

Chapter 1800

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1801 Office Personnel May Not Express Opinion on Validity of Registered Trademark

A certificate of registration of a mark on the Principal Register is prima facie evidence of the validity of the registration. 15 U.S.C. §1057(b). Public policy demands that every employee of the United States Patent and Trademark Office (“USPTO”) refuse to express to any person any opinion as to the validity of any registered mark, except to the extent necessary to carry out inter partes proceedings at the Trademark Trial and Appeal Board in cancellation and similar proceedings authorized by law.

The question of the validity of a registered mark is otherwise exclusively a matter to be determined by a court. Members of the Trademark Examining Operation are cautioned to be especially wary of any inquiry from any person outside the USPTO, including an employee of another Government agency, the answer to which might indicate that a particular registration should not have been published or issued.

An employee of the USPTO, particularly a trademark examining attorney who examined an application, should not discuss or answer inquiries from any

person outside the USPTO as to whether a certain registration or particular evidence was considered during the examination of the application, or whether a mark would have been published or registered if the registration or other evidence had been considered during the examination. Likewise, employees should not answer any inquiry concerning any entry in a registration file, including the extent of the field of search. The record of the file of a registration or inter partes proceeding before the Trademark Trial and Appeal Board must speak for itself.

Employees should refuse to discuss these matters with members of the public, and this refusal should not be considered discourteous. Practitioners should not make improper inquiries of members of the Trademark Examining Operation.

See TMEP §1806 regarding contacts with third parties about ex parte matters.

1801.01 Office Personnel Cannot Testify

37 C.F.R. Part 104.

Subpart A--General Provisions

37 C.F.R. §104.1 Definitions.

Demand means a request, order, or subpoena for testimony or documents for use in a legal proceeding.

Director means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (see § 1.9(j)).

Document means any record, paper, and other property held by the Office, including without limitation, official letters, telegrams, memoranda, reports, studies, calendar and diary entries, maps, graphs, pamphlets, notes, charts, tabulations, analyses, statistical or informational accumulations, any kind of summaries of meetings and conversations, film impressions, magnetic tapes, and sound or mechanical reproductions.

Employee means any current or former officer or employee of the Office.

Legal proceeding means any pretrial, trial, and posttrial stages of existing or reasonably anticipated judicial or administrative actions, hearings, investigations, or similar proceedings before courts, commissions, boards or other tribunals, foreign or domestic. This phrase includes all phases of discovery as well as responses to formal or informal requests by attorneys or others involved in legal proceedings.

Office means the United States Patent and Trademark Office, including any operating unit in the United States Patent and Trademark Office, and its predecessors, the Patent Office and the Patent and Trademark Office.

Official business means the authorized business of the Office.

General Counsel means the General Counsel of the Office.

Testimony means a statement in any form, including personal appearances before a court or other legal tribunal, interviews, depositions, telephonic, televised, or videotaped statements or any responses given during discovery or similar proceedings, which response would involve more than the production of documents, including a declaration under 35 U.S.C. 25 or 28 U.S.C. 1746.

United States means the Federal Government, its departments and agencies, individuals acting on behalf of the Federal Government, and parties to the extent they are represented by the United States.

37 C.F.R. §104.2 Address for mail and service; telephone number.

(a) Mail under this part should be addressed to General Counsel, United States Patent and Trademark Office, P.O. Box 15667, Arlington, VA 22215.

(b) Service by hand should be made during business hours to the Office of the General Counsel, 10B20, Madison Building East, 600 Dulany Street, Alexandria, Virginia.

(c) The Office of the General Counsel may be reached by telephone at 571-272-7000 during business hours.

37 C.F.R. §104.3 Waiver of rules.

In extraordinary situations, when the interest of justice requires, the General Counsel may waive or suspend the rules of this part, sua sponte or on petition of an interested party to the Director, subject to such requirements as the General Counsel may impose. Any petition must be accompanied by a petition fee of \$130.00.

37 C.F.R. §104.4 Relationship of this Part to the Federal Rules of Civil or Criminal Procedure.

Nothing in this part waives or limits any requirement under the Federal Rules of Civil or Criminal Procedure.

Subpart B--Service of Process

37 C.F.R. §104.11 Scope and purpose.

(a) This subpart sets forth the procedures to be followed when a summons and complaint is served on the Office or on the Director or an employee in his or her official capacity.

(b) This subpart is intended, and should be construed, to ensure the efficient administration of the Office and not to impede any legal proceeding.

(c) This subpart does not apply to subpoenas, the procedures for which are set out in subpart C.

(d) This subpart does not apply to service of process made on an employee personally on matters not related to official business of the Office or to the official responsibilities of the employee.

