

Discovery Conferences Now Required by the TTAB

The Trademark Trial and Appeal Board, or TTAB for short, is the quasi-judicial branch at the U.S. Trademark Office that oversees, amongst other matters, all trademark opposition-, trademark cancellation-, and concurrent use proceedings. Recently, the TTAB has adopted amendments to its rules of practice that mirror the Federal Rules of Civil Procedure, particularly with respect to discovery issues. The changes come into effect on November 1, 2007.

Of significance, the TTAB rules will now require that the plaintiff and defendant in a TTAB proceeding partake in a discovery conference to map out a discovery plan, including the guidelines for taking discovery and timing of discovery activities for the proceeding, and engage in the exchange of mandatory initial disclosures, including an initial production of relevant documents and things, and identification of potential witnesses. These new provisions correlate directly to the Federal Rules. In adopting these changes, the TTAB reasoned that the earlier the parties sit down to discuss the dispute and the earlier they begin to exchange discovery, the earlier the parties will discuss settlement.

The new rules also provide that the TTAB's standard protective order is applicable for all cases before the TTAB. Accordingly, in the absence of a mutual agreement upon protective order, the standard protective order applies. This provision became effective on August 31, 2007.

Another amendment that addressed a subject of much commentary involves the former requirement that a trademark application or registration owner provide a certified copy of the application or registration showing current title and ownership. The USPTO's website makes all of this information available electronically, which begged the question,

why make litigants provide a certified copy when the TTAB could take judicial notice of the information provided on the USPTO's website. The amended rule establishes that ownership and title information obtained from the USPTO's website may be submitted in lieu of a certified copy of an application or registration. This provision also came into effect on August 31, 2007.

Design Patents Not Just Ornamental

In a recent decision, the International Trade Commission (ITC) ruled that the owner of a design patent could rely on it through Customs to block the importation of infringing products into the United States. In *In re Certain Automotive Parts*, Investigation No. 337-TA-557, 2007 WL 2021234 (ITS 2007), the ITC found that certain spare parts for Ford trucks being manufactured overseas without authorization infringed certain design patents owned by Ford. Pending the outcome of the appeal to the Court of Appeals for the Federal Circuit (CAFC), *Ford vs. ITC*, Docket No. 07-1357, Ford can take the ITC determination to the U.S. Customs Service, which must hold for inspection at the port of entry any spare parts that are covered by Ford's design patents. If the parts are considered to be infringing, they must be barred from entry into the U.S.

Design patents protect the ornamental appearance of a novel and non-obvious design. There is a non-statutory exception, the repair doctrine, which permits the lawful purchaser of a product to effect a repair. The accused importers in this case argued that the parts fell within this exception because they were to be used for repair purposes. The ITC disagreed, finding that the accused were importing complete replacement parts, which were themselves the subject matter of Ford's design patents.

National Arbitration Forum to Permit Combining of Respondent Aliases

In a letter to ICANN, the National Arbitration Forum—one of two main forums for UDRP proceedings—has proposed updated Supplemental Rules for the UDRP, with an intended effective date of November 1, 2007. The proposed change with likely the greatest impact is one relating to allegations of Respondent aliases. In instances where a Complainant believes that a number of domain names are registered to a single entity or person, but under multiple aliases, the Complainant will be allowed to make arguments and present evidence in the UDRP Complaint, linking the alleged aliases. The determination of whether presented evidence is sufficient to link the alleged aliases will be made by the Panel, rather than by the service provider. Large-scale domain name registrants in the "pay-per-click" business often use multiple aliases to avoid being detected and perceived as "cybersquatters." This proposed rule change is also relevant in the context of domain names whose WHOIS information is shielded by the same privacy protection service.

Although there will be an increase in filing fees dependent on the number of domain names involved in the dispute, the proposed change will likely yield monetary savings for Complainants by allowing them to proceed under a single filing instead of having to pursue each of Respondent's multiple aliases separately. It should be noted, however, that if the Panel determines that Complainant's evidence is insufficient to link the alleged aliases, the domain names held by the unrelated registrants will not be subject to further consideration and no portion of the filing fee will be refunded.