrial disclosures. [Note 1.] Under 37 CFR § 2.122(g), the notice of reliance must include a description and the general relevance of the proffered materials, and it must associate the materials with one or more issues in the case. [Note 2.] For example, if the claim is likelihood of confusion, the propounding party should associate the materials with a relevant likelihood of confusion factor. Further, if the same document is submitted to support more than one element of a claim or defense, the propounding party should indicate the specific element or fact supported by the document in a group of documents. Failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. [Note 3.] Even if an adverse party fails to lodge a timely objection, the Board may sua sponte decline to consider the proffered evidence if the notice of reliance does not specify the relevance of the materials and identify the issues. [Note 4.]

A discussion of the types of evidence that may be submitted by notice of reliance and the requirements for introduction of such evidence by notice of reliance can be found in the sections that follow.

NOTES:

1. 37 CFR § 2.121(e). *Accord Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 n.4 (TTAB 2015).

2. 37 CFR § 2.122(g). Effective January 14, 2017, the Board added new subsection (g) to 37 CFR § 2.122 detailing the requirements for admission of evidence by notice of reliance. This amendment effectively overruled any prior case law stating that an offering party is not required to specify the general relevance of certain types of evidence submitted under notice of reliance such as discovery deposition excerpts and answers to interrogatories. *See, e.g., Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883

(TTAB 1979) (not required to set forth the relevance of interrogatory answers). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("To alleviate any uncertainty, this final rule adds a paragraph to the requirements for a notice of reliance, specifically, to require that the notice indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the rule explicitly states any failure of a notice of reliance to meet this requirement will be considered a curable procedural defect. This codifies the holding in *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014).").

3. 37 CFR § 2.122(g). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("To alleviate any uncertainty, this final rule adds a paragraph to the requirements for a notice of reliance, specifically, to require that the notice indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the rule explicitly states any failure of a notice of reliance to meet this requirement will be considered a curable procedural defect. This codifies the holding in *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014).").

4. *See, e.g., Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010).

704.03 Applications and Registrations

704.03(a) Subject of Proceeding

37 CFR § 2.122

(b) ***Application and registration files.***

(1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant. Establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part.*

The file of an application or registration that is the subject of a Board inter partes proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose. [Note 1.] The Board discourages filing a copy of the subject application or subject registration because it is of record. [Note 2.]

However, the fact that the subject application or registration file is automatically part of the record in a proceeding does not mean that an allegation of a date of use or that the specimens filed therein are evidence on behalf of the applicant or registrant in the inter partes proceeding. The alleged date of use of the mark and the specimens in an application or registration file are not evidence in an inter partes proceeding, on behalf of the applicant or registrant, unless the alleged date of use is established by competent evidence and the specimens are identified and introduced in evidence as exhibits during the testimony period. [Note 3.] *See* TBMP § 704.04.

Likewise, statements made in an affidavit or declaration in the file of an application or registration are not testimony. [Note 4.] Although part of the record of the proceeding, such statements constitute hearsay (except for statements falling under Fed. R. Evid. 801(d)). [Note 5.] However, self-authenticating exhibits (e.g., printed publications, Internet printouts with the URL and date) attached to affidavits or declarations in applications or registrations may have evidentiary value for what they show on their face. [Note 6.]

Evidence submitted during the prosecution of an application with respect to the acquired distinctiveness of a mark under Trademark Act § 2(f), 15 U.S.C. § 1052(f), is evidence on behalf of the applicant or registrant without any action by the parties. [Note 7.] Nonetheless, such evidence is subject to the Federal Rules of Evidence, the Federal Rules of Civil Procedure, and the relevant provisions of Title 28 of the United States Code and the provisions of title 37 of the Code of Federal Regulation. [Note 8.]

For further information concerning the probative value of applications and registrations, see TBMP § 704.03(b).

NOTES:

1. 37 CFR § 2.122(b)(1). *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984); *Cleveland-Detroit Corp. v. Comco (Machinery) Ltd.*, 277 F.2d 958, 125 USPQ 586, 586-87 (CCPA 1960) (application file automatically forms part of record on appeal); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1923 (TTAB 2011) (record includes pleadings and registration file for respondent's mark), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (same), *on appeal*, No. 11-3684 (D.N.J. June 2016); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 (TTAB 2010) (same); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007) (applications automatically of record); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.4 (TTAB 2007) (respondent's introduction of a certified copy of his registration sought to be cancelled is superfluous); *Uncle Ben's Inc. v. Studenberg International Inc.*, 47 USPQ2d 1310, 1311 n.2 (TTAB 1998) (notice of reliance on application file not necessary as it is automatically of record); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (submission of portions of application unnecessary since file is automatically of record), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). *See also Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1107 (TTAB 2015) (plaintiff's pleaded registration is of record by operation of Trademark Rule 2.122(b)(1) and defendant's objection thereto is overruled).

2. *Anthony's Pizza & Pasta International Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1274 n.6 (TTAB 2009) (not necessary for respondent to file a status and title copy of its registration because registration is automatically of record), *aff'd*, 415 Fed. Appx. (Fed. Cir. 2010); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (respondent's registration file is automatically part of the record of the proceeding and need not be introduced under a notice of reliance); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.4 (TTAB 2007) (respondent's introduction of a certified copy of his registration sought to be cancelled is

superfluous); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007) (applications automatically of record and need not be introduced again).

3. 37 CFR § 2.122(b)(2). *See UMG Recordings, Inc. v. O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009) (dates of use not evidence); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1960 (TTAB 2008) (alleged date of use in application not evidence); *Baseball America, Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1848 n.10 (TTAB 2004) (dates of use and specimens not evidence); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (without proof of use, application filing date, not dates of use alleged in the application, is the earliest use date on which the applicant may rely), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994).

4. 37 CFR § 2.122(b)(2). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("In response to Cold War Museum Inc. v. Cold War Air Museum Inc., 56 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009), this final rule makes clear that while the file history of the subject application or registration is of record, statements in affidavits or declarations in the file are not testimony.").

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("Now that testimony by affidavit or declaration is unilaterally available, it is necessary to clearly distinguish material residing in an application or registration from testimony introduced in the proceeding."). *See Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent's office action response constitute admissions against interest and fall within hearsay exception under Fed. R. Evid. 801(d)(2)). *See also EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 599 (TTAB 1982) (statements made in an application constitute admissions and may be considered as evidence, albeit not conclusive evidence, of the truth of the assertions therein), *aff'd*, 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983) (citing *Bakers Franchise Corp. v. Royal Crown Cola Co.*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969)); *Maremont Corp. v. Airlift Corp.*, 463 F.2d 1114, 174 USPQ 395, 396 (CCPA 1972)).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).

7. *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

8. 37 CFR § 2.122(b)(2). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).

704.03(b) Not Subject of Proceeding – In General

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

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

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

37 CFR § 2.122

(d) ***Registrations.***

(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

(2) *A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance in accordance with paragraph (g) of this section, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

A party that wishes to rely on its ownership of a federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it. [Note 1.] This may be done in a number of different ways.

A federal registration *owned by the plaintiff* in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by (a) an original or a photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current copy of information from the electronic database records of the Office such as (i) TSDR (Trademark Status and Document Retrieval) showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a copy of information from the Office's Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS (Trademark Electronic Search System) along with a copy of any records from the Assignment database showing an assignment to the current owner of the registration. [Note 2.] The Board does not take judicial notice of a party's registration. [Note 3.] A plaintiff which pleads ownership of an application in its complaint must, in order to rely on the subsequently issued registration, make the registration of record. However, the plaintiff does not have to amend its pleading to assert the registration. The pleading of the application is viewed as providing sufficient notice to the defendant of the plaintiff's intention to rely on any registration that issues from the pleaded application. [Note 4.] However, if the registration issues after the plaintiff's testimony period closes, even if the defendant has admitted that the plaintiff is the owner of the application and the plaintiff has introduced a copy of the application into evidence, the Board will not consider the registration. [Note 5.]

Please Note: Except under limited circumstances, requests to record an assignment of a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) registration must be filed directly with the International Bureau. [Note 6.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register, and the USPTO will record only those assignments or other documents transferring title that have been recorded in the International Register. [Note 7.]

A federal registration *owned by any party* to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by (a) a copy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current printout or copy of information from the electronic database records of the Office such as (i) TSDR (Trademark Status and Document Retrieval) showing the current status and title (owner) of the registration and, if TSDR does not

reflect the current owner of the registration, a printout or copy of the information from the Office's Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS (Trademark Electronic Search System) along with a copy of any records from the Assignment database showing an assignment to the current owner of the registration. [Note 8.]

If a party chooses to make its registration of record by submitting a status and title copy prepared by the Office, the party's submission, with a notice of reliance on its registration, of an *order* for status and title copies of the registration is not sufficient to make the registration of record. Although that procedure was once permitted, it is no longer allowed. [Note 9.] The status and title copies themselves must accompany the notice of reliance. [Note 10.] However, the status and title copies need not be certified. [Note 11.] Additionally, a party need not submit the original status and title copy; a photocopy is sufficient. [Note 12.]

The registration copies "prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by 37 CFR § 2.122(d), are printed copies of the registration on which the Office has entered the information it has in its records, at the time it prepares and issues the status and title copies, about the current status and title of the registration. That information includes information about the renewal, cancellation, publication under Trademark Act § 12(c), 15 U.S.C. § 1062(c); affidavits or declarations under Trademark Act § 8, Trademark Act § 15, and Trademark Act § 71, 15 U.S.C. § 1058, 15 U.S.C. § 1065 and 15 U.S.C. § 1141; and recorded documents transferring title. [Note 13.] Plain copies of the registration are not sufficient. [Note 14.]

The issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. Status and title copies filed under a notice of reliance during the offering party's testimony period must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter. [Note 15.]

When it comes to the attention of the Board that there has been an Office error in the preparation of a registration status and title copy made of record in an inter partes proceeding, that is, that the status and title copy does not accurately reflect the status and title information which the Office has in its records, the Board will take judicial notice of the correct facts as shown by the records of the Office. [Note 16.] Further, when a federal registration owned by a party has been properly made of record in an inter partes proceeding, and the status of the registration changes between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the Office. [Note 17.]

As an alternative to submitting status and title copies of registrations, 37 CFR § 2.122(d) allows a party to submit copies of its registrations taken from the Office's electronic database records such as TSDR or TESS.

A federal registration owned by any party to a Board inter partes proceeding may be made of record by that party by appropriate identification and introduction during the taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the current status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party. [Note 18.]

A federal registration *owned by a plaintiff* (including a counterclaimant) will be deemed by the Board to be of record in an inter partes proceeding if the defendant's answer to the complaint contains admissions sufficient for the purpose, i.e., admission to the current existence of the registration and the plaintiff's ownership of the registration. [Note 19.]

Similarly, a registration *owned by any party* to the proceeding may be deemed by the Board to be of record in the proceeding, even though the registration was not properly introduced in accordance with the applicable rules, if the adverse party in its brief, or otherwise, treats the registration as being of record. [Note 20.]

Finally, a registration *owned by any party* to the proceeding may be made of record in the proceeding by stipulation of the parties. [Note 21.]

When a subsisting registration on the Principal Register has been properly made of record by its owner in a Board inter partes proceeding, the certificate of registration is entitled to certain statutory evidentiary presumptions. [Note 22.]

In contrast, a subsisting registration on the Supplemental Register, even when properly made of record by its owner, is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued. [Note 23.]

Expired or Cancelled Registrations. Although an expired or cancelled registration may be made of record by any of the methods described above, such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used. [Note 24.]

State Registrations. A state registration owned by a party to a Board inter partes proceeding may be made of record therein by notice of reliance under 37 CFR § 2.122(e), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. *See* TBMP § 704.07.

However, a state registration (whether owned by a party, or not) is incompetent to establish that the mark shown therein has ever been used, or that the mark is entitled to federal registration. [Note 25.]

Foreign Registrations. A foreign registration owned by a party to a Board inter partes proceeding may be made of record in the same manner as a state registration, but a foreign registration is not evidence of the use, registrability, or ownership of the subject mark in the United States. [Note 26.]

Making the file history of the registration of record. If a party owns a registration that is not the subject of the proceeding and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, it may do so by: (1) filing, during its testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e) (*see* TBMP § 704.07; or (2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or (3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof. The registration file or a portion thereof may be taken from the Office's electronic database records.

The file history of a registration owned by another party, but not the subject of the proceeding, may be made of record in the same manner. [Note 27.] Copies of official records of the USPTO need not be certified. [Note 28.]

NOTES:

1. *See Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978) (plain copies of registrations introduced through testimony which established ownership of the registrations but failed to establish that they were currently subsisting were not considered); *Maybelline Co. v. Matney*, 194 USPQ

438, 440 (TTAB 1977) (pleaded registration was not considered of record where testimony introduced original certificate of registration into evidence but failed to establish current status and title); *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (mere fact that copies show that registration originally issued to opposer does not establish that title still resides in opposer). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copies of pleaded registration attached to notice of opposition considered of record when issue date "reasonably contemporaneous" with filing date of notice of opposition; two others originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id.* at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition).

2. 37 CFR § 2.122(d)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (effective January 14, 2017, "[t]he Board amended § 2.122(d) by replacing the word 'printout' with the word 'copy' to broaden the manner in which a registration may be attached to include, for example, printouts or downloads. The Office has retained the slightly different wording in § 2.122(d)(1) and (2) but the wording does not have different meanings."). *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (not of record where opposer's copies of registrations submitted with notice of opposition did not show current status or title); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with "'simple and clear' directives of Trademark Rule 2.122(d)" by submitting plain copy of registration attached to notice of opposition – registration not of record); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1709 (TTAB 2011) (pleaded registrations of record because copies from USPTO databases were submitted with notice of opposition); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, (pleaded registrations not of record where registration numbers were inputted in the ESTTA protocol but copies of registrations were not attached as exhibits); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may file a notice of reliance on a registration prepared by the Office showing both the current status and current title to the registration or a current printout of information from Office electronic database records showing the current status and title of the registrations), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from TSDR (formerly TARR) database of pleaded registrations submitted with notice of reliance sufficient to enter registrations in evidence; Board noted that "To the extent that there may appear to be a discrepancy between Trademark Rule 2.122(d)(1) and Trademark Rule 2.122(d)(2) in that the former allows for proof of a pleaded registration by the submission of USPTO records with a pleading while the latter appears to preclude use of such records during trial, there is no sound basis for the distinction."); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration did not contain status and title information); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate insufficient to show status of registration); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979). *Cf. FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copy of pleaded registration attached to notice of

opposition considered of record when issue date "reasonably contemporaneous" with filing date of notice of opposition; two others originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id.* at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition).

3. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) ("The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office.") (citing *Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987)); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 n.4 (TTAB 2007).

The Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010) exercised its discretion to take judicial notice of a third party's registrations. Although the court took judicial notice of a third-party registration in that case, the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify, as discussed above, how to make such registrations of record in an inter partes proceeding.

4. *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014) (when an opposer pleads ownership of an underlying application, opposer may make of record subsequently issued registration of that application without amending pleading); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.6 (TTAB 2011) (an applicant is on notice that an opposer intends to rely on a registration that matured from a pleaded application), *on appeal*, No. 11-3684 (D.N.J. June 2016); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n. 12 (TTAB 2009); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1223 n.6 (TTAB 2005); *M & T Chemicals Inc. v. Stepan Chemical Co.*, 150 USPQ 570, 571 (TTAB 1966).

5. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009).

6. 37 CFR § 7.22 and 37 CFR § 7.23.

7. *See* TMEP § 1906.01(a) and TMEP § 1906.01(a)(i).

8. 37 CFR § 2.122(d)(2). *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may file a notice of reliance on a registration prepared by the Office showing both the current status and current title to the registration or a current printout of information from Office electronic database records showing the current status and title of the registrations), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1041-43 (TTAB 2014) (non-status and title copies of two pleaded registrations originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance, but four others not considered of record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations

in notice of opposition); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with "'simple and clear' directives of Trademark Rule 2.122(d)" by submitting plain copy of registration attached to notice of opposition – registration not of record); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from TSDR (formerly TARR) database of pleaded registrations submitted with notice of reliance sufficient to enter registrations in evidence; Board noted that "To the extent that there may appear to be a discrepancy between Trademark Rule 2.122(d)(1) and Trademark Rule 2.122(d)(2) in that the former allows for proof of a pleaded registration by the submission of USPTO records with a pleading while the latter appears to preclude use of such records during trial, there is no sound basis for the distinction."); *UMG Recordings, Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009) (notice of reliance on registration certificate which issued after applicant filed its brief untimely; that applicant also admitted opposer owned the application that matured into the registration did not dictate that the resulting registration would be of record whenever it issued); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (untimely notice of reliance on status and title copy of registration filed after close of testimony period); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.3 (TTAB 1986).

See also Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329, 331 (TTAB 1979); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 80-81 (TTAB 1979); *W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118, 120 (TTAB 1973).

Cf. FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd., 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have).

9. *See* 37 CFR § 2.122 (d); Notice of Final Rulemaking, 48 Fed. Reg. 23122 (May 23, 1983); *In re Inter-State Oil Co.*, 219 USPQ 1229, 1230 n.1 (TTAB 1983).

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

11. 37 CFR § 2.122(e). Although status and title copies need not be certified (*see* 37 CFR § 2.122(e)), at present all status and title copies prepared and issued by the Office are certified. *See Industrial Adhesive Co. v. Borden, Inc.* , 218 USPQ 945, 947 (TTAB 1983) (copies do not have to be certified but must contain status and title information). For the cost of a copy of a registration showing status and title, see 37 CFR § 2.6(b)(4).

12. 37 CFR § 2.122(d).

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

14. *See Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with "'simple and clear' directives of Trademark Rule 2.122(d)" by submitting plain copy of registration attached to notice of opposition – registration not of record); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from TSDR (fomerly TARR) database of pleaded registrations submitted with notice of reliance sufficient to make registrations of record; Board noted that "To the extent that there may appear to be a discrepancy between Trademark Rule 2.122(d)(1) and Trademark Rule 2.122(d)(2) in that the former allows for proof of a pleaded registration by the submission of USPTO

records with a pleading while the latter appears to preclude use of such records during trial, there is no sound basis for the distinction."). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947-48 (photocopy of registration without status and title information insufficient to establish prima facie showing); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of registration certificate insufficient). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copies of pleaded registration attached to notice of opposition considered of record when issue date "reasonably contemporaneous" with filing date of notice of opposition; two others considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id.* at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition).

15. *See Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 n.2 (TTAB 2014) (plain copy of registration attached to notice of opposition indicating issuance five years before such filing not "reasonably contemporaneous"); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (whether notice of reliance on status and title copy of registration prepared four years earlier is sufficiently recent goes to the competency, not the admissibility, of the registration); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (status and title copies from 1963 not reasonably contemporaneous with filing of opposition in 1986); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) (status and title copy of registration prepared two months prior to filing of opposition is reasonably contemporaneous); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 81-82 (TTAB 1979); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735, 736 (TTAB 1976). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copy of pleaded registration attached to notice of opposition considered of record when issue date approximately four months prior to filing date of notice of opposition; two others originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id*. at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates were "years earlier" and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title).