37 C.F.R. §104.12 Acceptance of service of process.

(a) Any summons and complaint to be served in person or by registered or certified mail or as otherwise authorized by law on the Office, on the Director, or on an employee in his or her official capacity, shall be served as indicated in §104.2.

(b) Any employee of the Office served with a summons and complaint shall immediately notify, and shall deliver the summons and complaint to, the Office of the General Counsel.

(c) Any employee receiving a summons and complaint shall note on the summons and complaint the date, hour, and place of service and whether service was by hand or by mail.

(d) When a legal proceeding is brought to hold an employee personally liable in connection with an action taken in the conduct of official business, rather than liable in an official capacity, the employee by law is to be served personally with process. See Fed. R. Civ. P. 4(e). An employee sued personally for an action taken in the conduct of official business shall immediately notify and deliver a copy of the summons and complaint to the General Counsel.

(e) An employee sued personally in connection with official business may be represented by the Department of Justice at its discretion (28 CFR 50.15 and 50.16).

(f) The Office will only accept service of process for an employee in the employee's official capacity.

Subpart C--Employee Testimony and Production of Documents in Legal Proceedings

37 C.F.R. §104.21 Scope and purpose.

(a) This subpart sets forth the policies and procedures of the Office regarding the testimony of employees as witnesses in legal proceedings and the production or disclosure of information contained in Office documents for use in legal proceedings pursuant to a demand.

(b) Exceptions. This subpart does not apply to any legal proceeding in which:

(1) An employee is to testify regarding facts or events that are unrelated to official business; or

(2) A former employee is to testify as an expert in connection with a particular matter in which the former employee did not participate personally while at the Office.

37 C.F.R. §104.22 Demand for testimony or production of documents.

(a) Whenever a demand for testimony or for the production of documents is made upon an employee, the employee shall immediately notify the Office of the General Counsel at the telephone number or addresses in §104.2 and make arrangements to send the subpoena to the General Counsel promptly.

(b) An employee may not give testimony, produce documents, or answer inquiries from a person not employed by the Office regarding testimony or documents subject to a demand or a potential demand under the provisions of this subpart without the approval of the General Counsel. The General Counsel may authorize the provision of certified copies not otherwise available under Part 1 of this title subject to payment of applicable fees under §1.19.

(c)(1) Demand for testimony or documents. A demand for the testimony of an employee under this subpart shall be addressed to the General Counsel as indicated in §104.2.

(2) Subpoenas. A subpoena for employee testimony or for a document shall be served in accordance with the Federal Rules of Civil or Criminal Procedure or applicable state procedure, and a copy of the subpoena shall be sent to the General Counsel as indicated in §104.2.

(3) Affidavits. Except when the United States is a party, every demand shall be accompanied by an affidavit or declaration under 28 U.S.C. 1746 or 35 U.S.C. 25(b) setting forth the title of the legal proceeding, the forum, the requesting party's interest in the legal proceeding, the reason for the demand, a showing that the desired testimony or document is not reasonably available from any other source, and, if testimony is requested, the intended use of the testimony, a general summary of the desired testimony, and a showing that no document could be provided and used in lieu of testimony.

(d) Failure of the attorney to cooperate in good faith to enable the General Counsel to make an informed determination under this subpart may serve as a basis for a determination not to comply with the demand.

(e) A determination under this subpart to comply or not to comply with a demand is not a waiver or an assertion of any other ground for noncompliance, including privilege, lack of relevance, or technical deficiency.

(f) Noncompliance. If the General Counsel makes a determination not to comply, he or she will seek Department of Justice representation for the employee and will attempt to have the subpoena modified or quashed. If Department of Justice representation cannot be arranged, the employee should appear at the time and place set forth in the subpoena. In such a case, the employee should produce a copy of these rules and state that the General Counsel has advised the employee not to provide the requested testimony nor to produce the requested document. If a legal tribunal rules that the demand in the subpoena must be complied with, the employee shall respectfully decline to comply with the demand....

37 C.F.R. §104.23 Expert or opinion testimony.

(a)(1) If the General Counsel authorizes an employee to give testimony in a legal proceeding not involving the United States, the testimony, if otherwise proper, shall be limited to facts within the personal knowledge of the employee. Employees, with or without compensation, shall not provide expert testimony in any legal proceedings regarding Office information, subjects, or activities except on behalf of the United States or a party represented by the United States Department of Justice.

(2) The General Counsel may authorize an employee to appear and give the expert or opinion testimony upon the requester showing, pursuant to §104.3 of this part, that exceptional circumstances warrant such testimony and that the anticipated testimony will not be adverse to the interest of the Office or the United States.

