Chapter 500 STIPULATIONS AND MOTIONS

501 **Stipulations**
501.01 In General
501.02 Filing Stipulations
501.03 Form of Stipulations
502 **Motions - In General**
502.01 Available Motions
502.02 Form of Motions and Briefs on Motions
502.02(a) Form of Motions
502.02(b) Briefs on Motions
502.02(c) Confidential Information
502.03 Oral Hearings on Motions
502.04 Determination of Motions
502.05 Attorneys' Fees, etc., on Motions
502.06 Telephone and Pretrial Conferences
502.06(a) Telephone Conferences
502.06(b) Pretrial Conferences
502.07 Fed. R. Civ. P. 11 Applicable
503 **Motion to Dismiss for Failure to State a Claim**
503.01 Time for Filing
503.02 Nature of Motion
503.03 Leave to Amend Defective Pleading
503.04 Matters Outside the Pleading Submitted on Motion to Dismiss
504 **Motion for Judgment on the Pleadings**
504.01 Time for Filing
504.02 Nature of Motion
504.03 Matters Outside the Pleadings Submitted on Motion for Judgment on Pleadings
505 **Motion for a More Definite Statement**
505.01 Nature of Motion
505.02 Time for Filing
505.03 Failure to Obey Order for More Definite Statement
506 **Motion to Strike Matter From Pleading**
506.01 Nature of Motion
506.02 Time for Filing
506.03 Exhibits Attached to Pleadings
507 **Motion to Amend Pleading**
507.01 In General
507.02 Amendments – General Rule – Fed. R. Civ. P. 15(a)
507.02(a) Timing of Motion to Amend Pleading – In General
507.02(b) Timing of Motion to Amend to Add Counterclaim
507.03 Amendments to Conform to the Evidence - Fed. R. Civ. P. 15(b)
507.03(a) During Trial After Objection to Trial Evidence
507.03(b) To Add Issues Tried by Express or Implied Consent
508 **Motion for Default Judgment for Failure to Answer**
509 **Motion to Extend Time; Motion to Reopen Time**
509.01 Nature of Motions
509.01(a) Motions to Extend Time
509.01(b) Motions to Reopen Time
509.01(b)(1) In General
509.01(b)(2) To Introduce Newly Discovered Evidence
509.02 Form and Determination of Motions to Extend or Reopen
510 **Motion to Suspend; Motion to Resume**

510.01 In General
510.02 Suspension Pending Outcome of Another Proceeding; Resumption
510.02(a) Suspension
510.02(b) Resumption
510.03 Suspension for Other Reasons; Resumption
510.03(a) Suspension
510.03(b) Resumption
511 Motion to Consolidate
512 Motion to Join or Substitute
512.01 Assignment of Mark
512.02 Change of Name
512.03 Issuance of Registration to Assignee, or in New Name
512.04 Misidentification
513 Motion to Withdraw as Representative; Petition to Disqualify
513.01 Motion to Withdraw as Representative
513.02 Petition to Disqualify
514 Motion to Amend Application or Registration
514.01 In General
514.02 Amendment With Consent
514.03 Amendment Without Consent
514.04 Amendment to Allege Use; Statement of Use
515 Motion to Remand Application to Examining Attorney
516 Motion to Divide Application or Registration
517 Motion to Strike Brief on Motion
518 Motion for Reconsideration of Decision on Motion
519 Motion for Leave to Serve Additional Interrogatories, Requests for Production of Documents, or Requests for Admission
520 Motion to Take Foreign Deposition Orally
521 Motion to Quash Notice of Deposition
522 Motion for Order re Manner or Place of Document Production
523 Motion to Compel Disclosure or Discovery
523.01 In General
523.02 Special Requirements for Motion
523.03 Time for Filing Motion
523.04 Failure to File Motion to Compel
524 Motion to Test Sufficiency of Response to Requests for Admission
524.01 In General
524.02 Special Requirements for Motion
524.03 Time for Filing Motion
524.04 Failure to File Motion
525 Motion to Withdraw or Amend Admission
526 Motion for a Protective Order
527 Motion for Sanctions
527.01 Motion for Discovery Sanctions
527.01(a) For Failure to Comply With Board Discovery Order
527.01(b) If Party Says It Will Not Respond to Discovery Request or Make Required Disclosures
527.01(c) Untimely Response to Discovery Requests
527.01(d) In the Case of Requests for Admission
527.01(e) Estoppel Sanction
527.01(f) Motions in Limine

527.02 Motion for Fed. R. Civ. P. 11 Sanctions
527.03 Inherent Authority to Sanction
528 **Motion For Summary Judgment and Accelerated Case Resolution (ACR)**
528.01 General Nature of Motion
528.02 Time For Filing Motion
528.03 Suspension Pending Determination of Motion
528.04 Miscaptioned Motion
528.05 Summary Judgment Evidence
528.05(a)
528.05(a)(1) In General
528.05(a)(2) Accelerated Case Resolution (ACR)
528.05(b) Affidavits and Accompanying Exhibits
528.05(c) Discovery Responses and Disclosures
528.05(d) Registrations
528.05(e) Printed Publications and Official Records
528.05(f) Testimony from Another Proceeding
528.06 Request For Discovery to Respond to Summary Judgment
528.07 Unpleaded Issue
528.07(a) Not Basis for Entering Summary Judgment
528.07(b) Not Defense Against Summary Judgment
528.08 Entry of Summary Judgment in Favor of Nonmoving Party
529 **Motion to Offer Discovery Deposition of Self or Nonparty**
530 **Motion to Use Testimony From Another Proceeding**
531 **Motion That Deposition Upon Written Questions Be Taken Orally**
532 **Motion to Strike Notice of Reliance**
533 **Motion to Strike Trial Testimony Deposition**
533.01 On Ground of Untimeliness
533.02 On Other Grounds
533.02(a) On Ground of Improper or Inadequate Notice
533.02(b) On Ground of Failure to Disclose Witness in Expert or Pretrial Disclosures
533.03 When Motion to Strike Should Not Be Filed
534 **Motion For Judgment For Plaintiff's Failure to Prove Case**
534.01 In General
534.02 Motion For Judgment Under 37 CFR § 2.132(a)
534.03 Motion For Judgment Under 37 CFR § 2.132(b)
534.04 Motion Under Fed. R. Civ. P. 41(b) or Fed. R. Civ. P. 50(a) Not Available
535 **Motion For Order to Show Cause Under 37 CFR § 2.134(b)**
536 **Motion For Order to Show Cause Under 37 CFR § 2.128(a)(3)**
537 **Motion For Leave to Exceed Page Limit For Brief On Case**
538 **Motion For Leave to File Amicus Brief**
539 **Motion to Strike Brief On Case**
540 **Motion For Augmented Panel Hearing**
541 **Motion to Change Oral Hearing Date; For Additional Time**
541.01 Motion to Change Oral Hearing Date
541.02 Motion For Additional Time For Oral Argument
542 **Motion For Leave to Record Oral Hearing**
543 **Motion For Reconsideration of Final Decision**
544 **Motion For Relief From Final Judgment**

501 Stipulations

501.01 In General

Subject to the approval of the Board, parties may stipulate to a wide variety of matters. For example, parties may stipulate: that times be extended or reopened; that the total number of interrogatories or requests for production that one party may serve upon another party in a proceeding may be reduced from the limitation specified in 37 CFR § 2.120(d) or 37 CFR § 2.120(e); that the production of documents and things under the provisions of Fed. R. Civ. P. 34 may be made in a specified place and/or manner [Note 1.]; that protective agreements or provisions different from or in substitution for the Board's standard protective order be used; to the substance or the form of the facts or testimony in the case [Note 2.]; that a deposition may be taken at a particular place, or in a certain manner [Note 3.]; that the proceeding shall be ended in a specified way; or that the proceeding be determined by pretrial disposition on the merits or abbreviated trial on the merits by means of Accelerated Case Resolution (ACR). [Note 4.] *See* TBMP § 403.04 (Extensions of Discovery Period, Time to Respond to Discovery Requests, and Disclosures), TBMP § 412.02 (Modification of Board's Standard Protective Order Upon Stipulation), TBMP § 528.05(a)(2) (Accelerated Case Resolution (ACR)), and TBMP § 605.03 (Settlement Agreements), TBMP § 702.04 (Accelerated Case Resolution), TBMP § 702.04(e) (Utilizing Stipulations in Non-ACR cases), and TBMP § 705 (Stipulated Evidence and Accelerated Case Resolution).

