

CHAPTER 400 DISCOVERY

401 In General

402 Scope of Discovery

403 Timing of Discovery

404 Discovery Depositions

405 Discovery Deposition Objections

406 Interrogatories

407 Responses to Interrogatories

408 Requests for Production of Documents and Things

409 Responses to Requests for Production

410 Requests for Admission

411 Responses to Requests for Admission

412 Duties to Cooperate, Search Records, Supplement

413 Filing Discovery Requests and Responses With Board

414 Motions Attacking Requests for Discovery

415 Remedy for Failure to Provide Discovery

416 Protective Orders

417 Telephone and Pre-trial Conferences

418 Discovery Sanctions

419 Discovery Guidelines

DISCOVERY

401 In General

Through the use of the various discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in inter partes proceedings before the Board, a party may ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case; simplify the issues; or reveal a basis for a motion for summary judgment, an additional claim (in the case of a plaintiff), or an additional defense or counterclaim (in the case of a defendant). At the very least, discovery enables the discovering party to better prepare for trial. For a discussion of the purposes served by discovery, see *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979). See also *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978).

The conduct of discovery in Board inter partes proceedings is governed by 37 CFR §2.120. Discovery before the Board under 37 CFR §2.120 is similar in many respects to discovery before the Federal district courts under the Federal Rules of Civil Procedure. In fact, the discovery provisions of the Federal Rules of Civil Procedure are applicable in Board inter partes proceedings, except as otherwise provided in 37 CFR §2.120 and "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). The differences that do exist between the two discovery systems are due primarily to the administrative nature of Board proceedings. See *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor upon those which do not. See: TBMP section 412.01.

402 Scope of Discovery

402.01 In General

The general scope of the discovery which may be obtained in inter partes proceedings before the Board is governed by FRCP 26(b)(1), which provides, in part, as follows:

DISCOVERY

Parties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action, whether it relates to the claim or defense of the party seeking discovery or to the claim or defense of any other party, including the existence, description, nature, custody, condition and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. The information sought need not be admissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence.

See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975).

A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact. *See* FRCP 33(c) and 36(a); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); and *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973).

A party may take discovery not only as to matters specifically raised in the pleadings (*see Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975), and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286 (TTAB 1974)), but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974). The taking of discovery cannot, under any circumstances, be construed as an attack upon any registration. *See Johnson & Johnson v. Rexall Drug Co.*, *supra*, and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way. *See Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

DISCOVERY

402.02 Limitations on Right to Discovery

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, inter alia, it is unreasonably cumulative or duplicative; or is obtainable from some other source that is more convenient, less burdensome, or less expensive; or "where no need is shown, or compliance would be unduly burdensome, or where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information." *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990), and FRCP 26(b)(2). See also *Haworth Inc. v. Herman Miller Inc.*, 998 F.2d 975, 27 USPQ2d 1469 (Fed. Cir. 1993), and *Katz v. Batavia Marine & Sporting Supplies Inc.*, 984 F.2d 422, 25 USPQ2d 1547 (Fed. Cir. 1993).

For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. 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); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346 (TTAB 1974); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286 (TTAB 1974).

Nor will a party be permitted to obtain, through a motion to compel, discovery broader in scope than that actually sought in the discovery request(s) to which the motion pertains. See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980).

The Board may refuse to permit the discovery of confidential commercial information, or may allow discovery thereof only under an appropriate protective order. See, for example FRCP 26(c); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Sunkist Growers*,

DISCOVERY

Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); and *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974).

Similarly, information protected by the attorney-client privilege is not discoverable unless the privilege has been waived; and documents and things prepared in anticipation of litigation or for trial by or for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means. *See*, for example *FRCP 26(b)(3)*; *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974).

In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of *FRCP 26(g)*, a certification by the party or its attorney that, *inter alia*, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986); *Medtronic, Inc. v. Pacemaker Systems, Inc.*, 222 USPQ 80 (TTAB 1984); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623 (TTAB 1974); and *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477 (TTAB 1974). *See also* TBMP §412.01. A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. *See Miss America Pageant v. Petite Productions, Inc.*, *supra*.

DISCOVERY

403 Timing of Discovery

403.01 In General

The discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period. *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978). A party has no obligation to respond to an untimely request for discovery.

When a defendant's answer to a complaint is received by the Board, the Board prepares and sends out to the parties a trial order, wherein the Board acknowledges receipt of the answer; specifies the closing date for the taking of discovery; and assigns each party's time for taking testimony. *See* 37 CFR §§2.120(a) and 2.121(a)(1). The date set for the close of discovery normally is 90 days after the mailing date of the trial order.

The opening of the discovery period hinges upon the commencement of the proceeding, and service of the complaint upon the defendant by the Board; it is not contingent upon joinder of issues. *See Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990); *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141 (TTAB 1975); "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994); and Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34892, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 31.

403.02 Time for Service of Discovery Requests

Interrogatories, requests for production of documents and things, and requests for admission may be served upon the plaintiff after the proceeding commences, and upon the defendant with or after service of the complaint by the Board. *See* "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994); Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34892, and in the *Official Gazette* of

DISCOVERY

September 12, 1989 at 1106 TMOG 26, 31; and *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993).

Discovery depositions generally may be taken by any party after commencement of the proceeding. However, the Board's permission must be obtained under the following circumstances:

(1) If a plaintiff seeks to take a deposition prior to the expiration of 30 days after service of the complaint by the Board upon any defendant, except that permission is not required if the defendant has itself served a notice of taking deposition or otherwise sought discovery, or if the plaintiff's notice (i) states that the proposed deponent is about to go out of the United States, or is bound on a voyage to sea, and will be unavailable for examination unless his or her deposition is taken before expiration of the 30-day period, and (ii) sets forth facts to support the statement; or

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

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

See FRCP 30(a); "*Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings*," 1159 TMOG 14 (February 1, 1994); *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993); and *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141 (TTAB 1975).

An opposition or cancellation proceeding commences when the complaint, i.e., the notice of opposition or petition to cancel, is filed. See 37 CFR §§2.101(a) and 2.111(a). In an interference or concurrent use proceeding, there is no "complaint," as such; rather, the notice of institution and accompanying materials take the place of a complaint, and the proceeding commences when the Board mails the notice to each party. See 37 CFR §§2.93, 2.99(c), and 2.99(d)(1), and TBMP §§1003 and 1105.

Interrogatories, requests for production of documents and things, and requests for admission may be served upon an adversary through the last day of discovery, even though the answers thereto will not be served until after the discovery period has closed. See *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978); *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974); *AMP Inc. v. Raychem Corp.*, 179 USPQ 857 (TTAB 1973); and *Deere & Co. v. Deerfield Products Corp.*, 176 USPQ 422 (TTAB

DISCOVERY

1973). However, discovery depositions must be not only noticed but also taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, *supra*.

