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## TTAB RULES CHANGES

### Complaint

➤ Service Requirement

- Plaintiff timely serves and files complaint on the owner of record at the correspondence address of record according to TARR
- Who to serve?
  - Opposition – Applicant, its attorney or domestic representative
  - Cancellation – Registrant or its domestic representative
- Where to serve?
- When to serve? – concurrent use at time of institution
- How to serve? Regular mail, unless parties in advance agree otherwise. 37 CFR 2.119. Fed. R. Civ. P. 4, 4.1, 5 and international conventions do not apply
- Returned as Undeliverable? – Plaintiff must notify the Board in writing within ten (10) days and advise Board, if known, of any new address for defendant. No independent investigation is required. Board will then effect service on its own or by publication.

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## Complaint Practice Tips

- Practice Tip: Check/Update Assignment for owner
- Practice tip: Check/Update TARR for correspondence address
- Practice Tip: Parties may agree to serve by fax or email
- Effect if service fails or incorrect service?

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## Making Registrations of Record

- A party may now make its pleaded registration of record by attaching to its complaint, an electronic copy of the certificate of registration, and status and title and information from TARR.

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## Institution

- Board may send notice of institution by email when a party has provided an email address
- When has a party provided an email address?
  - Plaintiff filing any paper by ESTTA or with a complaint delivered by other means
  - Applicant/registrant who authorized office to communicate with it by email during prosecution
- Undelivered notices may result in notice by publication

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## Standard Protective Order

- Automatically of record
  - Available at [www.uspto.gov](http://www.uspto.gov)
  - May be modified by Board order or stipulation approved by Board
  - Practice Tip: Enforceability if parties do not sign?
- Covers initial disclosures, expert disclosures and other discovery

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## New timeline

- Example of new timeline for Opposition instituted on November 20, 2007
- Scheduling Order mail date 11/20/07
- Time to Answer 12/30/07
- Deadline for Discovery Conference 1/29/08
- Discovery Opens 1/29/08
- Initial Disclosures Due 2/28/08

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## Opposition Timeline (Cont'd)

- Expert Disclosures Due 6/27/08
- Discovery Closes 7/27/08
- Plaintiff's Pretrial Disclosures 9/10/08
- Plaintiff's 30-day Trial Period Ends 10/25/08
- Defendant's Pretrial Disclosures 11/9/08
- Defendant's 30-day Trial Period Ends 12/24/08

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## Opposition Timeline (Cont'd)

- Plaintiff's Rebuttal Disclosures 1/8/09
- Plaintiff's 15-day Rebuttal Period Ends 2/07/09

Note: Briefing and oral hearing schedule is still governed by 37 C.F.R. 2.128 and 2.129

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## New Timeline

- Practice Tips: Initial Disclosures are due 30 days after the opening of the discovery period, not 30 days after actual date of discovery conference
- Practice Tip: You may suspend case and initial disclosure requirements for settlement talks
- Practice Tip: Defendant's default, or filing of Fed. R. Civ. P. 12 motions will stay conference and initial disclosure obligations

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## Motions To Extend

- Generally good cause will be found to suspend or extend if for settlement if motion is filed before answer. If filed after answer, such motions generally will not be granted until discovery conference occurs.

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## Discovery Conference

- When - not later than 30 days after answer is filed
- Content
  - Timing and specificity of information required to comply with initial disclosures
  - Whether to dispense with formal discovery in favor of reciprocal disclosures
  - Whether to dispense with initial or expert disclosures and use formal discovery only
  - Settlement
  - Expert testimony
- Effect
- Written report not needed unless parties propose to change standard deadlines or obligations
- Practice Tip: File motion or stipulation to change disclosure obligations and deadlines promptly after conference as absent Board approval obligations/deadlines may remain as set
- Practice Tip: Board professional will participate if either side requests upon written or telephone request to Board made after answer but no later than ten days before deadline to conduct discovery conference

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## Initial Disclosures

- When – 30 days after the opening of discovery period
- Content – Fed. R. Civ. P. 26(a)(1)(A) and (B) apply. Fed. R. Civ. P. 26(a)(1)(C) and (D) do not apply
- Text of Fed.R.Civ.P. 26(a)(1)(A) and (B):

(a)(1) Initial Disclosures. Except in categories of proceedings specified in Rule 26(a)(1)(E), or to the extent otherwise stipulated or directed by order, a party must, without awaiting a discovery request, provide to other parties:

- (A) The name, and, if known, the address and telephone number of each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses, unless solely for impeachment, identifying the subjects of the information;
- (B) A copy of, or a description by category and location of, all documents, electronically stored information, and tangible things that are in the possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses, unless solely for impeachment;

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## Initial Disclosures (Cont.)

