CHAPTER 700 INTRODUCTION OF EVIDENCE

701 Time of Trial

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

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

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

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

37 CFR §2.121 Assignment of times for taking testimony.
(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

(2) The initial trial order will be mailed by the Board after issue is joined.

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

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

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

When a defendant's answer to a complaint is received by the Board, the Board prepares and mails to the parties a trial order setting the closing date of the discovery period, and assigning each party's time for taking testimony and introducing other evidence. *See* 37 CFR §§2.120(a), 2.121(a)(1), and 2.121(a)(2), and TBMP §403.01. Specifically, the Board schedules a 30-day testimony period for the plaintiff to present its case in chief, a 30-day testimony period for the defendant to present its case and to meet the case of the plaintiff, and a 15-day testimony period for the plaintiff to present rebuttal evidence. *See* 37 CFR §§2.121(b)(1) and 2.121(c). The plaintiff's period for presenting its case in chief is scheduled to open 30 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. *See Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 356 (TTAB 1978), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982).

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 and from each other by 30-day intervals. *See* 37 CFR §§2.121(b)(2) and 2.121(c); *Jan Bell Marketing Inc. v. Centennial Jewelers Inc.*, 19 USPQ2d 1636 (TTAB 1990) (example of a trial order, including a briefing schedule, in an opposition with a counterclaim); TBMP §1007 (example of a trial order, including a briefing schedule, in an interference proceeding); and TBMP §1108 (examples of trial orders, including briefing schedules, in concurrent use proceedings). 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. *See* 37 CFR §§2.96 and 2.99(e), and TBMP §§1005 and 1007.

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. *See* 37 CFR §2.121(a)(1). *See also M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747 (TTAB 1986); and *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

Testimony periods may be rescheduled, extended, or reopened by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. *See* 37 CFR §§2.121(a)(1) and 2.121(c); FRCP 6(b); and TBMP §§501 and 509. It is preferable, where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion. *See* TBMP §509.02.

The resetting of the closing date for discovery results in the automatic rescheduling of the testimony periods, without action by any party. However, the resetting of a party's time to respond to an outstanding request for discovery does not result in the automatic rescheduling of the discovery and/or testimony periods. When a party's time to respond to an outstanding request for discovery is reset, the discovery and/or testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. *See* 37 CFR §2.121(a)(1).

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In Board inter partes proceedings, the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period. *See* TBMP §504.01, and authorities cited therein. *Cf.* TBMP §528.02.

702 Manner of Trial

Because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts. *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988), and *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976). *Cf.* TBMP §§102.03 and 502.01. For example, proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. *See* 37 CFR §1.2. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board. *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991), and *La Maur, Inc. v. Bagwells Enterprises, Inc., supra.*

Depositions may be noticed for any reasonable place in the United States. *See* 37 CFR §2.123(c). As a result, parties do not have to travel to the offices of the Board, or to the geographical area surrounding the Board's offices, to take their testimony. A party to a proceeding before the Board need never come to the offices of the Board at all, unless the party wishes to argue its case at oral hearing (and an oral hearing is held only if requested by a party to the proceeding--*see* 37 CFR §2.129(a)).

For a discussion concerning the general nature of trials in proceedings before the Board, *see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976); and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976).

The papers and other materials filed with the Board during the course of an inter partes proceeding are kept, during the course of the proceeding, in the physical possession of the Board. *See* TBMP §120. However, no paper, document,

exhibit, etc. will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. *See* 37 CFR §2.123(l), and TBMP §717. The provisions of those rules are described below.

703 Applications and Registrations

703.01 Subject of Proceeding

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

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

The file of an application or registration which 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. *See* 37 CFR §2.122(b)(1). *See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *Cleveland-Detroit Corp. v. Comco* (Machinery) Ltd., 277 F.2d 958, 125 USPQ 586 (CCPA 1960); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

However, the fact that the subject application or registration file is automatically part of the record in a proceeding does not mean that the allegations made, and the specimens, documents, exhibits, etc. filed, therein are evidence on behalf of the applicant or registrant in the inter partes proceeding. Allegations must be established by competent evidence properly adduced at trial, and the specimens,

documents, exhibits, etc. in an application or registration file are not evidence, in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period. *See* 37 CFR §2.122(b)(2). *See also* TBMP §704. For further information concerning the probative value of applications and registrations, *see* TBMP §§703.02 and 703.03.

703.02 Registration Not Subject of Proceeding

703.02(a) Registration Owned by Party

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

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party which owns a subsisting Federal registration of its mark, and wishes to rely upon the registration in an inter partes proceeding before the Board (the registration not being the subject of the proceeding), 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 upon it. *See Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742 (TTAB 1978); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647 (TTAB 1975). This may be done in a number of different ways.

A Federal registration *owned by the plaintiff* in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in

evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by two copies of the registration prepared and issued by the PTO showing both the current status of and current title to the registration. *See* 37 CFR §2.122(d)(1). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591 (TTAB 1980); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); *Vita-Pakt Citrus Products Co. v. Cerro*, 195 USPQ 78 (TTAB 1977); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498 (TTAB 1976); *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976); *Fort Howard Paper Co. v. Georgia-Pacific Corp.*, 189 USPQ 537 (TTAB 1975); *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647 (TTAB 1975); and *A.R.A. Manufacturing Co. v. Equipment Co.*, 183 USPQ 558 (TTAB 1974). *Cf. Hollister Inc. v. Downey*, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977).

NOTE: Although some of the cases cited in this TBMP section indicate that a plaintiff may also make its pleaded registration of record by filing, with its complaint, an order for two status and title copies of the registration, that is no longer true. *See* 37 CFR §2.122(d); Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the Patent and Trademark Office *Official Gazette* of June 21, 1983 at 1031 TMOG 13; and *In re Inter-State Oil Co.*, 219 USPQ 1229 (TTAB 1983).

A Federal registration *owned by any party* to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by a copy of the registration prepared and issued by the PTO showing both the current status of and current title to the registration. *See* 37 CFR §2.122(d)(2). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986); *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ

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

A party's submission, with a notice of reliance upon its registration, of an *order* for status and title copies of the registration is not sufficient to make the registration of record. The notice of reliance must be accompanied by the status and title copies themselves. *See Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992). However, the status and title copies need not be certified. *See* 37 CFR §2.122(e).

The registration copies "prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by 37 CFR §2.122(d), are printed copies of the registration in question whereon the PTO has entered the information it has in its records, at the time of the preparation and issuance of the status and title copies, pertaining to the current status and title of the registration, including information relating to renewal; cancellation; publication under Section 12(c) of the Act, 15 U.S.C. §1062(c); affidavits or declarations under Sections 8 and 15 of the Act, 15 U.S.C. §§1058 and 1065; and recorded documents transferring title. *See Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983), and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647 (TTAB 1975). Plain copies of the registration, and the electronic equivalent thereof, i.e., printouts of the registration from the electronic records of the PTO's trademark automated search system, known as "X-Search," are not sufficient for the purpose. *See, for example, Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); and *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977).

Although the status and title copies need not be certified (s*ee* 37 CFR §2.122(e)), at present all status and title copies prepared and issued by the PTO are certified. For the cost of a copy of a registration showing status and title, *see* 37 CFR §2.6(b)(4).

The issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. Status and title copies filed under a notice of reliance during the offering party's testimony period must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter. *See Electronic Data Systems Corp. v. EDSA Micro*

Corp., 23 USPQ2d 1460 (TTAB 1992); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); and *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976). The fact that there have been no changes in the status and title of a party's registration since the date of its issuance does not mean that a plain photocopy thereof may be used by the party as a substitute for the status and title copy required by 37 CFR §2.122(d). *See Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); and *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976).

When it comes to the attention of the Board that there has been a PTO 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 PTO has in its records, the Board will take judicial notice of the correct facts as shown by the records of the PTO. *See Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846 (TTAB 1978). Cf. *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979). Further, when a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and there are changes in the status of the registration 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 upon, the current status of the registration, as shown by the records of the PTO. *See Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846 (TTAB 1978); and *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979).

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. *See* 37 CFR §2.122(d)(2). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331 (TTAB 1985); *Acme*

Boot Co. v. Tony and Susan Alamo Foundation, Inc., 213 USPQ 591 (TTAB 1980); *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979); *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742 (TTAB 1978); *Groveton Papers Co. v. Anaconda Co.*, 197 USPQ 576 (TTAB 1977); *Maybelline Co. v. Matney, 194 USPQ 438* (TTAB 1977); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976).

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. *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991), and *Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6 (CCPA 1972). 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. *See Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221 (CCPA 1974); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); *American Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457 (TTAB 1978); *Jockey International, Inc. v. Frantti*, 196 USPQ 705 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53 (TTAB 1976). Finally, a registration *owned by any party* to the proceeding may be made of record in the proceeding by stipulation of the parties. *See* 37 CFR §2.123(b); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979).

When a subsisting registration upon 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. *See, for example,* Section 7(b) of the Act, 15 U.S.C. §1057(b); *CTS Corp. v. Cronstoms Manufacturing, Inc.*, 515 F.2d 780, 185 USPQ 773 (CCPA 1975); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *David Crystal, Inc. v. Glamorise Foundations, Inc.*, 189 USPQ 740 (TTAB 1975); J*ohnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 USPQ 790 (TTAB

1974); and *Gates Rubber Co. v. Western Coupling Corp.*, 179 USPQ 186 (TTAB 1973). *See also* Section 7(c) of the Act, 15 U.S.C. §1057(c) (conferring, contingent on the registration of a mark on the Principal Register, and subject to certain specified exceptions, constructive use priority dating from the filing of the application for registration of the mark); *Jimlar Corp. v. Army and Air Force Exchange Service*, 24 USPQ2d 1216, at fn.5 (TTAB 1992); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991)..