403.03 Time for Service of Discovery Responses

Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days after the date of service of the request for discovery; except that a defendant may serve responses either within 30 days after service of a discovery request, or within 45 days after service of the complaint upon it by the Board, whichever is later. *See* FRCP 33(b)(3), 34(b), and 36(a), and "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). If service of the request for discovery is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the request. *See* 37 CFR §2.119(c), and TBMP §113.05. *See also Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987).

Discovery in proceedings before the Board is not governed by any concept of priority of discovery or deposition. That is, a party which is the first to serve a request for discovery does not thereby gain a right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Rather, a party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery. *See* FRCP 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986).

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to

DISCOVERY

have forfeited its right to object to the discovery request on its merits. *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

403.04 Extensions

37 CFR §2.121(a)(1) ... *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.*

The closing date of the discovery period may be extended by stipulation of the parties approved by the Board, or upon motion (pursuant to FRCP 6(b)) granted by the Board, or by order of the Board. An extension of the closing date for discovery will result in a corresponding extension of the testimony periods without action by any party. *See* 37 CFR §2.121(a)(1). For information concerning stipulations to extend, *see* TBMP §501.03. For information concerning motions to extend, *see* TBMP §509.

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987), and Janet E. Rice, *TIPS FROM THE TTAB: The Timing of Discovery*, 68 Trademark Rep. 581 (1978). *See also American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992). Thus, a party which waits until the waning days of the discovery period to serve interrogatories, requests for production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto after the close of the discovery period, that it needs an extension of the discovery period in order to take "follow-up" discovery.

DISCOVERY

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, rob its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990), and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975).

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

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

403.05 Need for Early Initiation of Discovery

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

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

DISCOVERY

403.05(b) To Allow Time for Summary Judgment Motion

37 CFR §2.127(e)(1) A motion for summary judgment should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Trademark Trial and Appeal Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter.

A party which has been served with interrogatories, requests for production of documents and things, and/or requests for admission is allowed 30 days from the date of service in which to respond thereto (or, in the case of a defendant, 30 days from service of the request or 45 days after service of the complaint upon it by the Board, whichever is later), plus an extra 5 days if service of the requests for discovery was made by first-class mail, "Express Mail," or overnight courier. *See* TBMP §403.03. If requests for discovery are served at the end of the discovery period, responses thereto may not be received until well after the beginning of the plaintiff's main testimony period, which opens 30 days after the closing date of the discovery period.

A summary judgment motion, however, should be filed prior to the commencement of the plaintiff's main testimony period, and may be denied as untimely if it is filed thereafter. *See* 37 CFR §2.127(e)(1).

Therefore, if a party wishes to have an opportunity to file a motion for summary judgment based upon discovery responses received from its adversary, it must serve its discovery requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and file the summary judgment motion prior to the commencement of the plaintiff's main testimony period.

403.05(c) To Facilitate Introduction of Produced Documents

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

DISCOVERY

There are a number of different methods by which documents produced in response to a request for production of documents may be made of record. *See*, in this regard, TBMP §711. Three of the easiest methods are available for use only if the request for production of documents is served relatively early in the discovery period.

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

Second, if the discovery period has not yet expired, the party which obtained the documents may make them of record by taking a discovery deposition of its adversary, marking the documents as exhibits thereto, and having the witness identify the documents during the deposition.

Third, the request for production of documents may be combined with a notice of the taking of the adversary's discovery deposition; that is, the combined request and notice may ask that the deponent bring the requested documents to his or her deposition. However, a party served with a request for production of documents has 30 days from the date of service of the request in which to respond thereto (or, in the case of a defendant, 30 days from service of the request or 45 days after service of the complaint upon it by the Board, whichever is later), plus an extra 5 days if service of the request was made by first-class mail, "Express Mail," or overnight courier. *See* TBMP §403.03. Moreover, in proceedings before the Board, a discovery deposition must be both noticed and taken before the end of the discovery period. *See* TBMP §403.02. Thus, a combined notice of deposition and request for production of documents normally must be served at least 35 days prior to the close of the discovery period.

404 Discovery Depositions

404.01 When and By Whom Taken

DISCOVERY

After commencement of an inter partes proceeding before the Board, discovery depositions generally may be taken by any party. However, the Board's permission must be obtained under the following circumstances:

(1) If a plaintiff seeks to take a deposition prior to the expiration of 30 days after service of the complaint by the Board upon any defendant, except that permission is not required if the defendant has itself served a notice of taking deposition or otherwise sought discovery, or if the plaintiff's notice (i) states that the proposed deponent is about to go out of the United States, or is bound on a voyage to sea, and will be unavailable for examination unless his or her deposition is taken before expiration of the 30-day period, and (ii) sets forth facts to support the statement; or

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

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

See FRCP 30(a); *"Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings,"* 1159 TMOG 14 (February 1, 1994); *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993); and *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141 (TTAB 1975).

An opposition or cancellation proceeding commences when the complaint, i.e., the notice of opposition or petition to cancel, is filed. *See* 37 CFR §§2.101(a) and 2.111(a). In an interference or concurrent use proceeding, there is no "complaint," as such; rather, the notice of institution and accompanying materials take the place of a complaint, and the proceeding commences when the Board mails the notice to each party. *See* 37 CFR §§2.93, 2.99(c), and 2.99(d)(1), and TBMP §§1003 and 1105.

Discovery depositions must be both noticed and taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978); and TBMP §403.02.

404.02 Compared to Testimony Depositions

DISCOVERY

A discovery deposition, like a testimony deposition, may be taken either upon oral examination or upon written questions. *See* FRCP 26(a). In fact, the actual taking of a discovery deposition is very similar to the taking of a testimony deposition. Nevertheless, there are substantial differences between the two, stemming from the differences between the discovery and trial stages of a proceeding. Some of the most significant differences are discussed below.

A discovery deposition is a device used by a party to obtain from an adversary information about the adversary's case, or to obtain from a nonparty information which may be helpful to the deposing party's case. The discovery deposition is taken of the adversary or a nonparty, or an official or employee of the adversary or a nonparty. A testimony deposition, on the other hand, is a device used by a party to present evidence in support of its own case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party. *See Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978); and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time. *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978); TBMP §403.02. A testimony deposition may only be taken by a party during the party's assigned testimony period; each party has an assigned testimony period, and only the party to which a particular testimony period is assigned may take testimony therein. *See* 37 CFR §2.121(a)(1).

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence. *See* FRCP 26(b)(1). In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection. *See* 37 CFR §§2.122(a) and 2.123(k), and TBMP §534.

In both types of depositions, questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential. *See* 37 CFR §2.123(e)(4); FRCP 26(b)(5), 30(c), and 37(a)(2)(B); FRE 501; 4A *Moore's*

DISCOVERY

Federal Practice, ¶ 30.59 (2d ed. 1984); and Wright & Miller, *Federal Practice and Procedure: Civil* §2113 (1970). Both types of depositions are taken out of the presence of the Board, and if a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by adjourning the deposition and applying, under 35 U.S.C. 24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. See *Ferro Corp. v. SCM Corp.*, 219 USPQ 346 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); *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). In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the Board to compel the witness to answer the unanswered question. See 37 CFR §2.120(e) and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*. A motion to compel is not available, however, in the case of a testimony deposition taken in a proceeding before the Board, nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. See *Ferro Corp. v. SCM Corp.*, *supra*; *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, *supra*; and *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, *supra*. Accordingly, in those cases where the witness in a *testimony* deposition refuses to answer a particular question; no court action is sought; and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony. See TBMP §718.03(d), and authorities cited therein.

