UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: December 22, 2010

Opposition No. 91193562

Deere & Company

v.

UniPat Products, Virginia, LLC

Before Bucher, Mermelstein and Wellington, Administrative Trademark Judges

By the Board:

On October 12, 2010, the Board issued an order (the "Prior Order") denying opposer's motion for summary judgment on its claim that the involved application is void because it was assigned from Sayre Enterprises, Inc. to applicant in violation of Section 10 of the Act. This case now comes up for consideration of opposer's fully-briefed motion for reconsideration of the Prior Order, filed October 22, 2010.

In the Prior Order, the Board relied on applicant's amended response to opposer's Interrogatory No. 32, and the Declaration of R. Scott Sayre, President of Sayre Enterprises and applicant, to find that genuine issues of material fact remain for trial, specifically "as to whether an ongoing and existing business existed at the time of the Assignment and was transferred to a successor of Sayre

Enterprises, Inc." The Prior Order recognized that the amended interrogatory response and Mr. Sayre's declaration "appear to contradict applicant's original interrogatory response," and that the U.S. Court of Appeals for the Federal Circuit has applied the "sham affidavit" rule to disregard declarations which contradict prior deposition testimony. However, the Prior Order declined to apply the sham affidavit rule in this case, noting that the Federal Circuit has not held "that a party may not rely on a declaration which contradicts a prior inconsistent interrogatory response," as opposed to prior inconsistent deposition testimony. Furthermore, while recognizing that applicant's explanation for the inconsistency "leaves much to be desired and raises additional questions," the Board noted applicant's explanation that it "discovered" additional evidence after serving the original interrogatory response, and that applicant's later testimony and amended interrogatory response are supported by "contemporaneous e-mails and documents."

In its request for reconsideration, opposer first argues that "[i]t was error for the Board to apply Federal Circuit case law regarding" the sham affidavit rule, rather than the law of the "appropriate regional circuit." Opposer does not, however, indicate which regional circuit's law it

believes should be applied in this case.[1] Opposer next argues, based on federal district court decisions from across the United States, that the sham affidavit rule applies to prior inconsistent interrogatories, just as it applies to prior inconsistent deposition testimony, and that the Federal Circuit has not so applied the rule because it "has not been asked to address this precise question." Finally, opposer points out that only opposer's attorney, and not Mr. Sayre, attempts to explain the contradiction between the original and amended interrogatory response, and argues that applicant's evidence does not support a finding that applicant is a successor to the business of Sayre Enterprises.

A motion for reconsideration "may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion." TBMP § 518 (2d ed. rev. 2004). Instead, a motion for reconsideration "should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change." Id.

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[1] When considering an appeal of a patent case from a U.S. district court, the Court of Appeals for the Federal Circuit applies the law of the regional circuit in which the district court sits to determine non-patent issues which may be part of the case. Panduit Corp. v. All States Plastic Mfg. Co., Inc., 744 F.2d 1564, 223 USPQ 465 (Fed. Cir. 1984). However, when

Here, opposer is simply rearguing the points presented in its original motion. Its motion for reconsideration is therefore **DENIED**.

We recognize that, as opposer points out, many federal courts have indicated that the sham affidavit rule may apply to prior inconsistent interrogatories in certain circumstances, and that some courts have in fact applied the rule to prior inconsistent interrogatories. However, even if we granted reconsideration on the assumption that the Federal Circuit would apply the sham affidavit rule to prior inconsistent interrogatories in certain circumstances, we would find that the rule should not apply under the circumstances of this case.

In fact, the sham affidavit rule "does not automatically dispose of every case in which a contradictory affidavit is introduced to explain portions of earlier deposition testimony." Kennedy v. Allied Mut. Ins. Co., 952 F.2d 262, 266-67 (9th Cir. 1991)). Instead, it is necessary to determine whether the subsequent affidavit is actually a "sham." Id.