NOTES:

1. 37 CFR § 2.120(e).

2. 37 CFR § 2.123(b). *See, e.g., Board of Regents, University of Texas System v. Southern Illinois Miners LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of produced documents and waiver of objections based on authenticity or hearsay); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1426 (TTAB 2014) (stipulation to the authenticity of certain documents, retail prices of opposers' goods, the fact that advertisements and news articles refer to opposers, and press clippings are representative of the media in which opposers advertise); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (TTAB 2014) (parties filed joint stipulation that all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (the parties stipulated to the entire record, including business records, public records, marketing materials, Internet materials, and 13 paragraphs of facts, while reserving the right to object to such facts and documents on the bases of relevance, materiality and weight).

3. 37 CFR § 2.123(b).

4. *See, e.g., Fiserv, Inc. v. Electronic Transmission Systems Corp.*, 113 USPQ2d 1913, 116 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded filing of motions for summary judgment and use of expert testimony, streamlined methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *on appeal*, No. 14-CV-4463 (D. Minn.); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1950 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert

declarations, trial briefs and an oral hearing), *vacated on other grounds and remanded*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775-76 (TTAB 2013) (approving parties' stipulation to proceed via ACR).

501.02 Filing Stipulations

37 CFR § 2.120(a)(2) ***[Discovery]*** …

(iv) *The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board... Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. ..*

(v) *The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.*

37 CFR § 2.120(a)(3) ***[Discovery]*** *A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. ...*

37 CFR § 2.121(d) ***[Assignment of times for taking testimony and presenting evidence.]*** *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

Stipulations that require action or consideration by the Board must be filed with the Board. For example, the following must be filed with the Board: stipulations to extend a defendant's time to file an answer to the complaint; stipulations to alter the length of the discovery period or disclosure obligations occurring during the discovery period; stipulations to waive required initial disclosures; stipulations to reschedule pretrial disclosures and subsequent trial dates; stipulations to extend trial dates; stipulations relating to the form of testimony; stipulations to end a proceeding in a specified way; stipulations to pretrial disposition on the merits or abbreviated trial on the merits by means of Accelerated Case Resolution (ACR). [Note 1.] Some other types of stipulations, such as stipulations to extend a party's time for responding to a request for discovery, do not necessarily have to be filed with the Board. However, even in the case of a stipulation that does not have to be filed, the better practice is to reduce the stipulation to writing, in order to avoid any misunderstanding between the parties as to the existence and terms thereof.

NOTES:

1. 37 CFR § 2.120(a)(2)(iv); 37 CFR § 2.120(a)(3); 37 CFR § 2.121(d). *See, e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775-76 (TTAB 2013) (approving parties' stipulation to proceed via ACR).

501.03 Form of Stipulations

A stipulation may be signed either by the parties, or by their attorneys or other authorized representatives.

If parties stipulate to extend or reopen a time or times, the stipulation should specify the closing date for each rescheduled time. For example, if parties stipulate to extend or reopen a defendant's time to file an answer to the complaint, the stipulation should specify the new due date for the answer and all subsequent dates that require rescheduling when the due date for the answer is reset, including the deadline for the required discovery conference, disclosures, discovery and trial. If parties stipulate to extend or reopen testimony periods, or the discovery period and testimony periods, the stipulation should be submitted in the form used in a trial order, specifying the closing date for each period to be reset, including relevant disclosure deadlines, such as the deadline for expert disclosures which occurs 30 days prior to the close of discovery, and pretrial disclosure deadlines which are tied to each testimony period. [Note 1.] When the parties agree to a new schedule of dates and file for approval using ESTTA "consent motions option," the system will prompt the filer to enter new deadlines in a manner that will generate an appropriate schedule in the proper form. If the calculator provided by ESTTA does not reflect all the deadlines required by the parties' agreed-upon schedule, the filing party should select the "general filings" option and attach or embed in the motion the agreed-upon schedule with an express statement that all parties agree to the new dates.

The resetting, whether by stipulation or otherwise, of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods--such dates will be rescheduled only upon stipulation of the parties being approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 2.] *See* TBMP § 403.04 (Extensions of Discovery Period, Time to Respond to Discovery Requests, and Disclosures).

NOTES:

1. 37 CFR § 2.121(d).

2. 37 CFR § 2.120(a)(3); 37 CFR § 2.121(a).

502 Motions - In General

502.01 Available Motions

There is a wide range of motions that may be filed in inter partes proceedings before the Board. 37 CFR § 2.116(a), provides that "[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure." Thus, many of the motions available under the Federal Rules of Civil Procedure are also available in proceedings before the Board.

However, because the Board is an administrative tribunal, its rules and procedures, and hence the motions available in proceedings before it, necessarily differ in some respects from those prevailing in the federal district courts. *See* TBMP § 102.03 (General Description of Board Proceedings) and TBMP § 702 (Pretrial Disclosures; Manner of Trial and Introduction of Evidence).

For example, the Board does not preside at the taking of oral testimony. Instead, oral testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. [Note 1.] *See* TBMP § 702. Further, for reasons of administrative economy, it is the

policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. [Note 2.] For this reason, the Board will defer consideration of substantive objections to trial evidence (e.g., on the grounds of hearsay, relevance, or that the evidence constitutes improper rebuttal) until final decision. [Note 3.] *See also* TBMP § 707 (Objections to Evidence).Therefore, except for the motions for involuntary dismissal under 37 CFR § 2.132(a) and 37 CFR § 2.132(b) for failure of the plaintiff to take testimony or offer evidence (other than plaintiff's pleaded registration under 37 CFR § 2.132(b)), the Board will not entertain any motion challenging or otherwise relating to the probative value or sufficiency of a party's trial evidence. For information concerning these motions, see TBMP § 534 (Motion for Judgment for Plaintiff's Failure to Prove Case). Motions that require examination of trial evidence prior to final decision, such as motions in limine, and those under Fed. R. Civ. P. 41(b) for involuntary dismissal and under Fed. R. Civ. P. 50(a) for judgment as a matter of law (formerly known as a motion for directed verdict), are not available in Board proceedings. [Note 4.]

Given the broad range of possible motions which that be filed in an inter partes proceeding before the Board, this chapter discusses only the motions that most commonly arise in Board proceedings.

NOTES:

1. *See* 37 CFR § 2.123(a); 37 CFR § 2.125(d).

2. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003) (substantive evidentiary issues are deferred until final decision); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) ("The Board does not read testimony and consider substantive objections to evidence, or determine the probative value of evidence, prior to final hearing"); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (Board will not rule on objections pertaining to admissibility prior to final decision).

3. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003) (substantive evidentiary issues are deferred until final decision); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (contested motions to introduce discovery depositions filed with a notice of reliance deferred); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (objection to notice of reliance that the evidence is improper rebuttal evidence will be deferred); *M-Tek Inc. v. CVP Systems, Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (motion to strike documents submitted under a notice of reliance as hearsay and not properly authenticated deferred).