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. *See McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978); *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).

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. *See Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744 (TTAB 1987); *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815 (TTAB 1986); *Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc.*, 191 USPQ 292 (TTAB 1976); *Bonomo Culture Institute, Inc. v. Mini-Gym, Inc.*, 188 USPQ 415 (TTAB 1975); *Borden, Inc. v. Kerr-McGee Chemical Corp.*, 179 USPQ 316 (TTAB 1973), *aff'd without opinion*, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); *Unitec Industries, Inc. v. Cumberland Corp.*, 176 USPQ 62 (TTAB 1972); and *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506 (TTAB 1972).

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) (*see* TBMP §707), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. 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. *See, for example, Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141 (CCPA 1976); *Kraft, Inc. v. Balin*, 209 USPQ 877 (TTAB 1981);

Plak-Shack, Inc. v. Continental Studios of Georgia, Inc., 204 USPQ 242 (TTAB 1979); *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 356 (TTAB 1978), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982); *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976); *Old Dutch Foods, Inc. v. Old Dutch Country House, Inc.*, 180 USPQ 659 (TTAB 1973); and *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240 (TTAB 1963). *Cf. In re Anania Associates, Inc.*, 223 USPQ 740 (TTAB 1984); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984); and *In re Illinois Bronze Powder & Paint Co.*, 188 USPQ 459 (TTAB 1975).

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

NOTE: If a party to a Board inter partes proceeding owns a registration which is not the subject of the proceeding, and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, the party may do so by filing, during its testimony period, a copy of the file history, or the portion thereof, together with a notice of reliance thereon pursuant to 37 CFR §2.122(e) (*see* TBMP §707); or by appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or by stipulation of the parties, accompanied by a copy of the file history, or portion thereof. The file history of a registration owned by another party, but not the subject of the proceeding, may be made of record in the same manner. *See Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692 (TTAB 1974). Copies of official records of the Patent and Trademark Office need not be certified. *See* 37 CFR §2.122(e).

703.02(b) Third-Party Registration

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

A party to an inter partes proceeding before the Board may introduce, as part of its evidence in the case, a third-party registration, that is, a registration owned by a party not involved in the proceeding. *See* J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297 (1982).

A party which wishes to make a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration together with a notice of reliance thereon specifying the registration and indicating generally its relevance. See 37 CFR §2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (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 (TTAB 1976); and J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982).

A party to a Board inter partes proceeding may also make a third-party registration of record by introducing a copy thereof 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 PTO; 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 PTO's trademark automated search system, known as "X-Search," is all that is required. *See* 37 CFR §2.122(e); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977); J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977). A current status and title copy prepared by the PTO (or other appropriate proof of current status and title) is necessary when the owner of a registration on the Principal Register seeks to make the registration of record for the purpose of relying on the presumptions accorded to a certificate of registration pursuant to Section 7(b) of the Act, 15 U.S.C. §1057(b). *See* TBMP §703.02(a). However, the Section 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner, or when the registration is cited by a Trademark Examining Attorney (in an ex parte case) as a reference under Section 2(d) of the Act, 15 U.S.C. §1052(d), against a mark sought to be registered. *See* Section 7(b) of the Act; *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139 (TTAB 1986); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986); *In re H & H Products*, 228 USPQ 771 (TTAB 1986); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701 (TTAB 1979); *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473 (TTAB 1972); and *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394 (TTAB 1968). Thus, when third-party registrations are made of record, the Section 7(b) presumptions may not be relied upon by the party offering them; normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose. *See Hiram Walker & Sons, Inc. v. Milstone*, 130 USPQ 274 (TTAB 1961), and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977).

On the other hand, a party may *not* make a third-party registration of record simply by introducing a list of third-party registrations wherein it appears; or by filing a trademark search report wherein 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 residing in the PTO). *See, for example, In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1993); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *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 (TTAB 1986); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976). *See also* Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977). *Cf. In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761 (TTAB 1991); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990); *In re Classic Beverage Inc.*, 6 USPQ2d 1383 (TTAB 1988); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Certified Burglar Alarm Systems*, 191 USPQ 47 (TTAB 1976); and *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). *Cf. also* 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. *See, for example, Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422 (CCPA 1975); *Spice Islands, Inc. v. Frank Tea and Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ2d 1404 (TTAB 1988); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987); *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 USPQ 964 (TTAB 1985); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221

USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Mead Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977); *Cutter Laboratories, Inc. v. Air Products & Chemicals, Inc.*, 189 USPQ 108 (TTAB 1975); and J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982). A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board. *See Allstate Insurance Co. v. DeLibro*, 6 USPQ2d 1220 (TTAB 1988), and TBMP §703.02(a) and cases cited therein.

703.03 Application Not Subject of Proceeding

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

If a party to a proceeding before the Board wishes to introduce, as part of its evidence in the case, a copy of an application which is not the subject of the proceeding, the party may do so by filing, during its testimony period, a copy of the application, or of the portions thereof which it wishes to introduce, together with a notice of reliance thereon specifying the application and indicating generally its relevance. *See* 37 CFR §2.122(e); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (TTAB 1979); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778 (TTAB 1977). It is not necessary that the copy of the application, or portions thereof, filed under a notice of reliance be certified. *See* 37 CFR §2.122(e).

An application which 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. *See Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (TTAB 1979); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390 (TTAB 1979); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831 (TTAB 1978); *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778 (TTAB 1977); *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449 (TTAB 1976); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); and TBMP §704. 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, and cases cited therein.

704 Statements and Things in Application or Registration

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

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

While the file of a particular application or registration may be of record in a Board inter partes proceeding, by operation of 37 CFR §2.122(b) (*see* TBMP §703.01) or otherwise, the allegations made, and documents and other things filed,

in the application or registration are not evidence in the proceeding on behalf of the applicant or registrant. Allegations must be established by competent evidence properly adduced at trial, and the documents and other things in an application or registration file are not evidence, in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period. See: 37 CFR 2.122(b); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986); *Omega SA v. Compucorp*, 229 USPQ 191 (TTAB 1985); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905 (TTAB 1985); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985); *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101 (TTAB 1982); *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607 (TTAB 1981); *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978); *Dap, Inc. v. Century Industries Corp.*, 183 USPQ 122 (TTAB 1974); *Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315 (TTAB 1973); *ILC Products Co. v. ILC, Inc.*, 175 USPQ 722 (TTAB 1972); *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473 (TTAB 1972); and *W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273 (TTAB 1962). This is because the adverse party has a right to confront and cross-examine the person making the allegations, and to question the authenticity of the specimens, documents, exhibits, etc. *See ILC Products Co. v. ILC, Inc.*, 175 USPQ 722 (TTAB 1972); *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473 (TTAB 1972); and *W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273 (TTAB 1962).

Thus, for example, the allegation in an application or registration of a date of use is not evidence on behalf of the applicant or registrant in an inter partes proceeding; to be relied on by the applicant or registrant, a claimed date of use of a mark must be established by competent evidence. *See* 37 CFR §2.122(b)(2). *See also Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Omega SA v. Compucorp*, 229 USPQ 191 (TTAB 1985); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905 (TTAB 1985); and *Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315 (TTAB 1973). Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used. *See* 37 CFR §2.122(b)(2), and *Alpha Industries, Inc. v. Alpha Microsystems*, 223 USPQ 96 (TTAB 1984). *See*

also, for example, Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139 (TTAB 1986); and *Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc.*, 224 USPQ 512 (TTAB 1984).

The specimens in the file of an application or registration are not evidence on behalf of the applicant or registrant, in an inter partes proceeding, unless they are identified and introduced in evidence as exhibits during the testimony period. See: 37 CFR 2.122(b)(2); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985); *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607 (TTAB 1981); and *Dap, Inc. v. Century Industries Corp.*, 183 USPQ 122 (TTAB 1974).

Affidavits or declarations in an application or registration file cannot be relied upon by the applicant or registrant, in an inter partes proceeding, as evidence of the truth of the statements contained therein; the statements must be established by competent evidence at trial. *See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989), and *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101 (TTAB 1982). Similarly, statements made by counsel, and exhibits filed, in an application or registration do not constitute admissible evidence in the applicant's or registrant's behalf in an inter partes proceeding; the statements must be established by competent evidence, and the exhibits must be properly identified and introduced in evidence, at trial. *See W. T. Grant Co. v. Grant Avenue Fashions, Inc.*, 135 USPQ 273 (TTAB 1962).

Further, the fact that the file of an application or registration which is the subject of a Board inter partes proceeding is automatically of record in that proceeding, does not mean that a registration claimed by applicant or registrant in the application or registration is also automatically of record. *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390 (TTAB 1979); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978).

Although the allegations made and documents and things filed in an application or registration are not evidence, in a Board inter partes proceeding, on *behalf* of the applicant or registrant (unless they are properly proved at trial), they may be used

as evidence *against* the applicant or registrant, that is, as admissions against interest and the like. *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985) (specimens and other materials in applicant's application used as evidence of meaning of applicant's recitation of services, and that those services are not "substantially identical" to goods in applicant's subsisting registration of mark), and *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607 (TTAB 1981) (information in specimens in respondent's registration used as evidence of relationship between respondent's and petitioner's goods). *See also, for example, Hydro-Dynamics Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987) (applicant which seeks to prove date of first use earlier than that stated in its application must do so by clear and convincing evidence, rather than by preponderance of the evidence, because of 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 (Fed. Cir. 1984) (statements in application file illustrate the variety of images that may be attributed to, and commercial impression projected by, applicant's mark); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (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 (CCPA 1971) (specimens in application with typed drawing illustrate one form in which mark may be used); and *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793 (TTAB 1986) (fact that party took position in its application inconsistent with its position in inter partes proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

705 Exhibits to Pleadings or Briefs

705.01 Exhibits to Pleadings

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

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

With one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. *See* 37 CFR §2.122(c), and TBMP §313 and cases cited therein.

