Managing Discovery in Trademark Cases: TTAB v. Federal Court

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Presenters

- Moderator: Jonathan Hudis
  - Quarles & Brady LLP

- Speaker: Christen English
  - USPTO

- Speaker: Linda McLeod
  - Kelly IP

- Speaker: Naresh Kilaru
  - Finnegan
Topics We Will Cover Today

- Meet-and-Confer
- Initial Disclosures
- Written Discovery
- Discovery Depositions
- Motions to Compel Discovery
- Pre-Trial Disclosures
- Final Pre-Trial Conference
Meet-and-Confer (Meeting of Counsel)

- Trademark Trial and Appeal Board
  - Is a *pro se* party involved?
  - Clean up of pleadings needed?
  - What is the scope of the proceeding?
  - Jurisdiction of the TTAB
  - ACR? Stipulation(s) on any issues?
  - Simple document exchange or full-on discovery?
  - Settlement; Encouraging communications of the parties
  - Modifications to TTAB Standard Protective Order
Meet-and-Confer (Cont'd)

- Trademark Trial and Appeal Board
  - Confer with client beforehand
  - Contact adversary to schedule
  - Is Board participation needed?
  - Otherwise, should be a short call
  - Discuss service of large document files; e-Discovery format
  - Discussion of the merits?
  - Schedule of issues if not on the TTAB's Institution Order
Meet-and-Confer (Cont'd)

- Court
  - Governed by FRCP 26(f), Local Rules, Judge's Indiv Rules
  - Subjects usually discussed
  - Follow-on report to Court usually expected
  - Report to Court "can" influence case scheduling
  - Time for discussion of Stipulated Protective Order
  - Litigating against pro se adversary in court more difficult than at the TTAB
  - Meet-and-Confer followed by in-person conference before the Court pursuant to FRCP 16
    - Scheduling, Protective Order, special issues needing attention (e.g., experts, surveys, etc.)
Initial Disclosures

- Trademark Trial and Appeal Board
  - Witnesses, Documents
- Court
  - Witnesses, Documents, Damages, Insurance
- Best Practices
  - Match with grounds / defenses
  - Work on with client early
  - Thorough listing (broad and short v. narrow and detailed)
  - Revisit for possible supplementation before discovery closes
Written Discovery

- Trademark Trial and Appeal Board
  - 75 number limit: INT, ADM, RFP, plus 1 extra ADM
  - TTAB Counting Rules: Sub-Parts, Compound Questions

- Court
  - 25 number limit: INT
  - Unlimited ADM, RFP
  - Counting Rules: Court-specific
Written Discovery (Cont'd)

- **Best Practices**
  - Do we need discovery?
  - If so, serve early; follow-up discovery (depositions)
  - Docket response deadlines carefully
  - Proportionality
  - Boilerplate and "general" objections
  - Confidentiality objections (consult your protective order)
  - Privilege objections (and privilege logs)
  - Agreements on "search terms"
  - Discovery as leverage
Discovery Depositions

- Trademark Trial and Appeal Board
  - Differences between discovery and testimony depositions
  - When taken
  - Use at trial (use only the good stuff)

- Court
  - When taken
  - Use at trial
  - Cross-examination
  - Transcribed vs. Live vs. Video depositions
  - De bene esse depositions
Discovery Depositions (Cont'd)

- Best Practices
  - Are any depositions needed?
  - Sufficient notice
  - Place of deposition
  - FRCP 30(b)(1) v. FRCP 30(b)(6) depositions
  - Thorough preparation
    - Produced documents, discovery responses, outline
  - Exhibits: copies, labeling
  - "Speaking" objections
Motions to Compel Discovery

- Trademark Trial and Appeal Board
  - Handled by Interlocutory Attorney ("IA")
  - A telephone conference with the IA pre-filing is optional
  - No oral argument

- Court
  - Handled by Judge or Magistrate-Judge
  - Courts more often are requiring letter submissions or telephone conferences before giving permission to file
  - "May" have oral argument
Motions to Compel Discovery (Cont'd)

- **Best Practices**
  - Can I avoid having to file the motion in the first place?
  - What do I really need for my case / defense?
  - No response vs. inadequate response
  - *Good faith effort* to resolve, pre-filing
  - Does or do the discovery request(s) / objection(s) have merit?
  - Proportionality, relevance, breadth, privilege
  - A discovery motion alleging a large number of discovery requests in dispute likely will be denied
Pre-Trial Disclosures

- Trademark Trial and Appeal Board
  - Witnesses, and what they will say
  - Documents intended for use as trial exhibits
  - Need not disclose Notice of Reliance documents
  - Time to consider motions to quash/exclude

- Court
  - Witnesses, live and by deposition
  - Documents intended for use as trial exhibits
  - Local court rules and individual judge rules often have further requirements
  - Time to consider motions *in limine*
Pre-Trial Disclosures (Cont'd)

- Best Practices
  - Before discovery closes: time to reconsider your initial disclosures, written discovery responses and produced documents – do they need amending and/or supplementation (to avoid preclusion)?
  - When adversary's pre-trial disclosures arrive, consider:
    - Any prior TTAB/Court Orders already precluding witnesses or exhibits?
    - Any witnesses or proposed exhibits identified for the first time (but called for during discovery and not produced)?
Final Pre-Trial Conference

- The Final Pre-Trial Conference only applies to court actions. There is no TTAB equivalent.
  - Final Pre-trial Conference Order
    - **Note:** Careful – This can be a full substitute for the pleadings.
  - Witness Lists
  - Exchange of Exhibits
  - *Possible* decisions on *in limine* motions
  - Trial date
  - Proposed findings and conclusions (bench trial); proposed jury charges (jury trial)
Thank You: Questions?

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