4. *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010) (applicant's motion to exclude testimony not construed as motion in limine); *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750-51 (TTAB 1995) (motions in limine not available); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993) (directed verdicts not available); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718, 718 (TTAB 1985) (to extent motion for summary judgment was intended as one for directed verdict, it is inappropriate); *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 56 n.7 (TTAB 1983) (motion for involuntary dismissal under Fed. R. Civ. P. 41(b) unavailable), *aff'd*, 737 F.2d 1576, 222 USPQ 665, 668-69 (Fed. Cir. 1984). *Cf. Hunter Industries Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014) (noting that because the Board does not entertain motions in limine, opposer was unable to raise the issue of over-designation of confidential identifying information of declarants until applicant submitted the declarations during its testimony period), *on appeal*, No. 14-CV-4463 (D. Minn.).

502.02 Form of Motions and Briefs on Motions

37 CFR § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*
(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto ... must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:*

(1) *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*

(2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*

(3) *If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*

(4) *A paper submission must not be stapled or bound;*

(5) *All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in §2.123(g)(2);*

(6) *Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

(c) *To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to §2.125(f) must be submitted using the "Confidential" selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.*

37 CFR § 2.127(a) *Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion. Neither the brief in support of a motion nor the brief in response to the motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion,*

the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

* * * *

37 CFR § 2.127(e)(1) ... *If no motion under Rule 56(d) is filed, a brief in response to the motion for summary judgment shall be filed within thirty days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board.*

502.02(a) Form of Motions

Every motion must be submitted via ESTTA, in written form and must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.126. The requirements for electronic submissions are specified in 37 CFR § 2.126(a), the requirements for paper submissions can be found in 37 CFR § 2.126(b), and the requirements for confidential submissions are in 37 CFR § 2.126(c). Additional information regarding electronic submissions made through ESTTA may be found at the USPTO website (http://www.uspto.gov) by accessing the "Trademark Trial and Appeal Board" portion of that site. *See also* TBMP § 106.03.

In addition, a motion should bear the name and number of the inter partes proceeding in connection with which it is being filed, and a title describing the nature of the motion. *See* TBMP § 106.01. A party who files a motion that does not bear the correct proceeding number runs the risk that the paper will not be associated with the proceeding for which it is intended (and hence may never be considered by the Board). [Note 1.]

A motion must be signed by the party filing it, or by the party's attorney or other authorized representative. If a motion is unsigned, it will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. [Note 2.] *See* TBMP § 106.02 (Signature of Submissions). When a motion is filed via ESTTA, it must be signed in conformance with 37 CFR § 2.193(c). As a practical matter, ESTTA will allow the filing party to complete the submission process only after the required electronic signature has been entered. [Note 3.]

Motions may be filed in paper form only when ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. In such exceptional situations, a motion in paper form must include a written explanation of such technical problems or extraordinary circumstances. The explanation must include specific facts rather than mere conclusory statements as to the technical problem or extraordinary circumstance that prevented the use of ESTTA. Paper submissions that do not meet the showing of ESTTA unavailability or extraordinary circumstances will not be considered; however, the parties should consider any such paper filing accepted unless the Board indicates otherwise. [Note 4.] When motions are filed in exceptional paper form, the certificate of mailing by first-class mail procedure provided under 37 CFR § 2.197, and the Priority Mail Express® procedure provided under 37 CFR § 2.198 are both available. [Note 5.] *See* TBMP § 111. Parties are not permitted to file motions via email except at the request of the Board attorney or judge. ESTTA is the only available procedure for electronic filing with the Board.

When a party files a motion electronically through ESTTA, the filing is time-stamped with the official filing date when the ESTTA filing, including any required fee, is received by the Board server. Eastern Time controls the filing date, and the time the transmission began is not a factor in determining the filing date. The official filing date and time are found on the confirmation web screen and the party's email confirmation. Once the electronic filing is submitted, the Board immediately transmits an email filing receipt. If the filing

party does not receive the email filing receipt within 24 hours (or by the next business day), the filing party should contact the Board. For technical assistance with an ESTTA filing, a party may call the Board with questions at (571) 272-8500 or (800) 786-9199 (toll free); or may send an email to ESTTA@uspto.gov. The Board should respond to the inquiry within two (2) business days. When contacting the Board for ESTTA assistance please describe the nature of the problem and include the ESTTA tracking number, which should appear on the computer screen after transmission. *See* TBMP § 106.03.

ESTTA filing is required; it is no longer optional. If ESTTA filing is not possible prior to a deadline because ESTTA is unavailable due to technical problems, or other extraordinary circumstances are present, parties should timely make their submission on paper with the required written explanation. *See* TBMP § 107 and TBMP § 111. The parties should consider any such paper filing accepted unless the board indicates otherwise.

A party should file only one copy of a motion with the Board. Unless otherwise directed by the Board, it is not necessary to file a paper copy of a motion that has been filed electronically. Every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service ordinarily must be made before the motion will be considered by the Board. [Note 6.] *See* TBMP § 113 (Service of Papers). Service must be made by email unless the parties stipulate otherwise or the serving party shows that email service could not be made due to technical problems or extraordinary circumstances. [Note 7.]

NOTES:

1. *See Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1033 n.3 (TTAB 2007) (applicant did not separately caption her motion to amend the filing basis of the application at issue; rather she incorporated it into her response to opposer's motion for summary judgment. The better practice is either to file such a motion as a separate filing or, at a minimum, to caption it separately).

2. 37 CFR § 2.119(e).

3. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005).

4. 37 CFR § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016).

5. 37 CFR § 2.197; 37 CFR § 2.198.

6. 37 CFR § 2.119(a); 37 CFR § 2.119(b).

7. 37 CFR § 2.119(b).

502.02(b) Briefs on Motions

Every motion must embody or be accompanied by a brief. [Note 1.]

Briefs on motions, and any exhibits thereto, must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.126. *See* TBMP § 106.03 (Form of Submissions).

Briefs on motions are also subject to page limitations and time requirements. [Note 2.] Briefs in support of and in response to a motion may not exceed 25 pages in length and a reply brief may not exceed 10 pages. [Note 3.] Exhibits submitted with the brief are not counted in determining the length of the brief. However,

because 37 CFR § 2.127(a) does not require an index of cases and authorities or a table of contents, should a party elect to include these items, they will count as part of the page limit for the brief. [Note 4.]

A brief in response to a motion, except a motion for summary judgment, must be filed within 20 days from the date of service of the motion. [Note 5.] When a motion for summary judgment is filed, a brief in response, or a motion for Fed. R. Civ. P. 56(d) discovery must be filed within 30 days from the date of service of the summary judgment motion. [Note 6.] *See also* TBMP § 528.02 for further information regarding the time for filing a motion for summary judgment. The time for filing a responsive brief may be extended, but the time for filing, in lieu thereof, a motion for Fed. R. Civ. P. 56(d) discovery will not be extended. *See* TBMP §528.06 (Request for Discovery to Respond to Summary Judgment).

These time periods for responding to motions shall apply unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause; or the time is reopened by stipulation of the parties approved by the Board or by order of the Board on motion showing excusable neglect. [Note 7.] *See* TBMP § 509. If a motion for an extension of time to respond to a motion is denied, the time for responding to the motion remains as specified under 37 CFR § 2.127(a), unless otherwise ordered. [Note 8.]

A reply brief, if filed, including a reply brief for a summary judgment motion, shall be filed within 20 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended, even upon the parties' consent. [Note 9.] No further papers (including surreply briefs) will be considered by the Board. [Note 10.] The filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief. [Note 11.] If the nonmoving party does not file a responsive brief, a reply brief should not be filed.

In general, all motions should be filed separately, or at least be captioned separately, to ensure they receive attention. A party should not embed a motion in another filing that is not routinely reviewed by the Board upon submission. [Note 12.]

NOTES:

1. 37 CFR § 2.127(a). *See Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 n.15 (TTAB 2010) (citing 37 CFR § 2.127(a)).

2. 37 CFR § 2.127.