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

17. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1425 n.19 (TTAB 2014) (judicial notice taken of changes in title and status of pleaded and proven registrations); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460 n.4 (TTAB 2014) (judicial notice taken of status of pleaded registration made of record, but no further consideration because registration had been cancelled); *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007) (judicial notice taken of current status of a registration owned by a party properly made of record, when status of registration changed between the time it was made of record and time case decided); *Black & Decker Corp. v. Emerson*

Electric Co., 84 USPQ2d 1482, 1487-88 n.10-12 (TTAB 2007) (Board confirmed Trademark Act §§ 8 and 15 affidavits that were filed after submission of opposer's registrations during testimony period); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1014 n. 4 (TTAB 2007) (Board confirmed filing of Trademark Act §§ 8 and 15 affidavits that occurred subsequent to submission of registrations); *Tea Board of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1896 n.25 (TTAB 2006) (judicial notice taken of renewal of registration); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002) (review of Office automated records subsequent to filing of status and title copy of registration revealed that Trademark Act §§ 8 and 15 affidavits had been accepted and acknowledged); *Ultratan Suntanning Centers Inc. v. Ultra Tan International AB*, 49 USPQ2d 1313, 1314, n.6 (TTAB 1998) (same); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB 1979) (status and title copy need not be updated after it is submitted; judicial notice of filing of Trademark Act §§ 8 and 15 affidavits); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846, 847 n.5 (TTAB 1978); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 80 n.3 (TTAB 1979).

18. 37 CFR § 2.122(d)(2). *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may introduce registrations through witness testifying that registrations are still subsisting and are owned by opposer), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985) (no probative value where testimony established opposer's ownership of registration, but not current status); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (identification by witness as having come from opposer's files insufficient to establish ownership and status); *Acme Boot Co. v. Tony and Susan Alamo Foundation Inc.*, 213 USPQ 591, 592 (TTAB 1980).

See also Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329, 331 n.2 (TTAB 1979); *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978); *Groveton Papers Co. v. Anaconda Co.*, 197 USPQ 576, 577 n.2 (TTAB 1977); *Maybelline Co. v. Matney*, 194 USPQ 438, 440 (TTAB 1977); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498, 500 (TTAB 1976); *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53, 54 (TTAB 1976).

19. *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (admission only of ownership and not validity was not sufficient); *Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) (Board erred in refusing to consider registrations of record when applicant admitted "the registrations referred to in the notice of opposition" in its answer); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (applicant effectively admitted active status and ownership of certain specifically identified registrations); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (not of record where although applicant admitted that copies attached to opposition were "true copies" applicant did not admit to status and title of those registrations). *Cf. United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1041-42 (TTAB 2014) (non-status and title copies of four registrations attached to notice of opposition not of record despite applicant's admission in answer that opposer is the owner of them, as opposer did not plead validity of registrations in notice of opposition); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1602 (TTAB 2014) (applicant's admission that opposer "is listed" as the owner insufficient to establish opposer's current ownership of pleaded registration); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009) (applicant admitted opposer's ownership of pleaded application; admission did not make resulting registration automatically of record and registration still had to be introduced); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008) (applicant's statement in answer that he "does not dispute the filing" of opposer's application not an admission of opposer's ownership of subsequently issued registration and registration's validity).

20. *See Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) (after filing its answer, respondent filed a "paper" in which respondent admitted existence of petitioner's registration; admission was sufficient to overcome respondent's 37 CFR § 2.132 motion for default judgment); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1157 (TTAB 1990) (applicant conceded ownership and validity in trial brief); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (applicant's treatment of pleaded registrations as properly of record in its trial brief was deemed a stipulation as to current status and title); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983) (admission in brief). *See also Jockey International, Inc. v. Frantti*, 196 USPQ 705, 706 n.5 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 392 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53, 54 (TTAB 1976).

21. *See* 37 CFR § 2.123(b); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 774 n.2 (TTAB 1979).

22. *See, e.g.*, Trademark Act § 7(b), 15 U.S.C. § 1057(b); *CTS Corp. v. Cronstoms Manufacturing, Inc.*, 515 F.2d 780, 185 USPQ 773, 774 (CCPA 1975) (prima facie evidence of registrant's right to use the mark on the identified goods); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 274 (CCPA 1974) (prima facie evidence of validity of registration, ownership of mark and exclusive right to use it); and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (prima facie evidence of registrant's continuous use of the mark). *See also* Trademark Act § 7(c), 15 U.S.C. § 1057(c) (conferring, contingent on the registration of a mark on the Principal Register, and subject to certain specified exceptions, constructive use priority dating from the filing of the application for registration of the mark); *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216, 1217 n.5 (TTAB 1992) (opposer's constructive use date on ITU application was subsequent to applicant's); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (constructive use dates intended to give ITU applicants superior rights to others who adopt the mark after filing date).

See also Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232, 234 (TTAB 1976); *David Crystal, Inc. v. Glamorise Foundations, Inc.*, 189 USPQ 740, 741 (TTAB 1975); *Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 USPQ 790, 791 (TTAB 1974); *Gates Rubber Co. v. Western Coupling Corp.*, 179 USPQ 186, 189-90 (TTAB 1973).

23. *See McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966) (registration on Supplemental Register is not evidence of constructive notice of ownership nor evidence of exclusive right to use); *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978). *See also Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *Aloe Creme Laboratories, Inc. v. Johnson Products Co.*, 183 USPQ 447 (TTAB 1974); *Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970).

24. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (does not provide constructive notice of anything); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) (cancelled and expired registrations are not probative), *vacated and remanded on other grounds, Princeton Vanguard , LLC v. Frito-Lay North. America., Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650, 1653 n.6 (TTAB 2002) (status and title copy of expired registration); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746-47 (TTAB 1987) (parties stipulated to introduction of photocopy of expired registration having no probative value other than that it issued); *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 818 n.7 (TTAB 1986) (expired "Act of 1920" registration had no probative value); *Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc.*, 191 USPQ 292, 294

(TTAB 1976) (lapsed registration of affiliated company is not evidence of use of mark at any time); *Bonomo Culture Institute, Inc. v. Mini-Gym, Inc.*, 188 USPQ 415, 416 (TTAB 1975) (expired registration is incompetent evidence of any existing rights in mark). *Cf. Nike Inc. v. Maher*, 100 USPQ2d 1018, 1021 (TTAB 2011) (limited probative value of expired third-party registration is further limited to the short time it was registered).

See also Borden, Inc. v. Kerr-McGee Chemical Corp., 179 USPQ 316, 316 n.2 (TTAB 1973), *aff'd without opinion*, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); *Unitec Industries, Inc. v. Cumberland Corp.*, 176 USPQ 62, 63 (TTAB 1972); *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506, 508 (TTAB 1972).

25. *See, e.g., Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976) (state registrations do not establish use); *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981) (although parties stipulated to introduction of state registration, said registration is incompetent to prove anything material to opposition proceeding); *Plak-Shack, Inc. v. Continental Studios of Georgia, Inc.*, 204 USPQ 242, 246 (TTAB 1979) (incompetent as evidence of use of a mark); *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 352 (TTAB 1978) (incompetent evidence to establish use of the mark), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982). *See also Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307, 390 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 390 (TTAB 1976); *State Historical Society of Wisconsin v. Ringling Brothers-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25, 26 n.2 (TTAB 1976); *Old Dutch Foods, Inc. v. Old Dutch Country House, Inc.*, 180 USPQ 659, 660 n.6 (TTAB 1973); *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240, 243-44 (TTAB 1963).

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

26. *See Societe Anonyme Marne et Champagne v. Myers*, 250 F.2d 374, 116 USPQ 153, 156 (CCPA 1957); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610, 1618 (TTAB 1988). *See also Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503, 507 (TTAB 1973); *Barash Co. v. Vitafoam Ltd.*, 155 USPQ 267, 267 n.3 (TTAB 1967), *aff'd*, 427 F.2d 810, 166 USPQ 88 (CCPA 1970). *Cf. In re Hag AG*, 155 USPQ 598, 599 (TTAB 1967).

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

28. 37 CFR § 2.122(e).

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

37 CFR § 2.122 (e) ***Printed publications and official records.***

(1) *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 in a particular 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 in accordance with paragraph (g) of this section. The notice of reliance 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 Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party to an inter partes proceeding before the Board may introduce, as part of its evidence in the case, a registration owned by a third party not involved in the proceeding. [Note 1.]

A party that wishes to make such a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration, a printout or a copy of information of the registration from the Office's electronic database records, together with a notice of reliance thereon specifying the registration and indicating generally its relevance and associating the registration with one or more issues in the case. [Note 2.]

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

It is not necessary that the copy of the third-party registration submitted with a notice of reliance (or with testimony or a stipulation) be certified, nor need it be a current status and title copy prepared by the Office; a plain copy (or legible photocopy) of the registration itself, or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the Office's automated search system is all that is required. [Note 3.]

As stated in TBMP § 704.03(b)(1) above, a current status and title copy of a registration prepared by the Office (or other appropriate proof of current status and title), or a current printout or copy of information from the Office's electronic database records showing the current status and title of the registration, submitted with a notice of opposition or petition to cancel, is necessary when the owner of a registration on the Principal Register seeks to make the registration of record for the purpose of relying on the presumptions accorded to a certificate of registration pursuant to Trademark Act § 7(b), 15 U.S.C. § 1057 (b) . However, the § 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner, or when the registration is cited by an examining attorney (in an ex parte case) as a reference under Trademark Act § 2(d), 15 U.S.C. § 1052(d), against a mark sought to be registered. [Note 4.]

Thus, when third-party registrations are made of record, the party offering them may not rely on the Trademark Act § 7(b), 15 U.S.C. § 1057(b), presumptions. Normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose. [Note 5.]

On the other hand, a party may not make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned; or by filing a printout, from a private company's data base, of information about the registration; or by filing a notice of reliance together with a reproduction of the mark as it appeared in the Official Gazette for purposes of publication; or by referring to the registration in its brief or pleading. The Board does not take judicial notice of registrations in the Office. [Note 6.] *Cf.* TBMP § 528.05(d) (for purposes of responding to a summary judgment motion only, a copy of a trademark search report may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation).

Even when a third-party federal registration has been properly made of record, its probative value is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in the registration. [Note 7.] Nevertheless, third-party registrations may be entitled

to some weight to show the meaning of a mark, or a portion of a mark, in the same manner as a dictionary definition. [Note 8.]

A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board. [Note 9.] *See, e.g.*, TBMP § 704.03(b)(1)(A).

Making file history of third-party registration of record. The file history of a third-party registration (rather than just the certificate of registration), or a portion thereof, may be made of record by: (1) filing, during the offering party's testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 CFR § 2.122(e) (*see* TBMP § 704.07); or (2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or (3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof. The file history, or portion thereof, may be obtained from the Office's electronic database records, such as TSDR.

It is not necessary that the copy of the registration file, or portions thereof, be certified. [Note 10.] However, third-party registration histories are of very limited probative value. [Note 11.]

NOTES:

1. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1110 (TTAB 2007). *Cf. FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have).

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

3. *See* 37 CFR § 2.122(e); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011) (not necessary to submit title and status copies of third-party registrations prepared by Office; plain copies from the USPTO's electronic database would have sufficed); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete excerpts of registrations from internal USPTO trademark database system was insufficient); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). *See also Interbank Card Association v. United States National Bank of Oregon*, 197 USPQ 123, 124 n.6 (TTAB 1977).

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

use of a mark, petitioner cannot rely on the registrations owned by its wholly-owned subsidiary for statutory presumptions); *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394, 395 (TTAB 1968) (opposer cannot rely on registrations owned by its parent or its parent's subsidiaries).

5. *See Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 593 n.16 (TTAB 1980); *Hiram Walker & Sons, Inc. v. Milstone*, 130 USPQ 274, 276 (TTAB 1961).

6. *See, e.g., Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (listing of third-party marks downloaded from Office database does not make registrations of record); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n.8 (TTAB 2012) (summary of search results from USPTO's electronic database is not an official record of the Office); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 (TTAB 2011) (summaries of search results for third-party registrations are not official records and have not been considered); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (third-party registrations mentioned in trial brief); *Truescents, LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1337 (TTAB 2006) (listing of applications and registrations obtained from Office's electronic database); *In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (listings from commercial trademark search reports); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (search report from private company's database); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1885 (TTAB 1993) (trademark search report wherein registrations are mentioned); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (trademark search reports from private companies are neither printed publications nor official records); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990) (search report), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 532 (TTAB 1986) (reference to third-party registrations in a brief). *See also National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

The Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party's registrations. Although the court took judicial notice of a third-party's registrations in that case, as discussed above the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding.

7. *See AMF Inc. v. American Leisure Products, Inc,*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (not evidence of what happens in the market place or consumer familiarity); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 n.10 (TTAB 2014) (third-party registrations do not constitute evidence of use, thus of limited probative value to show mark is weak), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *In re the Dot Communications Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011) (limited probative value in view of the current market conditions which are very different from when registrations issued); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1222 (TTAB 2011) (third-party registrations for same term are not evidence of use in the marketplace); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1028 (TTAB 2011) (little probative value because they tell nothing about whether the marks are being used or the manner of such use); *Nike, Inc. v. WNBA Enterprises, LLC*, 85 USPQ2d 1187, 1200 (TTAB 2007) (not evidence of use); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (not evidence of use or that

consumers have been exposed to them); *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988) (not evidence of use to show public awareness of the marks).

See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (may not be given any weight in determining strength of a mark); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 n.12 (CCPA 1977) (little evidentiary value in determining scope of protection); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975) (little weight on likelihood of confusion), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975) (little weight on question of likelihood of confusion); *Spice Islands, Inc. v. Frank Tea and Spice Co.*, 505 F.2d 1293, 184 USPQ 35, 38 (CCPA 1974) (do not control determination of whether marks are so similar that they are likely to cause confusion); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983) (third-party registration only establishes what appears on its face, that application was made claiming adoption and use and that registration was granted), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

Cf. In re Alpha Analytics Investment Group LLC, 62 USPQ2d 1852, 1856 (TTAB 2002) (registrations under Trademark Act § 2(f) or on the Supplemental Register, although not conclusive evidence, may be probative evidence of mere descriptiveness). *Cf. also Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1221 (TTAB 2011) (while third-party registrations based on use in commerce may suggest listed goods and services are of the type which may emanate from a single source, third party registrations based on international registrations are not evidence that the marks have been used in the United States for the stated goods and services); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (third-party registrations may have some probative value to the extent that they may serve to suggest that goods or services are of a type which may emanate from the same source).

8. *See Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 425 (CCPA 1975). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1029 (TTAB 2011) (may indicate that a mark, or portion of a mark, is descriptive or suggestive); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1028 (TTAB 2011) (to indicate a commonly registered expression with a suggestive meaning); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011) (probative of meaning of term, not probative that term is commercially weak), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (that a term is adopted to convey a particular suggestive meaning); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992) (to show the sense in which the term is employed in the marketplace); *United Foods Inc. v. J.R. Simplot Co,*, 4 USPQ2d 1172, 1174 (TTAB 1987) (to show ordinary usage of a term and descriptive or suggestive significance); *Bottega Veneta, Inc. v. Volume Shoe Corp,*, 226 USPQ 964, 968 (TTAB 1985) (to show geographic significance of terms).

9. *See Allstate Insurance Co. v. DeLibro*, 6 USPQ2d 1220, 1223 (TTAB 1988) (third-party state registrations "are of absolutely no probative value" on the question of likelihood of confusion).

10. 37 CFR § 2.122(e).

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

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

37 CFR § 2.122(e) ***Printed publications and official records.***

(1) *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 in a particular 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 in accordance with paragraph (g) of this section. The notice of reliance 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 Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

A party to a proceeding before the Board may introduce, as part of its evidence in the case, a copy of an application that is not the subject of the proceeding, by filing, during its testimony period, a copy of the application file, or of the portions which it wishes to introduce, together with a notice of reliance thereon specifying the application and indicating generally its relevance as well as associating the application with one or more issues in the case. [Note 1.] It is not necessary that the copy of the application, or portions thereof, filed under a notice of reliance be certified. [Note 2.] The copy of the application, or portion thereof, may be obtained from the Trademark Status and Document Retrieval ("TSDR") database accessible on the Office's website.

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

An application made of record in a Board inter partes proceeding, whether owned by a party or not, is generally of very limited probative value. [Note 3.] *See* TBMP § 704.04. However, if the application is owned by a party to the proceeding, the allegations made and documents and things filed in the application may be used as evidence against the applicant, that is, as admissions against interest and the like. *See* TBMP § 704.04. [Note 4.]

NOTES:

1. *See* 37 CFR § 2.122(e); 37 CFR § 2.122(g). *See Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1933 (TTAB 2013) (opposer's objection sustained; applicant's mere listing of third-party applications in brief not properly made of record); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231 (TTAB 1992) (copy of drawing from abandoned application); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (copies of third-party applications); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778, 780 n.4 (TTAB 1977) (file history of petitioner's application). *Cf. Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1867 n.3 (TTAB 2016) (in ruling on motion for summary judgment, Board noted that the mere listing of an application number in the electronic record does not make that application of record).

2. *See* 37 CFR § 2.122(e); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350 (TTAB 2014) (plain copies of third-party applications from USPTO's electronic databases admissible as official records), appeal dismissed per stipulation, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

3. *See Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) ("The applications are not evidence of anything except that they were filed."), *vacated and remanded on other grounds*, *Princeton Vanguard , LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1360 (TTAB 2014) (evidence only that applications were filed, thus incompetent to show common third-party use), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); ; *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (evidence only of the filing of the application); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979) (claim of ownership of a registration in an application is not competent evidence of ownership of the registration); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978) (petitioner's application file is proof only of filing, not of any facts alleged in the application); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778, 780 n.4 (TTAB 1977) (incompetent to prove use). *See also Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Trademark Act § 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public); *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449, 451 (TTAB 1976); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232, 234 n.6 (TTAB 1976).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (statements falling under Fed. R. Evid. 801(d) do not constitute hearsay).

704.04 Statements and Things in Application or Registration

37 CFR § 2.122

(b) ***Application and registration files.***

(1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant. Establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part.*

The file of a particular application or registration that is the subject of the proceeding is of record in a Board inter partes proceeding by operation of 37 CFR § 2.122(b)(1). *See* TBMP § 704.03(a). [Note 1.] However, statements made in an affidavit or declaration in the file of an application or registration are not testimony; rather, such matter constitutes hearsay, except for statements falling under Fed. R. Evid. 801(d)). [Note 2.]

Likewise, the allegation of a date of use of a mark made in the application or registration is not evidence in the proceeding on behalf of the applicant or registrant and the specimen in the application or registration, without more, is not evidence on behalf of the applicant or registrant. [Note 3.] The date of use must be established by competent evidence, properly adduced at trial, [Note 4] and the specimen in an application or registration file is not evidence in an inter partes proceeding, on behalf of the applicant or registrant, unless it has been identified and introduced in evidence as an exhibit during the testimony period. [Note 5.]

Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used. [Note 6.]

The allegations and statements made and documents and things filed in an application or registration may be used as evidence *against* the applicant or registrant, that is, as admissions against interest and the like. [Note 7.]

Self-authenticating exhibits (e.g., printed publications, internet printouts with the URL and date) attached to affidavits or declarations in applications or registrations may have evidentiary value for what they show on their face. [Note 8.]

NOTES:

1. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009).

2. 37 CFR § 2.122(b)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("Now that testimony by affidavit or declaration is unilaterally available, it is necessary to clearly distinguish material residing in an application or registration from testimony introduced in the proceeding. … Although part of the record of the proceeding, such material constitutes hearsay (except for statements falling under Fed. R. Evid. 801(d)), further compounded by the fact that the affidavits or declarations were not subject to contemporaneous cross-examination.).

3. 37 CFR § 2.122(b)(2) *See, e.g., UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009) (allegations in application are not evidence); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (in the absence of proof of use, the filing date of the application, rather than the dates of use alleged in the application, is treated as the earliest use date on which applicant may rely); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979); (an application is not evidence of anything on behalf of applicant except that it was filed); *Omega SA v. Compucorp*, 229 USPQ 191, 195 (TTAB 1985) (allegations and documents in application file not evidence unless and to the extent they have been identified and introduced in evidence during testimony). *See also The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

4. 37 CFR § 2.122(b)(2) *See Baseball America, Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1848, n.10 (TTAB 2004) (dates of use in application not evidence of such use); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (in the absence of proof, the filing date of the application and not the dates of use alleged in the application is treated as the earliest use date on which an applicant may rely); *Omega SA v. Compucorp*, 229 USPQ 191, 193 n.10 (TTAB 1985) (applicant may rely on presumption that its mark was in use as of filing date of application in absence of any proof of earlier use); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985) (statements and materials in registration file bearing on respondent's dates of use not evidence on behalf of respondent

unless properly introduced); *Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315 (TTAB 1973) (applicant cannot rely on dates of use alleged in application).

5. 37 CFR § 2.122(b)(2). *See Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in application not evidence on behalf of respondent); *Dap, Inc. v. Century Industries Corp.*, 183 USPQ 122, 123 (TTAB 1974) (applicant cannot rely on specimens filed with application to delineate nature and use of its goods).

6. 37 CFR § 2.122(b)(2). *See Alpha Industries, Inc. v. Alpha Microsystems*, 223 USPQ 96, 96 (TTAB 1984) (Board will not take judicial notice of statements made in third-party applications regarding use). *See also e.g., Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (registrations owned by opposer's parent corporation are third-party registrations and opposer cannot rely on those registrations to prove priority); *Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc.*, 224 USPQ 512, 514 (TTAB 1984); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Trademark Act § 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (statements falling under Fed. R. Evid. 801(d) do not constitute hearsay). *See Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent's office action response constitute admissions against interest and fall within hearsay exception under Fed. R. Evid. 801(d)(2)); *Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008) (disclaimer may be considered an admission that term is merely descriptive); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n.5 and n.11 (TTAB 1985) (date of first use asserted by opposer in its application may be considered as admission against interest; in evaluating "Morehouse" type defense, Board relied on specimens and other materials in applicant's application as evidence of the nature of applicant's services to find that those services were not "substantially identical" to the goods in applicant's subsisting registration); *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101, 1102 n.3 (TTAB 1982) (applicant's claim of distinctiveness in its application is an admission by applicant that term is descriptive); *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in respondent's registration may be used as admission against interest of relationship between respondent's and petitioner's goods).

See also e.g., Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (applicant which seeks to prove date of first use earlier than that stated in its application must do so by heavier burden of clear and convincing evidence, rather than a preponderance of the evidence, because of the change of position from one "considered to have been made against interest at the time of filing of the application"); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) (applicant's earlier contrary position before the examining attorney as to the meaning of its mark as demonstrated by statements in the application illustrating the variety of meanings that may be attributed to, and commercial impression projected by, applicant's mark, may be relevant); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (fact that party took position in its application inconsistent with its position in inter partes proceeding may be considered as evidence "illuminative of shade and tone in the total picture confronting the decision maker"); *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (in application for mark in typed form, specimens in application may be used to illustrate one form in which mark may actually be used in order to show similarity with opposer's mark); *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 798 (TTAB 1986) (fact that opposer took position in its application regarding descriptiveness of term

inconsistent with its position in inter partes proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).

704.05 Exhibits to Pleadings or Briefs

704.05(a) Exhibits to Pleadings

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

37 CFR § 2.122(d) ***Registrations.***

(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

Exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached, and must be properly identified and introduced in evidence as exhibits during the testimony period. [Note 1.] However, there are two exceptions to this rule.

The first exception is a current status and title copy, prepared by the Office, of a plaintiff's pleaded registration. When a plaintiff submits an original or photocopy of a status and title copy, prepared and issued by the Office, of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff. [Note 2.]

The second exception is a current printout or copy of information from the electronic database records of the USPTO showing the current status and title of the registration. When a plaintiff submits a printout or copy of such information as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff. [Note 3.] *See* TBMP § 704.03(b)(1)(A). The printout or copy of the information may be taken from (a) the TSDR (Trademark Status and Document Retrieval) showing the current status and title (owner) of the registration and, if the TSDR printout or copy of the information does not reflect the current owner of the registration, a printout or copy of the information from the Office's Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (b) the TESS (Trademark Electronic Search System) electronic database of the Office along with a copy of records from the Assignment database showing and assignment to the current owner of the registration.

NOTES:

1. 37 CFR § 2.122(c) *See Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016 n.5 (TTAB 2014) (materials attached to answer not considered).

2. *See* 37 CFR § 2.122(c) and 37 CFR § 2.122 (d) (1) .

3. *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008). *Cf. Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1867 n.3 (TTAB 2016) ("The mere listing of an application number in the electronic record does not make that application of record."); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1539-40 (pleaded registrations not of record where registration numbers were inputted in the ESTTA protocol but copies of registrations were not attached as exhibits).

704.05(b) Exhibits to Briefs

Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. [Note 1.]

Evidence which was timely filed during the parties' trial periods need not and should not be resubmitted with a party's brief. [Note 2.]

If, after the close of the time for taking testimony, a party discovers new evidence that it wishes to introduce in its behalf, the party may file a motion to reopen its testimony period. However, the moving party must show not only that the proposed evidence has been newly discovered, but also that it could not have been discovered earlier through the exercise of reasonable diligence. *See* TBMP § 509.01(b).

NOTES:

1. *See, e.g., Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman Warehouse, Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008); *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006) (excerpts from novel not considered); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.5 (TTAB 1986) (third-party registrations attached to brief not considered); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of Canadian Opposition Board decision attached to brief not considered); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978); *Astec Industries, Inc. v. Barber-Greene Co.*, 196 USPQ 578, 580 n.3 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976)., *See also L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254, 255 (TTAB 1975); *American Crucible Products Co. v. Kenco Engineering Co.*, 188 USPQ 529, 531 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 589 n.1 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 61, 61 n.2 (TTAB 1975), *aff'd*, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.3 (TTAB 1973).

Compare, Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1405 (TTAB 1998) (dictionary definitions attached to applicant's brief were the proper subject of judicial notice); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (evidence which had been timely filed was not objectionable when a reproduction of the evidence was later attached to a trial brief) with TBMP § 704.12 regarding judicial notice.

2. *See Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1092 (TTAB 2012) (not necessary to submit duplicates of material that is already in record); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ 2d 1112, 1116 (TTAB 2009); *Life Zone, Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 n.4 (TTAB 2008) (attaching previously-filed evidence to a brief is neither a courtesy nor a convenience to the Board).

704.06 Statements in Pleadings or Briefs

704.06(a) Statements in Pleadings

Statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. [Note 1.]

However, statements in pleadings may have evidentiary value as admissions against interest by the party that made them. [Note 2.]

NOTES:

1. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in answer not evidence unless supported by evidence introduced at trial or except as admission against interest); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656, 662 (TTAB 1979) (statements in answer referring to sales of applicant's magazines were not considered).

2. *See Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in answer not evidence unless supported by evidence introduced at trial or except as admission against interest); *Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 174 USPQ 395, 396 n.4 (CCPA 1972) (pleadings in prior proceeding available as evidence, although not conclusive evidence, against the pleader); *Bakers Franchise Corp. v. Royal Crown Cola Co.*, 404 F.2d 985, 160 USPQ 192, 193 (CCPA 1969) (admission contained in pleading of one action may be evidence against pleader in another action); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1548 n.6 (TTAB 1990) (pleadings have evidentiary value only to the extent they contain opponent's admissions against interest), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 196 USPQ 711, 714 (TTAB 1977) (admissions in answer regarding meaning of mark); *Brown Co. v. American Stencil Manufacturing Co.*, 180 USPQ 344, 345 n.5 (TTAB 1973) (applicant having admitted in its answer that it did not use mark prior to a certain date was estopped from later contending that it has an earlier date of use).

704.06(b) Statements in Briefs

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest by the party that made them. [Note 1.]

NOTES:

1. *See, e.g., Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in brief not evidence unless supported by evidence introduced at trial or except as admission against interest); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (broad and general statements in brief regarding marketing experience not supported by any evidence and cannot be accorded evidentiary value or consideration); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (no consideration given to reference in brief to third-party registrations not of record); *Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007) (lack of evidence undercuts contentions in brief); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1224 n.5 (TTAB 2005) (by acknowledging in its brief on the case that a label was provided to opposer by applicant, applicant stipulated to its authenticity and to its admission into the record); *Baseball America*,

Inc. v. Powerplay Sports, Ltd., 71 USPQ2d 1847, 1847 (TTAB 2004) (factual assertions in brief not supported by competent evidence not considered); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992) (additional revenue figures provided in trial brief not considered); *Kellogg Co. v. Pack'Em Enterprises Inc*., 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements made in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (factual statements regarding certain scientific matter which cannot be deemed to be public knowledge not considered); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502, 507 (TTAB 1978); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 and 113 (TTAB 1978).

See also In re Teledyne Indus., Inc., 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982) (in absence of evidence in the record, mere argument of counsel cannot rebut prima facie case of functionality); *In re Simulations Publications, Inc.*, 521 F.2d 797, 798, 187 USPQ 147, 148 (CCPA 1975) ("Statements in a brief cannot take the place of evidence.").

Cf. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) (without copies of relevant documentation including relevant portions of application file, not possible to determine validity of opposer's allegations that applicant took inconsistent position in its application).

704.07 Official Records

37 CFR § 2.122(e) ***Printed publications and official records.***

(1) *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 in a particular 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 in accordance with paragraph (g) of this section. The notice of reliance 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 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.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

A party that wishes to introduce an official record in evidence in a Board inter partes proceeding may do so, if the official record is competent evidence and relevant to an issue in the proceeding, by filing a notice of reliance thereon during its testimony period. The notice of reliance must specify the official record and the pages to be read; indicate generally the relevance of the material being offered and associate it with one or more issues in the case; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence. [Note 1.]

The term "official records" as used in 37 CFR § 2.122(e)(1) refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer. [Note 2.] These official records are considered self-authenticating, and as such, require no extrinsic

evidence of authenticity as a condition to admissibility. [Note 3.] Electronic versions of applications and registrations printed from the USPTO's databases are official records. [Note 4.]

For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 CFR § 2.122(e)(1), see cases cited in the note below. [Note 5.] For information concerning the admissibility of official records obtained through the Internet, see TBMP § 704.08.

For information concerning establishing the authenticity, under the Federal Rules of Evidence, of an official record, see Fed. R. Evid. 901(a), Fed. R. Evid. 901(b)(7), and Fed. R. Evid. 902(4). The latter rule provides, in effect, that extrinsic evidence of authenticity as a condition precedent to admissibility is not required with respect to a properly certified copy of an official record, and describes the requirements for proper certification. However, a copy of an official record of the USPTO need not be certified to be offered in evidence by notice of reliance. [Note 6.]

In lieu of the actual "official record or a copy thereof," the notice of reliance may be accompanied by an electronically generated document (or a copy thereof) which is the equivalent of the official record, and whose authenticity is established under the Federal Rules of Evidence. [Note 7.] *Cf.* TBMP § 704.08.

Although official records may be made of record by notice of reliance under 37 CFR § 2.122(e), it is not mandatory that they be introduced in this manner. They may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. [Note 8.] These latter two methods may also be used to introduce types of official records that are not admissible by notice of reliance under 37 CFR § 2.122(e). [Note 9.]

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

Materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record. [Note 10.]

NOTES:

1. *See* 37 CFR § 2.122(e) and 37 CFR § 2.122(g). *See also Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006) (registration not considered because opposer did not explain in notice of reliance what registration pertained to or why it was submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports are not official records); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on official records is untimely when filed after oral hearing), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (relevance of third-party registrations sufficiently indicated); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (official records are records prepared by a public officer); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (submission of duplicate copies of third-party registrations with brief was not untimely where the evidence had been timely filed during course of proceeding); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (untimely notice of reliance on official records filed after expiration of testimony period not considered).

2. *See Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (company invoices not official records); *7-Eleven, Inc. v. Wechsler*,

83 USPQ2d 1715, 1717 n.3 (TTAB 2007) (opposer's file copy of documents from Board proceeding, such as applicant's opposition brief to opposer's summary judgment motion, do not constitute official records); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (party's own file copies of documents from a Board proceeding are not official records); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (official records are records prepared by a public officer). *See also* Fed. R. Evid. 902(4).

3. *See Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979).

4. *See Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1352 n.13 (TTAB 2014) (third-party applications printed from USPTO's electronic database admissible under notice of reliance as official records; status and title copies not required), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217, 1219 (TTAB 2011) (electronic versions of the registrations printed from USPTO databases, showing the URL and date they were printed, are official records); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1038 (TTAB 2010) (the Office's files are in electronic form and accessible to all via the Internet, and to that extent they are both official records and in general circulation).

5. *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1013 (TTAB 2015) ("Proclamation of Delmonico's Day of Mayor Rudolph Giuliani" found on the wall of party's restaurant at the time the party purchased the business – no; listing of telephone area codes published online by North American Numbering Plan Administration - yes), *aff'd*, Rule 36, No. 2015-1939 (Fed. Cir. 2016) (mem.); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1108 n.14 (TTAB 2015) (sales history reports – no, however, because non-offering party treated as being of record, Board construed exhibit as having been stipulated into the record by the parties); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (certificate of incorporation – yes); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603 n.2 (TTAB 2010) (corporate annual reports not printed from the Internet – no), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713, 1718 (Fed. Cir. 2012) (print versions of annual reports - no); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1826 (TTAB 2010) (applicant's copies of legal briefs that do not reflect they were received by court -- no), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009) (printouts of abandoned applications obtained from Trademark Status and Document Retrieval (TSDR) database, formerly Trademark Document Retrieval (TDR) database - yes); *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009) (trademark application file -- yes); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (office actions from trademark application and patent application from USPTO files -- yes); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (United States Postal Service form completed by publisher/mailer of catalogues with "no official markings or signature" -- no); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007) (copies of registration from USPTO's electronic records -- yes); *Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (annual reports, financial statements, advertising invoices and other advertising documents -- no); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1508 (TTAB 2000) (copy of Board's decision on summary judgment in prior opposition -- yes; purported copy of brief in support of summary judgment motion in prior proceeding which did not reflect that it was received by the Board but appeared to be merely applicant's file copy of the document -- no); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (trademark search report -- no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports -- no); *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157, 1159 n.3 (TTAB 1992) (trademark search report -- no; third-party registrations -- yes), *aff'd*, 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1993); *Osage Oil & Transportation*,

Inc. v. Standard Oil Co., 226 USPQ 905, 906 n.5 (TTAB 1985) (copy of cancellation proceeding file -- yes; party's file copies of documents filed in the USPTO -- no); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.3 (TTAB 1985) (letters between counsel for parties, and list of party's licensees -- no); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (third-party registrations -- yes); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (portions of an agreement between applicant and a third party, press release, list of foreign trademark registrations, and a shipping document for applicant's product -- no); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (copy of letter from Amtrak to applicant congratulating applicant for having an appointment as an Amtrak agent, copy of a "Passenger Sales Agency Agreement" between the International Air Transport Association and applicant, etc. -- no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (brochures and other promotional literature -- no); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (certified copies of corporate records maintained by Secretary of State of Missouri -- yes); *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 663 n.3 and 664 (TTAB 1977) (plat plan, deed of realty, and confirmatory assignment -- not admissible by notice of reliance as official record because not properly authenticated); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 654 n.9 (TTAB 1976) (third-party registrations -- yes); *Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of party's registration -- yes); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (drawings from federal trademark applications -- yes); *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) (certificate of good standing from a United States district court -- yes).

6. *See* 37 CFR § 2.122(e).

7. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

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

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

10. *See, e.g., U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (improper subject matter but adverse party expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (neither party objected to the notice of reliance on annual reports by the other); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered where no objection was raised); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.3 and 4 (TTAB 1984) (improper subject matter deemed stipulated into record where no objection was raised); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (improper subject matter deemed stipulated into record where adverse party did not object and specifically referred to the matter in

its brief); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely notice of reliance filed prior to testimony period considered where no objection was raised and error was not prejudicial). *Cf. Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where although there was no objection, no agreement could be inferred) and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (improper subject matter excluded, although adverse party did not object to the material).

704.08 Printed Publications

37 C.F.R §2.122(e) ***Printed publications and official records.***

(1) *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 in a particular 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 in accordance with paragraph (g) of this section. The notice of reliance 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 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.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

704.08(a) Traditional Printed Publications

Certain types of printed publications may be introduced into evidence in a Board inter partes proceeding by notice of reliance. Specifically, printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, if the publication is competent evidence and relevant to an issue in the proceeding, may be introduced in evidence by filing a notice of reliance thereon during the testimony period of the offering party. [Note 1.] The notice must specify the printed publication, including information sufficient to identify the source and the date of the publication, and the pages to be read; indicate generally the relevance of the material being offered and associate it with one or more issues in the case; and be accompanied by the printed publication or a copy of the relevant portion thereof. [Note 2.]

In lieu of the actual "printed publication or a copy of the relevant portion thereof," the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion, as, for example, by a printout from the LexisNexis or Westlaw computerized library of an article published in a newspaper or magazine of general circulation. [Note 3.]

In case of reasonable doubt as to whether printed publications submitted by notice of reliance under 37 CFR § 2.122(e) are "available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue" in the proceeding, the burden of showing that they are so available lies with the offering party. [Note 4.] The offering party need only make such a showing if its adversary has challenged its submission; it need not make such a showing as part of its original submission.

For examples of cases concerning the admissibility of specific materials, by notice of reliance, as "printed publications" under 37 CFR § 2.122 (e)), see cases cited in the note below. [Note 5.]

Printed publications made of record by notice of reliance under 37 CFR § 2.122(e) are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. [Note 6.]