The one exception is a current status and title copy, prepared by the PTO, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part ot the record without any further action by plaintiff. *See* 37 CFR §§2.122(c) and (d)(1), and TBMP §703.02(a).

705.02 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. *See, for example, Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747 (TTAB 1986); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB 1983); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111 (TTAB 1978); *Astec Industries, Inc. v. Barber-Greene Co.*, 196 USPQ 578 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *American Crucible Products Co. v. Kenco Engineering Co.*, 188 USPQ 529 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 61 (TTAB 1975), *aff'd*, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

If, after the close of the time for taking testimony, a party discovers new evidence which 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, and cases cited therein.

706 Statements in Pleadings or Briefs

706.01 Statements in Pleadings

Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), and *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656 (TTAB 1979).

However, statements in pleadings may have evidentiary value as admissions against interest by the party which made them. See Maremont Corp. v. Air Lift Co., 463 F.2d 1114, 174 USPQ 395 (CCPA 1972); *Bakers Franchise Corp. v. Royal Crown Cola Co.*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 196 USPQ 711 (TTAB 1977); and *Brown Co. v. American Stencil Manufacturing Co.*, 180 USPQ 344 (TTAB 1973).

706.02 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. *See, for example, Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB 1983); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819 (TTAB 1981); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502 (TTAB 1978); and *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111 (TTAB 1978). *Cf. Martahus*

v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846 (Fed. Cir. 1993), and *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147 (CCPA 1975).

707 Official Records

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

A party which 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 must specify the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence. *See* 37 CFR §2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164 (TTAB 1984); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579 (TTAB 1979); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979); and *May Department Stores Co. v. Prince*, 200 USPQ 803 (TTAB 1978). For information concerning establishing the authenticity, under the Federal Rules of Evidence, of an official record, *see* FRE 901(a), 901(b)(7), and 902(4) (the latter rule provides, in effect, that extrinsic evidence of

authenticity as a condition precedent to admissibility is not required with respect to a properly certified copy of an official record, and describes the requirements for proper certification). A copy of an official record of the PTO need not be certified to be offered in evidence by notice of reliance. *See* 37 CFR §2.122(e).

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. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). *Cf.* TBMP §708.

The term "official records," as used in 37 CFR §2.122(e), refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer. *See Black's Law Dictionary* (Fifth Edition, 1979); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); and *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579 (TTAB 1979). *See also* FRE 902(4). For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 CFR §2.122(e), *see Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1993) (trademark search report--no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992) (trademark search reports--no); *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157 (TTAB 1992), *aff'd*, 28 USPQ2d 1687 (Fed. Cir. 1993) (trademark search report--no; third-party registrations--yes); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905 (TTAB 1985) (copy of cancellation proceeding file--yes; party's file copies of documents filed in the PTO--no); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331 (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 (TTAB 1984) (third-party registrations--yes); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73 (TTAB 1983) (portions of an agreement between applicant and a third party, and a shipping document for applicant's product--no); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579 (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 (TTAB 1979) (promotional literature--no); *May Department Stores Co. v. Prince*, 200 USPQ 803 (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

(TTAB 1977) (plat plan, deed of realty, and confirmatory assignment--not admissible by notice of reliance as official record because not authenticated); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653 (TTAB 1976) (third-party registrations--yes); *Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692 (TTAB 1974) (file history of party's registration--yes); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467 (TTAB 1973) (drawings from Federal trademark applications--yes); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123 (TTAB 1971) (certificate of good standing from a United States district court--yes).

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. *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634 (TTAB 1983); and *Regent Standard Forms, Inc. v. Textron Inc.*, 172 USPQ 379 (TTAB 1971). These latter two methods may also be used for the introduction of official records which are not admissible by notice of reliance under 37 CFR §2.122(e). *See, for example, Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73 (TTAB 1983). *Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990), and *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433 (TTAB 1973).

For information concerning the raising of objections to notices of reliance and materials filed thereunder, *see* TBMP §§533 and 718.02.

Materials improperly offered under 37 CFR §2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object thereto, and/or itself treats the materials as being of record. *See, for example, U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990) (improper subject matter); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (improper subject matter); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717 (TTAB 1987) (improper subject matter, and advertisement not sufficiently identified); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (improper subject matter, and improper rebuttal); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (improper subject matter); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205

USPQ 579 (TTAB 1979) (improper subject matter); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979) (untimely). *Cf. Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection).

708 Printed Publications

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

Certain types of printed publications may be introduced in evidence in a Board inter partes proceeding by notice of reliance. Specifically, printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, if the publication is competent evidence and relevant to an issue in the proceeding, may be introduced in evidence by filing a notice of reliance thereon during the testimony period of the offering party. 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 be accompanied by the printed publication or a copy of the relevant portion thereof. *See* 37 CFR §2.122(e). *See also Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717 (TTAB 1987); *Beech*

Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164 (TTAB 1984); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (TTAB 1979); *Chicken Delight, Inc. v. Delight Wholesale Co.*, 197 USPQ 630 (TTAB 1977); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33 (TTAB 1976); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18 (TTAB 1976); and *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467 (TTAB 1973).

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 thereof, as, for example, by a printout from Mead Data Central's Nexis computerized library of an article published in a newspaper or magazine of general circulation. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169 (TTAB 1985), and *International Ass'n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 USPQ 940 (TTAB 1985), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). *Cf.* TBMP §707, and *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

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. *See Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (TTAB 1979).

For examples of cases concerning the admissibility of specific materials, by notice of reliance, as "printed publications" under 37 CFR §2.122(e), see *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992) (trademark search reports--no); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (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 (TTAB 1986) (conference papers, dissertations, and journal papers--no); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73 (TTAB 1983) (press releases--no); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (annual reports--no); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767 (TTAB 1980) (annual report--no; magazine articles--yes); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090

(TTAB 1979) (promotional literature--no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979) (promotional literature--no); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33 (TTAB 1976) (catalogs and other house publications--no); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (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 (TTAB 1976) (telephone directory pages, indexes from United States Code Annotated, and dictionary pages--yes); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407 (TTAB 1975) (annual reports--no); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443 (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 (TTAB 1973) (annual reports, product booklets, and product brochures--no); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973) (article from "Memoirs of the University of California"--no, since publication not shown to be available to the general public).

Printed publications made of record by notice of reliance under 37 CFR §2.122(e) are admissible, and probative, merely 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. *See, for example, Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 469 F.2d 1397, 176 USPQ 123 (CCPA 1972); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767 (TTAB 1980); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 404 (TTAB 1978); *Food Producers, Inc. v. Swift & Co.*, 194 USPQ 299 (TTAB 1977); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33 (TTAB 1976); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407 (TTAB 1975); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310 (TTAB 1975); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443 (TTAB 1974).

Although the types of printed publications described above 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. *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984), and *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634 (TTAB 1983). These latter two methods may also be used

for the introduction of printed publications which are not admissible by notice of reliance under 37 CFR §2.122(e). See, for example, *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *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 (TTAB 1983); and *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433 (TTAB 1973).

For information concerning the raising of objections to notices of reliance and materials filed thereunder, *see* TBMP §§533 and 718.02.

Materials improperly offered under 37 CFR §2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object thereto, and/or itself treats the materials as being of record. *See, for example, U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990) (improper subject matter); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (improper subject matter); *Original Appalachian Artworks Inc. v. Streeter,* 3 USPQ2d 1717 (TTAB 1987) (improper subject matter, and advertisement not sufficiently identified); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (improper subject matter, and improper rebuttal); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (improper subject matter); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579 (TTAB 1979) (improper subject matter); and *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979) (untimely). *Cf. Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection).

709 Discovery Depositions

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

(2) Except as provided in paragrpah (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party

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

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

* * *

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

* * *

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

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

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

The discovery deposition *of a party* (or of anyone who, at the time of taking the depositioon, was an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party) may be offered in evidence *by any adverse party*. *See* 37 CFR §2.120(j)(1). *See also Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321 (TTAB 1992); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026 (TTAB 1980); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383 (TTAB 1977); *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647 (TTAB 1976); *Coca-Cola Co. v. Seven-Up Co.*, 175 USPQ 491 (Comm'r 1972); and *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214 (TTAB 1970).

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. *See* 37 CFR §2.120(j)(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 at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion must be filed promptly after the circumstances claimed to justify use of the deposition became known. *See* 37 CFR §2.120(j)(2). *See also Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747 (TTAB 1986); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354 (TTAB 1984); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); and *Insta-Foam Products, Inc. v. Instapak Corp.*, 189 USPQ 793 (TTAB 1976).

(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 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. *See* 37 CFR §2.120(j)(4). *See also Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804 (TTAB 1990), *aff'd*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954 (TTAB 1985); *Dynamark Corp. v. Weed Eaters, Inc.*, 207

USPQ 1026 (TTAB 1980); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383 (TTAB 1977); and *Rogers Corp. v. Fields Plastics & Chemicals, Inc.*, 172 USPQ 377 (TTAB 1972).

A discovery deposition which may be offered in evidence under the provisions of 37 CFR §2.120(j) may be made of record by filing, during the testimony period of the offering party, the deposition or any part thereof with any exhibit to the part that is filed, together with a notice of reliance thereon. See 37 CFR §2.120(j)(3)(i). *See also BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20 (CCPA 1978); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584 (TTAB 1976); *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647 (TTAB 1976); *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495 (TTAB 1970); *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214 (TTAB 1970); and *American Skein & Foundry Co. v. Stein*, 165 USPQ 85 (TTAB 1970). The notice of reliance need not indicate the relevance of the deposition, or parts thereof, relied on. *See* 37 CFR §2.120(j)(3)(i). *Cf. Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979). When only part of a deposition is relied on, the notice of reliance must specify the part or parts relied on. *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440 (TTAB 1983).