3. 37 CFR § 2.127(a). *See also Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB 2011) (reply brief not considered because it exceeded the page limit); *Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (the page limitation for a "brief in response to a motion" applies to a brief in which an opposition to a motion and a cross-motion are combined but address the same issues; in other words, one cannot exceed the page limitation for a brief by combining an opposition brief and cross-motion addressing the same issue); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2010 (TTAB 2002) (reply brief was untimely and exceeded page limit); *Estate of Shakur v. Thug Life Clothing Co.*, 57 USPQ2d 1095, 1096 (TTAB 2000) (respondent improperly attempted to circumvent the page limitations in 37 CFR § 2.127(a) by "dissect[ing] what is a single motion to compel into two motions separately addressing the interrogatories and document requests in order to file briefs totaling 50 pages").

4. *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220, 1222 (TTAB 2003). *See also Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB) (over-length reply brief included a table of contents and a table of authorities).

5. 37 CFR § 2.127(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (Oct. 7, 2016) ("provision adding five days to the prescribed period for action after service by the postal service or overnight courier" removed, "[a]ll fifteen-day response dates initiated by a service date are amended to twenty days.").

6. 37 CFR § 2.127(e)(1). *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (extension of Fed. R. Civ. P. 56(d) motion prohibited by 37 CFR § 2.127(e)(1)).

7. Fed. R. Civ. P. 6(b).

8. 37 CFR § 2.127(a).

9. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1). *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (denying parties' stipulation to provide for additional five days, noting that such a stipulation would violate the provisions of 37 CFR § 2.127, which do not allow for extensions of time to file reply briefs); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2010 (TTAB 2002) (approval of consented motion to extend time to file reply brief vacated).

10. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005) (because 37 CFR § 2.127(a) prohibits the filing of surreply briefs, opposer's surreply to applicant's motion was not considered); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000).

11. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto"); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1223 n.4 (TTAB 1987) (reply brief, constituting mere reargument given no consideration).

12. *See Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 (TTAB 2010); and *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1033 n.3 (TTAB 2007).

502.02(c) Confidential Information

The Board's standard protective order is automatically in place for inter partes proceedings unless the Board approves a stipulation or motion to use an alternative order. [Note 1.] Except for materials filed under seal pursuant to a protective order or designated as confidential in ESTTA, the files of applications and registrations that are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying on TTABVUE, http://ttabvue.uspto.gov (docket information and full images of Board files). [Note 2.] Therefore, only the particular portion of a motion that discloses confidential information should be electronically designated as "CONFIDENTIAL" in ESTTA or when filed exceptionally by paper under seal pursuant to a protective order. Parties should avoid over-designation of non-confidential information as confidential. If a party submits a motion containing confidential information either electronically via ESTTA or by paper under seal, the party must also submit for the public record a redacted version of the motion. [Note 3.]

Confidential information filed without appropriate designation in accordance with the Board's standard protective order or one adopted by the parties as a substitute for the standard order is not regarded as confidential, will not be kept confidential by the Board and will be placed in the Board's public records available on the Internet. [Note 4.] To be handled as confidential and kept out of the public record, submissions to the Board must be filed using the "Confidential" selection available in ESTTA, or filed under a separate cover with a showing by written explanation accompanying the submission that ESTTA was unavailable due to technical problems or that extraordinary circumstances justify the paper submission. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must also be submitted concurrently for public viewing. [Note 5.]

When filing confidential documents electronically through ESTTA, the party must use the "File Documents in a Board Proceeding" option, select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use," enter the proceeding number and click "Start." The documents filed in this manner will not be viewable in the publicly available electronic proceeding file. The party filing the confidential document electronically must also file concurrently a separate redacted version of the confidential filing for public viewing.

Any confidential filing must include redacted versions for the public record. *See* 37 CFR § 2.126(c). For any confidential unredacted version of a submission for which a redacted version must be filed, the parties are encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision.

Disclosure of an individual's personally identifiable information (e.g., social security number, financial account numbers, or home address) is not necessary. Such information should always be redacted from any submission.

For further information regarding protective orders, see TBMP § 412 and TBMP § 412.01. For further information regarding confidential materials, see TBMP § 120.02 ("Access to Files – Confidential Material"), TBMP §703.01(p) ("Oral Testimony Depositions - Confidential or Trade Secret Material"), and TBMP §801.03 ("Form and Content of Briefs").

NOTES:

1. 37 CFR § 2.116(g).

2. 37 CFR § 2.27(d); 37 CFR § 2.27(e), and 37 CFR § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

3. 37 CFR § 2.27(e) and 37 CFR § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

4. *Cf. Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (Board was not bound by parties' overdesignation of testimony and evidence as confidential); and *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003).

5. 37 CFR § 2.126(c). *See also Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

502.03 Oral Hearings on Motions

A formal oral hearing at the Board is not held on a motion except by order of the Board. [Note 1.] It is the practice of the Board to deny a request for an oral hearing on a motion unless, in the opinion of the Board, an oral hearing is necessary to clarify the issues to be decided. Ordinarily, arguments on a motion are, and should be, adequately presented in the briefs thereon, and therefore the Board rarely grants a request for an oral hearing on a motion. [Note 2.] In contrast, a telephone conference with a Board attorney or judge may be used in lieu of a brief to present arguments in support of or against a motion. [Note 3.] *See* TBMP § 413.01 and TBMP § 502.06 for further information regarding telephone conferences on motions.

NOTES:

1. 37 CFR § 2.127(a).

2. *The Scotch Whiskey Association v. United States Distilled Products Co.*, 13 USPQ2d 1711 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391, 1391 n.3 (TTAB 1991) (issues on motion to dismiss not so extraordinary to warrant an oral hearing), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 n.3 (TTAB 1989) (exception to usual practice is not warranted). *Cf. Federal Trade Commission v. Formica Corp.*, 200 USPQ 182, 186 (TTAB 1978) (oral hearing on motion allowed in view of importance and novelty of issue).

3. 37 CFR § 2.127(a). *See, e.g., Byer California v. Clothing for Modern Times*, 95 USPQ2d 1175, 1176 (TTAB 2010).

502.04 Determination of Motions

37 CFR § 2.127(a) ... *When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. ...*

37 CFR § 2.127(c) *Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board or by an Interlocutory Attorney or Paralegal of the Board to whom authority to act has been delegated, or by ESTTA. Motions disposed of by orders entitled "By the Trademark Trial and Appeal Board" have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board.*

Motions fall into three categories: consented, uncontested, and contested. If the nonmoving party has consented to a motion, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto (unless written consent is required under the provisions of 37 CFR § 2.106(c), 37 CFR § 2.114(c), 37 CFR § 2.134(a), or 37 CFR § 2.135). Ordinarily, the Board will grant a consented motion.

If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the Board, in its discretion, may grant the motion as conceded. [Note 1.]

However, the Board, in its discretion, may also decline to treat an uncontested motion as conceded, and may grant or deny the motion on its merits. [Note 2.]

A motion that does not expressly state that the nonmoving party has consented to the motion will not be granted as conceded until after passage of sufficient time for filing and receipt by the Board of a brief in response. If a motion is contested by the nonmoving party by filing an acceptable opposition brief or presenting a responsive argument in a telephone conference, the Board will decide the motion on its merits. When determining a motion, the Board need not address every argument raised by the parties, it need only specify the basis supporting its determination. [Note 3.]

Interlocutory motions that are not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, attorney, or paralegal to whom such authority has been delegated, or by ESTTA. [Note 4.] *See* TBMP § 102.03 (General Description of Board Proceedings). A panel of at least three Board judges determines contested motions that are actually or potentially dispositive of a proceeding. *See* TBMP § 102.03 (General Description of Board Proceedings). Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be determined under the authority of the Board.