Although the types of printed publications described above may be made of record by notice of reliance under 37 CFR § 2.122(e), they may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. [Note 7.] These latter two methods may also be used for the introduction of printed publications that are not admissible by notice of reliance under 37 CFR § 2.122(e). [Note 8.]

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

Materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record. [Note 9.]

The party who submits printed publications must ensure that the evidence is legible and have been entered into the record. [Note 10.]

NOTES:

1. 37 CFR § 2.122(e) and 37 CFR § 2.122(g) *See Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (while subject matter may be of interest to the general public such materials are not necessarily in general circulation); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 n.5 (TTAB 1984) (objection that applicant failed to indicate relevance of materials overruled); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on printed material filed after oral hearing untimely), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (duplicates of printed publications submitted with brief which had been properly filed by notice of reliance during testimony period considered); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (rule provides safeguard that party against whom evidence is offered is readily able to corroborate or refute authenticity of what is proffered); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (plaintiff's catalogs and house publications not considered because it was not shown they are "available to the general public in libraries or in general circulation;" advertisements permitted if publication in which they appeared and dates are provided to allow party to verify authenticity); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (publication shown to be available in public library properly submitted under 37 CFR § 2.122(e), even though it may constitute hearsay or be of dubious relevance).

2. *See* 37 CFR § 2.122(e) and 37 CFR § 2.122(g). *See also Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789, 1793 (TTAB 2009) (statement that documents are introduced to show use of opposer's marks sufficient to indicate relevance); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007) (article from a trade magazine is admissible under 37 CFR § 2.122(e) because "[o]n its face, it identifies the publication and the date published"); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005) (general statement of relevance sufficient for a collection of materials), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008); *Harjo v. Pro-Football Inc.*, 50 USPQ2d

1705, 1721 n.50 (TTAB 1999) (excerpts that were unidentified as to either source or date were not considered, as the extent to which such material is genuine and available to the public could not be ascertained), *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), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (finding it sufficient that copies of the excerpted articles contained notations either on the copies themselves or in the notice of reliance as to the source and date of the copied articles, but noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (printed advertisement not identified with the specificity required to be considered a printed publication); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (notice of reliance received without appended copy of printed publication).

3. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (Board "routinely accepts printouts of articles obtained from the LexisNexis database, when filed under notice of reliance, so long as the date and source of each article are clear."), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *International Association of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 USPQ 940, 942 n.6 (TTAB 1985) (NEXIS printout of excerpted stories published in newspapers, magazines, etc. are admissible because excerpts identify their dates of publication and sources and since complete reports, whether through the same electronic library or at a public library, are available for verification), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

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

4. *See Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217-1218 (TTAB 2011) ("Certainly if these materials are in general circulation it was incumbent on plaintiff to show this in response to defendant's objection."); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (private promotional literature is not presumed to be publicly available within the meaning of the rule).

5. *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1466 (TTAB 2013) (magazine article explaining the results of a consumer brand awareness survey – yes), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009) (annual reports - no; opposer's file copies of financial reports submitted to SEC - no); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (foreign publications without a showing that publications are in general circulation in the United States - no; Spanish language publication shown to be in general circulation in the United States - yes; press clippings - no; distribution of in-house publications/catalogs and auction catalogs to retailers, trade shows, guitar clinics and individuals upon request does not constitute "general circulation"); *Hiraga v. Arena*, 90 USPQ2d 1102, 1104 (TTAB 2009) (invoices and annual catalog - no); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956-59 (TTAB 2008) (brochures, periodic newsletters, materials used in seminars and conferences showing topics of discussion, recently created marketing materials, materials used in radio ads and interviews, testimonials from customers in affidavit form - no); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886, n.6 (TTAB 2008) (letters and emails - no); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84

USPQ2d 1912, 1914 (TTAB 2007) (excerpt from wine atlas - yes; certificate awarded to defendant from Italian government - no; copy of disciplinary rules governing wine production in geographic area - no); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (annual reports, financial statements, advertising invoices and other advertising documents - no); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005) (opposer's newsletters and brochures - no); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 n.54 (TTAB 1999) (advertisements in newspapers or magazines available to the general public in libraries or in general circulation - yes), *rev'd*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 (TTAB 1998) (press releases, press clippings, studies prepared for a party, affidavits or declarations, or product information - no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 n.5 (TTAB 1992) (trademark search reports - no); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (annual reports - no); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (conference papers, dissertations, and journal papers - no); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (press releases--no); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (annual reports - no); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (annual report even if in some libraries, or available on request - no; magazine articles - yes); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (promotional literature - no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (promotional literature - no); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (catalogs and other house publications - no); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232, 234 (TTAB 1976) (annual reports, promotional brochures, price list, reprints of advertisements, and copies of advertising mats - no); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (telephone directory pages, indexes from United States Code Annotated, and dictionary pages - yes); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (annual reports - no); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (credit card applications, handouts, and flyers - no; articles from trade publications and other magazines - yes); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets, and product brochures - no); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.2 (TTAB 1973) (article from "Memoirs of the University of California" - no, since publication not shown to be available to the general public).

6. *See, e.g., Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1399 n.65 (TTAB 2016) (telephone directory listings themselves are not hearsay; while the Yellow Pages display advertisements may not be considered for the truth of the matters asserted therein, they do show on their face that the public may have been exposed to the advertisements); *City Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013) (testimony failed to expand the probative value of business brochure prepared by third-party; document is admissible solely for what it shows on its face and cannot be considered to prove the truth of any matter stated therein); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (noting that printed publications submitted in a foreign language without translations are of limited probative value); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2010) (truth of matters asserted in printed publications not considered; printed publications considered as showing continued consumer exposure of opposer's mark in connection with opposer's name), *aff'd on other grounds* , *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (2d Cir. March 7, 2013) (unpublished); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1037 n.14 (TTAB 2010); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009) (printed publications probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the

truth of such matters); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) (newspaper article probative only for what it shows on its face, not for the truth of the matters contained therein); *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles are not used to support the truth of the statements therein but to show descriptive usage of term); *Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 469 F.2d 1397, 176 USPQ 123, 123 (CCPA 1972) (advertisement from newspaper only showed promotion of the product on the day the publication issued); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report considered stipulated into evidence only for what it showed on its face), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.50 (TTAB 1999) (evidence of the manner in which the term is used in the articles and of the fact that the public has been exposed to the articles and may be aware of the information contained therein), *rev'd*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (magazine article limited to what it showed on its face); *Volkswagenwerk AG v. Ridewell Corp.*, 201 USPQ 410 (TTAB 1979) (advertisement submitted with notice of reliance only showed that advertisement appeared on that date in that journal and does not show customer familiarity with marks nor actual sales); *Food Producers, Inc. v. Swift & Co.*, 194 USPQ 299, 301 n.2 (TTAB 1977) (publications limited to their face value because no opportunity to ascertain basis for information or confront and cross-examine individuals responsible therefor); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (advertisements were only probative of fact that opposer advertised its goods under the mark in the publications on those dates); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (even if annual reports were admissible as printed publications, they would only be probative of fact that they are opposer's annual reports for the years shown thereon); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310, 312 n.4 (TTAB 1975) (magazine article showed only that the goods under the mark were the subject of the article in that publication); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (articles from trade publications admissible to show that they appeared in the publication on a certain date and that they contained certain information, but not that the information is true).

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

8. *See, e.g., Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual reports), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (copies of agreements, press releases, shipping documents and foreign registrations); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets and brochures).

9. *See, e.g., Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1108 n.14 (TTAB 2015) (because non-offering party treated sales history reports as being of record, Board construed exhibit as having been stipulated into the record by the parties); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.6 (TTAB 2008) (letters and emails considered as stipulated into the record because opposer treated materials as being of record, setting forth in its brief that such materials are part of the evidence of record); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007) (Internet evidence considered because party stipulated at deposition that it would not contest the authenticity of web pages and treated the evidence as being of record, stating in its brief that the Internet evidence is part of other party's evidence of record); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1266 (TTAB 2003) (documents construed

as being offered under 37 CFR § 2.122(e) and deemed to be of record despite lack of information as to source and date since applicant did not object to the materials and moreover treated them as of record; however, probative value of such materials necessarily limited due to lack of information as to source and date); (*Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (plaintiff did not object to introduction of curriculum vitae, advertising literature, printout of page from website by notice of reliance and treated materials as of record); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (opposer's improper subject matter considered where applicant expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (neither party objected to the annual reports submitted by the other party), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (matter improper for notice of reliance and for rebuttal considered); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (annual reports and responses to document production request considered); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (various documents constituting improper subject matter considered where no objection was raised and adverse party specifically addressed the materials in its brief); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely, but no objection or prejudice).

Cf. Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where adverse party, while not objecting to the improperly offered materials, did not treat the materials as being of record); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (improper subject matter excluded, although no objection).

10. 37 CFR § 2.126(a)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The amendment codifies the use of electronic filing."). *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (citing *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible … .")), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

704.08(b) Internet Materials

37 CFR § 2.122(e) ***Printed publications and official records.***

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

In *Safer, Inc. v. OMS Investments, Inc*, , 94 USPQ2d 1031 (TTAB 2010) ("*Safer* "), the Board changed its practice regarding Internet evidence, holding that if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with 37 C.F.R §2.122(e). [Note 1.] Effective January 14, 2017, the Board amended 37 CFR § 2.122(e) to add a new subsection (2) to codify the Board's decision in Safer. [Note 2.]

A document obtained from the Internet must be publicly available; that is, it must identify its date of publication or the date it was accessed and printed, and its source (URL). [Note 3.] As with traditional printed publications submitted by notice of reliance, the propounding party must indicate in the notice of reliance generally the relevance of those materials and associate the materials with one or more issues in the case. [Note 4.] *See* TBMP § 704.02 and TBMP § 704.08(a).

Internet documents that may be introduced by notice of reliance include websites, advertising, business publications, annual reports, and studies or reports prepared for or by a party or non-party, as long as they can be obtained through the Internet as publicly available documents. This expands the types of documents that can be introduced by notice of reliance beyond printed publications in general circulation, and means that some Internet documents, such as annual reports that are publicly available, can be made of record by notice of reliance when paper versions of the annual reports are not acceptable as printed publications.

The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face. However, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed. A printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight the Board will give website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. Otherwise, the document may not be considered to have much probative value.

The nonoffering party may verify the Internet document through the date and source information on the face of the document, and may rebut the probative value of the document by showing that there has been a significant change to the document as submitted by the offering party. Due to the transitory nature of the Internet, the party proffering information obtained from the Internet runs the risk that the website owner may change the information contained therein.

Internet search summaries, which essentially are links to the website pages, are not admissible by notice of reliance. [Note 5.]

The Board strongly discourages the submission of cumulative evidence. *See* TBMP § 702.05. The Board has specifically stated that "It is not necessary for the parties to introduce every document obtained from an Internet search especially when it includes duplicative and irrelevant materials." [Note 6.] Internet documents may be objectionable under Fed. R. Evid. 403 on the ground that they are "needlessly presenting cumulative evidence."

Internet printouts that are otherwise properly authenticated are acceptable to show that the statements contained therein were made or that information was reported, but not to prove the truth of the statements contained therein. [Note 7.]

NOTES:

1. *See, e.g., Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (objection to Internet printouts from petitioner's website showing the dates accessed and printed and URL information on the grounds that petitioner failed to authenticate the documents by testimony overruled), *aff'd*, 565 F. App'x. 900 (Fed. Cir. 2014) (mem.); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1604 n.4 (TTAB 2010) (excerpts from websites promoting the sale of books and software admitted into evidence pursuant to notice of reliance), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713, 1718 (Fed. Cir. 2012); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1216-19 (TTAB 2011) (detailed discussion of why certain documents, accompanied by adequate authentication, were admissible and why certain other documents,

lacking in specifically-addressed authentication elements, were not admissible); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (documents obtained from Internet admitted even though witness did not personally obtain or download documents).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016). *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) overruled the Board's holding in *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998), that Internet materials are not self-authenticating and are treated differently from articles taken from the LexisNexis database with respect to whether they may be submitted as official records.

3. 37 CFR § 2.122(e)(2) *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (Internet printouts personal to applicant such as invoices and account information not admissible through notice of reliance even if show URLs and dates printed; press releases posted on Internet have become publicly available, thus admissible under notice of reliance); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (notice of reliance failed to specify the relevance of the voluminous web pages submitted under two exhibits; defect is curable); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (objection to Internet printouts from petitioner's website showing the dates accessed and printed and URL information on the grounds that petitioner failed to authenticate the documents by testimony overruled), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (web pages inadmissible for lack of URL and date accessed); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1216-19 (TTAB 2011) (detailed discussion of why certain documents, accompanied by adequate authentication, were admissible and why certain other documents, lacking in specifically-addressed authentication elements, including absent URL's or dates accessed printed, were not admissible); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (applicant did not indicate the general relevance of opposer's archival website and such relevance is not clear on the face of the submissions, but applicant may rely on copy of opposer's website made of record by opposer).

4. 37 CFR § 2.122(g). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirements for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice.").

5. *See Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (search summary inadmissible because it merely offers links to information not otherwise of record); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1219 (TTAB 2011). *Cf. Miller v. Miller*, 105 USPQ2d 1615, 1617-18 (TTAB 2013) (search results summary introduced by testimony have probative weight to the extent the results include sufficient information surrounding the term searched to show context, that Miller is a surname, and have been supplemented by other testimony). *Cf. Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (results from search engine introduced by testimony admissible but of limited probative value because they lack sufficient context), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

6. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 n.19 (TTAB 2010). *See also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (relevant, representative

sample of articles obtained from Internet database sufficient and preferred; parties discouraged from submitting all results), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

7. *See, e.g., Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016) (statements made on website constitute hearsay and cannot be used to establish prior use); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (search engine results are only probative of what they show on their face, not for the truth of the matters contained therein), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012) (Internet printouts submitted as exhibits to testimony are not hearsay).

704.08(c) Other Printed Materials

Certain printed publications qualify for submission by notice of reliance under 37 CFR § 2.122(e) because they are considered essentially self-authenticating. [Note 1.] That is, permanent sources for the publications are identified and the nonoffering party is readily able to verify the authenticity of the documents. [Note 2.] The Board also deems a document obtained from the Internet that displays a date and its source as presumptively true and genuine. [Note 3.] Materials that do not fall within 37 CFR § 2.122(e), that is, materials that are not admissible by notice of reliance, may nevertheless be introduced into evidence through the testimony of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials. [Note 4.] Trade inscriptions applied to a product or packaging or other materials affixed in the course of business may be self-authenticating. [Note 5.] Even if properly made of record, however, such materials are only probative of what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. [Note 6.]

NOTES:

1. *See Swatch AG v. M. Z. Berger & Co.*, 108 USPQ2d 1463, 1466 (TTAB 2013) (applicant's objection to article from the magazine *Women's Wear Daily* overruled; periodicals are considered self-authenticating pursuant to Fed. R. Evid. 902(6) and may be admitted via notice of reliance), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 (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), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

2. *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

3. 37 CFR § 2.122(e) *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963-64 (October 7, 2016) ("The Office is adding new § 2.122(e)(2) permitting admission of internet materials into evidence by notice of reliance and providing requirements for their identification. The amendment codifies current case law and Office practice.") and *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

4. *See Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006) (excerpts taken from Internet websites sought to be introduced during testimony deposition not properly authenticated because witness was not aware of the parameters of the Internet search and was not able to name the individual who conducted the Internet search).

5. *See* Fed. R. Evid. 902(7); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1167-68 (TTAB 2011) (although deponent failed to authenticate exhibits made up of product packaging, they were found to be self-authenticating).

6. *See ShutEmDown Sports Inc. v. Lacy,* 102 USPQ2d 1036 (TTAB 2012) (hangtag by itself, without any testimony describing how it was used, merely demonstrates that the hangtag existed at some point in time; not that the mark was actually placed on goods or that goods bearing the hangtag were offered for sale in commerce); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1168 (TTAB 2011) (trade designations on materials of limited probative value because they do not establish they were actually used in commerce or the degree of consumer exposure); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217, 1220-21 n.14 (TTAB 2011) (plaintiff's own printed publications and printouts from plaintiff's webpage are not evidence of statements made therein); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (articles and advertisements considered for whatever they may show on their face, but not for the truth of the matters asserted); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.8 (TTAB 2006) (publications only admissible for what they show on their face); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006) (Lexis/Nexis articles submitted by notice of reliance to demonstrate merchandising activities of applicant and other third parties is inadmissible as hearsay); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005) (printed publications and news reports hearsay if offered to prove the truth of the statements made therein, but acceptable to show that the stories have been circulated to the public), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008); and *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (not evidence of use but may have some probative value to show the meaning of a mark in the same way as third-party registrations).

704.09 Discovery Depositions

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

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

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

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (k) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement*

that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * * *

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

* * * *

(6) *Paragraph (k) 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.*

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

(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or 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 in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

The discovery deposition *of a party* (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party) may be offered in evidence *by any adverse party*. [Note 1.]

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

(1) By stipulation of the parties, approved by the Board. [Note 2.]

(2) By order of the Board, on motion showing that the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The motion must be filed when the party makes its pretrial disclosures, unless the motion is based on a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion must be filed promptly after the circumstances claimed to justify use of the deposition became known. [Note 3.]

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

adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts. [Note 4.]

A discovery deposition that may be offered in evidence under 37 CFR § 2.120(k) may be made of record by filing, during the testimony period of the offering party, the deposition or any part thereof with any exhibit to the part that is filed, together with a notice of reliance. [Note 5.] The notice of reliance must indicate the general relevance of the discovery deposition or any part thereof and associate it with one or more issues in the case. [Note 6.] When only part of a deposition is relied on, the notice of reliance must specify the part or parts relied on. [Note 7.] In order to avoid creating an overly large record of irrelevant evidence, parties should, where appropriate, file only those portions of a discovery deposition transcript that are relevant to the pleaded claims, counterclaims, or affirmative defenses. [Note 8.] *See* TBMP § 702.05 (Overly Large Records).

When a discovery deposition has been made of record by one party in accordance with 37 CFR § 2.120(k), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 9.] If only part of a discovery deposition has been made of record pursuant to 37 CFR § 2.120(k), that part only may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. If one party has filed a notice of reliance on a discovery deposition or part thereof and an adverse party has based its presentation of evidence on the belief that the deposition or the part thereof is of record, the notice of reliance may not later be withdrawn. [Note 10.]

A discovery deposition not properly offered in evidence under 37 CFR § 2.120(k) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto, or treats the deposition as being of record, or improperly offers a discovery deposition in the same manner. [Note 11.] The failure to disclose or supplement an initial disclosure to identify a witness does not necessarily preclude the introduction of a discovery deposition of that witness at trial. [Note 12.] *See* TBMP § 408.03

Written disclosures, disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board except when submitted (1) with a motion relating to disclosure or discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. [Note 13.] *See* TBMP § 409.

Nothing in 37 CFR § 2.120(k) will be interpreted to preclude the reading or the use of a discovery deposition as part of the examination or cross-examination of any witness during the testimony period of any party. [Note 14.]