When a discovery deposition has been made of record by one party in accordance with 37 CFR §2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. *See* 37 CFR §2.120(j)(7). *See also Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954 (TTAB 1985); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431 (TTAB 1985); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191 (TTAB 1984); and *Miles Laboratories, Inc. v. SmithKline Corp.*, 189 USPQ 290 (TTAB 1975). If only part of a discovery deposition has been made of record pursuant to 37 CFR §2.120(j), that part only may be referred to by any party for any purpose permitted by the Federal Rules of evidence. If one party has filed a notice of reliance on a discovery deposition or part thereof and an adverse party has based its presentation of evidence on the belief that the deposition or the part thereof is of record, the notice of reliance may not later be withdrawn. *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440 (TTAB 1983).

A discovery deposition not properly offered in evidence under 37 CFR §2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties)

does not object thereto, and/or treats the deposition as being of record, and/or improperly offers a discovery deposition in the same manner. *See, for example, Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1990); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308 (TTAB 1978); and *Plus Products v. Don Hall Laboratories*, 191 USPQ 584 (TTAB 1976).

Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery; or (6) with the complaint, in the case of discovery requests, for later service upon the defendant, by the Board, with defendant's copies of the complaint and proceeding notification letter. Discovery papers or materials filed under other circumstances may be returned by the Board. *See* 37 CFR §2.120(j)(8), and TBMP §413 and authorities cited therein.

Nothing in 37 CFR §2.120(j) will be interpreted to preclude the reading or the use of a discovery deposition as part of the examination or cross-examination of any witness during the testimony period of any party. *See* 37 CFR §2.120(j)(6). *See also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984). *Cf. West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306 (TTAB 1987).

For information concerning the taking of a discovery deposition, and the raising of objections thereto, *see* TBMP §§404, 405, 533, and 718.02.

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

710 Interrogatory Answers; Admissions

37 CFR §2.120(j)(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.*

* * *

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

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

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

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

Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party. *See* 37 CFR §2.120(j)(5). *See also Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826 (TTAB 1987); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949 (TTAB 1981); *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025 (TTAB 1979); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751 (TTAB 1978); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690 (TTAB 1977); *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658 (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 (TTAB 1976); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647 (TTAB 1976).

However, if fewer than all of the answers to a set of interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance any other answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the inquiring party. The notice of reliance must be supported by a written statement explaining why the responding party needs to rely upon 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. *See* 37 CFR §2.120(j)(5). *See also Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842 (TTAB 1988); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826 (TTAB 1987); *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986); *Packaging Industries Group, Inc. v. Great American Marketing, Inc.*, 227 USPQ 734 (TTAB 1985); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949 (TTAB 1981); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647 (TTAB 1976).

An interrogatory answer (including documents provided as all or part of an interrogatory answer), or an admission to a request for admission, which may be offered in evidence under the provisions of 37 CFR §2.120(j) may be made of record in the case by filing, during the testimony period of the offering party, 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 a notice of reliance thereon. *See* 37 CFR §2.120(j)(3)(i); *BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20 (CCPA 1978); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990) (documents provided as interrogatory answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986) (documents provided as interrogatory answer); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982); *May Department Stores Co. v. Prince*, 200 USPQ 803 (TTAB 1978); *Bausch & Lomb Inc. v. Gentex Corp.*, 200 USPQ 117 (TTAB 1978); *E. I. du Pont de Nemours & Co. v. G. C. Murphy Co.*, 199 USPQ 807 (TTAB 1978); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977); *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584 (TTAB 1976); and *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340 (TTAB 1976). The notice of reliance need not indicate the relevance of the discovery responses relied on. *See* 37 CFR §2.120(j)(3)(i), and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979). Offering interrogatory answers, or admissions, on the record during the taking of a testimony deposition is the equivalent of serving and filing a notice of reliance by mail. *See Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp.*, 204 USPQ 945 (TTAB 1979).

An interrogatory answer, or an admission, 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, 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). *See Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012 (TTAB 1984), and *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). *See also Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751 (TTAB 1978), and *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690 (TTAB 1977).

When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 CFR §2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. *See* 37 CFR §2.120(j)(7). *See also Henry Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ2d 1154 (TTAB 1987); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191 (TTAB 1984); and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647 (TTAB 1976).

An interrogatory answer, or an admission, not properly offered in evidence under 37 CFR §2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the answer, or admission, as being of record; and/or improperly offers an interrogatory answer, or an admission, in the same manner. *See, for example, Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1993); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842 (TTAB 1988); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826 (TTAB 1987); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308 (TTAB 1978); *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025 (TTAB 1979); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751 (TTAB 1978); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690 (TTAB 1977); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584 (TTAB 1976); and *Plus Products v. Sterling Food Co.*, 188 USPQ 586 (TTAB 1975).

Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery; or (6) with the complaint, in the case of discovery requests, for later service upon the defendant, by the Board, with defendant's copies of the complaint and proceeding notification letter. Discovery papers or materials filed under other circumstances may be returned by the Board. *See* 37 CFR §2.120(j)(8), and TBMP §413 and authorities cited therein.

Nothing in 37 CFR §2.120(j) will be interpreted to preclude the reading or the use of an interrogatory answer, or an admission, as part of the examination or cross-

examination of any witness during the testimony period of any party. *See* 37 CFR §2.120(j)(6). *See also West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306 (TTAB 1987). *Cf. Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

For information concerning the taking of discovery by way of interrogatories, *see* TBMP §§406 and 407. For information concerning the taking of discovery by way of requests for admission, *see* TBMP §§410 and 411. For information concerning the raising of objections to notices of reliance and materials filed thereunder, *see* TBMP §§533 and 718.02.

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

711 Produced Documents

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

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

In an inter partes proceeding before the Board, a party which has obtained documents from another party, under FRCP 34, may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR §2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding--*see* TBMP §§707 and 708). *See* 37 CFR §2.120(j)(3)(ii). *See also, for example, M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905 (TTAB 1985); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984); *BAF Industries v. Pro-Specialties, Inc.*, 206 USPQ 166 (TTAB 1980); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367 (TTAB 1978); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566 (TTAB 1977); *Dow Corning Corp. v. Doric Corp.*, 192 USPQ 106 (TTAB 1976); *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119 (TTAB 1976); *MRI Systems Corp. v. Wesley-Jessen Inc.*, 189 USPQ 214 (TTAB 1975); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record,* 67 Trademark Rep. 54 (1977).

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

(1) A party which has obtained documents under FRCP 34 may serve upon its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under 37 CFR §2.120(j)(3)(i), on the requests for admission, the exhibits thereto, and its adversary's admissions (or a statement that its adversary failed to respond to the requests for admission). However, if a party wishes to have an opportunity to serve requests for admission after obtaining documents under FRCP 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. *See* TBMP §§403.05(a) and 403.05(c).

(2) A party which has obtained documents under FRCP 34 may offer them as exhibits in connection with the taking of its adversary's discovery deposition. Again, however, the request for production of documents must be served early in the discovery period, so that there will still be time remaining therein, after the

requested documents have been produced, to notice and take a discovery deposition. *See* TBMP §§403.05(a) and 403.05(c).

(3) A party which has obtained documents under FRCP 34 may introduce them as exhibits during the cross-examination of its adversary's witness. *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119 (TTAB 1976). This method is available only if the adversary takes testimony, and the obtained documents pertain to matters within the scope of the direct examination of the witness.

(4) A party which has obtained documents under FRCP 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. *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119 (TTAB 1976).

(5) A party which has obtained documents under FRCP 34 may, during its own testimony period, make of record by notice of reliance, under 37 CFR §2.122(e), any of the documents which falls into the category of "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue" (see: TBMP sections 707 and 708). *See* 37 CFR §2.120(j)(3)(ii), and cases cited in the first paragraph of this section.

(6) A party which wishes to obtain documents under FRCP 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 prior to the date set for the deposition, because a discovery deposition must be both noticed and taken prior to the close of the discovery period, and because FRCP 34(b) allows a party 30 days in which to respond to a request for production of documents (this period is lengthened to 35 days if service of the request is made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)), except that a defendant may serve responses either within 30 days (35 days) after service of the request, or within 45 days after service of the complaint upon it by the Board. *See* TBMP §§403.05(a) and 403.05(c).

(7) Documents obtained under FRCP 34 may be made of record by stipulation of the parties.

Documents obtained by request for production of documents under FRCP 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 FRCP 34. See, for example, *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367 (TTAB 1978); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566 (TTAB 1977); *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119 (TTAB 1976). *Cf. Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905 (TTAB 1985).

Further, documents provided as all or part of an answer to an interrogatory may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR §§2.120(j)(3)(i) and 2.120(j)(5). *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990), and *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986).

For information concerning the obtaining of discovery by way of a request for production of documents, *see* TBMP §§408 and 409.

NOTE: Most of the cases cited in this section preceded 37 CFR §2.120(j)(3)(ii).

712 Judicial Notice

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

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

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

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

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

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

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

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

712.01 Kind of Fact Which May be Judicially Noticed

The only kind of fact which may be judicially noticed by the Board is a fact which is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." *See* FRE 201(b). *See also, for example, B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); *Omega SA v. Compucorp*, 229 USPQ 191 (TTAB 1985); and *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977).