A discovery deposition does not form part of the evidentiary record in a case unless a party entitled to offer it into evidence files, during the party's testimony period, the deposition together with a notice of reliance thereon. That is, the offering of a discovery deposition in evidence is voluntary, not mandatory. See, for example, 37 CFR §§2.120(j)(1), (j)(2), and (j)(3)(i); TMBP §709; *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Reporter 353 (1980). Every testimony deposition taken *must* be filed, and, when filed, becomes part of the record; a notice of reliance thereon is not necessary. See generally 37 CFR §2.123, and TBMP §713.12.

DISCOVERY

For further information concerning differences between discovery and testimony depositions, *see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978); and Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

404.03 Securing Attendance of Deponent

404.03(a) In General

A discovery deposition may be taken of any person, whether or not the person is a party, and whether or not the person resides in the United States.

404.03(b) Person Residing in the United States

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

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

The deposition may be taken either orally, or upon written questions in the manner described in 37 CFR §2.124. *See* FRCP 26(a)(5), 30, and 31. For information on the taking of a deposition upon written questions, *see* TBMP §714.

404.03(b)(1) Person Residing in United States--Party

If a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, the deposition may be taken upon notice alone. *See* 37 CFR §2.120(b); FRCP 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582 (TTAB 1976); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). For information concerning notices of deposition, *see* TBMP §404.04.

DISCOVERY

404.03(b)(2) Person Residing in United States--Nonparty

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

... The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. (See 35 U.S.C. 24)

If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent. *See* 37 CFR §2.120(b). If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. §24 and FRCP 45. The subpoena must be issued from the United States District Court in the Federal judicial district where the deponent resides or is regularly employed. *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383-384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and FRCP 30(a)(1) and 45. *Cf. Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582 (TTAB 1976); and TBMP §713.06(b).

If a person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States District Court which issued the subpoena; the Board has no jurisdiction over such depositions. *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, 383-384 (1985); and

DISCOVERY

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

404.03(c)(1) Person Residing in a Foreign Country--Party

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

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

(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.

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 31(a)(3) to testify on behalf of a party, may be taken upon notice alone. See 37 CFR §§2.120(c) and 2.124.

DISCOVERY

However, if the discovery deposition of such a person is taken in a foreign country, it must be taken 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* *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989); *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984). *Cf.* TBMP §713.02. For information on the taking of a deposition upon written questions, *see* TBMP §714.

The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. *See Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978); *Miller v. N. V. Cacao-En Chocoladefabrieken Boon*, 142 USPQ 364 (E.D. N.Y. 1964); and Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253 (1980). *See also* *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983).

However, whenever a natural person who is a foreign party, or an officer, director, or managing agent, of a foreign party, or some other person who consents to testify on a foreign party's behalf, is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination upon notice pursuant to 37 CFR §2.120(c)(2). *See also* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984). Indeed, this option was available even before the adoption of 37 CFR §2.120(c)(2). *See* *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978). The place, within the United States, where the deposition is to be taken is specified in 37 CFR §2.120(c)(2).

DISCOVERY

404.03(c)(2) Person Residing in Foreign Country--Nonparty

The discovery deposition of a natural person who resides in a foreign country, and is not a party, or an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party, i.e., in the manner described in TBMP §404.03(c)(1). *Cf.* 37 CFR §§2.120(c) and 2.123(a).

There is no certain procedure for obtaining, in an inter partes proceeding before the Board, the discovery deposition of a natural person who resides in a foreign country, is not a party, or an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, and does not agree to appear voluntarily to be deposed. However, a party may be able to obtain the discovery deposition of such a person through the letter rogatory procedure, whereby an unwilling nonparty witness in a foreign country sometimes may be compelled to respond to questions routed through diplomatic channels to an appropriate judicial authority in the foreign country. *See, in general, Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). Cf. DBMS Consultants Ltd. v. Computer Associates International, Inc., 18 FR Serv3d 33, 131 FRD 367 (D. Mass. 1990).*

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

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

DISCOVERY

37 F. Supp. 819, 820.

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

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

A party which wishes to have the Board issue a letter rogatory should file a written request therefor with the Board. *See* FRCP 28(b). The party must also submit an original and two copies of the proposed letter rogatory, and an original and two copies of the questions to be propounded to the nonparty witness. If the official language of the foreign country is not English, the propounding party must submit an original and two copies of the letter rogatory and questions in English, and an original and two copies thereof translated into the official language. In addition, the propounding party must serve upon each adverse party a copy of every paper submitted to the Board. *See* 37 CFR §2.119(a). *Cf.* 37 CFR §2.124(b)(2).

If the request is granted, each adverse party will be given an opportunity to submit cross questions, a copy of which must also be served upon the propounding party. If an adverse party does submit cross questions, the propounding party, in turn, will be given an opportunity to submit redirect questions, a copy of which must be served upon each adverse party. *Cf.* 37 CFR §2.124(d)(1). As in the case of the initial questions, an original and two copies of any cross questions and redirect questions must be submitted to the Board; if the official language of the foreign country is not English, an original and two copies of the questions in English, and an original and two copies thereof translated into the official language, must be submitted.

After the original and copies of the letter rogatory, and of all of the questions, have been submitted to the Board, and the letter rogatory has been approved as to form, the letter rogatory will be issued by the Board. The letter rogatory will be signed

DISCOVERY

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

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

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

Once the letter rogatory has been received by the appropriate foreign judicial authority, it may or may not be executed. As indicated above, the letter rogatory "rests entirely upon the comity of courts towards each other." Some countries refuse or are reluctant to lend assistance in the taking of a discovery deposition in their country through the letter rogatory procedure, and compliance with the procedural requirements for a letter rogatory does not ensure that the requested deposition will be completed. See NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to FRCP 28(b), and Wright & Miller, *Federal Practice and Procedure*: Civil 2d §2083 (1970). Before a request for issuance of a letter rogatory is filed with the Board, the requesting party should examine the law and policy of the involved foreign country, and consult with the Office of Citizens Consular Services, Department of State, in order to determine

DISCOVERY

whether the country in question is likely to honor a letter rogatory, particularly a letter rogatory issued by the Board.

Even in those foreign countries which are not reluctant to execute a letter rogatory, the foreign judicial authority may refuse to honor a letter rogatory issued by the Board (an administrative tribunal) rather than by a United States district court. Further, if the foreign country has a "blocking statute" prohibiting its residents from disclosing certain types of information in judicial or administrative proceedings outside of the foreign country, a letter rogatory may not be honored if the foreign judicial authority believes that disclosure of the information requested therein would violate the blocking statute. *See* Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985).