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

Please Note: Some of the cases cited in this section established principles later codified in former 37 CFR § 2.120(j) which was amended and redesignated as 37 C.F.R §2.120(k) effective January 14, 2017, or were decided under rules that were the predecessors to such provisions.

NOTES:

1. 37 CFR § 2.120(k)(1). *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1427 (TTAB 1993) (deponent was no longer an officer or director at time his deposition was taken);

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1325 (TTAB 1992) (same); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1630 n.5 (TTAB 1988) (only by adverse party); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (same); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980) (same); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 867 n.7 (TTAB 1979) (discovery deposition of non-party taken on written questions inadmissible); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977) (party who takes discovery deposition may place it into evidence).

2. 37 CFR § 2.120(k)(2). *See, e.g., Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1013 n.6 (TTAB 2015) (parties stipulated to allow excerpts of discovery deposition of a non-party to be entered into evidence), *aff'd mem.* 652 Fed.Appx 971 (Fed. Cir. 2016); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1425 n.21 (TTAB 2014) (discovery depositions of opposers' own officers submitted by parties' stipulation); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of non-party properly in evidence by stipulation of parties).

3. 37 CFR § 2.120(k)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(2) to change the time for a motion to use a discovery deposition to when the offering party makes its pretrial disclosures and to clarify that the exceptional circumstances standard applies when this deadline has passed."). *See also Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (motion granted to use discovery deposition of foreign resident not willing to appear voluntarily and whose attendance could not be compelled); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426–27 (TTAB 1993); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (no special circumstances shown by applicant to admit discovery deposition of applicant's president); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979) (mere speculation that non-party witness would be unavailable is insufficient); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691, 692 n.4 (TTAB 1978) (no special circumstances shown to admit discovery deposition of non-party).

4. 37 CFR § 2.120(k)(4). *See Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1352 n.13 (TTAB 2014) ("in the interests of fairness," Board considers additional excerpts of discovery deposition submitted by adverse party under notice of reliance), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1466 (TTAB 2013) (opposer's objections to applicant's offer in evidence of portions of the Fed. R. Civ. P. 30(b)(6) discovery depositions of applicant's own witnesses sustained as to those portions that constitute new testimony, overruled as to those portions that clarify witness' statements), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1671 (TTAB 2013) (petitioner's objection to respondent's "counter-designations" of portions of respondent's Fed. R. Civ. P. 30(b)(6) discovery deposition overruled); *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1190 (TTAB 2011) (adverse party provided the requisite written statement explaining why it needs to rely upon the additional excerpts), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013); *Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804, 1806 n.2 (TTAB 1990) (adverse party failed to show how portions submitted were misleading), *aff'd*, 17 USPQ2d 1866 (Fed. Cir. 1991); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988) (Board refused to consider pages of a deposition relied on by applicant in its brief since they were not relied on by opposer and not properly made of record by applicant and since opposer objected thereto); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1631, n.5 (TTAB 1988) (where applicant submitted entire deposition of its president in response to opposer's partial submission, without identifying specific relevant testimony, Board refused to consider additional portions);

Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445, 1447 n.6 (TTAB 1986) (pages of additional portions should be clearly marked); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (Board refused to consider additional exhibits since they did not serve to correct misimpression engendered by those of record); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980) (distinguishing mandatory filing of trial deposition in its entirety from discovery deposition where only the portion or portions which are properly introduced are of record); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977).

5. 37 CFR § 2.120(k)(3)(i). *See BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978) (mere presence of discovery responses in the file does not make them of record without a notice of reliance); *Galaxy Metal Gear Inc. v. Direct Access Tech.nology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647 (TTAB 1976); *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495, 496 n.2 (TTAB 1970) (discovery depositions not in evidence since notice of reliance not filed); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition inadmissible where it was timely filed but not accompanied by notice of reliance).

6. *See* 37 CFR § 2.120(g). Effective January 14, 2017, the Board added new subsection (g) to 37 CFR § 2.122 detailing the requirements for admission of evidence by notice of reliance. This amendment effectively overruled any prior case law stating that an offering party is not required to specify the general relevance of certain types of evidence submitted under notice of reliance such as discovery deposition excerpts and answers to interrogatories. *See also* 37 CFR § 2.120(k)(3)(i).

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

8. *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) ("[E]ach party has submitted discovery deposition transcripts in toto, i.e., has made no apparent effort to identify and introduce only those portions that are relevant to our determination of the pleaded claims. While not improper, it is more effective to file only those portions that are relevant and explain their relevancy in the notice of reliance") (citing *Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804, 1805 n.1 (TTAB 1990)) and *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1217 n.9 (TTAB 1988).

9. 37 CFR § 2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice."). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (objection based on failure to indicate relevance to applicant's notice of reliance introducing opposer's archival websites sustained, but applicant may rely on copy of opposer's website made of record by opposer's deposition); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (notice of reliance on deposition already made of record by the other party is superfluous); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 432 n.6 (TTAB 1985) (stipulation that deposition relied on by opposer may also be considered as part of applicant's case was unnecessary); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984); *Miles Laboratories, Inc. v. SmithKline Corp.*, 189 USPQ 290, 291 n.4 (TTAB 1975).

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

11. *See, e.g., Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 n.6 (TTAB 2008) (because the parties stipulated to the use of discovery depositions as evidence, because petitioner did not object to respondent's reliance on respondent's answers to petitioner's written discovery, and because the discovery responses were used as exhibits during depositions, Board considered the responses as having been properly made of record); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1737 n.11 (TTAB 1990) (no objection to applicant's introduction of discovery deposition of officer of opposer's parent corporation); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (deposition taken during discovery but treated by both parties as a testimonial deposition introduced by deposed party treated as trial deposition taken prior to testimony period pursuant to stipulation); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (deposition of non-party treated as stipulated into the record since adverse party did not object and referred to it as being of record in its brief); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.7 (TTAB 1982) (discovery deposition of non-party treated by both parties as properly of record); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (considered of record where although opposer did not file a notice of reliance on discovery depositions, both parties referred to the depositions in their briefs); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976) (plaintiff's notice of reliance filed during rebuttal testimony period improper where defendant introduced no evidence; but since defendant filed improper notice of reliance in response thereto and because neither party objected to the untimely evidence of the other and moreover addressed each other's evidence, all material was considered); *Insta-Foam Products, Inc. v. Instapak Corp.*, 189 USPQ 793, 795 n.4 (TTAB 1976) (discovery deposition of non-party deemed stipulated into the record where there was no objection and both parties relied on the deposition).

12. *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (failure to disclose non-party witness in initial disclosures or to supplement initial disclosures did not preclude introduction of discovery deposition at trial when deposition was adequately noticed, at least one of party's principals attended deposition and attorney cross-examined witness).

13. 37 CFR § 2.120(k)(8). *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.3 (TTAB 1999).

14. 37 CFR § 2.120(k)(6). *Cf. West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (party may testify as to veracity of information contained in interrogatory answers or use such answers to refresh memory of witness during testimony deposition).

704.10 Interrogatory Answers; Admissions

37 CFR § 2.120(k)

* * * *

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (j) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance*

and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * * *

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

(6) *Paragraph (k) 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.*

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

(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or 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 in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party. [Note 1.] See TBMP § 401 and TBMP § 704.14 for further information concerning disclosures.

However, if fewer than all of the answers to a set of interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce, under a notice of reliance, any other answers to interrogatories, or any other admissions that should be considered so as to avoid an unfair interpretation of the responses offered by the inquiring party. [Note 2.] The notice of reliance must be supported by a written statement explaining why the responding party needs to rely on each of the additional interrogatory answers, or admissions, listed in the responding party’s notice, failing which the Board, in its discretion, may refuse to consider the additional responses. [Note 3.]

An interrogatory answer (including documents provided as all or part of an interrogatory answer under Fed. R. Civ. P. 33), or an admission to a request for admission, [Note 4], that may be offered in evidence under 37 CFR § 2.120(k) may be made of record by notice of reliance during the testimony period of the offering party. The party should file a copy of the interrogatory and the answer thereto, with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with its notice of reliance thereon. [Note 5.]

The notice of reliance must indicate the general relevance of the interrogatory answer or admission (or any part thereof) and associate it with one or more issues in the case. [Note 6.] Interrogatory answers, or

admissions, may be admitted into evidence through the testimony of a witness as an alternative to the notice of reliance procedure. [Note 7.]

An interrogatory answer may also be made of record by stipulation of the parties, accompanied by a copy of the interrogatory and the answer thereto with any exhibit made part of the answer. Similarly, an admission may be made of record by stipulation of the parties, accompanied by a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). [Note 8.]

When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 CFR § 2.120(k), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 9.]

An interrogatory answer, or an admission, not properly offered in evidence under 37 CFR § 2.120(k) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the answer, or admission, as being of record; and/or improperly offers an interrogatory answer, or an admission, in the same manner. [Note 10.]

Written disclosures, disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board except when submitted (1) with a motion relating to disclosure or discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. [Note 11.] **Please Note:** Unlike documents that are provided as all or part of an interrogatory answer under Fed. R. Civ. P. 33, documents that are produced in response to a document request cannot be made of record under a notice of reliance unless they are otherwise eligible for submission under a notice of reliance, e.g., because they are printed publications or were provided in connection with a response to an interrogatory or unless they have been authenticated by an admission or stipulation from the producing party. [Note 12.] *See* TBMP § 704.08 and TBMP § 704.11

Nothing in 37 CFR § 2.120(k) precludes reading or using an interrogatory answer, or an admission, as part of the examination or cross-examination of any witness during the testimony period of any party. [Note 13.]

Denials to admission requests cannot be submitted under notice of reliance. [Note 14.] "[U]nlike an admission (or a failure to respond which constitutes an admission), 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. *Cf.* Fed. R. Civ. P. 36(b)." [Note 15.]

Although parties are obliged to supplement their discovery responses under Fed. R. Civ. P. 26(e)(1), supplemental discovery materials served upon an adversary during trial cannot be made of record unless such materials fall under an exception in 37 CFR § 2.120(k)(8). [Note 16.]

For information concerning the taking of discovery by way of interrogatories, see TBMP § 405. For information concerning the taking of discovery by way of requests for admission and for the effect of not responding to a request for admission, see TBMP § 407. For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP § 532 and TBMP § 707.02.

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

NOTES:

1. 37 CFR § 2.120(k)(5). *See Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1151 (TTAB 2016); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 (TTAB 2011) (defendant's responses to plaintiff's interrogatories and document requests, but not produced documents); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1015 n.7 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.8 (TTAB 1982); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981).

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

2. 37 CFR § 2.120(k)(5). *See Turdin v. Trilobite, Ltd.* , 109 USPQ2d 1473, 1476-77 (TTAB 2014) (concurrent-use defendant's objection to plaintiff's submission of initial answer to interrogatory with notice of reliance, on ground that answer did not include defendant's supplemental response, is overruled, since 37 CFR § 2.120(j)(5) provides in relevant part that inquiring party may make answer to interrogatory of record by notice of reliance, and that, if fewer than all answers to interrogatories are offered in evidence, responding party may introduce, under notice of reliance, any other answers to interrogatories which should in fairness be considered so as to render inquiring party's submission not misleading, and since defendant remedied any perceived unfairness by submitting supplemental answer and documents it produced under Fed. R. Civ. P. 33(d)); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988). *Cf. Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1218 (TTAB 2011) (plaintiff introduced its responses to defendant's interrogatories by notice of reliance which were considered only to the extent that defendant submitted the non-confidential portions of plaintiff's responses through its own notice of reliance).

3. 37 CFR § 2.120(k)(5). *See Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (additional interrogatory responses by answering party not considered because he did not include explanation as to why he needed to rely on each additional discovery response, and not obvious in what way they avoided any unfairness from what propounding party submitted); *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1128 n.4 (TTAB 1995) (notice of reliance on responses stricken since responses did not clarify answers relied on by inquiring party); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988) (TTAB 1988) (answering party is expected to select only the relevant answers and to inform the Board of the relationship of that answer to those offered by propounding party); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (other answers may be introduced to clarify, rebut or explain responses relied on by inquiring party; opposer failed to indicate the relevance of its interrogatory responses to rebut those relied on by applicant); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (broad statement by answering party that without the additional responses the selected responses would be misleading is insufficient); *Packaging Industries Group, Inc. v. Great American Marketing, Inc.*, 227 USPQ 734, 734

n.3 (TTAB 1985) (applicant did not introduce the additional responses referred to in its brief by notice of reliance); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981) (answering party may not simply rely on all remaining answers and expect Board to determine which, if any, answers require explanation or clarification); *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976).

4. *Cf. Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (denials of requests for admission not admissible; 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).

5. 37 CFR § 2.120(k)(3)(i). *See B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007) (catalog produced in lieu of interrogatory response can be made of record through notice of reliance on interrogatory response); *BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance must specify and be accompanied by the interrogatory to which each document was provided in lieu of an answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986) (documents provided in lieu of interrogatory answer admissible by notice of reliance); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (notice of reliance filed after close of testimony period untimely); *Bausch & Lomb Inc. v. Gentex Corp.*, 200 USPQ 117, 119 n.2 (TTAB 1978) (neither party filed notice of reliance on the other party's interrogatories and therefore not of record).

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

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

6. *See* 37 CFR § 2.120(g). On January 14, 2017, the Board added new subsection (g) to 37 CFR § 2.122 detailing the requirements for admission of evidence under notice of reliance, effectively overruling *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.* , 201 USPQ 881, 883 (TTAB 1979) (not required to set forth the relevance of interrogatory answers). *See also* 37 CFR § 2.120(k)(3)(i)

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

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

9. 37 CFR § 2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of

Evidence. The amendments codify current Office practice."). *See also Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on matter already made of record by opposer is superfluous); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (objection based on failure to indicate relevance to applicant's notice of reliance sustained, but applicant may rely on copy of record by opposer' deposition); *Henry Siegel Co. v. M & R International Manufacturing Co.*, 4 USPQ2d 1154, 1155 n.5 (TTAB 1987); *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976) (where party relies on all of adversary's answers to interrogatories, the adversary need not file its own notice of reliance thereon).

10. *See, e.g., L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1435 n.3 (TTAB 2012) (opposer did not object to applicant's improper introduction of applicant's responses to interrogatories and requests for admission but instead treated as matter as being of record); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 n.6 (TTAB 2008) (because the parties stipulated to the use of discovery depositions as evidence, petitioner did not object to respondent's reliance on respondent's answers to petitioner's written discovery, and the discovery responses were used as exhibits during depositions, respondent's discovery responses considered as having been properly made of record); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (no objection to party's reliance on its own answers and moreover the responses set forth facts which were described in the parties' stipulation); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988) (no objection to responding party's notice of reliance on remaining answers and such answers were deemed as explanatory or clarifying); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987) (no objection to party's reliance on its own answers); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (objection which was raised for first time in brief waived since defect of failing to explain why the additional responses were necessary could have been cured); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.4 (TTAB 1979) (no objection to untimely notice of reliance or to failure to submit copies of the discovery requests or responses thereto); *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025, 1027 n.1 (TTAB 1979) (no objection by either party to the other's improper reliance on its own answers; opposer did not object to interrogatories introduced by applicant and in fact referred to answers to other of opposer's interrogatories without benefit of notice of reliance); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (discovery depositions filed without a notice of reliance were treated as being of record where both parties referred to the depositions in their briefs and in view of stipulations concerning marking of exhibits in the depositions); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978) (both parties relied on answers given by each to the other's interrogatories without objection); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977) (same); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976) (neither party objected to improper notice of reliance by the other and each relied on the contents of the other's notice of reliance); *Plus Products v. Sterling Food Co.*, 188 USPQ 586, 587 n.2 (TTAB 1975) (applicant did not file required notice of reliance on opposer's answers but both parties referred to the answers in their briefs).

Cf. Hiraga v. Arena, 90 USPQ2d 1102, 1106 (TTAB 2009) (additional interrogatory answers not considered because non-offering party timely objected and never treated interrogatory answers as being of record).

11. 37 CFR § 2.120(k)(8).

12. 37 CFR § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents produced by another party of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party

that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party.”).

13. 37 CFR § 2.120(k)(6). *See West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (use of interrogatory answers to refresh memory of witness and testifying as to veracity of interrogatory answers permitted). *Cf. Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169-70 (TTAB 1984) (reading answers into record when witness was present at deposition inadmissible because no written copy given to refresh witness’s memory), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

14. 37 CFR § 2.120(k)(3)(i) *See, e.g., Ayoub, Inc. v. ACS Ayoub Carpet Services*, 118 USPQ2d 1392, 1395 n.9 (TTAB 2016); *N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1501 n.11 (TTAB 2015) (Board considered only opposer’s admissions, not denials, in response to applicant’s requests for admission); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1477 (TTAB 2014) (concurrent use defendant’s objection to submission of denial to admission request sustained; “rule does not extend to denials”); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 (TTAB 2008) (denials to requests for admission inadmissible).

15. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008).

16. *Joel Gott Wines LLC v. Rehobeth Von Gott, Inc.*, 107 USPQ2d 1424, 1427-28 (TTAB 2013) (“It is true that Fed. R. Civ. P. 26(e)(1) charges parties with a duty to supplement their discovery responses. But this does not make whatever supplemental material is produced of record in the case.”).

704.11 Produced Documents

37 CFR § 2.122(e) ***Printed publications and official records.***

(1) *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 in a particular 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 in accordance with paragraph (g) of this section. The notice of reliance 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 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.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

37 CFR § 2.120(k)(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) or the party has obtained an admission or stipulation from the producing party that authenticates the documents.*

Documents provided as all or part of an answer to an interrogatory under Fed. R. Civ. P. 33 may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR § 2.120(k)(3)(i) and 37 CFR § 2.120(k)(5). [Note 1.] *See* TBMP § 704.10

However, a party that has obtained documents from another party through disclosure or under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR § 2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding; or Internet documents); or unless the documents have been authenticated by an admission or stipulation from the producing party. [Note 2.] *See* TBMP § 704.07 and TBMP § 704.08.

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

(1) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may serve on its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under 37 CFR § 2.120(k)(3)(i), on the requests for admission, the exhibits thereto, and its adversary's admissions (or a statement that its adversary failed to respond to the requests for admission). [Note 3.] However, if a party wishes to have an opportunity to serve requests for admission after obtaining documents under Fed. R. Civ. P. 34, it must serve its request for production of documents early in the discovery period, so that when it obtains the produced documents, it will have time to prepare and serve requests for admission prior to the expiration of the discovery period. [Note 4.] For information regarding the need for early initiation of discovery, see TBMP § 403.05(a) and TBMP § 403.05(b).

(2) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may offer them as exhibits in connection with the taking of its adversary's discovery deposition. With regard to Fed. R. Civ. P. 34 documents, however, the request for production of documents must be served early in the discovery period, so that there will still be time remaining, after the requested documents have been produced, to notice and take a discovery deposition. *See* TBMP § 403.05.