For examples of decisions concerning whether particular facts are appropriate subject matter for judicial notice by the Board, *see B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (dictionary definition of term as trademark--yes, indicates mark is reasonably famous; also, encyclopedias may be consulted); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (home cold permanent wave kits have for

many years been sold directly to nonprofessional consumers through retail outlets--yes); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C.--yes); *Los Angeles Bonaventure Co. v. Bonaventure Associates*, 4 USPQ2d 1882 (TTAB 1987) (whether other companies have expanded from restaurant services to hotel services under a single mark, and, if so, when--no); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (files of applications and/or registrations, where no copies thereof are filed, and they are not the subject of the proceeding--no); *Hertz System, Inc. v. A-Drive Corp.*, 222 USPQ2d 625 (TTAB 1984) (the numeral "1" is widely used to indicate superiority--yes); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819 (TTAB 1981) (use of antimicrobial agents in the floor covering industry--no); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (dictionary definitions--yes); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981) (dictionary definitions--yes); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980) (standard reference works--yes); *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396 (TTAB 1979), *aff'd*, Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (frequent use of famous marks on collateral products such as clothing, glassware, trash cans, etc.--yes); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978) (third-party registrations and listings in trade directories, where no copies thereof are submitted--no); Quaker Oats Co. v. Acme Feed Mills, Inc., 192 USPQ 653 (TTAB 1976) (law of any jurisdiction, when a copy thereof is submitted under notice of reliance--yes); *Plus Products v. Sterling Food Co.*, 188 USPQ 586 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products--yes); and *Bristol-Myers Co. v. Texize Chemicals, Inc.*, 168 USPQ 670 (TTAB 1971) (operations of opposer and applicant--no).

712.02 When Discretionary

The Board, in its discretion, *may* take judicial notice of a fact not subject to reasonable dispute, as defined in FRE 201(b), whether or not it is requested to do so. *See* FRE 201(c). *See also United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977), and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976).

712.03 When Mandatory

The Board *will* take judicial notice of a fact not subject to reasonable dispute, as defined in FRE 201(b), if a party (1) requests that the Board do so, and (2) supplies the necessary information. *See* FRE 201(d). *See also United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977), and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976). The request should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information. *See Litton Business Systems, Inc. v. J. G. Furniture Co., supra*. *See also Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985), and *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980).

712.04 Opportunity to be Heard

A party to a proceeding before the Board is entitled, upon timely request, "to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken." *See* FRE 201(e). *See also Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976). This does not mean, however, that when judicial notice is taken without prior notification, a party is automatically entitled to a hearing upon request, even if it makes no offer to show that the taking of judicial notice was improper. *See In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). *See also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

712.05 Time of Taking Notice

Judicial notice may be taken at any stage of a Board proceeding, even at the time of decision on appeal from the Board's decision therein. *See, for example,* FRE 201(f); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988);

American Security Bank v. American Security and Trust Co., 571 F.2d 564, 197 USPQ 65 (CCPA 1978); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and *Food Specialty Co. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136 (CCPA 1973).

713 Oral Depositions

713.01 In General

A testimony deposition is a device used by a party to a Board inter partes proceeding to present evidence in support of its case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) in behalf of the party. *See* TBMP §404.02, and authorities cited therein.

Testimony depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, but also those documents and other exhibits which may not be made of record by notice of reliance. *See* TBMP §§703 and 707-711, 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; inadmissibility is a valid ground for objection. *See* 37 CFR §§2.122(a) and 2.123(k), and TBMP §718.03.

The Board does not preside at the taking of testimony. Rather, testimony is taken out of the presence of the Board, upon oral examination or written questions, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board. *See* TBMP §702. *See also* TBMP §502.01.

For a comparison of testimony depositions and discovery depositions, *see* TBMP §404.02.

713.02 Form of Testimony

37 CFR §2.123(a)(1) *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by*

depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

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

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

Ordinarily, the testimony of a witness may be taken either upon oral examination pursuant to 37 CFR §2.123, or by deposition upon written questions pursuant to 37 CFR §2.124. *See* 37 CFR §2.123(a)(1). For information concerning depositions upon written questions, *see* TBMP §714.

However, if a party serves notice of the taking of a testimony 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 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. *See* 37 CFR §2.123(a)(1). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and TBMP §532.

In addition, a testimony deposition taken in a foreign country *must* be taken by deposition upon written questions, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate. *See* 37 CFR §2.123(a)(2). *See also* TBMP §520. *Cf.* 37 CFR §2.120(c)(1); TBMP §404.03(c)(1); and *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989).

By agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit by such witness or witnesses. *See* 37 CFR §2.123(b). *See also Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989); *Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389 (TTAB 1985); *Oxy Metal Industries Corp. v. Transene Co.*, 196 USPQ 845 (TTAB 1977); and *National Distillers and Chemical Corp. v. Industrial Condenser Corp.*, 184 USPQ 757 (TTAB 1974). The parties may also stipulate the facts in the case of any party, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony. *See* 37 CFR §2.123(b). *See also Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990), and *Oxy Metal Industries Corp. v. Transene Co.*, 196 USPQ 845 (TTAB 1977).

713.03 Time for Taking Testimony

A party which desires to take testimony may do so only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. *See* 37 CFR §2.121(a)(1). *See also* TBMP §701 and authorities cited therein.

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

713.04 Time and Place of Deposition

37 CFR §2.123(a)(1) *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice*

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

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

* * *

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

A testimony deposition may be noticed for any reasonable time during the deposing party's testimony period. *See* 37 CFR §2.123(c). 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, upon motion, by order of the Board. *See* 37 CFR §2.121(a)(1). *See also* TBMP §701 and authorities cited therein. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

A testimony deposition to be taken *in the United States* may be noticed for any reasonable place. *See* 37 CFR §2.123(c).

A deposition may not be noticed for a place *in a foreign country*, unless the deposition is to be taken upon written questions as provided by 37 CFR §2.124, or unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. *See* 37 CFR §§2.123(a)(2) and 2.123(c). *See also* TBMP §713.02.

A party may not 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. *See* 37 CFR §2.123(c).

If the parties so stipulate in writing, a deposition 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 any other deposition. *See* 37 CFR §2.123(b).

713.05 Notice of Deposition

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

Before the oral depositions of witnesses may be taken by a party, the party must give due (i.e., reasonable) notice in writing to every adverse party. *See* 37 CFR §2.123(c). *See also Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982). *Cf.* TBMP §404.04.

The notice must specify the time and place the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. If the name of a witness is not known, the notice must include a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation. *See* 37 CFR §2.123(c). *See also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973). *Cf.* TBMP §404.04.

If the parties so stipulate in writing, a deposition 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 any other deposition. *See* 37 CFR §2.123(b).

Ordinarily, a notice of oral deposition need not be filed with the Board, except as part of the completed deposition. *See* Rany L. Simms, *TIPS FROM THE TTAB: Whether and When to File Papers During Trademark Proceedings*, 67 Trademark Rep. 175 (1977), and 37 CFR §2.123(f). However, if a certified copy of the notice of deposition is, for some reason, required for use before a Federal district court, the notice of deposition must be filed with the Board for purposes of certification. *See* TBMP §§123 and 713.06(b).

For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, *see* 37 CFR §2.123(e)(3) and TBMP §534.01.

713.06 Securing Attendance of Unwilling Witness

713.06(a) In General

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

However, where a party wishes to take the testimony of an adverse party or nonparty, or an official or employee of an adverse party or nonparty, and the proposed witness is not willing to appear voluntarily to testify, the deposition may not be taken on notice alone. Rather, the party which wishes to take the deposition must take steps, discussed below, to compel the attendance of the witness. If the witness resides in a foreign country, the party may not be able to take the deposition. *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582 (TTAB 1976); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and TBMP §§713.06(b), 713.06(c), and 713.07. *See also Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52 (TTAB 1983), *aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

713.06(b) Unwilling Witness Residing in United States

If a party wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena. *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582 (TTAB 1976); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). *Cf.* TBMP §404.03(b)(2).

The subpoena must be issued, pursuant to 35 U.S.C. §24 and FRCP 45, from the United States district court in the Federal judicial district where the witness resides or is regularly employed. 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 PTO seal) of the

notice, or will accept a Board verification letter (see TBMP §123.03). A certified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and certified by the PTO as being a true copy of the notice of deposition filed in the proceeding before the Board. A verified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and verified by the Board as being a true copy of the notice of deposition filed in the Board proceeding. A copy of a notice of deposition cannot be certified by the PTO, or verified by the Board, unless it has been filed in the Board proceeding. *See* Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985), and TBMP §123. For further information relating to PTO certification or Board verification of a notice of deposition, *see* TBMP §123.

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 which issued the subpoena. Similarly, any request to quash a subpoena must be directed to the United States district court which issued the subpoena. The Board has no jurisdiction over depositions by subpoena. *See, for example, Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); In re Johnson & Johnson, 59 F.R.D. 174, 178 USPQ 201 (D.Del. 1973); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318 (TTAB 1971); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

713.06(c) Unwilling Witness Residing in Foreign Country

There is no certain procedure for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a nonparty (or an official or employee of an adverse party or nonparty), and is not willing to appear voluntarily to testify. However, the deposing party may be able to obtain the testimony deposition of such a witness through the letter rogatory procedure or the Hague Convention letter of request procedure. *See* Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). For information concerning these procedures, *see* TBMP §404.03(c)(2).

713.07 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.*

FRCP 28. Persons Before Whom Depositions May Be Taken
(a) Within the United States. *Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.*

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

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

Depositions in Board inter partes proceedings may be taken before the persons described in FRCP 28. *See* 37 CFR §2.123(d).