If a letter rogatory is honored, its probative value may be limited. In executing the letter rogatory, the foreign judicial tribunal will follow its customary procedures for taking testimony. The fact that these procedures may differ from those normally followed in proceedings before the Board does not mean that the deposition must necessarily be excluded. Rather, any such differences are matters to be considered by the Board in determining the probative value of the deposition. *See* FRCP 28; NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to FRCP 28(b); 4 *Moore's Federal Practice*, ¶28.05 (2d ed. 1984); and Wright & Miller, *Federal Practice and Procedure: Civil* 2d §2083 (1970).

A party considering the filing of a request for issuance of a letter rogatory should bear in mind not only the complexity and uncertain outcome of the procedure, but also its time-consuming nature. The entire process, from the filing of the initial request for issuance of a letter rogatory, to receipt by the Board either of the completed deposition, or of notification that the letter rogatory will not be honored, will consume months, if not years. During the interim, proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory. *Cf.* 37 CFR §2.124(d)(2).

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

DISCOVERY

deposition of an unwilling nonparty witness residing in a foreign country, if the foreign country is a member of the Convention. See, for example, *Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522 (1987); *In re Anschuetz & Co., GmbH*, 838 F.2d 1362 (5th Cir. 1988); Wright & Miller, *Federal Practice and Procedure: Civil* 2d §2005 (1970); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985). For general information concerning the Hague Convention, see *Double J of Broward Inc. v. Skalongy Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) [NOTE: this case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

The Hague Convention provides for the compulsion of evidence (including the deposition of an unwilling witness) in a member country pursuant to a "letter of request," which is very similar in nature to a letter rogatory. For information concerning the letter of request procedure under the Hague Convention, see Chapter 1 of the Convention. See also *Double J of Broward Inc. v. Skalongy Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991). However, the Board has been advised by the Department of State that foreign countries are more likely to lend assistance in the taking of a discovery deposition if the request therefor is made under the more formal letter rogatory procedure. Before filing a motion for issuance of a letter of request, the moving party should consult with the Office of Citizens Consular Services, Department of State, in order to determine whether the foreign country in question is likely to honor a letter of request, particularly a letter of request issued by the Board.

404.04 Notice of Deposition

FRCP 30(b) Notice of Examination: General Requirements; ...

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

DISCOVERY

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

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

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

Prior to the taking of a discovery deposition upon notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party. *See* FRCP 30(b)(1), and 37 CFR §§2.120(c), 2.124(b)(2), and 2.124(c). *Cf.* 37 CFR §2.123(c); FRCP 31(a)(3); and TBMP §713.05. The elements to be included in the notice are specified in FRCP 30(b)(1), for a deposition upon oral examination, and in 37 CFR §§2.124(b)(2) and 2.124(c), for a deposition upon written questions. It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition. The deposition must be taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). *See* TBMP §403.02.

In noticing the deposition of a corporation, partnership, association, governmental agency, or other juristic person, the deposing party may, in lieu of naming a person to be deposed, simply name as the deponent the corporation, partnership, association, governmental agency, or other juristic person, and describe with reasonable particularity the matters on which examination is requested. The named organization must, in turn, designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may

DISCOVERY

state, for each person designated, the matters on which he or she will testify. Each designated person must testify not only as to those matters within his or her knowledge, but also as to matters known or reasonably available to the organization. *See* FRCP 30(b)(6) and 31(a)(3), and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383 (1985).

The discovery deposition of a person who resides in the United States must be taken in the Federal judicial district where the deponent resides or is regularly employed or at any place on which the parties agree by stipulation. *See* 37 CFR §2.120(b).

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

404.05 Taking a Discovery Deposition

The procedure for taking a discovery deposition in an inter partes proceeding before the Board is very similar to that for taking a testimony deposition. *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991). For information concerning the procedure for taking a testimony deposition, *see* TBMP §§713 and 714. For a discussion of significant differences between the two types of depositions, *see* TBMP §404.02.

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 Federal judicial district and at the place where the witness is to answer the questions propounded to him or her.

405 Discovery Deposition Objections

DISCOVERY

405.01 Objections to Notice

Objections to errors and irregularities in a notice of the taking of a discovery deposition must be promptly served, in writing, on the party giving the notice; any such objections which are not promptly served are waived. *See* FRCP 32(d)(1). *Cf.* 37 CFR §2.123(j). *Cf. also* *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991); *Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 (TTAB 1982); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729 (TTAB 1976), petition to Commissioner denied, 198 USPQ 485 (Comm'r 1977); *O.M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973).

405.02 Objections as to Disqualification of Officer

An objection to the taking of a discovery deposition because of a disqualification of the officer before whom the deposition is to be taken, is waived unless it is made before the deposition begins, or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence. *See* FRCP 32(d)(2). *Cf.* 37 CFR §2.123(j).

405.03 Objections During Deposition

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

(B) Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be

DISCOVERY

obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.

Objections to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony "are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time." *See* FRCP 32(d)(3)(A). *Cf.* 37 CFR §2.123(k).

In the case of a discovery deposition taken upon oral examination, objections to errors and irregularities occurring at the deposition in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and objections to errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonably made at the deposition. *See* FRCP 32(d)(3)(B). *Cf.* 37 CFR §2.123(j).

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Questions objected to ordinarily should be answered 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* 37 CFR §2.123(e)(4); FRCP 26(b), 30(c), and 37(a); FRE 501; 4A *Moore's Federal Practice*, ¶30.59 (2d ed. 1984); and Wright & Miller, *Federal Practice and Procedure: Civil* §2113 (1970). *See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974).

If a witness, having stated an objection to a discovery deposition question, answers the question subject to the objection, and the deposition is subsequently made of record in the proceeding pursuant to the provisions of 37 CFR §§2.120(j)(1), (2), (3)(i), and (4), the propriety of the objection will be considered by the Board at final hearing; that is, the Board will evaluate the testimony in light of the stated objection. *See* 37 CFR §2.120(j)(3)(i), and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974).

For information concerning the propounding party's options if a witness not only objects to, but also refuses to answer, a particular question, *see* TBMP §415.03.

DISCOVERY

406 Interrogatories

406.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written interrogatories upon any other party. *See* TBMP §403.01. Interrogatories may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition to cancel is filed, in an opposition or cancellation, or after the notice of institution is mailed, in an interference or concurrent use proceeding), and upon the defendant with or after service by the Board of the "complaint" (i.e., the notice of opposition or petition for cancellation, in an opposition or cancellation proceeding; and the notice of institution, in an interference or concurrent use proceeding). *See* TBMP §403.02.

Interrogatories may be served upon an adversary through the last day of discovery, even though the answers thereto will not be served until after the discovery period has closed. *See* TBMP §403.02.

406.02 Scope

Interrogatories may seek any information which is discoverable under FRCP 26(b)(1). *See* FRCP 33(c). An interrogatory which is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact. *See* FRCP 33(b); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); and *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973).

