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Devoted to Intellectual Property Law

2007 TTAB Rule Changes: Part III

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Topics for this Portion

- Expert Testimony Disclosure
- Pretrial Disclosure
- Making Pleaded Registrations of Record
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Expert Testimony Disclosure

- Rule 2.120: Deadline dates for expert testimony disclosures will be set out in the trial order included with the notice of institution of the proceeding.

- Disclosure will occur “in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2).”

Expert Testimony Disclosure

- When? 30 days prior to the end of the discovery period for both parties; i.e., 90 days before commencement of trial.

- Rebuttal expert disclosure must be made within 30 days thereafter (i.e., by the close of discovery).

Expert Testimony Disclosure

- Rule 26(a)(2)(B), FRCP: "… disclosure shall, with respect to a witness who is retained or specially employed to provide expert testimony in the case or whose duties as an employee of the party regularly involve giving expert testimony, be accompanied by a written report prepared and signed by the witness."

Expert Testimony Disclosure

- The report shall contain:
  - a statement of all opinions to be expressed and the basis and reasons therefor;
  - the data or other information considered by the witness in forming the opinions;
  - any exhibits to be used as a summary of or support for the opinions;

Expert Testimony Disclosure

- the qualifications of the witness, including a list of all publications authored by the witness within the preceding ten years;
- the compensation to be paid for the study and testimony;
- and a listing of any other cases in which the witness has testified as an expert at trial or by deposition within the preceding four years.

Expert Testimony Disclosure

- (C) the disclosures shall be made at least 90 days before the trial date or the date the case is to be ready for trial or, if the evidence is intended solely to contradict or rebut evidence on the same subject matter identified by another party under paragraph (2)(B), within 30 days after the disclosure made by the other party.

Expert Testimony Disclosure

- If an expert is retained after the deadline, party must promptly file motion for leave. 2.120(a)(2).

- A motion to compel expert testimony disclosure must be made prior to end of discovery period. 2.120(e).

Expert Testimony Disclosure

- Party must notify the Board of its plan to use an expert, and the Board may suspend to allow for discovery limited to experts.

- Board may also issue an order setting a deadline for any other party to disclose experts.

Pre-Trial Disclosure

- Rule 2.121(a), (d), and (e):
- When? For the plaintiff, 15 days prior to the opening of its testimony period.
- There is still a 60-day break between the close of discovery and the opening of the first testimony period.

Pre-Trial Disclosure

- For the defendant: 15 days from the opening of its testimony period.
- Plaintiff's rebuttal disclosures: 15 days before opening of rebuttal period.

Pre-Trial Disclosure

- What? See Rule 26(a)(3)(A) and (B).
  - Name, phone #, and address of each witness;
  - Identifying information about the witness;
  - "general summary or list of the subjects" of witness's testimony;
  - "general summary or list of the types of documents and things which may be introduced" during testimony.

Pre-Trial Disclosure

- A party is <u>not</u> required to disclose each document or exhibit that it plans to introduce at trial.
- Nor must a party disclose its plan to file notices of reliance, or its plan to use discovery deposition excerpts.
- Proper notices of taking testimony are still required.

Pre-Trial Disclosure

- If a party does not plan to introduce witness testimony, it must so state.

- If one party fails to serve pre-trial disclosure, other may move to delay or re-set subsequent disclosures or testimony.

Pre-Trial Disclosure

- A party may object to improper or inadequate pretrial disclosure and may move to strike the testimony of a witness on the ground of improper disclosure.

Making Pleaded Registrations of Record

- Rule 2.122(d)(1) amended: As of August 31, 2007, an opposer or petitioner has an additional option for submission of its pleaded registration(s) with its opening pleading.
- Rather than obtain a certified status-and-title copy of its registration, it may submit printouts from the PTO's TARR and assignment databases.

Making Pleaded Registrations of Record

- The PTO commentary states that this amends the Rule to “conform to existing practice.” How is that? Board accepted Internet downloads re third-party registrations offered in evidence on issues like descriptiveness or confusion, but not from a party submitting its own registration into evidence.

Making Pleaded Registrations of Record

- What about submitting a registration with a motion for summary judgment or a notice of reliance, rather than an initial pleading?

- See, e.g., *Omega SA v. Oldenberg*, Opposition No. 91164080 (July 16, 2007) [not precedential]. [Board rejected mere photocopy of registration accompanying summary judgment motion.]

CD-ROMS Not Acceptable

- Deleted from Rule 2.126 is the option to file submissions in CD-ROM form. Effective August 31, 2007.

- "CD-ROMS have rarely been utilized by parties and have presented technical problems for the ESTTA/TTABIS System."

Timing of Summary Judgment

- Rule 2.127(e)(1): A party may not file a summary judgment motion until the party has made its initial disclosures.

- Exceptions: motion asserting claims or issue preclusion or of the Board's lack of jurisdiction.

Page Limit for Briefs on Motions

- Rule 2.127(a) clarifies the page limits for briefs on motions. Effective August 31st.

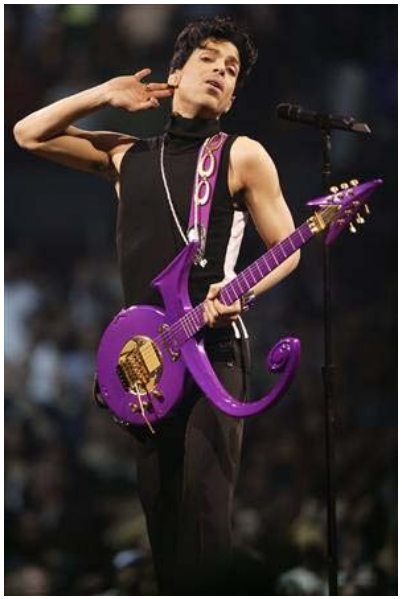
- Supporting and opposing briefs no more than 25 pages, including table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary.

Page Limit for Briefs on Motions

- For reply briefs, ten pages maximum
- Exhibits submitted with the motion are not considered in the count.
- Previously, it was unclear how and what to count. The rule stated that "[t]he brief in support of the motion and the brief in response shall not exceed 25 pages in length."

Page Limit for Briefs on Motions

- Parties would wind up re-filing motions. E.g., *Saint Gobain Corp. v. Minnesota Mining and Mfg. Co.*, 66 USPQ2d 1220 (TTAB 2003). [Briefs of both parties too long: Board *sua sponte* struck the briefs and denied the motion. Parties then re-filed their motion papers.]



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