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a Board proceeding testimony deposition "shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending." *See* FRCP 28(a). As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter who is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a Board proceeding testimony deposition may be taken pursuant to FRCP 28(b). This means, for example, that a Board proceeding testimony deposition taken of a willing witness in a foreign country usually may be taken on notice before a United States consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. *See* Wright & Miller, *Federal Practice and Procedure*: Civil §2083 (1970). A party which wishes to take a testimony deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. The testimony of an unwilling adverse party or nonparty witness may be taken in a foreign country, if at all, only by the letter rogatory procedure, or by the letter of request procedure provided under the Hague 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. *Cf.* TBMP §§404.03(c)(2) and 713.06(c).

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, upon

any notice, and in any manner, and when so taken may be used like any other deposition. *See* 37 CFR §2.123(b).

713.08 Examination of Witnesses

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

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

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

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

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

Before testifying, a witness whose testimony deposition is being taken for use in a Board inter partes proceeding must be duly sworn, according to law, by the officer before whom the deposition is to be taken. *See* 37 CFR §2.123(e)(1). *See also* TBMP §713.07.

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 FRCP 28) in the presence of the officer, except when the officer's presence is waived on the record by agreement of the parties. The testimony is taken stenographically and transcribed, unless the parties present agree otherwise. If no adverse party, or its attorney or other authorized representative, attends the deposition, the testimony may be taken in longhand, typewriting, or stenographically. *See* 37 CFR §2.123(e)(2).

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

Upon stipulation of the parties, or upon motion granted by the Board, a deposition may be taken or attended by telephone. *See* FRCP 30(b)(7), and *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991). A deposition taken by telephone is taken in the district and at the place where the witness is to answer the questions propounded to him or her.

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. *See* 37 CFR 2.123(e)(2). *See also Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835 (TTAB 1989) (decided just prior to adoption of the present rule).

If exhibits are large, bulky, valuable, or breakable, the Board strongly prefers that they be photographed (or, in the case of documents, photocopied), and that the photographs (or photocopies) be filed with the Board in lieu of the originals. The originals should, of course, be shown to every adverse party. If an original exhibit

does not photograph (or photocopy) well, and one of the parties intends to request that an oral hearing be held on the case, the parties may agree that the original be carried to the oral hearing and given to the Board at that time. *See* Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980). The Board cannot be responsible for the safekeeping and/or safe return of original exhibits which are large, bulky, valuable, or breakable.

Every adverse party must be given a full opportunity to cross-examine the witness. If the notice of deposition served by a party is improper or inadequate with respect to the witness, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. *See* 37 CFR §2.123(e)(3). For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, *see* 37 CFR §2.123(e)(3), and TBMP §§534.02 and 718.03(b).

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. *See* 37 CFR §2.123(e)(4). *See also* TBMP §718.03.

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 which is, for example, privileged or confidential. *See* TBMP §404.02, and authorities cited therein. 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 §§404.02 and 718.03(d), and authorities cited therein.

For further information concerning the raising of objections to testimony depositions, *see* TBMP §§534 and 718.03, and authorities cited therein.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other deposition. *See* 37 CFR §2.123(b).

713.09 Form of Deposition

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

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

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

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

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

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

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

Exhibits must be marked as specified in 37 CFR §2.123(g)(2). The Board, in its discretion, may refuse to enter and consider improperly marked exhibits. *See* 37 CFR §2.123(g)(2); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984); and G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

For information concerning deposition objections based on errors or irregularities in form, *see* TBMP §718.03(c).

713.10 Signature of Deposition by Witness

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

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

Reading and signature cannot be waived by mere agreement of the witness; the agreement of every party is required. *See* 37 CFR §2.123(e)(5), and Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

713.11 Certification and Filing of Deposition by Officer

37 CFR §2.123(f) Certification and filing by officer. *The officer shall annex to the deposition his certificate showing:*

(1) Due administration of the oath by the officer to the witness before the commencement of his deposition;

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

(3) The presence or absence of the adverse party;

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

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

If any of the foregoing requirements are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then, without delay, securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of

each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents and Trademarks. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted in a separate package marked and addressed as provided in this section.

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

* * *

(c) One certified transcript and exhibits shall be filed promptly 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, should be sent to the Board at its mailing address for papers not accompanied by a fee, i.e., BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

The certified transcript and exhibits must be filed promptly with the Board. *See* 37 CFR §2.125(c), and *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991). A notice of reliance thereon need not (and should not) be filed. *See, for example, Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897 (TTAB 1988), and *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982). 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. *See* 37 CFR §2.125(c). 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. *See* 37 CFR 2.125(a). For information concerning the remedy which an adverse party may have if it is not timely served with a copy of the deposition and exhibits, *see* TBMP §713.13.

If a party which took a deposition discovers that the officer has inadvertently failed to send the certified transcript, with exhibits, to the Board, the party should contact the officer and arrange for the immediate filing of the deposition with the Board. *See* Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

If the officer, by mistake, sends the certified deposition and exhibits to the party which took the deposition, or its attorney or other authorized representative, rather than to the Board, the party, or its attorney or other authorized representative, should, without delay, forward them to the Board, or return them to the officer for immediate transmittal to the Board.

713.12 Testimony Deposition Must be Filed

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

All trial testimony depositions that are taken in a Board inter partes proceeding *must* be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. *See* 37 CFR §2.123(h). *See also, for example, Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191 (TTAB 1984); and *An Evening at the Trotters, Inc. v. A Nite at the Races, Inc.*, 214 USPQ 737 (TTAB 1982). 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, or may receive and consider a copy of the

withheld deposition, attested by such evidence as is procurable. *See* 37 CFR §2.123(h).

713.13 Service of Deposition

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

One copy of the transcript of trial testimony, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. See 37 CFR §2.125(a).

The requirement that a copy of the transcript, with exhibits, be served upon every adverse party within the time specified in 37 CFR §2.125(a) is intended to ensure that each adverse party will have the testimony before it has to offer its own evidence, or, if the testimony in question is rebuttal testimony, to ensure that each adverse party will have the testimony before it has to prepare its brief on the case. *See Techex, Ltd. v. Dvorkovitz*, 220 USPQ 81 (TTAB 1983), and *S. S. Kresge Co. v. J-Mart Industries, Inc.*, 178 USPQ 124 (TTAB 1973). If a copy of the transcript, with exhibits, is not served on each adverse party within that time, any adverse party which 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. *See* 37 CFR 2.125(a), and *Techex, Ltd. v. Dvorkovitz, supra*.

If a party which took a deposition fails to serve a copy of the transcript, with exhibits, on an adverse party after having been ordered to do so by the Board, the

Board, in its discretion, may take any of the actions mentioned in 37 CFR §2.125(a).

713.14 Correction of Errors in Deposition

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

A party which 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. *See* 37 CFR §2.125(b), and *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991).

If the witness, upon reading the transcript, discovers that typographical or editorial corrections need to be made, or that other corrections are necessary to make the transcript an accurate record of what the witness actually said during the taking of his or her testimony, the witness should make a list of all such corrections and forward the list to the officer before whom the deposition was taken. The officer, in turn, should correct the transcript by redoing the involved pages. Alternatively, if there are not many corrections to be made, the witness may correct the transcript by writing each correction above the original text which 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.

If corrections are necessary, the party which 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. *See* 37 CFR §2.125(b). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991).

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 upon 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 which took the deposition should send a representative to the offices of the Board to make the listed corrections by writing them above the original text in the transcript. See: Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

While typographical and editorial corrections may be made in a transcript, as well as other corrections necessary 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. *See Marshall Field & Co. v. Mrs. Fields Cookies,* 25 USPQ2d 1321 (TTAB 1992); *Cadence Industries Corp. v. Kerr,* 225 USPQ 331 (TTAB 1985); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982).

713.15 Objections to Testimony Depositions

For information concerning objections to testimony depositions, *see* TBMP §718.03. *See also* TBMP §534.

713.16 Confidential or Trade Secret Material

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

Cf. 37 CFR §2.120(f), and TBMP §§120.03, 416, 526, and 527.01.

714 Depositions Upon Written Questions

714.01 When Available

714.01(a) For Testimony

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

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

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

Ordinarily, the testimony of a witness may be taken either upon oral examination pursuant to 37 CFR §2.123, or by deposition upon written questions pursuant to 37 CFR §2.124. *See* 37 CFR §2.123(a)(1). For information concerning depositions upon oral examination, *see* TBMP §713.

However, if a party serves notice of the taking of a testimony 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 15 days from the

date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. *See* 37 CFR §2.123(a)(1), and TBMP §713.02 and cases cited therein.

In addition, a testimony deposition taken in a foreign country must be taken by deposition upon written questions, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate. *See* 37 CFR §2.123(a)(2), and TBMP §713.02 and cases cited therein.

714.01(b) For Discovery

37 CFR §2.120(c) Discovery deposition in foreign countries.
(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not

preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

Ordinarily, a discovery deposition may be taken either upon oral examination or upon written questions. *See* FRCP 26(a). *See also* TBMP §404.02.

However, the discovery deposition of a natural person who resides in a foreign country, and who is a party (or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or FRCP 31 (a) to testify on behalf of a party), may be taken in a foreign country only upon written questions, in the manner described in 37 CFR §2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. *See* 37 CFR §2.120(c)(1). *See also* TBMP §404.03(c)(1) and authorities cited therein.

If a natural person who is a foreign party (or an officer, director, or managing agent of a foreign party, or some other person who consents to testify on a foreign party's behalf) is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, the party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination upon notice by the party seeking discovery. *See* 37 CFR §2.120(c)(2). See also TBMP §404.03(c)(1) and authorities cited therein. However, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her deposition. *See* TBMP §404.03(c)(1) and cases cited therein.

The discovery deposition of a natural person who resides in a foreign country, and is not a party (or an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31 (a) to testify on behalf of a party), but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party. *See* TBMP §404.03(c)(2). If such a person is not willing to appear voluntarily to be deposed, his or her discovery deposition may be obtained, if at all, only through the letter rogatory procedure or the Hague Convention letter of request procedure. *See* TBMP §404.03(c)(2).