406.03 Limit on Number

406.03(a) Description of Limit

37 CFR §2.120(d)(1) *The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow*

DISCOVERY

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

For information concerning motions for leave to serve additional interrogatories, *see* TBMP §519.

406.03(b) Application of Limit: Sets of Interrogatories

The numerical limit of 37 CFR §2.120(d)(1) pertains to the total number of interrogatories that one party may serve upon another party over the course of an entire proceeding, not just per set of interrogatories. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of interrogatories directed to the same party, the interrogatories in the separate sets will be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 UPSQ2d 1466 (TTAB 1990); Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886 and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26; and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

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

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

Rule 2.120(d)(1) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the

DISCOVERY

information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional interrogatories. However, a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex issues, and these are factors which will be considered in determining a motion for leave to serve additional interrogatories. *See* Notice of Final Rulemaking, published in the *Federal Register* on August 22, 1989 at 54 FR 34886 and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

406.03(d) Application of Limit: Counting Interrogatories

In determining whether the number of interrogatories served by one party upon another exceeds the limit of 37 CFR §2.120(d)(1), the Board will count each subpart within an interrogatory as a separate interrogatory, regardless of whether the subpart is separately designated (i.e., separately numbered or lettered). *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

If an interrogatory includes questions set forth as numbered or lettered subparts, each separately designated subpart will be counted by the Board as a separate interrogatory. The propounding party will, to that extent, be bound by its own numbering system, and will not be heard to complain that an interrogatory, although propounded with separately designated subparts, should nevertheless be counted as a single interrogatory because the interrogatory concerns a single transaction, state of facts, etc., or because the division was made for clarification or convenience. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies*

DISCOVERY

Corp., 16 USPQ2d 2055 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

On the other hand, if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990), and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

For example, if two or more questions are combined in a single compound interrogatory, and are not set out as separate subparts, the Board will look to the substance of the interrogatory, and count each question as a separate interrogatory. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468 (TTAB 1990); and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

If an interrogatory contains both an initial question, and follow-up questions to be answered if the first is answered in the affirmative, the initial question and each follow-up question will be counted as separate interrogatories. *See Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468 (TTAB 1990), and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

Similarly, if an interrogatory begins with a broad introductory clause ("Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:") followed by several subparts ("Applicant's date of first use of the mark on the goods listed in the application," "Applicant's date of first use of the mark on such goods in commerce," etc.), the Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated. *Cf. Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468 (TTAB 1990), and Carla

DISCOVERY

Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests "all relevant facts and circumstances" concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory. See Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990), and Notice of Final Rulemaking, published in the *Federal Register* on August 22, 1989 at 54 FR 34886 and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26.

The introductory instructions or preamble to a set of interrogatories will not be counted by the Board as interrogatories or subparts for purposes of determining whether the limit specified in 37 CFR §2.120(d)(1) has been exceeded. On the other hand, the Board's determination, on a motion to compel, of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble; the Board is not bound by the instructions or preamble, and will make its own independent determination of the adequacy of the answer, without regard to the instructions or preamble. See *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992), and Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990).

406.03(e) Remedy for Excessive Interrogatories

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

DISCOVERY

together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.

If a party upon which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR §2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. *See* 37 CFR §2.120(d)(1); Notice of Final Rulemaking, published in the *Federal Register* on September 12, 1991 at 56 FR 46376 and in the *Official Gazette* of October 22, 1991 at 1131 TMOG 54, as corrected in the *Federal Register* of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of Rule 2.120(e), including the requirement that a motion to compel be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement. *See* 37 CFR §§2.120(d)(1) and 2.120(e); Notice of Final Rulemaking, published in the *Federal Register* on September 12, 1991 at 56 FR 46376 and in the *Official Gazette* of October 22, 1991 at 1131 TMOG 54, as corrected in the *Federal Register* of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992). For further information concerning motions to compel discovery, *see* TBMP §523.

If, upon determining a motion to compel filed in response to a general objection to interrogatories on the ground of excessive number, the Board finds that the interrogatories are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not

DISCOVERY

exceeding the numerical limit. The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990); *See Rule 2.120(d)(1)*; Notice of Final Rulemaking, published in the *Federal Register* on September 12, 1991 at 56 FR 46376 and in the *Official Gazette* of October 22, 1991 at 1131 TMOG 54, as corrected in the *Federal Register* of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 UPSQ2d 1466 (TTAB 1990). However, if the revised set is not served until after the close of the discovery period, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information not sought in the excessive set. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468 (TTAB 1990); Notice of Final Rulemaking, *supra*; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*. In those cases where a party which has propounded interrogatories realizes, upon receipt of a general objection thereto on the ground of excessive number, that the interrogatories are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of interrogatories, in the manner normally allowed by the Board, instead of bringing their dispute to the Board by motion to compel. *See* Notice of Final Rulemaking, *supra*, and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, *supra*.

407 Responses to Interrogatories

407.01 Time for Service of Responses

DISCOVERY

Responses to interrogatories must be served within 30 days after the date of service of the interrogatories, except that a defendant may serve responses either within 30 days after service of the interrogatories, or within 45 days after service of the complaint upon it by the Board, whichever is later. *See* TBMP §403.03. If service of the interrogatories is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the interrogatories. *See* 37 CFR §2.119(c), and TBMP §§113.05 and 403.03.

A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits. *See* *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

407.02 Nature of Responses

Ordinarily, a party upon which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer. *See* FRCP 33(b). If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 CFR §2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. *See* 37 CFR §2.120(d)(1), and TBMP §406.03(e).

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto. *See* G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

In some cases, the information sought in an interrogatory may be derived or ascertained from the business records of the responding party, or from an

DISCOVERY

examination, audit, or inspection of those business records (including a compilation, abstract, or summary thereof), and the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party. In those cases, the responding party may answer the interrogatory by itself providing, in its written answer to the interrogatory, the information sought. Alternatively, the responding party may answer the interrogatory by specifying the records from which the information may be derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts, or summaries. If the responding party elects to answer an interrogatory by specifying and producing business records, the specification must be in sufficient detail to permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained. *See* FRCP 33(c).

It is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those interrogatories which it believes to be proper and stating its objections to those which it believes to be improper. *See* TBMP §414.

407.03 Signature of Responses

Interrogatories must be answered by the party served. If the party served is a corporation, partnership, association, or governmental agency, the interrogatories must be answered by an officer or agent, who must furnish whatever information is available to the party served. *See* FRCP 33(a) and (b).

The term "agent" includes an attorney, who may answer even though he has no personal knowledge of the facts stated in the answers; the attorney's answers, like an officer's answers, must contain the information available to the party served. *See Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663 (TTAB 1988). However, an attorney who answers interrogatories on behalf of a corporation, partnership, association, or governmental agency may thereafter be exposed to additional discovery and possibly even disqualification. *See* 37 CFR §10.63, and *Allstate Insurance Co. v. Healthy America Inc.*, *supra*.