> To allow every failure of memory or variation in a witness's testimony to be disregarded as a sham would require far too much from lay witnesses and would deprive the trier of fact of the traditional opportunity to determine which point in time and with which words

considering appeals from the TTAB, the Federal Circuit is not bound by the law of any particular circuit.

> the witness … was stating the truth. Variations in a witness's testimony and any failure of memory throughout the course of discovery create an issue of credibility as to which part of the testimony should be given the greatest weight if credited at all.

Tippens v. Celotex Corp., 805 F.2d 949, 953-54 (11th Cir. 1986). As stated in one of the cases upon which opposer relies, "[a]n affidavit might not be a sham if the affiant's actions were the result of honest discrepancy, a mistake, or the result of newly discovered evidence," or "if the affiant gives a plausible excuse for the contradiction." Jack v. Trans World Airlines, Inc., 854 F. Supp. 654, 660 (N.D. Cal. 1994)). In short, the rule "should be applied with caution." School District No. 1J, Multnomah County, Oregon v. ACandS, Inc., 5 F.3d 1255, 1264 (9th Cir. 1993).

Here, applicant contends that the contradiction was based on newly discovered facts. Courts may consider subsequent and contradictory affidavits when they are based on newly discovered facts. Delaney v. Deere and Co., 219 F.3d 1195, 1196 n. 1 (10th Cir. 2000); Adelman-Tremblay v. Jewel Companies, Inc., 859 F.2d 517, 520 (7th Cir. 1988).

Mr. Sayre's subsequent testimony is also supported by documentary evidence which predates opposer's motion for summary judgment. This is another basis upon which to consider his declaration. Baer v. Chase, 392 F.3d 609, 625 (3d Cir. 2004)("When there is independent evidence in the

record to bolster an otherwise questionable affidavit, courts generally have refused to disregard the affidavit"); Palazzo v. Corio, 232 F.3d 38, 44 (2d Cir. 2000); Colosimo v. United States, 707 F. Supp.2d 926, 939 (S.D. Iowa 2010)("Denning's affidavit is not a sham affidavit, created merely to head off summary judgment. Indeed, the document on which it is based … predates the motion for summary judgment."); Argusea LDC v. United States, 622 F. Supp.2d 1322 (S.D. Fla. 2008).

Finally, the sham affidavit rule is more likely to apply when the affiant was cross-examined during his prior inconsistent testimony. Jimenez v. All American Rathskeller, Inc., 503 F.3d 247, 253 (3d Cir. 2007); Shockley v. City of Newport News, 997 F.2d 18, 23 (4th Cir. 1993); Franks v. Nimmo, 796 F.2d 1230, 1237 (10th Cir. 1986)("Factors relevant to the existence of a sham fact issue include whether the affiant was cross-examined during his earlier testimony …"). In this case, however, Mr. Sayre's subsequent testimony contradicts a single interrogatory response, and there has not yet been any opportunity for cross-examination.

For all of these reasons, even if we were to assume that the Federal Circuit would apply the sham affidavit rule to prior inconsistent interrogatories, the apparent inconsistencies between applicant's original and

supplemental interrogatory responses in this case would present a credibility issue, rather than grounds for disregarding Mr. Sayre's declaration. See, Competitive Technologies, Inc. v. Marcovitch, 2009 WL 928647 (D. Conn. 2009).

Proceedings herein are resumed, and discovery, disclosure, trial and other dates are reset as follows:

Expert Disclosures Due	**March 16, 2011**
Discovery Closes	**April 15, 2011**
Plaintiff's Pretrial Disclosures	**May 30, 2011**
Plaintiff's 30-day Trial Period Ends	**July 14, 2011**
Defendant's Pretrial Disclosures	**July 29, 2011**
Defendant's 30-day Trial Period Ends	**September 12, 2011**
Plaintiff's Rebuttal Disclosures	**September 27, 2011**
Plaintiff's 15-day Rebuttal Period Ends	**October 27, 2011**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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