For information concerning the remedies available to a party that is dissatisfied with a decision on a motion, see TBMP § 518 (Motion for Reconsideration of Decision on Motion). *See also* TBMP § 905 (Petition to the Director).

A party should not presume that the Board will automatically reset discovery, disclosure deadlines and/or trial dates when it determines a pending motion. When the Board determines a pending motion, and there is no motion to extend discovery, disclosure deadlines and/or trial dates, the Board, in the exercise of its discretion, may or may not reset relevant dates. A party that wishes to have particular deadlines or periods reset upon the determination of a particular motion should file a motion requesting such action and specifying the deadlines or periods it wishes to have reset. [Note 5.] Alternatively, a moving or responding party may request the resetting of deadlines or periods in its pending motion or response thereto, where such pending motion is not otherwise one seeking an enlargement of time. In other words, a party may incorporate a motion to extend as part of another motion, and should caption the motion accordingly.

The filing of a request for reconsideration under 37 CFR § 2.127(b) or the filing of a petition under 37 CFR § 2.146(e)(2) will not, in the usual case, result in a stay of proceedings. Any discovery, trial dates, or other deadlines set by the Board will ordinarily remain as set, notwithstanding the request for reconsideration or petition. The Board may, however, reset dates, as appropriate, if either a request for reconsideration or a petition is granted.

NOTES:

1. 37 CFR § 2.127(a); *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (treating motion for summary judgment as conceded was proper); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 n.16 (TTAB 2010) (Board will generally treat unopposed motion as conceded); *Central Manufacturing Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210, 1211 (TTAB 2001) (motion to dismiss treated as conceded); *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1054 (TTAB 1999).

2. *See, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009) (Board exercised discretion to consider motion on merits even though late brief in opposition to motion was not considered); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003) (motion to suspend for civil action not treated as conceded where potentially dispositive motion was pending when motion to suspend

was filed); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1599 (TTAB 2002) (motion to retroactively suspend proceeding and deny applicant's motion for summary judgment decided on merits); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (cross-motion for judgment not treated as conceded in view of its potentially dispositive nature); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990) (uncontested motion to dismiss decided on merits). *Cf. Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.6 (TTAB 1990) (even if the Board not considered plaintiff's late responsive brief, defendant's motion would not have been treated as conceded under the circumstances).

3. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015) (reconsideration denied because no requirement that Board repeat or address irrelevant arguments when determining a motion).

4. 37 CFR § 2.127(c).

5. 37 CFR § 2.120(a)(3). *But see* 37 CFR § 2.121(a) ("The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.").

502.05 Attorneys' Fees, etc., on Motions

The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party. [Note 1.]

NOTES:

1. 37 CFR § 2.127(f); *NSM Resources Corp. v. Microsoft Corp.* , 113 USPQ2d 1029, 1035 n.10 (TTAB 2014) (Board cannot assess monetary damage awards); *General Mills Inc. v. Fage Dairy Processing Industries SA* , 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine damages), *judgment set aside on other grounds,* 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC* , 88 USPQ2d 1541, 1544 n.6 (2008); *Central Manufacturing Inc. v. Third Millennium Technology Inc.* , 61 USPQ2d 1210, 1213 (TTAB 2001) ("although the Board does not impose monetary sanctions or award attorneys' fees or other expenses, the Board has the authority to enter other appropriate sanctions"); *Duke University v. Haggar Clothing Co.* , 54 USPQ2d 1443, 1445 n.3 (TTAB 2000). *See also* 37 CFR § 2.120(g) and 37 CFR § 2.120(h)(1). Note, however, that conduct in violation of the Disciplinary Rules set forth in 37 CFR parts11 may be referred to the Office of Enrollment and Discipline (OED) for appropriate action. *See* 37 CFR § 11.19 *et seq.*

502.06 Telephone and Pretrial Conferences

502.06(a) Telephone Conferences

37 CFR § 2.120(j)(1) *Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by one or both of the parties, schedule a telephone conference.*

37 CFR § 2.127(a) . . . *Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by*

the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. ...

When it appears to the Board that a motion filed in an inter partes proceeding may be resolved by a telephone conference call involving the parties or their attorneys and a Board judge or attorney, the Board may, upon its own initiative or upon request made by a party, convene a conference to hear arguments on and to resolve the motion by telephone conference. [Note 1.] Immediately after the resolution of a motion by telephone conference, the Board normally will issue a written order confirming its decision on the motion. Immediate issuance of an order may be deferred, however, if the conference raises issues that require research or additional briefing before they can be resolved.

Board judges and attorneys retain discretion to decide whether a particular matter can and should be heard or disposed of by telephone. The Board may therefore deny a party's request to hear a matter by telephone conference. There is no formal limit as to the type of matters that can be handled through telephone conferences [Note 2.], but the Board will not decide by telephone conference any motion that is potentially dispositive, that is, a motion which, if granted, would dispose of a Board proceeding. The telephone conference procedure is particularly useful for resolving motions where time is of the essence, such as a motion to quash a notice of deposition, as well as numerous discovery motions. [Note 3.] *See* TBMP § 521 regarding motions to quash a notice of deposition, TBMP § 401.01 and TBMP § 408.01(a) regarding discovery conferences with Board participation, andTBMP § 413.01 regarding telephone conferences for motions relating to discovery. The telephone conference procedure may also be beneficial in instances where the parties are required to provide a progress report on the status of settlement negotiations as a prerequisite for filing a stipulation or consented motion to further suspend or extend proceedings.

Trademark Rule 2.191, 37 CFR § 2.191, which requires all business with the USPTO be transacted in writing, is waived to the extent that Board attorneys or judges may accept from parties, or direct parties to present, oral recitations of procedural facts and presentations of argument. In addition, Trademark Rule 2.119(b), 37 CFR § 2.119(b), which specifies the acceptable methods for forwarding service copies of papers filed with the Board, is waived to the extent necessary to facilitate telephone conferencing. [Note 4.]

Telephone conferences are not a substitute for written consented motions or stipulations. Parties should file consented motions or stipulations via ESTTA rather than call the Board for an order that can otherwise be agreed upon without Board involvement. Moreover, telephone conferences may not be used as a means to supplement a motion or a related brief, and are not an opportunity to present oral arguments in support of fully briefed written motions unless requested by the Board.

Requesting a telephone conference: A party may request a telephone conference from the assigned Board attorney before it files the underlying motion. The initial contact will be limited to a simple statement of the nature of the issues proposed to be decided by telephone conference, with no discussion of the merits. A party served with a written motion may request a telephone conference by contacting the assigned Board attorney soon after it receives the service copy of the motion so that the responding party will have sufficient time to respond to the motion in the event the request for a telephone conference is denied. A party may not request a telephone conference at or near the end of its time to respond to the motion when its purpose in doing so is to avoid or delay its response to the motion.

During the initial contact, the Board attorney will decide whether any party must file a motion or brief or written agenda to frame the issues for the conference and will issue instructions.

When the Board grants a party's request for a telephone conference, the requesting party is responsible for scheduling the conference at a time agreeable to all parties and the assigned Board attorney. The requesting

party must arrange the conference call. In order to facilitate the scheduling of a telephone conference, parties are required to provide a telephone number and email address where they can be reached during business hours when filing their respective pleadings with the Board. When the Board initiates a telephone conference, the Board attorney will schedule the conference.

The Board may in its discretion require additional written briefing of the motion or decide that additional written briefing is unnecessary. The Board has the discretion to decide the motion by telephone conference prior to the expiration of the written briefing period for filing a response or reply. [Note 5.] If a response to a pending motion has not yet been filed, the nonmoving party should be prepared to make an oral response to the motion during the telephone conference. Similarly, if a reply in support of a pending motion has not yet been filed, the moving party should be prepared to make its reply during the telephone conference. Any other instructions regarding filing of briefs or serving copies will be provided at the time the Board schedules the conference. To expedite matters, the moving party should call the Board attorney to request a telephone conference shortly after it files its motion via ESTTA. This procedure is useful when time is of the essence. Calling the Board attorney after filing a motion via ESTTA is the most efficient way to get a motion to the attention of the Board attorney. Filing by facsimile is prohibited. [Note 6.]

