

EXPERT ANALYSIS

Federal Trademark Litigation vs. Trademark Trial and Appeal Board Practice: Differences That Matter

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Although it is akin to federal trademark litigation, practicing before the Trademark Trial and Appeal Board involves significant differences. Being mindful of these disparities will help trademark litigators implement a successful strategy.

This analysis contains some of the key practice variations and provides useful practice tips unique to TTAB proceedings.

NO LIVE WITNESSES

The most significant difference between federal court litigation and TTAB proceedings is that the TTAB does not hear live testimony.

Instead, the party offering witness testimony generally must take that testimony as a deposition held during each party's 30-day trial period.

However, pursuant to 37 C.F.R. § 2.123(b), if the parties so stipulate in writing, the testimony of any witness may be submitted in the form of an affidavit or declaration.

It can be to a party's advantage to submit testimony via affidavit or declaration as opposed to deposition given that all testimony presented to the TTAB must be in writing.

This is often an effective and cost-efficient way to introduce undisputed facts.

Cross-examination can be accomplished through a short deposition or by allowing the opposing party to review the affidavit or declaration and raise questions or counterpoints to be included.

For example, testimony via affidavit or declaration can be a simple, non-burdensome way to introduce evidence regarding third-party use of a mark or evidence of a party's use of its mark in commerce.

AUTOMATIC CASE SCHEDULE

Unlike in district court, the act of filing a case-initiating document — such as a notice of opposition or petition for cancellation — will automatically trigger the TTAB system to generate a case schedule. The schedule provides for approximately 18 months between institution of the proceeding and the close of briefing.

The schedule can be set without a scheduling conference.

Once the TTAB sets the schedule, the parties can trigger automatic suspensions by filing dispositive or discovery motions.



When managing a TTAB case schedule, time for suspensions should be considered in strategy decisions and case management.

When a party files a dispositive motion, such as a motion to dismiss or for summary judgment, or a discovery motion such as a motion to compel, the case schedule is suspended with respect to all matters not germane to that motion.

During the period of suspension, no party may file any paper that is not germane to the motion except as otherwise specified in the board's suspension order.

If the motion does not resolve the case, the board will resume proceedings.

The parties may also agree to suspend the proceedings to engage in settlement discussions.

These suspensions can significantly increase the pendency of the case.

When managing a TTAB case schedule, time for suspensions should be considered in strategy decisions and case management.

COMMENCEMENT OF A TTAB PROCEEDING

Parties commence oppositions by timely filing a notice of opposition and fee; they commence cancellation proceedings by timely filing a petition for cancellation and fee.

The notice of opposition and petition for cancellation and associated answers correspond to the complaint and answer in a federal district court proceeding.

UNIQUE ASPECTS OF DISCOVERY

While the Federal Rules of Civil Procedure generally govern discovery, the TTAB has some unique procedural rules that are important to know.

For example, 37 C.F.R. § 2.120(d)(1) allows for 75 interrogatories, a much greater number than the 25 allowed under the Federal Rules of Civil Procedure.

The interrogatories are strictly counted, and subparts as well as compound questions are considered separate interrogatories.

As a result, it is often best to avoid subparts and compound questions.

Response time to discovery requests is also slightly different before the TTAB.

If parties make service of a discovery request by first-class mail or overnight courier, the date for the mailing or the delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for a response to the written discovery.

When the parties agree to electronic service, no additional time is allowed.

AUTOMATIC STANDARD PROTECTIVE ORDER

In district court, the parties must file a motion to have a protective order entered. But in actions before the TTAB, the board's standard protective order automatically applies.

It is not necessary for the parties to sign the order for it to take effect.

The parties may agree to an alternative order, and a party may move to modify the order, but the board's standard protective order will apply until the board grants such a motion and issues an alternative order.

The board's standard protective order includes three confidentiality designations:

- "Confidential," which is material to be shielded from the public.
- "Highly confidential," which includes restrictions on access even to the parties and attorneys.
- "Trade secret/commercially sensitive," which is restricted for review only by outside counsel and independent experts.

REQUESTS FOR ADMISSION

Requests for admission can be much more valuable in TTAB proceedings than they are in federal district court litigation.

For example, requests for admission can be used during the discovery phase to authenticate documents that parties intend to use during the trial period.

Because the TTAB allows positive responses to requests for admission to be considered as evidence during the trial period, it is easy to submit and rely upon such discovery responses to authenticate discovery documents or confirm undisputed facts.

DEPOSITION DIFFERENCES

While the transcript — or portions of the transcript — and exhibits from a discovery deposition of an adverse party may be submitted into evidence through a notice of reliance, discovery depositions and trial depositions are different procedural events.