DISCOVERY

Answers to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. *See* FRCP 33(b)(2).

408 Requests for Production of Documents and Things

408.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve requests for production of documents and things upon any other party. *See* FRCP 34(a); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978); and TBMP §403.01. Requests for production may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition to cancel is filed, in an opposition or cancellation, or after the notice of institution is mailed, in an interference or concurrent use proceeding), and upon the defendant with or after service by the Board of the "complaint" (i.e., the notice of opposition or petition for cancellation, in an opposition or cancellation proceeding; and the notice of institution, in an interference or concurrent use proceeding). *See* TBMP §403.02.

Requests for production may be served upon an adversary through the last day of discovery, even though the answers thereto will not be served until after the discovery period has closed. *See* TBMP §403.02.

If requests for production are combined with a notice of taking a discovery deposition (i.e., if it is requested that the deponent bring designated documents to the deposition), the requests for production must be served at least 35 days prior to the scheduled date of the deposition if service of the requests for production is made by first-class mail, "Express Mail," or overnight courier, and at least 30 days prior to the deposition if service of the requests for production is made by one of the other methods specified in 37 CFR §2.119(b). *See* FRCP 34(b); 37 CFR §2.119(c); and TBMP §§113.04, 113.05, and 403.03. Further, since a defendant may respond to requests for production either within 30 days after service of the requests (35 days if service of the requests is made by first-class mail, "Express Mail," or overnight courier), or within 45 days after service of the complaint upon it by the Board, whichever is later, a defendant cannot be required to produce documents at a deposition any earlier than 45 days after service of the complaint upon it by the Board.

DISCOVERY

If a discovery deposition deponent is a nonparty witness residing in the United States (*see* TBMP §404.03(b)(2)), production of designated documents by the witness at the deposition may be obtained by subpoena. *See* FRCP 45 and 35 U.S.C. §24. A subpoena is unnecessary, however, if the nonparty witness is willing to produce the documents voluntarily.

408.02 Scope

FRCP 34(a) Scope. Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on the requestor's behalf, to inspect and copy, any designated documents (including writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served; or (2) to permit entry upon designated land or other property in the possession or control of the party upon whom the request is served for the purpose of inspection and measuring, surveying, photographing, testing, or sampling the property or any designated object or operation thereon, within the scope of Rule 26(b).

The scope of a request for production, in an inter partes proceeding before the Board, is governed by FRCP 34(a), which in turn refers to FRCP 26(b). For a discussion of the scope of discovery permitted under FRCP 26(b), *see* TBMP §§402.01 and 402.02.

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

408.03 Elements of Request for Production; Place of Production

FRCP 34(b) Procedure. The request shall set forth, either by individual item or by category, the items to be inspected, and describe each with reasonable

DISCOVERY

particularity. The request shall specify a reasonable time, place, and manner of making the inspection and performing the related acts. ...

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

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

The place of production is governed by 37 CFR §2.120(d)(2). *See also Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449, 451 (1984). Upon motion pursuant to 37 CFR §2.120(d)(2), the Board may, for example, order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party, all at the requesting party's expense. *See Unicut Corp. v. Unicut, Inc.*, *supra*; Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, *supra*.

409 Responses to Requests for Production

409.01 Time for Service of Responses

Responses to requests for production must be served within 30 days after the date of service of the requests, except that a defendant may serve responses either within 30 days after service of the requests, or within 45 days after service of the complaint upon it by the Board, whichever is later. *See* TBMP 403.03. If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. *See* 37 CFR §2.119(c) and TBMP §§113.05 and 403.03.

DISCOVERY

A party which fails to respond to requests for production during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the requests on their merits. *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

409.02 Nature of Responses

A response to a request for production of documents and things must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated. If objection is made to only part of an item or category, the part must be specified. *See* FRCP 34(b).

A party which produces documents for inspection must produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request. *See* FRCP 34(b).

It is generally inappropriate for a party to respond to requests for production by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by indicating, with respect to those requests which it believes to be proper, that inspection and related activities will be permitted, and by stating reasons for objection with respect to those requests which it believes to be improper. *See* TBMP §414.

410 Requests for Admission

410.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written requests for admission upon any other party. *See* FRCP

DISCOVERY

36(a), and TBMP §403.01. Requests for admission may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition to cancel is filed, in an opposition or cancellation, or after the notice of institution is mailed, in an interference or concurrent use proceeding), and upon the defendant with or after service by the Board of the "complaint" (i.e., the notice of opposition or petition for cancellation, in an opposition or cancellation proceeding; and the notice of institution, in an interference or concurrent use proceeding). *See* TBMP §403.02.

Requests for admission may be served upon an adversary through the last day of discovery, even though the responses thereto will not be served until after the discovery period has closed. *See* TBMP §403.02.

410.02 Scope and Nature of Requests for Admission

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

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

The scope and nature of requests for admission, in inter partes proceedings before the Board, are governed by FRCP 36(a), which in turn refers to FRCP 26(b)(1). For a discussion of the scope of discovery permitted under FRCP 26(b)(1), *see* TBMP §402.01. *See also* TBMP §402.02.

Requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters which must be tried. Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985). These requests are also useful as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents. *See* TBMP §403.05(c).

DISCOVERY

411 Responses to Requests for Admission

411.01 Time for Service of Responses

Responses to requests for admission must be served within 30 days after the date of service of the requests, except that a defendant may serve responses either within 30 days after service of the requests, or within 45 days after service of the complaint upon it, whichever is later. *See* TBMP §403.03. If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. *See* 37 CFR §2.119(c), and TBMP §§113.05 and 403.03.

If a party upon which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to FRCP 36(b), and granted by the Board. *See* FRCP 6(b) and 36(a); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233 (TTAB 1979); and *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd*, *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979). *Cf. Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975). For information concerning motions pursuant to FRCP 36(b) to withdraw or amend admissions, *see* TBMP §525.

411.02 Nature of Responses

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested. *See* FRCP 36(a).

DISCOVERY

The Board prefers that the responding party reproduce each request immediately preceding the answer or objection thereto. *See* G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. *"A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny."* *See* FRCP 36(a).

If the responding party objects to a request for admission, the reasons for objection must be stated. If a responding party believes that a matter of which an admission has been requested presents a genuine issue for trial, the party may not object to the request on that ground alone. Rather, the party may deny the matter; alternatively, the party may set forth reasons why it cannot admit or deny the matter. *See* FRCP 36(a).

It is generally inappropriate for a party to respond to requests for admission by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those requests which it believes to be proper and stating its reasons for objection to those which it believes to be improper. *See* TBMP §414.

411.03 Signature of Responses

Answers and objections to requests for admission may be signed either by the responding party, or by its attorney. *See* FRCP 36(a).

411.04 Effect of Admission

DISCOVERY

Any matter admitted (either expressly, or for failure to timely respond) under FRCP 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. *See* FRCP 36(b). *See also American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991). For further information concerning motions to withdraw or amend an admission, *see* TBMP §525.