Denial of a request for a telephone conference is without prejudice on the merits of the motion or other matter sought to be heard by telephone. If the request is denied, the Board attorney will provide instructions to the party or parties regarding requirements for filing the motion or briefs required to have the matter decided on the written record.

For information on requesting Board participation in the settlement and discovery conference required under 37 CFR § 2.120(a)(2)(i), see TBMP § 401.01.

Conduct of conference. Unless otherwise specified, the telephone conference will be limited to the issues defined by the Board prior to, or at the commencement of, the conference. During the conference, the Board has discretion to consider new oral motions regarding issues that arise during the conference. The Board will not record the conference nor may the parties record the telephone conference. [Note 7.] The Board attorney may make rulings at the conclusion of the conference or may take the parties' arguments under advisement. If the Board attorney determines during the telephone conference that the motion or matter should be decided on the written record, the Board attorney may halt the telephone conference and direct the filing of a written motion or response to a motion, or both.

Parties must conduct themselves with appropriate decorum. Interruptions are to be avoided. The Board attorney conducting the conference generally will signal that a party may make an argument or presentation by inviting the party to do so or by inviting a response to an argument or presentation made by another.

Participation. The conference will involve the parties or their attorneys, and a Board judge or attorney. The Board may permit attendance by others, including Board staff and corporate representatives of the parties. If the Board permits a party to have more than one person in attendance, that party must designate a lead person to represent the party in the conference. Failure to participate in a scheduled telephone conference may result in the motion being denied with prejudice, the motion being treated as conceded, issuance of an order to show cause why judgment should not be entered against the non-participating party for loss of interest in the case, or the imposition of sanctions pursuant to the Board's inherent authority. *See* TBMP § 527.03 (Inherent Authority to Sanction).

Issuance of Rulings. The Board attorney may make rulings at the conclusion of a telephone conference or may take the parties' arguments under advisement. In every instance, after the resolution of a motion or matter by telephone conference, the Board attorney will issue a written order containing all rulings. In most

instances, the Board's written order will consist of only a brief summary of the issues and the resulting decision; generally, the order will not include a recitation of the parties' arguments. The decision will be forwarded to the parties by mail or email, and will be available for the parties to view on the Board's section of the USPTO website, specifically within the electronic proceeding file for the case (i.e., TTABVUE).

NOTES:

1. 37 CFR § 2.120(j)(1). *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1446 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1775 (TTAB 1999); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552 (TTAB 1991); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990); *Teleconferencing on Cases Before the TTAB*, O.G. Notice (June 20, 2000). The Official Gazette Notice describing the telephone conference procedures may be found at the Board home page of the USPTO website under TTAB Phone Conferencing in the Policy and Procedure section.

2. *See, e.g., Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239 (TTAB 2012) (motions to strike pretrial disclosures, quash, and reopen testimony); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010) (motions to compel and quash); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1446 (TTAB 2000) (consented request to stay opposer's rebuttal testimony period pending ruling on opposer's motion to quash); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1775 (TTAB 1999) (motions to quash and for discovery sanctions); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552 (TTAB 1991) (motion to attend testimony deposition by telephone); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (uncontested motion to extend testimony period and motion for a protective order).

3. *See, e.g., Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1655 (TTAB 2007) (party could have requested phone conference to quickly determine whether notice of deposition was reasonable); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999) (to the extent time was of the essence, party could have contacted the Board and requested that the motion to extend discovery be resolved on an expedited basis or by telephone conference); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1775 (TTAB 1999); and cases cited in previous note 2.

4. Teleconferencing on Cases Before the TTAB O.G. Notice (June 20, 2000).

5. 37 CFR § 2.127(a). *See, e.g., Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1176 (TTAB 2010).

6. 37 CFR § 2.126(a); 37 CFR § 2.195(d)(3).

7. 37 CFR § 2.120(j)(3)

502.06(b) Pretrial Conferences

37 CFR § 2.120(j)(2) *Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative direct that the*

parties and/or their attorneys meet with the Board for a disclosure, discovery or pretrial conference on such terms as the Board may order.

Because the pretrial conference procedure necessarily involves expense for the parties, it is rarely used by the Board. However, it may be advantageous in cases where numerous complex motions are pending, or where the Board has identified the case as being, or having the potential to be, overly contentious and/or involve creation of excessive records by the parties, or where attorneys or parties are unable to work out a resolution of any of their differences. [Note 1.] The Board may direct the parties and/or their attorneys to appear on such terms as the Board may order for such a conference. [Note 2.]

For information concerning discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

NOTES:

1. 37 CFR § 2.120(j)(2). *See Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011).

2. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 n.5 (TTAB 2011) (the Board may exercise its authority to order a pretrial conference in person at the Board's offices in Alexandria, VA), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011) (Board exercised its authority to require parties to attend a pretrial conference at the Board's offices in Alexandria, VA); *Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) ("under Trademark Rule 2.120(i)(2), where resolution of discovery or other interlocutory issues 'would likely be facilitated by a conference in person of the parties or their attorneys,' the Board may 'request that the parties or their attorneys … meet with the Board at its offices' for a conference. If the parties remain unwilling or unable to work together cooperatively and efficiently, the Board will not hesitate to invoke this Rule in the future."). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952 (Oct. 7, 2016) ("Correlative to electronic ... communication, the Board also has made it possible for parties ... and members of the Board to attend hearings remotely through video conference.").

502.07 Fed. R. Civ. P. 11 Applicable

For information concerning the applicability of the provisions of Fed. R. Civ. P. 11 to motions filed in proceedings before the Board, see TBMP § 527.02.

503 Motion to Dismiss for Failure to State a Claim

Fed. R. Civ. P. 12(b) How to Present Defenses. *Every defense to a claim for relief in any pleading must be asserted in the responsive pleading if one is required. But a party may assert the following defenses by motion:*

(6) *failure to state a claim upon which relief can be granted;*

A motion asserting any of these defenses must be made before pleading if a responsive pleading is allowed. If a pleading sets out a claim for relief that does not require a responsive pleading, an opposing party may assert at trial any defense to that claim. No defense or objection is waived by joining it with one or more other defenses or objections in a responsive pleading or in a motion.

503.01 Time for Filing

When the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer. [Note 1.] When the motion is directed to an amended pleading, it must be filed before, or concurrently with, the movant's answer to the amended pleading. [Note 2.]

The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. [Note 3.] If the motion is filed before the movant's answer, and is denied, the Board will reset the time for filing an answer. As a result, the filing of a motion to dismiss for failure to state a claim upon which relief can be granted also effectively stays the time for the parties to conduct their required discovery conference because the pleadings must be complete and issues joined before the conference is held. *See* TBMP § 316. When a motion to dismiss is denied, or is granted but the plaintiff is given leave to serve an amended pleading, the Board will not only reset the time for the defendant to answer but will also reset the discovery conference deadline and other appropriate dates or deadlines. [Note 4.]

The defense of failure to state a claim upon which relief can be granted may be raised after an answer is filed, provided that it is raised by some means other than a motion to dismiss. For example, the defense may be raised, after an answer is filed, by a motion for judgment on the pleadings, by a motion for summary judgment, or at trial. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 12(b); *Hollowform Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). *Cf. Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.1 (TTAB 1998) (although a Fed. R. Civ. P. 12(b)(6) motion should be filed prior to, or concurrently with the answer, untimeliness waived where Fed. R. Civ. P. 12(b)(6) motion filed three weeks after answer, but plaintiff responded to motion on the merits).

2. *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1872 (TTAB 1994) ("Just as a motion to dismiss can be interposed in response to an original pleading, so too can it be interposed in response to an amended pleading").