(3) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may introduce them as exhibits during the cross-examination of its adversary's witness. [Note 5.] This method is available only if the adversary takes testimony and the documents pertain to matters within the scope of the direct examination of the witness.

(4) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may, during its own testimony period, take the testimony of its adversary as an adverse witness and introduce the obtained documents as exhibits during direct examination. [Note 6.]

(5) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may, during its own testimony period, make of record by notice of reliance, under 37 CFR § 2.122(e), any of the documents that fall into the category of "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue" and Internet materials. [Note 7.] *See also* TBMP § 704.07 and TBMP § 704.08.

(6) A party that wishes to obtain documents under Fed. R. Civ. P. 34 may combine its request for production of documents with a notice of taking discovery deposition, and ask that the requested documents be produced at the deposition. However, the combined request for production and notice of deposition must be served well before the date set for the deposition, because a discovery deposition must be both noticed and taken before the close of the discovery period, and because Fed. R. Civ. P. 34(b) allows a party 30 days in which to respond to a request for production of documents. *See* TBMP § 403.05.

(7) Documents obtained through disclosure or under Fed. R. Civ. P. 34 may be made of record by stipulation of the parties. [Note 8.]

(8) Documents obtained through disclosure or by request for production of documents under Fed. R. Civ. P. 34, and improperly offered in evidence, may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the documents as being of record; and/or in the same manner improperly offers documents which it obtained under Fed. R. Civ. P. 34. [Note 9.]

For information on initial disclosures and on obtaining discovery by way of a request for production of documents, see TBMP § 401.02 and TBMP § 406.

If no documents exist which are responsive to a document request, a party's response that no documents exist may be made of record. [Note 10.]

NOTES:

1. *See Mini Melts, Inc. v. Reckitt Benckiser LLCI*, 118 USPQ2d 1464, 1467 (TTAB 2016) (Board considered documents otherwise inadmissible under notice of reliance where admissions submitted regarding their authenticity); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476-77 (TTAB 2014) (Board considered documents responsive to interrogatory under Fed. R. Civ. P. 33(d) submitted under notice of reliance); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103-1104 (TTAB 2007) (because respondent produced documents in responding to petitioner's interrogatories and admitted in responses to requests for admissions that the documents it produced were true and correct copies of authentic documents, documents are admissible by way of a notice of reliance); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance failed to indicate that documents were being introduced under 37 CFR § 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447-48 (TTAB 1986).

2. 37 CFR § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party."). *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1477 (TTAB 2014) (evidence submitted concurrently with concurrent use applicant's rebuttal disclosures not considered); *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1932 n.7 (TTAB 2013) (documents produced in response to a request for production of documents may not be introduced under notice of reliance); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 at n.8 (TTAB 2012) (produced documents cannot be introduced by notice of reliance alone); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011) (produced documents not considered because not admissible under notice of reliance); *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.5 (TTAB 2008); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.5 (TTAB 1985) (documents were neither official records nor printed publications); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (documents were not printed publications).

3. 37 CFR § 2.120(k)(3)(i). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents produced by another party of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party.").

4. 37 CFR § 2.120(a)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("Under the amended rules, discovery must be served early enough in the discovery period that responses will be provided and all discovery will be complete by the close of discovery. This includes production of documents, which have to be produced or inspected by the close of discovery.").

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

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

7. 37 CFR § 2.122(e); 37 CFR § 2.120(k)(3)(ii); *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

8. 37 CFR § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party.").

9. *See, e.g., Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (improper subject of notice of reliance but no objection raised); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978) (neither party objected to other's offering of Fed. R. Civ. P. 34 documents by notice alone); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 569 n.1 (TTAB 1977) (applicant did not object to documents produced and introduced by notice alone and referred to those documents in its brief); *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976) (no objection to notice of reliance). *Cf. Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.8 (TTAB 1985).

Cf. Association pour la Defense et la Promotion de l'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk, 82 USPQ2d 1838, 1841 (TTAB 2007) (Board did not consider at final decision evidence stricken by the Board in an earlier order as improperly filed, such evidence consisting of petitioner's interrogatory responses and labels produced by petitioner, even though petitioner did not object to submission of this evidence by respondent).

10. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 n.8 (TTAB 2011); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011);

Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi, 99 USPQ2d 1545, 1547-48 n.5 (TTAB 2011); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 n.5 (TTAB 2008).

See also Lebanon Seaboard Corp. v. R&R Turf Supply Inc., 101 USPQ2d 1826, 1829 (TTAB 2012) (document responses consisting of objections and/or representations that the documents would be produced treated as of record).

704.12 Judicial Notice

37 CFR § 2.122(a) ***Applicable rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

Fed. R. Evid. 201. Judicial Notice of Adjudicative Facts.

(a) ***Scope*** *. This rule governs judicial notice of an adjudicative fact only, not a legislative fact.*

(b) ***Kinds of Facts That May Be Judicially Noticed*** *. The court may judicially notice a fact that is not subject to reasonable dispute because it:*

(1) *is generally known within the trial court's territorial jurisdiction; or*

(2) *can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.*

(c) ***Taking Notice*** *. The court:*

(1) *may take judicial notice on its own; or*

(2) *must take judicial notice if a party requests it and the court is supplied with the necessary information.*

(d) ***Timing*** *. The court may take judicial notice at any stage of the proceeding.*

(e) ***Opportunity to Be Heard*** *. On timely request, a party is entitled to be heard on the propriety of taking judicial notice and the nature of the fact to be noticed. If the court takes judicial notice before notifying a party, the party, on request, is still entitled to be heard.*

(f) ***Instructing the Jury*** *. In a civil case, the court must instruct the jury to accept the noticed fact as conclusive. In a criminal case, the court must instruct the jury that it may or may not accept the noticed fact as conclusive.*

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

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

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

For examples of decisions concerning whether particular facts are appropriate subject matter for judicial notice by the Board, *see* cases cited in the note below. [Note 2.] *See also* TBMP § 1208.04 for additional cases.

NOTES:

1. Fed. R. Evid. 201(b); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999). *See, e.g., Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999); *Omega SA v. Compucorp*, 229 USPQ 191, 194 (TTAB 1985); *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 235 (TTAB 1977).

Please Note: The Federal Circuit, in *In re Chippendales USA, Inc.* , 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party's registrations. Although the court took judicial notice of a third-party registration in that case, the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding. *See* 37 CFR § 2.122(d) and 37 CFR § 2.122(e). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (October 7, 2016) (Board considered but rejected suggestion of taking judicial notice of USPTO records, explaining various reasons introduction of information contained in USPTO trademark file records is most appropriately borne by the party seeking to introduce the evidence).

2. *In re Morinaga Nyuguo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016) (locations of Puyallup, Washington and Mount Rainer-yes); In re Jimmy Moore LLC, 119 USPQ2d 1764, 1767-68 (TTAB 2016) (patent excerpt, and definitions from Wikipedia, definitions from commercial websites that do not constitute dictionary definitions, and excerpts for which the source of the materials was not identified - no); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-68 (TTAB 2016) (patent excerpt, and definitions from Wikipedia, definitions from commercial websites that do not constitute dictionary definitions, and excerpts for which the source of the materials was not identified - no); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1029 (TTAB 2015) (applicant's photographs of a person from which its marks were allegedly derived – no); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1098 n.114 (TTAB 2014) (census data – yes), *aff'd* 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *on appeal* , No. 15-1874 (4th Cir. Aug. 6, 2015); *UMG Recordings Inc. v. Matte, Inc.*, 100 USPQ2d 1868, 1874, 1879 n.12 (TTAB 2011) (dictionary definition - yes; web pages from websites - no); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011) (information from encyclopedias-yes), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1075 n.17 (TTAB 2011) (dictionary definitions- yes); *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1542 n.9 (TTAB 2009) (phrase with a possible industry specific-meaning and where the parties have not set forth and addressed a single, definable meaning - no); *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) (registration issuing from pleaded application after applicant's trial brief had been filed, although copy of application was of record -- no); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009) (definitions from an online source which does not indicate it is the electronic version of a printed reference work but are consistent with definitions in "a more traditional reference source" - yes); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (online reference works which exist in printed format or have regular fixed editions -- yes); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1723 (TTAB 2008) (items of outerwear and undergarments are related - no); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (the licensing of commercial trademarks on "collateral products" has become a part of everyday life - yes); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (third-party registrations mentioned in trial brief - no); *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192

n.9 (TTAB 2007) (current status of registration owned by party properly made of record, when status of registration changed between time made of record and time case decided - yes; Office assignment records reflecting current ownership - yes); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007) (number of applications and registrations in applicant's name - no); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378, 1379 n.7 (TTAB 2006) (dictionary definitions – yes; "scholarly reviews" of an essay at several websites - no); *Motion Picture Association of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (results from Internet search engines and from eBay website - no); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006) (third-party website materials - no); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (dictionary definition of term as trademark - yes, indicates mark is reasonably famous; also, encyclopedias may be consulted); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (home cold permanent wave kits have for many years been sold directly to nonprofessional consumers through retail outlets - yes); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (statements regarding race relations pleaded in the complaint - no); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (there are thousands of registered marks incorporating the term NEW YORK for goods and services that do not originate there - no) *aff'd* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982) (dictionary definitions - yes), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (online dictionary definition where resource was also available in book form - yes); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works -- yes); *In re 3Com Corp.*, 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (dictionary definitions and technical reference works, e.g., computer dictionary - yes); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) (dictionary definitions judicially noticed although not made of record by either party); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (on-line dictionaries which otherwise do not exist in printed format - no); *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1998) ("Physicians' Desk Reference" - yes); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1704 (TTAB 1998) ("U.S." means the United States, which is a geographic area with defined boundaries - yes); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) (third-party registrations - no); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 n.6 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C. - yes); *Los Angeles Bonaventure Co. v. Bonaventure Associates*, 4 USPQ2d 1882, 1884 (TTAB 1987) (whether other companies have expanded from restaurant services to hotel services under a single mark, and, if so, when - no); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (files of applications and/or registrations, where no copies thereof are filed, and where they are not the subject of the proceeding - no); *Omega SA v. Compucorp*, 229 USPQ 191, 192 n.6 (TTAB 1985) (presumptions concerning the significance in trade of certain terms - no); *Hertz System, Inc. v. A-Drive Corp.*, 222 USPQ 625, 630 n.14 (TTAB 1984) (the numeral "1" is widely used to indicate superiority - yes); *Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 USPQ 802, 804 n.5 (TTAB 1982) (probation report -- no); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (use of antimicrobial agents in the floor covering industry - no); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981) (dictionary definitions - yes); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980) (standard reference works - yes); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 (TTAB 1978) (third-party registrations and listings in trade directories, where no copies thereof are submitted - no); *Plus Products v. Sterling Food Co.*, 188 USPQ 586, 589 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products - yes); *Bristol-Myers Co. v. Texize Chemicals, Inc.*, 168 USPQ 670, 671 (TTAB 1971) (operations of opposer and applicant - no).

704.12(b) When Taken

The Board will take judicial notice of a relevant fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), if a party (1) requests that the Board do so, and (2) supplies the necessary information. [Note 1.] The request should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information. [Note 2.] The Board, in its discretion, may take judicial notice of a fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), whether or not it is requested to do so. [Note 3.]

NOTES:

1. Fed. R. Evid. 201(c). *See United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 235 (TTAB 1977); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 433 (TTAB 1976).

2. *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 434 (TTAB 1976). *See also Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 770 n.5 (TTAB 1985); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980).

3. Fed. R. Evid. 201(c). *See In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (Board takes judicial notice of dictionary definitions); *Boswell v. Mavety Media Group Ltd,*, 52 USPQ2d 1600, 1603 (TTAB 1999) (declined to take judicial notice of slang dictionary definition when submitted as part of rebuttal testimony when could have been submitted with case in chief); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982) (Board takes judicial notice of dictionary definitions), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 235 (TTAB 1977); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 433 (TTAB 1976).

704.12(c) Opportunity to be Heard

A party to a proceeding before the Board is entitled, on timely request, "to be heard on the propriety of taking judicial notice and the nature of the fact to be noticed. If the court takes judicial notice before notifying a party, the party, on request, is still entitled to be heard." [Note 1.] This does not mean, however, that when judicial notice is taken without prior notification, a party is automatically entitled to a hearing on request, even if it makes no offer to show that the taking of judicial notice was improper. [Note 2.]

NOTES:

1. Fed. R. Evid. 201(e). *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 433-34 (TTAB 1976).

2. *See In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 n.6 (Fed. Cir. 1983). *See also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (party can waive right to contest judicial notice if it does not request to be heard at the time), *aff'g* 204 USPQ 396 (TTAB 1979).

704.12(d) Time of Taking Notice

Judicial notice may be taken at any stage of a Board proceeding, even on review of the Board's decision on appeal. [Note 1.] However, the Federal Circuit may decline to consider a request for judicial notice made at the late stage of oral argument on appeal. [Note 2.]

NOTES:

1. *See, e.g.*, Fed. R. Evid. 201(d); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (request for judicial notice as to fame of mark made in the briefs on appeal); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (judicial notice of banking business on appeal); *American Security Bank v. American Security and Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 n.1 (CCPA 1978) (judicial notice of absence of listing in local telephone directories); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd* on other grounds, 558 F.2d 1019, 194 USPQ 419, 422 n.5 (CCPA 1977) (fact of common knowledge, e.g., of purchasers and channels of trade for home permanent wave kits, appropriate for judicial notice); *Food Specialty Co. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136, 139 n.3 (CCPA 1973) (judicial notice on appeal of general sentiment towards kittens which differs from that toward other small animal pets); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999) (judicial notice may be taken at any time).

2. *See Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (Court declined to consider whether to take judicial notice of fame where request for judicial notice was made for first time at oral argument on appeal).

704.13 Testimony From Another Proceeding

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

On motion granted by the Board, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or their privies, may be used in a pending Board inter partes proceeding, to the extent that the testimony is relevant and material, subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." [Note 1.]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony, [Note 2] or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding. The purpose of the rule is to offer a party a means for introducing testimony from a prior proceeding without having to call a witness to authenticate the testimony, thereby allowing a party a relatively quick and simple means by which to introduce testimony from another proceeding into evidence. It is not intended as specifying the only means by which oral or written statements from another proceeding can be introduced at trial in a Board proceeding. [Note 3.]

Testimony from another proceeding between the parties or their privies may be used, on motion granted by the Board, as evidence in connection with a motion for summary judgment, or as evidence at trial. [Note

4.] However, when the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken on recall of the same witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, on motion granted by the Board, during the appropriate trial period. *See* TBMP § 528.05(a) and TBMP § 528.05(f).

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

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

NOTES:

1. 37 CFR § 2.122(f). *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992) (stating that there is no prerequisite that the Board must have considered the testimony or determined the relevancy in the prior opposition, or that the adverse party actually attended the deposition when originally taken); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061, 1063 n.2 (TTAB 1988) (motion to use testimony from prior district court proceeding granted as uncontested and right to recall the witness waived since no request to do so was made), *rev'd on other grounds*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57, 58 (TTAB 1975) (motion to rely on testimony from prior cancellation proceeding between the parties granted, subject to applicant's right to recall witnesses), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973).

2. *See Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1035 n.8 (TTAB 2010) (the term "testimony," as used in Trademark Rule 2.122(f), has been construed to mean only trial testimony, or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding); *Marcon Ltd. v. Avon Products Inc.*, 4 USPQ2d 1474, 1475 n.3 (TTAB 1987) (discovery deposition from previous proceeding to which applicant was not a party would not be admissible under this rule, but in this case, it was made of record by another means); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 182 (TTAB 1986) (*cf.* dissent at 182 n.13 contending that discovery deposition should have been admitted as admission against interest).

3. *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1035 (TTAB 2010).

4. *See, e.g., Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1467 n.4 (TTAB 2016) (motions for leave to use testimony and evidence introduced in a civil action granted as uncontested); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061, 1063 n.2 (TTAB 1988) (evidence on the case); *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57, 58 (TTAB 1975) (summary judgment evidence).

704.14 Initial Disclosures and Disclosed Documents

37 CFR § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission or written disclosure.***

(3)(i) *A discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (k) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written*

initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party that files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

(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), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.*

* * * *

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

(6) *Paragraph (k) 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.*

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

(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or 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 in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

A written initial disclosure which may be offered in evidence under 37 CFR § 2.120(k)(3)(i) may be made of record by filing a copy of the written disclosure with a notice of reliance. [Note 1.] The notice of reliance and the material submitted should be filed during the testimony period of the party that files the notice of reliance. [Note 2.]

Disclosed documents, if provided in lieu of descriptions of documents, may be introduced at trial by a notice of reliance but only if otherwise appropriate for such filing pursuant to 37 CFR § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents. [Note 3.] *See* TBMP § 704.07 and TBMP § 704.08. In essence, initial written disclosures and initial disclosures of documents will be treated like responses to written discovery requests. [Note 4.]

Written disclosures may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must comply with the

requirements set forth in 37 CFR § 2.122(g) and also be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement the Board, in its discretion, may refuse to consider the additional written disclosures or responses. [Note 5.]

The Board will not interpret 37 CFR § 2.120(k) to preclude the reading or use of written disclosures or documents as part of the examination or cross-examination of any witness during the testimony period of any party. [Note 6.]

When a written disclosure or a part thereof has been made of record by one party in accordance with the provisions of 37 CFR § 2.120(k)(3), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 7.]

Written disclosures or disclosed documents 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 8.]

Please Note: Effective January 14, 2017, former subsection (j) of 37 CFR § 2.120 was amended and redesignated as 37 C.F.R §2.120(k).

NOTES:

1. 37 CFR § 2.120(k)(3)(i). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(i) to clarify that the disclosures referenced are initial disclosures, to remove the exclusion of disclosed documents, and to incorporate a reference to new § 2.122(g)."); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008); *Syngenta Crop Protection, Inc. v. Bio-Chek*, LLC, 90 USPQ2d 1112, 1117 (TTAB 2005).

2. 37 CFR § 2.120(k)(3)(i).

3. 37 CFR § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party.").

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See Kairos Institute. of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

5. 37 CFR § 2.120(k)(5). *See* 37 C.F.R §2.122(g) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirement for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."),

6. 37 CFR § 2.120(k)(6).

7. 37 CFR §2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice.").

8. 37 CFR § 2.120(k)(8). *See Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1542 n.3 (TTAB 2008).

705 Stipulated Evidence and Accelerated Case Resolution (ACR)

37 CFR § 2.127(e)(2). If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence. The parties may even stipulate to the entire trial record. [Note 1.] The use of stipulated evidence normally results in savings of time and expense for all concerned. Notwithstanding such a stipulation, a party may reserve the right to object to stipulated evidence on the grounds of competency, relevance, and materiality. [Note 2.] However, if a party has not reserved the right to object, the party may not later raise objections to that evidence once it has stipulated to the admissibility of that evidence. [Note 3.]