(b)(1) If, while testifying in any legal proceeding, an employee is asked for expert or opinion testimony regarding Office information, subjects, or activities, which testimony has not been approved in advance in writing in accordance with the regulations in this subpart, the witness shall:

(i) Respectfully decline to answer on the grounds that such expert or opinion testimony is forbidden by this subpart;

(ii) Request an opportunity to consult with the General Counsel before giving such testimony; and

(iii) Explain that upon such consultation, approval for such testimony may be provided.

(2) If the tribunal conducting the proceeding then orders the employee to provide expert or opinion testimony regarding Office information, subjects, or activities without the opportunity to consult with the General Counsel, the employee shall respectfully refuse to provide such testimony....

(c) If an employee is unaware of the regulations in this subpart and provides expert or opinion testimony regarding Office information, subjects, or activities in a legal proceeding without the aforementioned consultation, the employee shall, as soon after testifying as possible, inform the General Counsel that such testimony was given and provide a written summary of the expert or opinion testimony provided.

(d) Proceeding where the United States is a party. In a proceeding in which the United States is a party or is representing a party, an employee may not testify as an expert or opinion witness for any party other than the United States.

37 C.F.R. §104.24 Demands or requests in legal proceedings for records protected by confidentiality statutes.

Demands in legal proceedings for the production of records, or for the testimony of employees regarding information protected by the confidentiality provisions of the Patent Act (35 U.S.C. 122), the Privacy Act (5 U.S.C. 552a), the Trade Secrets Act (18 U.S.C. 1905), or any other confidentiality statute, must satisfy the requirements for disclosure set forth in those statutes and associated rules before the records may be provided or testimony given.

Subpart D--Employee Indemnification

37 C.F.R. §104.31 Scope.

The procedure in this subpart shall be followed if a civil action or proceeding is brought, in any court, against an employee (including the employee's estate) for personal injury, loss of property, or death, resulting from the employee's activities while acting within the scope of the employee's office or employment.

When the employee is incapacitated or deceased, actions required of an employee should be performed by the employee's executor, administrator, or comparable legal representative.

37 C.F.R. §104.32 Procedure for requesting indemnification.

(a) After being served with process or pleadings in such an action or proceeding, the employee shall within five (5) calendar days of receipt, deliver to the General Counsel all such process and pleadings or an attested true copy thereof, together with a fully detailed report of the circumstances of the incident giving rise to the court action or proceeding.

(b)(1) An employee may request indemnification to satisfy a verdict, judgment, or award entered against that employee only if the employee has timely satisfied the requirements of paragraph (a) of this section.

(2) No request for indemnification will be considered unless the employee has submitted a written request through the employee's supervisory chain to the General Counsel with:

(i) Appropriate documentation, including copies of the verdict, judgment, appeal bond, award, or settlement proposal;

(ii) The employee's explanation of how the employee was acting within the scope of the employee's employment; and

(iii) The employee's statement of whether the employee has insurance or any other source of indemnification.

Subpart E--Tort Claims

37 C.F.R. §104.41 Procedure for filing claims.

Administrative claims against the Office filed pursuant to the administrative claims provision of the Federal Tort Claims Act (28 U.S.C. 2672) and the corresponding Department of Justice regulations (28 CFR Part 14) shall be filed with the General Counsel as indicated in §104.2.

37 C.F.R. §104.42 Finality of settlement or denial of claims.

Only a decision of the Director or the General Counsel regarding settlement or denial of any claim under this subpart may be considered final for the purpose of judicial review.

It is the policy of the USPTO that its employees, including trademark examining attorneys, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in 37 C.F.R. Part 104. Any employee who testifies contrary to this policy will be dismissed or removed.

Whenever an employee of the USPTO, including a trademark examining attorney, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the General Counsel. Inquiries requesting testimony should also be referred immediately to the Office of the General Counsel.

Trademark examining attorneys and other USPTO employees who perform or assist in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any registration.

Any individual desiring the testimony of an employee of the USPTO, including the testimony of a trademark examining attorney or other quasi-judicial employee, must comply with the provisions of 37 C.F.R. Part 104.

A request for testimony of an employee of the USPTO should be made to the Office of the General Counsel at least ten working days prior to the date of the expected testimony.