3. *Hollow form, Inc. v. Delma Aeh*, 180 USPQ 284, 286 (TTAB 1973) (motion for default judgment for failure to answer denied), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

4. *Cf.* 37 CFR § 2.120(a)(2) and 37 CFR § 2.127(d). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (Aug. 1, 2007) ("Because disclosure is tied to claims and defenses, in general, a defendant's default or the filing of various pleading motions under Federal Rule 12 will effectively stay the parties' obligations to conference and, subsequently, make initial disclosures.").

5. Fed. R. Civ. P. 12(h)(2); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (construed as motion for judgment on the pleadings); 5B C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1357 (3d ed. 2017). *Cf. Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b)(6) permits defendant to assert in answer "defense" of failure to state a claim thereby allowing plaintiff to test sufficiency of defense by moving under Fed. R. Civ. P. 12(f) to strike the defense). *Cf. NSM Resources Corp. v. Microsoft Corp.*,

113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may sua sponte dismiss any insufficiently pleaded pleading).

503.02 Nature of Motion

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. [Note 1.] In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding). [Note 2.] To survive a motion to dismiss, a complaint must "state a claim to relief that is plausible on its face." [Note 3.] In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." [Note 4.]

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. [Note 5.]

In Board proceedings, there are certain facts not subject to proof – such as the filing date, filing basis, publication date and applicant's name in an application that is the subject of an opposition proceeding – that the Board may consider when a party has filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6). [Note 6.]

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. [Note 7.]

For a further discussion regarding the elements of a complaint, see TBMP § 309.03(a)(2).

NOTES:

1. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009), (quoting, *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007)); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1218 (TTAB 1990); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985).

2. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985); *Intersat Corp. v. International*

Telecommunications Satellite Organization, 226 USPQ 154, 156 (TTAB 1985); *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984).

3. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (retiring the pleading standard set forth in *Conley v. Gibson*, 355 U.S. 41 (1957) that dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim). *See also Ashcroft v. Iqbal*, 556 U.S.662, 678 (2009) (plausibility standard applies to all federal civil claims); *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 (TTAB 2013) (considering plausibility); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (considering plausibility); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Ashcroft v. Iqbal*, 556 U.S. 662 (2009); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)).

4. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 555). *See, e.g., Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (motion to dismiss applicant's fraud, non-use and abandonment counterclaims granted); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014).

5. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2014).

6. *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009). In *Compagnie*, the Board noted the difference between the above-noted objective facts, not subject to proof, and the allegations made in an application, such as dates of first use and first use in commerce, and allegations relative to acquired distinctiveness, that are not objective facts, but are subject to proof in an inter partes proceeding.

7. *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) ("under the notice pleading rules applicable to this proceeding opposer is only required to state a valid claim."); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1711 (TTAB 1993); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992); *Delta Tire Corp. v. Sports Car Club of America, Inc.*, 186 USPQ 431, 432 (TTAB 1975); *National Semiconductor Corp. v. Varian Associates*, 184 USPQ 62, 64 (TTAB 1974).

503.03 Leave to Amend Defective Pleading

A plaintiff may amend its complaint within 21 days after service of a motion under Fed. R. Civ. P. 12(b)(6) or with the written consent of every adverse party, or by leave of the Board, which is freely given when justice so requires. [Note 1.] *See* TBMP § 507.02 for further information about the timing for amending a pleading in Board proceedings. Thus, plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, inter alia, an amended complaint. If a timely amended complaint is submitted, the original motion to dismiss normally will be moot. [Note 2.]

If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading. [Note 3.]

However, in appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment. [Note 4.] *See* TBMP § 507.02 (regarding motions to amend pleadings).

NOTES:

1. *See* Fed. R. Civ. P. 15(a); *see, e.g., Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1521 (TTAB 2013).

2. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (finding first motion to dismiss moot in view of filing of amended pleading; considering amended pleading filed in response to second motion to dismiss); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537 (TTAB 2007) (considering amended pleading, filed in response to motion to dismiss, in connection with the motion to dismiss).

3. *Wise F&I, LLC, et al. v. Allstate Insurance Co.*, 120 USPQ2d 1103, 1110 (TTAB 2016) (allowed time to cure defective pleading); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993) ("the Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where challenged pleading is the initial pleading"); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985) (allowed time to file an amended opposition setting forth a statutory ground). *See also Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 154 (TTAB 1983) ("Although it is the general practice of the Board to allow a party an opportunity to correct a defective pleading, in the instant case leave to amend the pleading would serve no useful purpose"), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

4. Fed. R. Civ. P. 15(a)(2); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1929 n.10 (TTAB 2014) (Board did not grant leave to replead fraud claim due to futility and lack of plausibility based on recited facts); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1590-91 (TTAB 2009) (because petitioner twice failed to properly allege prior use, petitioner's Trademark Act § 2(d) claim was dismissed with prejudice); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (amendment would be futile because opposers cannot prevail on claim as a matter of law); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985) (plaintiff had already been allowed two opportunities to perfect its pleading, therefore, the Board did not find that it was in the interests of justice to grant plaintiff an additional opportunity to amend the complaint); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 154 (TTAB 1983) (amendment would serve no useful purpose), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). *Cf. Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (motion to amend to add claim or defense which is legally insufficient will be denied); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (would serve no useful purpose).

503.04 Matters Outside the Pleading Submitted on Motion to Dismiss

The circumstances in which the Board will treat a motion to dismiss relying on matters outside the pleadings as a motion for summary judgment are very limited. A party may not file a motion for summary judgment until it has made its initial disclosures, unless the motion is based on issue or claim preclusion or lack of Board jurisdiction. [Note 1.] Treatment of a motion to dismiss under Fed. R. Civ. P. 12(b)(6) as a motion for summary judgment generally would result in a premature motion for summary judgment. [Note 2.]

Accordingly, when a motion for summary judgment would be premature, the Board will not consider a motion to dismiss including matter outside the pleading to be a motion for summary judgment, even if the parties treat it as such. [Note 3.]

Where a motion to dismiss is based on issue or claim preclusion or lack of Board jurisdiction, the Board may treat the motion as one for summary judgment, in which case, the parties will be given reasonable opportunity to present all material that is pertinent to the motion. [Note 4.]

NOTES:

1. 37 CFR § 2.127(e)(1). *See Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 n.2 (TTAB 2013) (motion to dismiss amended counterclaim accompanied by evidence was not treated as a motion for summary judgment as there was nothing in the record which indicated that initial disclosures were served by opposer); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011) (motion to dismiss considered as one for summary judgment where it asserts claim preclusion); *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures). *Cf. Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1873-74 n.2 (TTAB 2011) (Board may consider matters outside the pleading on a motion to dismiss for lack of subject matter jurisdiction under Fed. R. Civ. P. 12(b)(1) without converting to a summary judgment).

2. 37 CFR § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment).

3. *See* Fed. R. Civ. P. 12(d); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1028 (TTAB 2015) (motion to dismiss that included matters outside of the pleadings not considered as motion for summary judgment because motion was filed before the parties' initial disclosures were due and initial disclosures had not been served); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (matters excluded); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1436 (TTAB 1996) (matters excluded).

Ordinarily, the parties to the proceeding will be notified when a motion to dismiss is being treated as a motion for summary judgment, and the responding party will be given reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56. *See* Fed. R. Civ. P. 12(d); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1044 (Fed. Cir. 1993) ("A movant's challenge to the sufficiency of the complaint as a matter of law, brought under 12(b)(6), is not sufficient notice that the nonmovant must respond as if to a motion for summary judgment, and place material facts in dispute"); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as a motion for summary judgment without notifying adverse party); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992), *summary judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156, 1156 (TTAB 1991) (not an appropriate case to treat as summary judgment; extrinsic matters excluded); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1042 n.2 (TTAB 1985); *Exxon Corp. v. National Foodline Corp.*, 196 USPQ 444, 445 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407, 408 (CCPA 1978). In such a case, notice may be dispensed with as unnecessary, however, where the parties themselves clearly have treated a motion to dismiss as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (both parties submitted evidentiary materials outside the pleadings). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316,

217 USPQ 641, 646 (Fed. Cir. 1983) (nonmoving party expected only that sufficiency, not merits of case would be decided).