714.02 Persons Before Whom Depositions May be Taken

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

A deposition upon written questions, like a deposition upon oral examination, may be taken before the persons described in FRCP 28. *See* 37 CFR §2.124(a). For further information, *see* TBMP §713.07.

714.03 Securing Attendance of Unwilling Witness

For information concerning securing the attendance of an unwilling witness, *see* TBMP §404.03 (for discovery deposition) and 713.06 (for testimony deposition).

714.04 Time for Taking Deposition

37 CFR §2.121 Assignment of times for taking testimony.
(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. ...

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

* * *

(d)(2) ... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board

shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.

A party which desires to take testimony may do so only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. *See* 37 CFR §2.121(a)(1), and TBMP §701 and authorities cited therein. For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, *see* TBMP §§509 and 701.

A party which desires to take a testimony deposition upon written questions must serve notice thereof upon each adverse party within 10 days from the opening date of the deposing party's testimony period, as originally set or as reset. *See* 37 CFR §2.124(b)(1), and *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

Upon receipt of written notice that one or more testimony depositions are to be taken upon written questions, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions upon written questions. *See* 37 CFR §2.124(d)(2). *See also Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990), and *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

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

714.05 Place of Deposition

A testimony deposition upon written questions may be taken at any reasonable place. *Cf.* 37 CFR §2.123(c), and TBMP §713.04. An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR §2.124(d)(1)), but rather merely for the purpose of observing.

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

714.06 Notice of Deposition

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

* * *

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

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

A party which desires to take a testimony deposition upon written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof upon each adverse party. *See* 37 CFR §2.124(b)(1). *See also Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

The notice must state the name and address of the witness; and 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. *See* 37 CFR §§2.124(b)(1), 2.124(c), and 2.124(d)(1). A copy of the notice, but not of the questions, must be filed with the Board. *See* 37 CFR §2.124(b)(1).

For information concerning the notice of deposition in the case of a discovery deposition upon written questions, *see* TBMP §404.04.

714.07 Examination of Witness

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

* * *

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

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

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

(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 upon written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof upon each adverse party. *See* 37 CFR §2.124(b)(1). *See also* TBMP §714.06.

The notice must be accompanied by the written questions to be propounded on behalf of the deposing party. *See* 37 CFR §§2.124(b)(1), 2.124(c), and 2.124(d)(1). A copy of the notice, but not of the questions, must be filed with the Board. *See* 37 CFR §2.124(b)(1).

Within 20 days from the date of service of the notice (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight courier--see: 37 CFR §2.119(c)), any adverse party may serve cross questions upon the deposing party. A party which serves cross questions upon the deposing party must also serve copies thereof upon every other adverse party. Within 10 days from the date of service of the cross questions (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), any party which served cross questions may serve recross questions upon the deposing party. A party which serves recross questions upon the deposing party must also serve copies thereof upon every other adverse party. *See* 37 CFR §2.124(d)(1). *See also Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979).

Written objections to questions may be served on the party which propounded the questions. A party which serves objections on a propounding party must also serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within 10

days from the date of service of the objections (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). The substitute questions must also be served upon every other adverse party. *See* 37 CFR §2.124(d)(1). *See also Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990).

Upon motion for good cause filed by any party, or upon 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, upon receipt of written notice that one or more testimony depositions are to be taken upon written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions. *See* 37 CFR §2.124(d)(2). *See also* TBMP §714.04 and cases cited therein.

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. *See* 37 CFR §2.124(e).

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

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other deposition. *See* 37 CFR §2.123(b).

714.08 Form of Deposition

The officer before whom a deposition upon written questions is taken shall record each answer immediately after the corresponding question. *See* 37 CFR §2.124(e).

For further information concerning the form for a deposition taken in an inter partes proceeding before the Board, see 37 CFR §2.123(g), and TBMP §713.09.

714.09 Signature of Deposition by Witness

For information concerning signature of a deposition taken in an inter partes porceeding before the Board, *see* 37 CFR §2.123(e)(5), and TBMP §713.10.

714.10 Certification of Deposition

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

After a deposition upon written questions has been taken by the officer designated in the notice of deposition, the transcript of the deposition must be certified by the officer. *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 §713.11.

When the transcript has been certified, the officer should mail the transcript and exhibits to the party which took the deposition. *See* 37 CFR §2.124(e).

714.11 Service, Correction, and Filing of Deposition

37 CFR §2.124(f) *The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who*

takes the deposition to assure that the transcript is correct (see §2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by §2.120(j). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.

The party which took the deposition upon written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party. *See* 37 CFR §2.124(f). *See also* TBMP §713.13.

The party which took the deposition must also assure that the transcript is correct. *See* 37 CFR §2.124(f) and 2.125(b). For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, *see* TBMP §713.14.

If the deposition is a discovery deposition, it may be made of record as provided by 37 CFR §2.120(j). *See* 37 CFR §2.124(f). *See also*, with respect to making a discovery deposition of record, TBMP §709.

If the deposition is a testimony deposition, the original, with exhibits, must be filed promptly with the Board. *See* 37 CFR §2.124(f).

714.12 Testimony Deposition Must be Filed

While the offering of a discovery deposition in evidence is voluntary, all trial testimony depositions that are taken in a Board inter partes proceeding *must* be filed in the PTO, and, when filed, automatically constitute part of the evidentiary record in the proceeding. *See* 37 CFR §2.123(h), and TBMP §713.12.

714.13 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 upon written questions may be served on the party which propounded the questions. Any party which serves written objections upon a propounding party must also serve a copy of the objections upon every other adverse party. *See* 37 CFR §2.124(d)(1). *See also* TBMP §714.07.

Objections to questions and answers in depositions upon written questions generally are considered by the Board (unless waived) at final hearing. *See* 37 CFR §2.124(g), and *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990).

For further information concerning the raising of objections to discovery depositions, *see* TBMP §405. For information concerning the raising of objections to a notice of reliance on a discovery deposition, *see* TBMP §§718.02 and 533.

For further information concerning the raising of objections to trial testimony depositions, *see* TBMP §§718.03 and 534.

714.14 Confidential or Trade Secret Material

For information concerning the protection of confidential or trade secret material forming part of a deposition transcript or exhibits thereto, *see* 37 CFR §2.125(e), and TBMP §713.16.

714.15 Utility

A deposition upon 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 upon 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. *See* 37

CFR §2.124(d)(1); TBMP §714.07; *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985).

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country. *See* 37 CFR §§2.120(c)(1) and 2.123(a)(2), and TBMP §§404.03(c), 713.02, and 714.01. Moreover, the deposition upon written questions is generally less expensive than the deposition upon oral examination, and is usually more convenient for the witness. Thus, even for a deposition to be taken in the United States, a deposing party may prefer to use the deposition upon written questions, particularly in those cases where the testimony will be short, simple, straight-forward, and not likely to be disputed, such as, to establish for the record examples of third-party usage. *Cf. Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980).

715 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.*

Upon 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." *See* 37 CFR §2.122(f). *See also Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061 (TTAB 1988), *rev'd on other grounds*, 889 F.2d 1070, 12

USPQ2d 1901 (Fed. Cir. 1989); *MarCon Ltd. v. Avon Products Inc.*, 4 USPQ2d 1474 (TTAB 1987); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 182 (TTAB 1986); *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57 (TTAB 1975), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973).

The Board has construed the term "testimony," as used in 37 CFR §2.122(f), as meaning only trial testimony (see *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 182 (TTAB 1986)), or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

Testimony from another proceeding between the parties or their privies may be used, upon motion granted by the Board, as evidence in connection with a motion for summary judgment, or as evidence on the case, or both. See, for example: *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061 (TTAB 1988), *rev'd on other grounds*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989) (evidence on the case), and *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57 (TTAB 1975), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976) (summary judgment evidence). 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 upon 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, upon motion granted by the Board, during the appropriate trial period. *See* TBMP §§528.05(a) and 528.05(e).

For information concerning the filing of a motion for leave to use testimony from another proceeding, *see* TBMP §531.

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

716 Stipulated Evidence

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence.

For example, parties may stipulate that a party may rely upon specified responses to requests for discovery, or upon other specified documents or exhibits; or that the testimony of a witness may be submitted in the form of an affidavit by the witness; or what a particular witness would testify to if called; or to the facts in the case of any party; or that a discovery deposition may be used as testimony; or that evidence from another proceeding may be used as evidence in the proceeding in which the stipulation is filed. *See, for example*, 37 CFR §2.123(b), and TBMP §§707-711 and 713.02.

The use of stipulated evidence normally results in savings of time and expense for all concerned. However, it is usually advisable that a party reserve the right to object to stipulated evidence on the grounds of competency, relevance, and materiality. *See* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397-398 (1985).

717 Noncomplying Evidence

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

Evidence not obtained and filed in compliance with the rules of practice governing inter proceedings before the Board will not be considered by the Board. *See* 37 CFR §2.123(l). *See also Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *Plus Products v. General Mills, Inc.*, 188 USPQ 520 (TTAB 1975); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85 (TTAB 1970); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 393 (1985).

718 Objections to Evidence

718.01 In General

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

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations). *See* 37 CFR §2.122(a). *Cf.* TBMP §§101.01 and 101.02.

A party to a Board inter partes proceeding which believes that evidence proffered therein by another party should, under the foregoing rules, be excluded from consideration, may, if it so desires, raise an objection thereto. The procedure for raising an objection to proffered evidence depends upon the nature of the evidence and the ground for objection.