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions. *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner); *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative questions or conclusions). Employees will not be permitted to give testimony with respect to subject matter that is privileged. Several court decisions limit testimony with respect to quasi-judicial functions performed by employees. *U.S. v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co., Inc. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions that probe the examiner's technical knowledge of the subject matter of a patent); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. §134 since board members need not be skilled in the art to render obviousness decision); *McCulloch Gas Processing Co. v. Department of Energy*, 650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *Lange v. Commissioner*, 352 F. Supp. 116, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in Sec. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding that took place before the USPTO, the employee will not be permitted to give testimony in response to questions that seek:

- (1) Information about that employee's:

- (A) Background.
 - (B) Expertise.
 - (C) Qualifications to examine or otherwise consider a particular patent or trademark application.
 - (D) Usual practice or whether the employee followed a procedure set out in any USPTO manual of practice (including the MPEP or TMEP) in a particular case.
 - (E) Consultation with another USPTO employee.
 - (F) Understanding of:
 - (i) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.
 - (ii) Prior art.
 - (iii) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference or concurrent use file.
 - (iv) Any USPTO manual of practice.
 - (v) USPTO regulations.
 - (vi) Patent, trademark, or other law.
 - (vii) The responsibilities of another USPTO employee.
 - (G) Reliance on particular facts or arguments.
- (2) To inquire into the manner in and extent to which the employee considered or studied material in performing the quasi-judicial function.
 - (3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that USPTO employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the General Counsel must comply with 37 C.F.R. §104.22(c). All requests must be in writing. The need for a subpoena may be obviated where the request complies with 37 C.F.R. §104.22(c) only if the party requesting the testimony meets the following conditions:

- (1) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include:
 - (A) the style of the case,
 - (B) the civil action number,
 - (C) the district in which the civil action is pending,
 - (D) the judge assigned to the case, and
 - (E) the name, address, and telephone number of counsel for all parties in the civil action.
- (2) The party agrees not to ask questions seeking information that is precluded by 37 C.F.R. §104.23.
- (3) The party must comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give ten working days notice to the Office of the General Counsel prior to the date a deposition is desired. Fifteen working days notice is required for any deposition that is desired to be taken between November 15 and January 15.
- (4) The party agrees to notice the deposition at a place convenient to the USPTO. The Conference Room in the Office of the General Counsel is deemed to be a place convenient to the USPTO.
- (5) The party agrees to supply a copy of the transcript of the deposition to the USPTO for its records.

Absent a written agreement meeting the conditions specified in paragraphs (1) through (5), a party must comply with the specific terms of 37 C.F.R. §104.22(c), and the USPTO will not permit a deposition without issuance of a subpoena.

See notice at 1099 TMOG 44 (February 28, 1989).

1802 Congressional Inquiries

Inquiries from congressional offices should be directed to the Office of Congressional Relations in the Office of External Affairs at (571) 272-9300.

1803 Freedom of Information Act Requests

Freedom of Information Act ("FOIA") requests should be sent by e-mail to efoia@uspto.gov, or by mail to the following address:

USPTO FOIA Officer

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Such requests may be addressed to the attention of the Freedom of Information Act/Privacy Act Officer.

Copies of final agency decisions of the USPTO and our most frequently requested FOIA documents are available on the USPTO website at <http://www.uspto.gov>.

1804 Inquiries from Members of the Press

Inquiries from members of the press should be directed to the Office of Public Affairs, at (571) 272-8400.

1805 General Inquiries from the Public

USPTO employees will gladly answer questions about the procedures for obtaining and maintaining a registration. For general information, callers may telephone the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199. See TMEP §108.02.

However, USPTO employees cannot:

- Comment on the validity of registered marks (see TMEP §1801);
- Provide a legal opinion on whether a particular mark or type of mark is eligible for registration; or
- Offer legal advice or opinions about common law rights in a mark, state registrations, or trademark infringement claims.

For a legal opinion about a trademark matter, a party must consult a private trademark attorney. The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11. Private trademark attorneys are generally listed in the yellow pages under the heading “Lawyers, Patent and Trademark,” or “Lawyers, Trademark.”

See TMEP §104 regarding trademark searches.

See TMEP §1806 regarding contacts with third parties about ex parte matters.

1806 Contacts with Third Parties Regarding Ex Parte Matters

An examining attorney or other USPTO employee may not discuss the merits of any particular application or registration with a third party. If a third party attempts to contact an examining attorney about an ex parte matter, either

orally or in writing, the examining attorney should refer the third party to the Office of the Deputy Commissioner for Trademark Examination Policy. See TMEP §§1715 *et seq.* regarding letters of protest.

An examining attorney may contact those in the relevant trade to obtain generally available information about an industry and its marketing practices, but the inquiry must be limited to eliciting factual information. It is inappropriate to discuss or request opinions about the registrability of a particular mark. See *In re Lutron Electronics Co. Inc.*, 8 USPQ2d 1701 (Comm'r Pats. 1988).

1807 United States Patent and Trademark Office World Wide Web Page

The USPTO has a website at www.uspto.gov that provides access to a wide variety of information about trademarks and offers electronic filing of trademark applications and other trademark documents. See TMEP §102 for further information.