The trial deposition takes place during a party's 30-day trial period and most closely resembles trial testimony in federal litigation.

The entire written transcript and all exhibits from the trial deposition are filed with the board for consideration.

When preparing for trial depositions, it is important to plan ahead.

There is no need to wait for the opening of a party's trial period to serve deposition notices.

To avoid disputes, it is best to either agree on the timing of depositions with the opposing party or provide enough advance notice to resolve potential conflicts.

Once the parties have agreed to a date and the deposition is underway, it is important to preserve objections.

The best practice is to make all evidentiary objections on the record at a trial deposition to avoid waiver in the event that the objection is later deemed curable.

Evidentiary objections also must be made in a party's trial brief — or a separate appendix submitted with the trial brief — but it is a crucial first step to preserve such objections for further briefing if they are asserted on the record at the time the evidence is introduced.

NOTICES OF RELIANCE

Notices of reliance are an excellent tool to introduce certain documents into evidence during a party's trial period without a sponsoring witness — if the relevance of the submitted materials is provided in at least one notice.

Notices of reliance can be used to introduce transcripts or portions of transcripts from discovery depositions of an adverse party, as well as answers to interrogatories or requests for admission that have been admitted.

Printed publications and official records also can be introduced through the use of a notice of reliance.

A notice of reliance is an effective method for introducing typical publications, such as books or magazines, as well as internet evidence.

The TTAB deems internet documents self-authenticating if the party relying on them identifies the date the documents were accessed and printed as well as the source, such as a URL.

Thus, websites can be introduced into evidence along with other printed publications.

This can be a very valuable technique for introducing evidence of third-party use of a mark that otherwise may require multiple third-party depositions.

NOT ALL PTO RECORDS ARE AUTOMATICALLY IN THE RECORD

The only registrations and applications of record in a TTAB proceeding are the registration sought to be canceled or the trademark application opposed.

If there are other federal registrations not at issue in the proceeding that may be helpful to your case, those records must be properly introduced into the record.

The TTAB does not take judicial notice of other Patent and Trademark Office registrations or filings.

Such records, such as third-party registrations, related registrations owned by either party and the prosecution history file wrapper of an opposer's registration can be introduced as "official records" through a notice of reliance.

They also can be introduced as exhibits to a trial deposition.

EXPERT TESTIMONY

Because the TTAB evaluates a written record, the board's "Trademark Rules of Practice" permit a variety of cost-saving methods for submitting testimony.

For example, the parties may stipulate to the introduction of an expert's report and necessary supporting materials by notice of reliance or as part of an expert's testimony via affidavit or declaration.

The same type of materials can be introduced by any countervailing expert. Some parties will reserve the right to a cross-examination deposition.

The ability to submit expert reports often benefits both parties, as it enables each party's expert opinions to be clearly and succinctly introduced into the record with minimal burden or expense.

TRIAL BRIEFS

After the party's trial periods have passed, they are expected to submit trial briefs.

These briefs should help guide the TTAB through the evidentiary record with references to relevant case law.

Affidavits, declarations or exhibits filed with a brief will not be considered evidence; instead, the focus should be on the evidence submitted during the parties' trial periods.

The members of the TTAB are knowledgeable about trademark law, so wasting time on arguments that are weak or will detract from your credibility is not recommended.

For example, in a case regarding likelihood of confusion, do not argue that the channels of trade between your client's goods and the opposing party's goods are different if there are no restrictions on trade channels in the opposed application or registration sought for cancellation.

ORAL ARGUMENT IS OPTIONAL

In TTAB proceedings, the only oral argument that may take place is at the end of the proceeding, after the parties' trial briefs are submitted. It is not mandatory.

An oral hearing will not take place unless one of the parties requests it within the applicable time limit.

Many parties forgo oral argument in exchange for a faster decision on their briefs.

The reality is that oral argument can delay a decision, especially when scheduling conflicts cause oral argument to be delayed.

Oral argument is important if you have something to add that was not already discussed in a trial brief, if the record evidence is complicated such that you believe that the TTAB will benefit from

further explanation, or if the case presents complicated legal or factual issues or issues of first impression.

When preparing for oral argument, consider using visual aids.

If you plan to use visual aids, make sure they consist of evidence already made of record, and make sure TTAB members appearing via videoconference will be able to see your visual aids.

UPDATES TO TTAB PROCEDURES

In June, the PTO incorporated amendments to the Trademark Rules of Practice, the Federal Rules of Civil Procedure and the Lanham Act.

The changes, announced on uspto.gov, “reflect the evolution and refinement of board practice as experienced and articulated between March 1, 2015, and March 4, 2016,” according to the preface to the June revision.



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