An admission made by a party under FRCP 36 is only for the purpose of the pending proceeding. It is not an admission for any other purpose, nor may it be used against that party in any other proceeding. *See* FRCP 36(b).

412 Duties to Cooperate, Search Records, Supplement

412.01 Duty to Cooperate

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor upon those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *See, for example* FRCP 26(g); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984); *C. H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506 (TTAB 1980); *C. H. Stuart Inc. v. S. S. Sarna, Inc.*, 212 USPQ 386 (TTAB 1980); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623 (TTAB 1974); and *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477 (TTAB 1974). *Cf. Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990).

It should be noted, in this regard, that under the provisions of FRCP 26(g), the signature of an attorney or party to a discovery request, response, or objection:

DISCOVERY

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

- (A) consistent with [the Federal Rules of Civil Procedure] and warranted by existing law or a good faith argument for the extension, modification or reversal of existing law;*
- (B) not interposed for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation; and*
- (C) not unreasonable or unduly burdensome or expensive, given the needs of the case, the discovery already had in the case, the amount in controversy, and the importance of the issues at stake in the litigation.*

See also Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990). *Cf.* 37 CFR §10.18(a); FRCP 11; and TBMP §106.02. Provision is made, in FRCP 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule.

Because the signature of a party or its attorney to a request for discovery constitutes a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623 (TTAB 1974); and *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477 (TTAB 1974). A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. *Miss America Pageant v. Petite Productions, Inc.*, *supra*.

412.02 Duty to Search Records

DISCOVERY

A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. A responding party which, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question). *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987).

412.03 Duty to Supplement Discovery Response

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

* * *

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

The duty to supplement discovery responses in proceedings before the Board is governed by FRCP 26(e)(2). *See* 37 CFR §2.116(a), and "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). Under that rule, a party which has responded to a request for discovery with a response is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2). In addition, a duty to supplement responses may be imposed by order of the Board. *Cf. P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431 (TTAB 1985); and *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60 (TTAB 1982).

DISCOVERY

413 Filing Discovery Requests and Responses With Board

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

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

See 37 CFR §§2.120(j)(6) and (j)(8), and Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34888, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 28. *See also* *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479 (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); *Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc.*, 5 USPQ2d 1067 (TTAB 1987); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); and G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163, 166-167 (1981) (but note that this article was written prior to the rule changes adopted in the Notice of Final Rulemaking cited above, as well as those adopted in the Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13).

In addition, a plaintiff may file discovery requests with its complaint, for later service upon the defendant, by the Board, with defendant's copies of the complaint and notification letter (*cf.* TBMP §§315.01 and 403.02).

Finally, when a party objects to proffered evidence on the ground that it should have been, but was not, provided in response to a request for discovery, a copy of

DISCOVERY

the pertinent discovery request(s) and response(s) should be submitted in support of the objection.

Discovery papers or materials filed with the Board under circumstances other than those specified above may be returned to the party which filed them. *See* 37 CFR §2.120(j)(8).

414 Motions Attacking Requests for Discovery

The rules governing discovery in proceedings before the Board provide both for the assertion of objections to discovery requests believed to be improper, and a means (namely, the motion to compel, in the case of discovery depositions, interrogatories, and requests for production; and the motion to test the sufficiency of answers or objections, in the case of requests for admission) for testing the sufficiency of those objections. It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by providing the information sought in those portions of the request which it believes to be proper, and stating its objections to those which it believes to be improper. *See Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974); and *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974).

Further, if a party upon which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR §2.120(d)(1), and wishes to object to the interrogatories on this basis, the responding party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number; a motion for a protective order is not the proper method for raising the objection of excessive number. *See* 37 CFR §2.120(d)(1); Notice of Final Rulemaking, published in the *Federal Register* on September 12, 1991 at 56 FR 46376 and in the *Official Gazette* of October 22, 1991 at 1131 TMOG 54, as corrected in the *Federal Register* of October 23, 1991 at 56 FR 54917; TBMP section 406.03(e); and Helen R. Wendel, *TIPS FROM*

DISCOVERY

THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), 82 Trademark Rep. 89 (1992).

Nevertheless, there are some situations in which a party may properly respond to a request for discovery by filing a motion attacking it.

In cases where a request for discovery constitutes clear harassment, or where a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest, the party upon which the request was served may properly respond to it by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. *See, for example* 37 CFR §2.120(f); FRCP 26(c); and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976). Alternatively, if the discovery sought is a discovery deposition, and the request therefor constitutes harassment, there is insufficient notice, etc., the party upon which the request was served may file a motion to quash the notice of deposition. *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988). For information concerning motions to quash a notice of deposition, *see* TBMP §521.

415 Remedy for Failure to Provide Discovery

415.01 Interrogatories or Requests for Production

If any party fails to answer any interrogatory, the party seeking discovery may file a motion with the Board for an order to compel an answer. Similarly, if any party fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion for an order to compel production and an opportunity to inspect and copy. *See* 37 CFR §2.120(e). *Cf.* FRCP 37(a)(2)(B). For information concerning motions to compel, *see* TBMP §523.

415.02 Requests for Admission

If a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show

DISCOVERY

that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to FRCP 36(b), and granted by the Board. *See* TBMP §411.01. For information concerning motions to withdraw or amend admissions, *see* TBMP §525.

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the answer or objection. *See* 37 CFR §2.120(h), and FRCP 36(a). If the Board determines that an answer does not comply with the requirements of FRCP 36(a), it may order either that the matter is admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. *See* FRCP 36(a). For information concerning motions to determine the sufficiency of answers or objections to requests for admission, *see* TBMP §524.

415.03 Discovery Depositions

If a party fails to designate a person pursuant to FRCP 30(b)(6) or FRCP 31(a)(3), or if a party or such designated person, or an officer, director or managing agent of a party, fails to attend a discovery deposition, or fails to answer any question propounded in a discovery deposition, the party seeking discovery may file a motion with the Board for an order to compel a designation, or attendance at a deposition, or an answer. *See* 37 CFR §2.120(e). *Cf.* FRCP 37(a). For information concerning motions to compel, *see* TBMP §523.

A discovery deposition is taken out of the presence of the Board, and if a witness objects to, and refuses to answer, a particular question, and the propounding party wishes to obtain an immediate ruling on the propriety of the objection, it may do so only by adjourning the deposition and applying, under 35 U.S.C. §24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. *See Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974). *Cf. Ferro Corp. v. SCM Corp.*, 219 USPQ 346 (TTAB 1983); *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). In the absence of a court order compelling an answer, the propounding party's only alternative, if it wishes to compel an answer, is to

DISCOVERY

complete the deposition and then file a motion to compel with the Board. *See* 37 CFR §2.120(e), and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

416 Protective Orders

416.01 Upon Motion

Upon motion, showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (1) through (8) of FRCP 26(c). *See* 37 CFR §2.120(f).

For information concerning motions for a protective order, *see* TBMP §526. *See also* TBMP §§120.03, 527.01, and 713.16.