718.02 Objections to Notices of Reliance

718.02(a) On Ground of Untimeliness

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. Rule 2.120(j), 37 CFR §2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under FRCP 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). Rule 2.122(d)(2), 37 CFR §2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Rule 2.122(e), 37 CFR §2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. See also TBMP §§703.02(a), 703.02(b), 703.03, and 707-711.

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. Alternatively, an adverse party may raise this ground for objection in its brief on the case. *See, for example, Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990); *May Department Stores Co. v. Prince*, 200 USPQ 803 (TTAB 1978); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); and *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (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 upon seasonable objection).

For information concerning motions to strike notices of reliance, *see* TBMP §533.

718.02(b) On Other Procedural Grounds

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 CFR §2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, or does not indicate the general relevance thereof. *See, for example, Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954 (TTAB 1985); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949 (TTAB 1981); *Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478 (TTAB 1975); *Rogers Corp. v. Fields Plastics & Chemicals, Inc.*, 172 USPQ 377 (TTAB 1972); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123 (TTAB 1971). For information concerning objection on the ground of untimeliness, *see* TBMP §718.02(a).

Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike. However, if the ground for the objection is one which could not be cured even if raised promptly, the adverse party may wait and raise the procedural objection in its brief on the case. *See, for example, Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986)

(defect could have been cured); *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) (defect could have been cured); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73 (TTAB 1983) (objection raised in brief sustained); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653 (TTAB 1976) (defect could have been cured); and *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18 (TTAB 1976) (defect could have been cured). *See also Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977), and TBMP §718.02(a). For information concerning motions to strike notices of reliance, *see* TBMP §533.

When, upon 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 party which filed the notice of reliance time in which to cure the defect, failing which the notice will stand stricken. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990); and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842 (TTAB 1988).

If a motion to strike a notice of reliance raises objections which 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. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992), and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990). 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.

718.02(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 the objecting party's brief on the case, rather than by motion to strike, unless the ground for objection is one which could be cured if raised promptly by motion to strike. *See*, in this regard, 37 CFR §2.123(k), and FRCP 32(d)(3)(A). *See also* Louise E. Fruge', *TIPS FROM THE TTAB: An "Object" Lesson*, 72 Trademark Rep. 211 (1982). *Cf.* TBMP §§718.02(b) and 718.03(c).

This is because it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. *See* TBMP §502.01, and authorities cited therein. If a motion to strike a notice of reliance raises objections which 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. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992), and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990).

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. *See, for example, Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467 (TTAB 1973); and *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123 (TTAB 1971). *Cf.* TBMP §718.03(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.

718.03 Objections to Trial Testimony Depositions

718.03(a) On Ground of Untimeliness

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. *See* 37 CFR §2.121(a), and TBMP §701.

When there is no such approved stipulation, or granted motion, or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety, as untimely. *See* TBMP §534.01, and authorities cited therein. Alternatively, an adverse party may raise this ground for objection in its brief on the case. *Cf.* TBMP §718.02(a), and cases cited therein.

On the other hand, when a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, an adverse party which fails to promptly object to the scheduled deposition, on the ground of untimeliness, may

be found to have waived this ground for objection, because the premature scheduling of a deposition is an error which can be corrected upon seasonable objection. *See Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991).

718.03(b) On Ground of Improper or Inadequate Notice

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

* * *

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

Before testimony depositions upon 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 (or, if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead). *See* 37 CFR §2.123(c). *See also* TBMP §713.05. *Cf.* FRCP 30(b)(1).

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. *See* 37 CFR §2.123(e)(3), and TBMP §534.02 and cases cited therein.

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. *See* 37 CFR §2.123(e)(3).

For further information concerning the motion to strike a testimony deposition for improper or inadequate notice, *see* TBMP §534.02.

718.03(c) On Other Grounds

37 CFR §2.123(e)(3) *Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

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

* * *

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

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

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

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

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

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

An adverse party may object to a testimony deposition not only on the grounds of untimeliness (*see* TBMP §718.03(a)) and improper or inadequate notice (*see* TBMP §718.03(b)), but also on the ground that the deposing party has not complied with one or more of the other procedural requirements specified in the rules governing the taking of testimony in Board inter partes proceedings. In addition, objection may be made to a testimony deposition on one or more substantive grounds, such as that the witness is incompetent to testify, or that the testimony is irrelevant or constitutes hearsay or improper rebuttal. The time and procedure for raising these objections is described below.

Some objections to testimony depositions must be raised promptly, failing which they are waived. The objections which are waived unless raised promptly are basically procedural in nature. They include objections to errors and irregularities in the notice for taking a deposition (waived unless written objection is promptly served upon the party giving the notice; in the case of an objection based upon improper or inadequate notice, waived unless the provisions of 37 CFR §2.123(e)(3) are followed--*see* TBMP §718.03(b)); 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); and objections based on errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented (waived unless seasonable objection thereto is made at the taking of the deposition). *See* 37 CFR §§2.123(e)(3) and 2.123(j), and FRCP 32(d)(1),(2), and (3)(A) and (B). *See also Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389 (TTAB 1985); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984); and TBMP §718.03(a). *Cf.* TBMP §718.02(b), and *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729 (TTAB 1976), *pet. to Comm'r den.*, 198 USPQ 485 (Comm'r 1977).

Moreover, notice will not be taken of merely formal or technical objections, unless they were timely raised, and appear to have wrought a substantial injury to the

party raising them. *See* 37 CFR §2.123(j); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986); and *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984). *See also* FRCP 61. 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.). *See* FRCP 61, and *Pass & Seymour, Inc. v. Syrelec*, *supra*.

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 which might have been obviated or removed if presented at that time. These objections, which are basically substantive in nature, include objections (1) to the competency of a witness, or (2) to the competency, relevance, or materiality of testimony, or (3) that the testimony constitutes hearsay or improper rebuttal. *See* 37 CFR §2.123(k); FRCP 32(d)(3)(A); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986); and *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985). When an objection of this type could not have been obviated or removed if presented at the deposition, it will be considered by the Board even if the objection is raised for the first time in a party's brief on the case. *See* Louise E. Fruge', *TIPS FROM THE TTAB: An "Object" Lesson*, 72 Trademark Rep. 211 (1982). *Cf. Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992).

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. *See, for example, Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *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); and *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469 (TTAB 1973). *Cf.* TBMP §718.02(c). This is because depositions are taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to final decision. *See* TBMP §502.01, and authorities cited therein. 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. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, *supra*; *Primal*

Feeling Center of New England, Inc. v. Janov, supra; and *Globe-Union Inc. v. Raven Laboratories Inc., supra*. *Cf.* TBMP §718.02(c).

Similarly, if the propriety of a procedural (i.e., technical or formal) objection to a testimony deposition cannot be determined without reading the deposition, or examining other trial evidence, it generally will not be considered by the Board until final hearing. *Cf.* TBMP §718.02(b); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990).

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 §§534.01 and 718.03(a); and the objection based upon improper or inadequate notice of the taking of a deposition, which is the subject of the motion to strike procedure described in 37 CFR §2.123(e)(3) and TBMP §534.02 and 718.03(b)), generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the rules cited above, or orally "on the record" at the taking of the deposition, as appropriate. These objections, if properly asserted and not waived or rendered moot, normally will be considered by the Board in its determination of the case at final hearing. *See* 37 CFR §2.123(k). *Cf.* TBMP §718.02(c).

When a deposition is taken upon 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 upon the party propounding the subject questions. A party which serves written objections upon a propounding party must also serve a copy of the objections upon every other adverse party. *See* 37 CFR §2.124(d)(1), and TBMP §714.07. Objections to questions and answers in depositions upon written questions generally are considered by the Board (unless waived) at final hearing. *See* TBMP §714.13.

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

718.03(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 which is, for example, privileged or confidential. *See* TBMP §404.02, and authorities cited therein.

If a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by the unwieldy process of adjourning the deposition and applying, under 35 U.S.C. §24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. *See* TBMP §404.02, and authorities cited therein.

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 §§404.02 and 718.03(c), and authorities cited therein. 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. *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346 (TTAB 1983); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982); *Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109 (TTAB 1981); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615 (TTAB 1981); *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953). *Cf. Land v. Regan*, 342 F.2d 92, 144 USPQ 661 (CCPA 1965). *But see University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983).

For information concerning refusal to answer a discovery deposition question, see: TBMP sections 404.02, 404.03(b)(2), 405.03, 415.03, and 523.

718.04 Waiver of Objection

INTRODUCTION OF EVIDENCE

A party may waive an objection to evidence by failing to raise the objection at the appropriate time. *See* 37 CFR §§2.123(e)(3), 2.123(j), and 2.123(k); FRCP 32(d)(1),(2), and (3)(A) and (B); and TBMP §§718.02 and 718.03.

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 which could not have been cured even if raised promptly. *See* TBMP §§718.02(a) and 718.02(b), and authorities cited therein.

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 §§718.03(a), 718.03(b), and 718.03(c), and authorities cited therein.

On the other hand, objections to a notice of reliance, or to a testimony deposition, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly. *See* TBMP §§718.02(c) and 718.03(c), and authorities cited therein.

If testimony is submitted in affidavit form by stipulation of the parties pursuant to 37 CFR §2.123(b), any objection which is waived if not made at deposition must be raised promptly after receipt of the affidavit submission, failing which it is waived. *See Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389 (TTAB 1985).

If a party fails to attend a testimony deposition, any objection which is waived if not made at the deposition, is waived. *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, at 23132, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, at 22; *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769 (TTAB 1985); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 274 (1984).

Additionally, a party may waive an objection which was seasonably raised at trial, by failing to preserve the objection in its brief on the case. *See Reflange, Inc. v. R-*

Con International, 17 USPQ2d 1125 (TTAB 1990); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217 (TTAB 1982); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317 (TTAB 1979); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977).