For example, parties may stipulate that a party may rely on specified responses to requests for discovery, or on other specified documents or exhibits; or what a particular witness would testify to if called; or to the facts in the case of any party; or that a discovery deposition may be used as testimony; or that evidence from another proceeding may be used as evidence in the proceeding in which the stipulation is filed. [Note 4.] Parties may also stipulate that materials submitted with summary judgment briefs be considered at trial as evidence which may be supplemented as additional evidence during trial. [Note 5.] See TBMP § 704.07 – TBMP § 704.11 for a discussion of various types of evidence, and TBMP § 703.01(b) regarding the testimony of witnesses.

In certain cases where the parties have entered into certain stipulations, the Board may allow the parties to participate in Accelerated Case Resolution (ACR). *See* TBMP § 528.05(a)(2) and TBMP § 702.04 . Generally, parties will stipulate to ACR during the pleading or discovery phase of a Board inter partes proceeding to obtain a pretrial final disposition on the merits in lieu of summary judgment or to have an abbreviated trial on the merits. However, parties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule. Parties seeking to avail themselves of such efficiencies may stipulate to, for example, abbreviating the length of the testimony period; limiting the subject matter for testimony; agreeing to limit the number of witnesses; or agreeing to streamline the method of introduction of evidence, for example, by stipulating to facts. [Note 6.] *See also* TBMP § 528.05(a)(2) and TBMP § 702.04 for further information about ACR.

NOTES:

1. *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entire record in the case including business records, public records, government documents, marketing materials,

materials obtained from the Internet, and 13 paragraphs of facts involving such issues as applicant's dates of first use and the extent and manner in which a designation is used and advertised, the channels of trade for such use, and recognition by third parties of such use; and the dates, nature and extent of descriptive uses of designation by opposer's parent company).

2. *See Blackhorse v. Pro-Football Inc.*, 111 USPQ2d 1080, 1084-85 (TTAB 2014) (parties stipulated that the record of a prior proceeding may be submitted into evidence under notice of reliance, reserving the right to object based on relevance), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *on appeal*, No. 15-1874 (4th Cir. Aug. 6, 2015); *UMG Recordings Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1875 (TTAB 2011) (stipulated evidence subject to objection); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).

3. *See Blackhorse v. Pro-Football Inc.*, 111 USPQ2d 1080, 1088 (TTAB 2014) (petitioner estopped from objection to certain evidence on any basis except relevance because it falls within the parties' stipulation), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *on appeal*, No. 15-1874 (4th Cir. Aug. 6, 2015); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating affidavit and exhibits thereto into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013). *Cf. UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1875 (TTAB 2011) (counterproductive for applicant to object to the submission of evidence to which it already provided a stipulation for introduction).

4. *See* 37 CFR § 2.123(b). *See, e.g.*, *N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1500 (TTAB 2015) (parties stipulated that witness testimony would be submitted solely by declaration and without cross-examination); *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence, and allowed option to opt out); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 (TTAB 2014) (ACR on cross-motions for summary judgment stipulated to likelihood of confusion limited issue to priority); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1950 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated and remanded on other grounds*, *Princeton Vanguard , LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Miller v. Miller*, 105 USPQ2d 1615, 1617 n.6 (TTAB 2013) (parties stipulated to testimony by affidavit and provided a stipulation of undisputed facts); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1435 n.2 (TTAB 2012) (parties stipulated to testimony by declaration); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (parties stipulated to submission of testimony via declaration, submission by notice of reliance of evidence from another case, and submission of information and documents provided by either party during discovery); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (with specified exceptions, parties stipulated that all evidence submitted in a previous case by notice of reliance shall be admissible in instant proceeding by a notice of reliance); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (parties stipulated to authenticity of produced documents and to the introduction of testimony in affidavit or declaration form, with certain guidelines), *on appeal*, No. 11-3684 (D.N.J. June 2016); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1915 (TTAB 2011) (parties stipulated to authenticity of produced documents).

5. 37 CFR § 2.127(e)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016) ("The Office is amending § 2.127(e)(2) to add that if a motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial. The revision codifies an approach used by parties in proceedings incorporating ACR-type efficiencies at trial.").

6. *See Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1561 (TTAB 2014) (parties' stipulation provided for the admission into evidence of specific dated expert reports and accompanying exhibits and an expert discovery deposition transcript); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1426 (TTAB 2014) (stipulation to submission of witness declarations and discovery depositions, the authenticity of certain documents, retail prices of opposers' goods, the fact that advertisements and news articles refer to opposers, and press clippings are representative of the media in which opposers advertise); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. January 15, 2016); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of certain produced documents and waiver of objections based on authenticity or hearsay as to those documents); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement included stipulation of undisputed facts); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts); *Brooks v. Creative Arts by Calloway, LLC*, 93 USPQ2d 1823, 1824 (TTAB 2009) (parties stipulated to 14 paragraphs of facts, submission of testimony of certain witnesses in declaration form, and that sole issue to be decided at final hearing was priority), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to 13 paragraphs of facts); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial). *Cf. UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (efficiencies realized by stipulations defeated by submission of excessive records).

706 Noncomplying Evidence

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

Evidence not obtained and filed in compliance with the rules of practice governing inter partes proceedings before the Board will not be considered by the Board. [Note 1.]

Please Note: Effective January 14, 2017, former subsection (l) of 37 CFR § 2.123 was amended and redesignated as 37 CFR § 2.123(k).

NOTES:

1. 37 CFR § 2.123(k). *See Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654 (TTAB 2014) (evidence submitted on flash drive stricken from record, parties may not by agreement override 37 CFR §

2.126 provisions prescribing form of submission), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. January 15, 2016); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (materials submitted outside of applicant's assigned testimony period and which failed to comply with the Board's evidentiary rules given no consideration); *The Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 (TTAB 1986) (collection of twenty-nine registrations listed in appendix to brief not considered because not in compliance with rules of practice); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (stating that a party may not reasonably presume evidence is of record when that evidence is not offered in accordance with the rules); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to main brief and not otherwise properly made of record was not considered); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976) (evidence submitted for first time with brief not considered); *Plus Products v. General Mills, Inc.*, 188 USPQ 520, 521 n.1 (TTAB 1975) (evidence submitted after filing of reply brief not considered); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition timely filed but not accompanied by notice of reliance not considered).

707 Objections to Evidence

707.01 In General

37 CFR § 2.122(a) ***Applicable Rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations). [Note 1.] A party to a Board inter partes proceeding that believes that proffered evidence should, under these rules, be excluded from consideration, may raise an objection. The procedure for raising an objection to proffered evidence depends on the nature of the evidence and the ground for objection.

As a general proposition, where ordinarily inadmissible hearsay evidence is admitted into evidence without objection, it may be considered for whatever probative value the finder of fact chooses to give it. [Note 2.] When parties specifically agree to waive hearsay objections, the Board may rely on the evidence for the truth of the matter asserted. [Note 3.]

NOTES:

1. 37 CFR § 2.122(a).

2. *See e.g., Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146 (TTAB 2016); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746 n.9 (TTAB 1987); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1582 n.4 (TTAB 1987).

3. *Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146 (TTAB 2016); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1086 (TTAB 2014), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *on appeal*, No. 15-1874 (4th Cir. Aug. 6, 2015).

707.02 Objections to Notices of Reliance

707.02(a) In General

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. *See generally* TBMP § 702 and TBMP § 704. 37 CFR § 2.120(k)(3)(i), provides for the introduction, by notice of reliance, of a discovery deposition, an answer to an interrogatory, an admission to a request for admission, or written initial disclosure; but 37 CFR § 2.120(k)(3)(ii)specifically states that documents obtained through disclosure or by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents. 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. 37 CFR § 2.122(e) provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. *Cf.* TBMP § 101.01 and TBMP § 101.02. *See also* TBMP § 704.03(b) and TBMP § 704.07-TBMP § 704.11 discussing introduction of other types of evidence by notice of reliance.

Some grounds for objection to a notice of reliance are waived unless promptly made (generally errors of any kind which might be obviated or cured if promptly presented) while other grounds that cannot be cured may be raised at any time. The various grounds for objection to a notice of reliance, and the time and procedure for raising them, are discussed in the sections that follow. *See also* TBMP § 707.04.

707.02(b) On Procedural Grounds

Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike if the defect is one that can be cured. [Note 1.] However, if the ground for the objection is one that could not be cured even if raised promptly, the adverse party may wait and raise the procedural objection in or with its brief on the case or in an appendix or separate statement of objections attached to the brief. [Note 2.] If the objection which is one that could have been cured promptly, and was not timely raised, the objection is deemed to be waived. [Note 3.]

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

NOTES:

1. *See, e.g.*, 37 C.F.R §2.122(g) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirement for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (objection waived where respondent received notice of reliance without referenced publications appended thereto but did not raise the issue until briefing); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201

USPQ 881, 883 (TTAB 1979) (objection that notice of reliance did not set forth relevance of appended documents raised for first time in brief waived).

2. Effective January 14, 2017, 37 C.F.R §2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 81 Fed. Reg. 69950, 69967 (October 7, 2016). *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief, were not untimely and paper did not result in violation of page limitation for final briefs).

3. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013) (petitioner's objection to respondent's submission via notice of reliance of a business brochure prepared by a third party overruled; "[a]ny shortcomings in respondent's original submission … under notice of reliance, such as its failure to identify the URL and when the document was actually accessed (either printed out or downloaded), are procedural deficiencies that were not timely raised by petitioner and thus have been waived); *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1093 (TTAB 2012) (objection that relevance of evidence not identified waived where raised for first time with brief because procedural deficiency could have been cured if objection had been raised seasonably); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291-92 (TTAB 1986) (defect of failing to append copy of printed publication identified in notice of reliance could have been cured); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (petitioner's objection that respondent's justification for reliance on its own discovery responses was insufficient raised for first time in petitioner's brief was untimely since defect is one which could have been cured if raised promptly); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (objection that items submitted by notice of reliance were neither official records nor printed publications raised in brief sustained); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 655 n.9 (TTAB 1976) (objection to notice of reliance as to statement of relevance of third-party registrations untimely); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (objection that notice of reliance failed to indicate relevance of materials was curable and should have been raised when notice was filed).

707.02(b)(1) On Ground of Untimeliness

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted thereunder), in its entirety, as untimely. [Note 1.] Alternatively, an adverse party may raise this ground for objection in its brief on the case or in an appendix or separate statement of objections attached to the brief. [Note 2.]

NOTES:

1. *See, e.g., Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1902 (TTAB 2006) (motion to strike supplemental notice of reliance as having been filed outside testimony period granted); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (motion to strike untimely supplemental notice of reliance to admit current status and title copy of registration in place of timely but older status and title copy granted); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (motion

to strike untimely notice of reliance on interrogatory answers and certified copies of corporate records filed with the state granted).

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

707.02(b)(2) On Other Procedural Grounds

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 CFR § 2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, or does not indicate the general relevance and associate the proffered materials with one or more issues in the case in accordance with 37 CFR § 2.122(g) [Note 1], or the proffered materials are not appropriate for introduction by notice of reliance. [Note 2.]

When, on a motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the relying party time to cure the defect, failing which the notice will stand stricken. [Note 3.]

If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), the Board will defer determination of the motion until final hearing. [Note 4.] When determination of a motion to strike a notice of reliance is deferred until final hearing, the parties should argue the matter alternatively in their briefs on the case.

Please Note: Some of the cases cited in this section involve former subsection (j) of 37 CFR § 2.120 which was amended and redesignated as 337 C.F.R §2.120(k) effective January 14, 2017.

NOTES:

1. *See, e.g., FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (notice of reliance failed to sufficiently indicate the relevance of the material being offered by not specifying the relevance of the voluminous web pages submitted under two exhibits); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (motion to strike granted where notice of reliance was filed under inapplicable provision of rules in that items did not constitute discovery materials admissible under 37 CFR § 2.120(j)(3) and opposer failed to explain relevance of appended copy of notice of opposition from a different case); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance failed to indicate that documents were being introduced under 37 CFR § 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (motion to strike notice of reliance granted where opposer failed to indicate how its own answers clarified, rebutted or explained those relied on by applicant); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 951 (TTAB 1981) (motion to strike notice of reliance granted in part where applicant failed to identify

specific answers sought to be introduced by answering party or indicate how they explained, clarified or rebutted answers relied on by inquiring party); *Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478, 479 (TTAB 1975) (applicant's objection to opposer's notice of reliance on letters between applicant and attorneys for third party well taken because such documents were not printed publications or official records and were not properly identified during deposition so as to lay foundation for introduction into evidence); *Rogers Corp. v. Fields Plastics & Chemicals, Inc.*, 172 USPQ 377, 378-79 (TTAB 1972) (motion to strike notice of reliance on entire remainder of deposition granted); *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 124 (TTAB 1971) (motion to strike items in applicant's notice of reliance stricken as they were either duplicative of evidence already made of record, not deemed to be printed publications in general circulation, or, in view of the purpose stated by applicant in the notice of reliance, hearsay).

2. *See, e.g., Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printed publications that include advertisements for party's goods and services are not disqualified as proper subject matter for notice of reliance because they contain advertisements); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance). *See also United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (evaluation of various documents submitted under notice of reliance).

3. 37 CFR § 2.122(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("To alleviate any uncertainty, this final rule adds a paragraph to the requirements for a notice of reliance, specifically, to require that the notice indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the rule explicitly states any failure of a notice of reliance to meet this requirement will be considered a curable procedural defect. This codifies the holding of *FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 USPQ2d 1234, 1237 (TTAB 2014)."). *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (motion to strike exhibits under notice of reliance granted with leave to cure); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (allowed 20 days to submit substitute notice of reliance remedying defects including submission of proper official record); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (allowed time to clarify that the documents submitted by notice of reliance were in fact produced in response to interrogatories rather than in response to document requests); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (documents remained stricken where party did not correct deficiencies).

4. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (motion to strike unpleaded registration deferred as admissibility depends on purpose for which it was submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (under the circumstances, whether documents were properly admissible under 37 CFR § 2.120(j)(3)(i) and/or 2.120(j)(3)(ii) deferred).

707.02(c) On Substantive Grounds

An adverse party may object to a notice of reliance on substantive grounds, such as that evidence offered under the notice constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial. Objections of this nature normally should be raised in or with the objecting party's brief on the case or in an appendix or separate statement of objections attached to the brief [Note 1.], rather than by motion to strike, unless the ground for objection is one that could be cured if raised promptly by motion to strike. [Note 2.] *Cf.* TBMP § 707.02(b)(2) and TBMP § 707.03(c). This is because it is the policy of the Board

not to read trial testimony or examine other trial evidence prior to final deliberations in the proceeding. *See* TBMP § 502.01. If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing. [Note 3.]

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing. [Note 4.] *Cf.* TBMP § 707.03(c).

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

NOTES:

1. Effective January 14, 2017, 37 C.F.R §2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016). *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753-54 (TTAB 2013) (appropriate evidentiary objections may be raised in appendix or separate submission rather than in text of brief.), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2013) (mem.); *Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief, were not untimely and paper did not result in violation of page limitation for final briefs).

2. *See* 37 CFR § 2.123(j) and 37 CFR § 2.128(b); Fed. R. Civ. P. 32(d)(3)(A).

3. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (motion to strike unpleaded registration deferred as admissibility depends on purpose for which it was submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (whether notice of reliance sought to introduce improper rebuttal evidence deferred); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (whether documents submitted by notice of reliance were properly authenticated and whether they constituted hearsay deferred).

4. *See, e.g., Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (timely notice of reliance on four-year-old status and title copy of pleaded registration was not stricken); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (copies of USPTO drawings are official records and therefore not stricken; however, their probative value is limited); *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) ("Certificate of Good Standing" from a U.S. district court is admissible as an official record and therefore not stricken; however its probative value determined at final hearing). *See also McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1274 (TTAB 2014) (where parties moved to strike evidence Board noted objections and took them into consideration allocating the appropriate weight to the evidence).

707.03 Objections to Trial Testimony

707.03(a) In General

As in the case of an objection to a notice of reliance, an objection to a testimony must be raised promptly if the defect is one that can be obviated or removed, failing which it is deemed waived. [Note 1.] Parties are discouraged from filing objections that are not outcome-determinative or that do not have an effect on either their own or their adversary's position. [Note 2.] The objections, which are waived unless promptly raised, are basically procedural in nature. Objections to trial testimony are not waived for failure to make them during or before the taking of the deposition, provided that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections are basically substantive in nature. The grounds for objection to trial testimony and the procedures for raising them are discussed below.

NOTES:

1. *See, e.g., Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (objections to portions of depositions on written questions deemed waived), *aff'd*, 112 F. Supp.3d 383 (E.D. Va. 2015).

2. *See, e.g., UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1875-77 (despite stipulations, opposer filed 25 pages of objections and applicant filed 100 pages of objections, essentially subverting the steps taken to streamline the process and burdening the Board; Board further set out specific objections as examples of what it overruled); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1501 (TTAB 2005) ("At the oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. … The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior.").

707.03(b) On Procedural Grounds

707.03(b)(1) On Ground of Untimeliness

A party may not take a testimony deposition or submit a testimony affidavit or declaration outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board. [Note 1.] *See* TBMP § 701.

When there is no such approved stipulation, granted motion or Board order, and a testimony deposition is taken or testimony is submitted by declaration or affidavit after the close of the deposing or offering party's testimony period, an adverse party may file a motion to strike the testimony, in its entirety, as untimely. *See* TBMP § 533.01. Alternatively, an adverse party may raise this ground for objection in its brief on the case or in an appendix or separate statement of objections attached to the brief. [Note 2.] See TBMP § 801.03. *Cf.* TBMP § 707.02(b)(1).

On the other hand, when a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, or affidavit or declaration testimony is submitted prior to the opening of the submitting party's testimony period, an adverse party that fails to promptly object to the testimony on the ground of untimeliness may be found to have waived this ground for objection, because the premature

scheduling or submission of testimony is an error which can be corrected on seasonable objection. [Note 3.]

NOTES:

1. 37 CFR § 2.121(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(a) to clarify that evidence must be presented during a party's testimony period. … These amendments codify current Office practice.").

2. 37 CFR § 2.128(b). Effective January 14, 2017, 37 CFR § 2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016).

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

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

37 CFR § 2.123(c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. Upon motion for good cause by any party, or upon its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).*

* * * *

(e)(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

Before testimony depositions on oral examination may be taken by a party, the party must give every adverse party due notice in writing of the time when and place where the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be deposed. [Note 1.] *See* TBMP § 703.01(e).

When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. [Note 2.] The Board may extend the periods for electing and taking oral cross-examination and, when necessary, will suspend or reschedule the proceeding to allow the parties to orderly complete oral cross-examination(s) that cannot be completed within a testimony period. [Note 3.] *See* TBMP § 703.01(e).

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as it does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. [Note 4.] *See* TBMP § 533.02.

A motion to strike testimony for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. [Note 5.]

For further information concerning motions to strike testimony for improper or inadequate notice, see TBMP § 533.02.

NOTES:

1. 37 CFR § 2.123(c). *Cf.* Fed. R. Civ. P. 30(b)(1).