416.02 Upon Stipulation

Subject to the approval of the Board, parties to proceedings before the Board may, and often do, enter into stipulated protective orders, that is, agreements as to specified procedures and restrictions that shall govern the disclosure of any confidential or trade secret information. *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

Only confidential or trade secret information should be filed pursuant to a stipulated protective order. Such an order may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR §2.27, which provide, in essence, that except for matter filed under seal pursuant to a protective order issued by a court or by the Board, the file of a published application or issued registration, and all proceedings relating thereto, are available for public inspection. *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, *supra*.

416.03 In Camera Inspection

DISCOVERY

In situations where there is a dispute between the parties to a proceeding as to the relevance and/or confidentiality of a document, or portions thereof, sought to be discovered, and the Board cannot determine from the arguments of the parties, upon motion to compel production, whether the document is relevant and/or confidential, the Board may request that a copy of the document be submitted to the Board for an in camera inspection, after which the document will be returned to the party which submitted it. *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

416.04 Contents of Protective Order

Typically, a protective order contains provisions such as the following:

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

DISCOVERY

(7) A provision that information designated by the disclosing party as confidential or trade secret may not include information which is acquired by the discovering party from a third party which lawfully possesses the information and/or owes no duty of nondisclosure to the party providing discovery.

(8) A specification of the persons to whom confidential or trade secret information may be disclosed (i.e., outside counsel; house counsel; counsel's necessary legal and clerical personnel; etc.).

(9) A provision that all persons to whom confidential or trade secret information is disclosed shall be advised of the existence and terms of the protective order.

(10) A provision that the discovering party will not disclose or make use of confidential or trade secret information provided to it under the order except for purposes of the proceeding in which the information is provided.

(11) A means for resolving disputes over whether particular matter constitutes confidential or trade secret information.

(12) A provision that if material designated as confidential or trade secret is made of record in the proceeding, it shall be submitted to the Board in a separate sealed envelope or other sealed container bearing the proceeding number and name, an indication of the general nature of the contents of the container, and, in large letters, the designation "CONFIDENTIAL."

(13) A statement that at the end of the proceeding, each party shall return to the disclosing party all confidential information and materials, including all copies, summaries, and abstracts thereof.

See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); and Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975).

416.05 Signature of Protective Order

DISCOVERY

Stipulated protective orders may be signed either by the parties thereto, or by their attorneys, or by both. However, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. *See Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987). *See also*, with respect to violation of a Board protective order after the conclusion of the Board proceeding *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

416.06 Filing Confidential Materials With Board

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

FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER.

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

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

Only the particular discovery responses, exhibits, deposition transcript pages, or pages of a brief which have been designated confidential should be filed under seal pursuant to a protective order. Discovery responses, exhibits, deposition transcript

DISCOVERY

pages, or pages of a brief which are not confidential should not be filed under seal along with the confidential ones.

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

416.07 Handling of Confidential Materials By Board

Confidential materials (including trade secret information) filed under seal subject to a protective order are stored by the Board in a locked file cabinet, and are disclosed only to the Board and to those people specified in the protective order as having the right to access. *See* Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981), and TBMP sections 120.03 and 121.02. For information concerning access to protective order materials during an appeal from the decision of the Board, *see* TBMP §904. After the proceeding before the Board has been finally determined, all confidential materials are returned to the party which submitted them.

417 Telephone and Pre-Trial Conferences

When appropriate and necessary, a motion relating to discovery may be resolved by telephone conference, or by pre-trial conference at the offices of the Board. In either case, the conference will involve the parties or their attorneys and an Attorney-Advisor, or a Member, or the Board. *See* 37 CFR §2.120(i). For further information concerning the resolution of motions by telephone and pre-trial conference, *see* TBMP §502.07.

418 Discovery Sanctions

In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide discovery. For information concerning the nature of these sanctions, and when they are available, *see* TBMP §527.

DISCOVERY

419 Discovery Guidelines

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

(1) The identification of discovery documents (as opposed to their substance) is not privileged or confidential. *See Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975), and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975).

(2) In those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. *See, for example 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); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346 (TTAB 1974); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286 (TTAB 1974).

(3) The classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers constitute confidential information, and generally are not discoverable, even under protective order. However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618

DISCOVERY

(TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

(4) Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant). See *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471 (TTAB 1974).

(5) Information concerning a party's first use of its involved mark is discoverable. See, for example *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976), and *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975). See also *Double J of Broward Inc. v. Skalongi Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991).

(6) Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived). See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); and *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974).

(7) A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. 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); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989); *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

(8) A party's plans for expansion may be discoverable under protective order. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988).

(9) Information concerning the use and/or registration by third parties of the same or similar marks for the same or closely related goods or services as an involved mark and goods or services is discoverable, but only to the extent that the

DISCOVERY

responding party has actual knowledge thereof (without performing an investigation), and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); and *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531 (TTAB 1979).

(10) Information concerning litigation and controversies between a responding party and third parties based on the responding party's involved mark is discoverable. However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). *See American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531 (TTAB 1979); *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127 (TTAB 1975); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975).

(11) A party need not provide discovery with respect to those of its marks and goods and/or services which are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion. *See TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974); *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493 (TTAB 1973). *See also Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977), and *Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649 (CCPA 1975).

(12) The names and addresses of a party's officers are discoverable. However, if a party has a large number of officers, it need only provide the names and addresses of those officers most knowledgeable of its involved activities. *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

DISCOVERY

(13) Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purpose of forestalling a foreign user's expansion into the United States, or where the foreign mark is "famous," albeit not used, in the United States. *See*, for general rule *Double J of Broward Inc. v. Skalongy Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991), and *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375 (TTAB 1974). *See also* *Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481 (TTAB 1975), *aff'd*, *Miller Brewing Co. v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976). *See, re possible exceptions*, Article 6 bis of the Paris Convention; *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed.Cir. 1990); *Double J of Broward Inc. v. Skalongy Sportswear GmbH*, *supra*; *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699 (TTAB 1986); *Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A.*, 228 USPQ 589 (TTAB 1985); *Davidoff Extension S.A. v. Davidoff International, Inc.*, 221 USPQ 465 (S.D. Fla. 1983); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73 (TTAB 1983); *All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc.*, 220 USPQ 1069 (TTAB 1983); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660 (TTAB 1983); *Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046 (TTAB 1983); and *Johnson & Johnson v. Diaz*, 339 F. Supp. 60, 172 USPQ 35 (C.D. Cal. 1971).

(14) Generally, the names and addresses of the stockholders of a corporate party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related companies" within the meaning of Section 5 of the Act, 15 U.S.C. 1055. *See* *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

(15) The locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its involved mark, are discoverable. *See* *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975), and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

(16) Information relating to the areas of distribution for a party's involved goods or services sold under its involved mark is discoverable. *See* *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671

DISCOVERY

(TTAB 1988); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471 (TTAB 1974).

(17) The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion. *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975).

(18) Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

(19) Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable. *See Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).