- Effect
  - A party may not serve a motion for summary judgment until after it has made its initial disclosures, unless grounds are issue or claim preclusion or lack of jurisdiction
  - No service of other discovery until after a party has made its initial disclosures
  - Information and actual documents disclosed will be treated for admissibility like responses to written discovery requests.

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## Expert Disclosures

- When – if known, not later than 30 days prior to the close of discovery, or if solely to contradict or rebut, within 30 days after the adverse party's prior disclosure. Parties must respond earlier, if formal discovery request served. Parties must disclose promptly after expert is retained if plans to use expert occurred after disclosure deadline and must make motion to Board to allow expert testimony.
- Effect – Upon notice that a party plans to use an expert at trial, the Board may suspend proceedings to allow for discovery limited to experts.
- Content – Fed. R. Civ. P. 26(a)(2). Any party disclosing plans to use an expert must also notify the Board.
- Opt-out - Upon stipulation or motion approved by the Board the parties may alter the sequence and timing of expert disclosures and the extent of information or material that must be disclosed

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## Motions to Compel

- Initial disclosures
  - When - prior to close of discovery
  - Effect - suspension
- Expert disclosures
  - When – prior to close of discovery
  - Effect - suspension
- Other Discovery
  - When – prior to commencement of first testimony period, as originally set or reset
  - Effect – suspension
- Good faith effort prerequisite

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## Motions For Sanctions

- Failure to participate in discovery conference
  - When – before initial disclosures due
- Failure to make initial disclosures
  - When - after motion to compel
- Failure to make expert disclosures
  - When – after motion to compel

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## Pretrial Disclosures

- When – Essentially fifteen days before before each testimony period opens
- Content – Fed. R. Civ. P. 26(a) (3), but not (a)(3)(c) and 2.123 (a) and (b).
  - No need to disclose notice of reliance documents
  - Must disclose identity and contact information for witnesses, a general summary of the topics on which they are expected to testify and a general summary of the types of documents and things that may be introduced as exhibits during the witnesses' testimony
  - A party must disclose if it intends not to take witness testimony
- Notices of deposition still required
- Effect of Failure to make any disclosures: Adverse party may move to delay or reset subsequent periods or move for sanctions
- Effect of Failure to provide adequate disclosures: Adverse party may move to strike the testimony of a witness or that portion of testimony not adequately disclosed. Adverse party should cross examine witness under protest while reserving right to object and move to strike promptly after the testimony is completed.

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## **RECENT CASES**

### **Fraud**

*Hurley International v. Volte*, Opp. No. 91158304 (TTAB January 23 2007), precedential

Board finds fraud where applicant lacked a bona fide intent to use the mark on all the goods/services listed in application. But in dicta, the Board suggests that by amending the description of goods upon discovery of the error, and before the application had published, a party may cure the fraud.

*Hachette Filipacchi Presse v. Elle Belle*, Cancellation No 92042991, precedential

Board finds fraud where registrant had not used the mark on all the goods/services listed in the application. But, in dicta, the Board suggests that by amending description of goods upon discovery of the error and before the filing of a petition for cancellation, a party may cure the fraud.

### **Service of Complaint**

*Springfield Inc v. XD*, Opp. No. 91180596 (TTAB February 7, 2008), precedential

Opposition dismissed as untimely where the opposition was filed, but not served, on the last day of the opposition period. The Board held that the filing date of an opposition is the date an opposition with valid proof of service is received. Since the proof of service was not valid, opposition was not timely filed and case was dismissed without prejudice to re-filing as a petition to cancel.

### **Surname Refusal**

*Joint Stock Co v. Batik*, Opp. No. 7852961 (TTAB August 28, 2007), precedential

Concurring Opinion by Judge Seeherman criticizing fourth surname test factor, that is whether the mark has " the look and feel of a surname." Given common law basis for surname refusal, this factor is not relevant. The degree of actual surname frequency/rarity is most important factor in analysis.