2. 37 CFR § 2.123(c). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is further amending § 2.123(c) to add that, when a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election..")

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is further amending § 2.123(c) to add that the Board may extend the periods for electing and taking oral cross-examination and, when necessary, shall suspend or reschedule proceedings in the matter to allow for the orderly completion of oral cross-examination(s) that cannot be completed within a testimony period.").

4. 37 CFR § 2.123(e)(3). *See Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (while respondent's objection to notice was raised at the deposition, respondent failed to preserve the objection by moving to strike testimony promptly thereafter).

5. 37 CFR § 2.123(e)(3).

707.03(b)(3) On Ground of Failure to Disclose

37 CFR § 2.121(e) However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. … If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. … When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. A party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike …

37 CFR § 2.123(e)(3) If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e). …*

A party may object to improper or inadequate pretrial disclosures and may move to strike the testimony of a witness for lack of proper pretrial disclosure. [Note 1.]

If pretrial disclosures or the notice of examination of witnesses served pursuant to 37 CFR § 2.123(c) are improper or inadequate with respect to any witness, an adverse party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. [Note 2.] The adverse party may also cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, must move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. [Note 3.] A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with 37 CFR § 2.121(e). [Note 4.]

When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike. [Note 5.]

Failure to assert an objection in a timely manner may result in the objection being waived. [Note 6.]

NOTES:

1. 37 CFR § 2.121(e) and 37 CFR § 2.123(e)(3). *See also* 37 CFR § 2.118; *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1628 (TTAB 2014) (expert witness testimony stricken after party failed to timely identify and disclose the witness), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and remanded* 819 F.3d 697 (4th Cir. 2016); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (testimony stricken because identity of witness not disclosed prior to trial).

2.37 CFR § 2.121(e). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The amendment codifies current Office practice.").

3. 37 CFR § 2.123(e)(3).

4. 37 CFR § 2.121(e) and 37 CFR § 2.123(e)(3)(i). *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1299 (TTAB 2015) (motion to strike the entirety of respondent's testimony deposition on the basis that pretrial disclosures were untimely because sent to an incorrect address and attention of attorney no longer employed at the law firm granted in part and denied in part); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (failure to disclose testimony witness in initial disclosures considered as a relevant circumstance in determining whether to strike testimony deposition.). *Cf. Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526 (TTAB 2015) (motion to substitute expert witness and report granted, where prior disclosed witness unavailable).

5. 37 CFR § 2.121(e). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that when testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike…").

6. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not renewed in main brief and raised for first time in rebuttal brief), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.).

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

37 CFR § 2.123(e)(3) If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

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

* * * *

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

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

Fed. R. Civ. P. 32(d) Waiver of Objections.

(1) ***To the Notice.*** *An objection to an error or irregularity in a deposition notice is waived unless promptly served in writing on the party giving the notice.*

(2) ***To the Officer's Qualification.*** *An objection based on disqualification of the officer before whom a deposition is to be taken is waived if not made:*

(A) *before the deposition begins; or*

(B) *promptly after the basis for disqualification becomes known or, with reasonable diligence, could have been known.*

(3) **To the Taking of the Deposition.**

(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.*

(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.*

(C) ***Objection to a Written Question.*** *An objection to the form of a written question under Rule 31 is waived if not served in writing on the party submitting the question within the time for serving responsive questions or, if the question is a recross question, within 7 days after being served with it.*

(4) **To Completing and Returning the Deposition.** *An objection to how the officer transcribed the testimony — or prepared, signed, certified, sealed, endorsed, sent, or otherwise dealt with the deposition — is waived unless a motion to suppress is made promptly after the error or irregularity becomes known or, with reasonable diligence, could have been known.*

An adverse party may object to testimony not only on the grounds of untimeliness, *see* TBMP § 707.03(b)(1), but also on the ground that the party taking the testimony has not complied with one or more of the procedural requirements specified in the rules governing the particular type of testimony in Board inter partes proceedings.

In the case of testimony depositions, a party may also object on the grounds of improper or inadequate notice, see TBMP § 707.03(b)(2). In addition, objection may be made to a testimony on one or more substantive grounds, such as that the witness is incompetent to testify, or that the testimony is irrelevant or constitutes hearsay or improper rebuttal. The time and procedure for raising these objections is described below.

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

(1) Objections to errors and irregularities in the notice for taking a deposition (waived unless written objection is promptly served on the party giving the notice, in the case of an objection based on improper or inadequate notice, waived unless the provisions of 37 CFR § 2.123(e)(3) are followed), *see* TBMP § 707.03(b)(2);

(2) Objections to taking a deposition because of disqualification of the officer before whom the deposition is to be taken (waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence);

(3) Objections based on errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties;

(4) Objections regarding the signing of testimonial deposition transcripts; [Note 1]; and

(5) Errors of any kind that might be obviated, removed, or cured if promptly presented (waived unless seasonable objection thereto is made at the taking of the deposition). [Note 2.] Moreover, notice will not be taken of merely formal or technical objections, unless they were timely raised, and appear to have caused substantial injury to the party raising them. [Note 3.] This applies not only to errors and irregularities in the taking of a deposition, but also in the form of a deposition transcript (such as, improperly numbered pages or questions, improperly marked exhibits, etc.). [Note 4.]

Other objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, provided that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections, which are basically substantive in nature, [Note 5] include objections:

(1) to the competency of a witness, or

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

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

When an objection of this type could not have been obviated or removed if presented at the deposition, the Board will consider it even if the objection is raised for the first time in or with [Note 6] a party's brief on the case. [Note 7.]

Substantive objections to testimony that is, objections going to such matters as the competency of a witness, or the competency, relevance, or materiality of testimony, or the asserted hearsay or improper rebuttal nature of the testimony, are not considered by the Board prior to final hearing. [Note 8.] *Cf.* TBMP § 707.02(c). This is because testimony is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to deliberations on the final decision. *See* TBMP § 502.01. Further, testimony regularly taken in accordance with the applicable rules ordinarily will not be stricken on the basis of a substantive objection; rather, any such objection (unless

waived) will be considered by the Board in its evaluation of the probative value of the testimony at final hearing. [Note 9.] *Cf.* TBMP § 707.02(c).

Similarly, if the propriety of a procedural objection to a testimony deposition (such as an objection to the form of a question) cannot be determined without reading the deposition, or examining other trial evidence, it generally will not be considered by the Board until final hearing. [Note 10.] *Cf.* TBMP § 707.02(b)(2).

For the foregoing reasons, the objections described in this section (as opposed to the objection to testimony as late-taken, which may be raised by motion to strike--*see* TBMP § 533.01 and TBMP § 707.03(b)(1)--and the objection based on improper or inadequate notice of the taking of an oral deposition, which is the subject of the motion to strike procedure described in 37 CFR § 2.123(e)(3), and TBMP § 533.02 and TBMP § 707.03(b)(2)), generally should not be raised by motion to strike. Rather, objections should simply be made in writing at the time specified in the rules cited above, or orally "on the record" at the taking of the deposition, as appropriate. These objections, if properly asserted and not waived or rendered moot, normally will be considered by the Board in its determination of the case at final hearing. [Note 11.] *Cf.* TBMP § 707.02(c).

Additionally, in order to preserve an objection that was seasonably raised during the taking of a testimony deposition, a party should maintain the objection in its brief on the case, as an appendix to its brief on the case or in a separate statement of objections filed with its brief on the case. [Note 12.] *See* TBMP § 707.04. However, parties are discouraged from filing objections that are not outcome-determinative or that are duplicative of issues previously raised via a motion to strike. [Note 13.] If a party advances numerous objections during each testimonial deposition and then renews the objections in a general manner in its brief, the Board may find the general objections insufficient to preserve the individual objections originally made during the testimonial depositions. [Note 14.]

Objections may be made to testimony presented by affidavit or declarations for any reason which would require the exclusion of the evidence from consideration. [Note 15.] As with testimony depositions, objections to the competency of a witness or to the competency, relevancy, or materiality of affidavit or declaration testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. [Note 16.] Such objections may not be considered until final hearing. [Note 17.]

When a deposition is taken on written questions pursuant to 37 CFR § 2.124, written objections to questions (that is, the direct questions, cross questions, redirect questions, and recross questions) may be served on the party propounding the subject questions. A party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party. [Note 18.] *See* TBMP § 703.02(g). Objections to questions and answers in depositions on written questions generally are considered by the Board (unless waived) at final hearing. [Note 19.] *See* TBMP § 703.02(k).

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

Please Note: Some of the cases cited in this section established principles later codified in the cited provisions in former 37 CFR § 2.123(i), now 37 CFR § 2.123(j), or were decided under rules which were the predecessors to such provisions.

NOTES:

1. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009) (objection that deposition transcripts were not signed waived by failing to timely raise objection – basis for objection could have been cured if objection was raised when the evidence was offered).

2. *See* 37 CFR § 2.123(e)(3) and 37 CFR § 2.123(i); Fed. R. Civ. P. 32(d)(1), Fed. R. Civ. P. 32(d)(2), Fed. R. Civ. P. 32(d)(3)(A), and Fed. R. Civ. P. 32(d)(3)(B). *See also Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070-71 (TTAB 2011) (objection concerning authentication made in brief but not in testimonial deposition procedural in nature and not timely raised; but same exhibits from Internet submitted under notice of reliance authenticated, and even if not submitted under notice of reliance, are admissible as long as witness testifies to general relevance and it is possible to determine the source and date of retrieval); *Hornby v. TJX Cos.*, 87 USPQ2d 1411, 1417 (TTAB 2008) (objection regarding authentication of testimonial deposition exhibits made in brief but not in testimonial deposition itself overruled); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1271 n.4 (TTAB 1999) (objection raised for the first time in brief to manner in which testimonial depositions were filed, waived since purported defect could have been cured if promptly raised); *Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389, 391 (TTAB 1985) (foundation objections to a survey submitted by opposer raised for the first time in brief waived); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (objection on grounds of improper identification or authentication of exhibits waived since defects could have been cured if made during the deposition).

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

3. *See* 37 CFR § 2.123(i). *See also, e.g., Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (regarding technical deficiencies in marking exhibits). *See also* Fed. R. Civ. P. 61 and, with respect to notices of reliance, *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1292 n.1 (TTAB 1986) (noting precept of Fed. R. Civ. P. 61, Board stated that plaintiff's failure to serve notice of reliance was not fatal per se to the notice of reliance).

4. *See* Fed. R. Civ. P. 61; 37 CFR § 2.123(g). *See, e.g., Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (Board will consider objection regarding improper authentication of documents in deposition, but ruling depends on facts of the case); *Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (improperly marked exhibits considered); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Board has discretion to consider improperly marked exhibits).

5. *See* 37 CFR § 2.123(j); Fed. R. Civ. P. 32(d)(3)(A); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003) (objection to the failure of opposer to provide applicant with the notes to which the witness was referring during his testimony was considered substantive, not procedural in nature); *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 769 n.4 (TTAB 1985) (objection that testimony is immaterial because it is outside scope of pleading is not waived).

6. 37 CFR § 2.128(b). Effective January 14, 2017, 37 CFR § 2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016). *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753-54 (TTAB 2013) (appropriate evidentiary objections may be raised in appendix or separate submission rather than in text of brief.), aff'd, 565 F. App'x 900 (Fed. Cir.

2013) (mem.) *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief, were not untimely and paper did not result in violation of page limitation for final briefs).

7. *See Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1579 (TTAB 2015) (based on the witness' status as CFO and personal knowledge of the records, objection based on lack of personal knowledge under Fed. R. Evid. 602 overruled; Board need not exclude evidence for danger of unfair prejudice under Fed. R. Evid. 403); *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674-75 (TTAB 2013) (objection sustained to testimony prior to witness' employment with respondent pursuant to Federal Rule of Evidence 602); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012) (objection sustained because deponents statements regarding information they received from third parties during telephone conversations was inadmissible hearsay); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (objection sustained because purported statements made by employees of retail websites to deponent, and handwritten notes taken by deponent of such statements, are hearsay).

Cf. Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845, 847 (TTAB 1984) (objection on ground of hearsay with no foundation for establishing an exception waived since defect could have been cured if objection was raised during the deposition).

8. *See, e.g., Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (Board considers substantive objections in evaluating probative value of testimony at final hearing); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy and materiality deferred); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 307 n.1 (TTAB 1979) (objections to relevance and materiality of exhibits offered at a deposition deferred); *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPQ 44, 47-48 (TTAB 1978) (objection on hearsay grounds or that witness offered opinion testimony without adequate foundation deferred); *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as lacking foundation deferred).

9. *See Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014) ("the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing."); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (Board considers substantive objections in evaluating probative value of testimony at final hearing). *See also Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1325 (TTAB 1992); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (TTAB 1979); *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPQ 44 (TTAB 1978); *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469 (TTAB 1973).

10. *See, e.g., Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as based on leading questions deferred).

11. *See* 37 CFR § 2.123(j).

12. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not

renewed in main brief and raised for first time in rebuttal brief), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1273 n.4 (TTAB 2009) (objection to testimony raised in deposition may be maintained in appendix to brief or by separate statement of objections), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1718 n.25 (TTAB 2007) (objection to deposition exhibit waived because not renewed in trial brief); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (objection to testimony waived when not renewed in brief); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (objection raised at trial waived when petitioner waited until its reply brief to renew objections); *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1785 (TTAB 2006) (objection that witness was not a trademark expert not maintained in brief and thus waived); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005), (objection made in deposition but not renewed in brief deemed waived), rev'd on other grounds, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615 (TTAB 1981); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections in its brief and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 587 n.3 (TTAB 1977).

13. *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("At the oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. … The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior.").

14. *See Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1747 (TTAB 2006) (sweeping allegations in brief insufficient to preserve individual objections originally made in testimonial deposition).

15. 37 CFR § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing.").

16. 37 CFR § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing.").

17. 37 CFR § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing.").

18. *See* 37 CFR § 2.124(d)(1).

19. . *See, e.g., Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (objections to portions of depositions on written questions deemed waived), aff'd, 112 F. Supp.3d 383 (E.D. Va. 2015).

707.03(d) Refusal to Answer Deposition Question

When an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. However, a witness may properly refuse to answer a question asking for information that is, for example, privileged, trade secret or otherwise protected from disclosure by the protective order in place for the case. *See* TBMP § 404.09.

If a deposition is being taken pursuant to a subpoena, issued pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, and a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by the unwieldy process of adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. *See* TBMP § 404.09.

There is no mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. *See* TBMP § 404.08 and TBMP § 707.03(c). Accordingly, where the witness in a testimony deposition refuses to answer a particular question, no court action is sought, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony. [Note 1.]

For information concerning a refusal to answer a discovery deposition question, see TBMP § 404.03(a)(2) regarding deposition of non-party residing in the United States, TBMP § 404.08(c) (Objections During Deposition), TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions), TBMP § 411 (Remedy for Failure to Provide Disclosures or Discovery), and TBMP § 523 (Motion to Compel Disclosures or Discovery).

NOTES:

1. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983) (no error in drawing adverse inference where witnesses inappropriately refused to answer relevant questions), *aff'g*, 213 USPQ 594 (TTAB 1982); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer's objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer's position); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982); *Data Packaging Corp. v. Morning*

Star, Inc., 212 USPQ 109, 114 n.5 (TTAB 1981); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615, 622 n.7 (TTAB 1981); *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499, 499 (TTAB 1969); *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953). *Cf. Land v. Regan*, 342 F.2d 92, 144 USPQ 661, 668-69 (CCPA 1965).

707.04 Waiver of Objection

A party may waive an objection to evidence by failing to raise the objection at the appropriate time. [Note 1.] *See* TBMP § 707.02 and TBMP § 707.03.

For example, an objection to a notice of reliance on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted generally should be raised promptly. If a party fails to raise an objection of this nature promptly, the objection may be deemed waived, unless the ground for objection is one that could not have been cured even if raised promptly. *See* TBMP § 707.02(b)(1) and TBMP § 707.02(b)(2).

Similarly, an objection to a testimony deposition on the ground that it does not comply with the applicable procedural rules generally is waived if not raised promptly, unless the ground for objection is one which could not have been cured even if raised promptly. *See* TBMP § 707.03(b)(1) and TBMP § 707.03(c).

On the other hand, objections to a notice of reliance, or to testimony, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly. [Note 2.] *See* TBMP § 707.02(c) and TBMP § 707.03(c).

Objections may be made to testimony presented by affidavit or declaration for any reason which would require the exclusion of the evidence from consideration. [Note 3.] As with testimony depositions, objections to the competency of a witness or to the competency, relevancy, or materiality of affidavit or declaration testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. [Note 4.] Such objections may not be considered until final hearing. [Note 5.]

If a party fails to attend a testimony deposition, any objection, which is waived if not made at the deposition, is waived. [Note 6.]

Additionally, by failing to preserve the objection in its brief on the case, or in an appendix to the brief on the case or in a separate statement of objections filed with the brief on the case, a party may waive an objection that was seasonably raised at trial. [Note 7.] *See* TBMP § 707.03(c). However, parties are discouraged from filing objections that are not outcome-determinative or that are duplicative of issues previously raised via a motion to strike. [Note 8.]

NOTES:

1. *See* 37 CFR § 2.123(e)(3), 37 CFR § 2.123(i), and 37 CFR § 2.123(j); and Fed. R. Civ. P. 32(d)(1), Fed. R. Civ. P. 32(d)(2), Fed. R. Civ. P. 32(d)(3)(A), and Fed. R. Civ. P. 32(d)(3)(B). *See, e.g., Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603, n.3 (TTAB 2010), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

2. *See Hornby v. TJX Companies*, 87 USPQ2d 1411, 1417 (TTAB 2008) (objection regarding authentication of testimonial deposition exhibits made in brief but not in testimonial deposition itself overruled – offering party did not have opportunity to provide authentication testimony in testimonial deposition).

3. 37 CFR § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing.").

4. 37 CFR § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing.").

5. 37 CFR § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing.").

6. *See* NOTICE OF FINAL RULEMAKING, 48 Fed. Reg. 23122, 23132 (May 23, 1983); *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 770 (TTAB 1985); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984).

7. *See UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 n.3 (TTAB 2015) (various objections asserted during testimony, including that certain documents introduced at trial were not produced during discovery, which were not maintained in brief were deemed waived); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 n.7 (TTAB 2011) (objection to testimony deemed waived because it was not maintained in brief) *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1273 n.4 (TTAB 2009) (objection to testimony raised in deposition may be maintained in appendix to brief or by separate statement of objections), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1718 n.25 (TTAB 2007) (objection to deposition exhibit waived because not renewed in trial brief); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (objection to testimony waived when not renewed in brief); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (objections raised at trial waived when petitioner waited until its reply brief to renew objections); *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1785 (TTAB 2006) (objection that witness was not a trademark expert not maintained in brief and thus waived); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005) (objection made in deposition but not renewed in brief deemed waived), rev'd on other grounds, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and

competency deemed waived where applicant did not repeat the objections and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 587 n.3 (TTAB 1977).

8. *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("At the oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. … The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior.").