4. Fed. R. Civ. P. 12(d). *Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 n.9 (TTAB 2016) (Board sua sponte entered summary judgment in favor of non-movant where parties were previously informed that Board would entertain question of whether res judicata applied to the proceeding and parties were given opportunity to present evidence and argument on that question); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 (TTAB 2011) (Board previously informed parties that motions to dismiss in consolidated case would be treated as motions for summary judgment).

504 Motion for Judgment on the Pleadings

504.01 Time for Filing

After the pleadings are closed, but within such time as not to delay the trial, any party to an inter partes proceeding before the Board may file a motion for judgment on the pleadings. [Note 1.] In Board inter partes proceedings, the submission of notices of reliance, declarations and affidavits, as well as the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period. [Note 2.] Under the Board's disclosure regime, a party is required to make pretrial disclosures fifteen days prior to the opening of its testimony period. [Note 3.] Thus, in order to avoid a disruption or delay in the trial phase of a Board proceeding, a motion for judgment on the pleadings must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. [Note 4.]

When a motion to dismiss for failure to state a claim upon which relief can be granted is filed after the answer, but prior to the deadline for plaintiff's pretrial disclosures, the Board may construe the motion as a motion for judgment on the pleadings. [Note 5.] *Cf.* TBMP § 503.01 (Time for Filing Motion to Dismiss).

NOTES:

1. Fed. R. Civ. P. 12(c).

2. 37 CFR § 2.116(e); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376, 1377 (TTAB 1986) (the opening of the plaintiff's testimony period marks the beginning of the trial period); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (the testimony periods assigned by the Board correspond to a trial in a court proceeding).

3. 37 CFR § 2.121(e); Fed. R. Civ. P. 26(a)(3).

4. *Cf.* 37 CFR § 2.127(e)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (Oct. 7, 2016) ("Under the amended rules motions for summary judgment also have to be filed prior to the deadline for plaintiff's pretrial disclosures for the first testimony period. This avoids disruption of trial planning and preparation through the filing, as late as on the eve of trial, of motions for summary judgment."); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376, 1377 (TTAB 1986) (summary judgment must be filed prior to the opening of plaintiff's testimony period); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718, 718 (TTAB 1985); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 428 n.2 (TTAB 1985); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (summary

judgment must not delay trial); *Peterson's Ltd. v. Consolidated Cigar Corp.*, 183 USPQ 559, 560 (TTAB 1974); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 182 USPQ 572, 572-73 (Comm'r 1974).

5. Fed. R. Civ. P. 12(h)(2)(B); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (since motion based on defense that petition fails to state claim, standard for adjudicating motion for judgment on pleading is same as Fed. R. Civ. P. 12(b)(6)).

504.02 Nature of Motion

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. [Note 1.]

For purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party that have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. [Note 2.] All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. [Note 3.]

A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law. [Note 4.]

A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment. [Note 5.]

NOTES:

1. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 15, 2011); *Land O'Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *The Scotch Whisky Association v. United States Distilled Products Co.*, 13 USPQ2d 1711, 1713 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

2. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 5, 2011); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1368 (3d ed. 2017).

3. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 5, 2011); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d

1048, 1049 (TTAB 1992); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 (TTAB 1992); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1368 (3d ed. 2017).

4. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 5, 2011); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1367 et seq. (3d ed. 2017).

5. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1368 (3d ed. 2017).

504.03 Matters Outside the Pleadings Submitted on Motion for Judgment on Pleadings

The Board is unlikely to treat a motion for judgment on the pleadings, filed prior to the moving party's service of initial disclosures and relying on matters outside the pleadings, as a motion for summary judgment. Treatment of a motion for judgment on the pleadings as a motion for summary judgment generally would result in a premature motion for summary judgment if the moving party had not served its initial disclosures prior to filing the motion. [Note 1.]

If, on a motion for judgment on the pleadings, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed. R. Civ. P. 56. [Note 2.] Ordinarily, the parties to the proceeding will be notified that the motion for judgment on the pleadings is being treated as a motion for summary judgment, and they will be given a reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56. [Note 3.]

Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion for judgment on the pleadings as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. [Note 4.]

NOTES:

1. 37 CFR § 2.127(e)(1). *Cf. Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment).

2. *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (matters outside the pleading excluded); *DAK Industries Inc. v. Daiichi Kiosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995) (exhibits excluded); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.5 (TTAB 1990); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (because no matters outside the pleading were included with the motion, it was treated as a motion for judgment on the pleadings, not summary judgment).

3. Fed. R. Civ. P. 12(d). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as motion for summary judgment without notifying

nonmoving party); *Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 n.9 (TTAB 2016) (Board sua sponte entered summary judgment in favor of non-movant after parties were informed that Board would entertain question of res judicata and were given opportunity to present evidence and argument on that question); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.5 (TTAB 1990) (did not convert to a summary judgment because the clear thrust of the motion is that petitioner failed to state a claim upon which relief can be granted); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1042 n.2 (TTAB 1985); *Exxon Corp. v. National Foodline Corp.*, 196 USPQ 444, 445 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978).

4. *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (nonmoving party did not expect Fed. R. Civ. P. 12(b)(6) motion to be treated as one for summary judgment); *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (both parties submitted evidentiary materials outside the pleadings in support of and in opposition to a Fed. R. Civ. P. 12(b)(6) motion).

505 Motion for a More Definite Statement

Fed. R. Civ. P. 12(e) Motion for a More Definite Statement. *A party may move for a more definite statement of a pleading to which a responsive pleading is allowed but which is so vague or ambiguous that the party cannot reasonably prepare a response. The motion must be made before filing a responsive pleading and must point out the defects complained of and the details desired. If the court orders a more definite statement and the order is not obeyed within 14 days after notice of the order or within the time the court sets, the court may strike the pleading or issue any other appropriate order.*

505.01 Nature of Motion

If, in an inter partes proceeding before the Board, a pleading to which a responsive pleading must be made is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement. [Note 1.] The motion must point out the defects complained of, specify the details which the movant desires to have pleaded, and indicate that the movant is unable to frame a responsive pleading without the desired information. [Note 2.]

A motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself. [Note 3.] If the movant believes that the pleading does not state a claim upon which relief can be granted, its proper remedy is a motion under Fed. R. Civ. P. 12(b)(6) to dismiss for failure to state a claim upon which relief can be granted, not a motion for a more definite statement. [Note 4.]

A motion for a more definite statement may not be used to obtain discovery. The only information that a movant may obtain by this motion is that which it needs to make its responsive pleading. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 12(e); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1377 (3d ed. 2017). *Cf. Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1700 (TTAB 2014) (after considering a motion to dismiss, Board denied motion, but required petitioner to provide a more definite statement of its request for a § 18 modification or restriction to registrant's registration); *CBS Inc.*

v. Mercandante, 23 USPQ2d 1784, 1787 n.8 (TTAB 1992) (answer to a counterclaim is not a pleading to which a responsive pleading is permitted).

2. Fed. R. Civ. P. 12(e); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1378 (3d ed. 2017).

3. *See* 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 1376-77 (3d ed. 2017).

4. *See* 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1376 (3d ed. 2017).

5. *See* 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 1376-77 (3d ed. 2017).

505.02 Time for Filing

A motion for a more definite statement, if filed, must be filed within the time for, and before, the moving party's responsive pleading. [Note 1.] An extension of time to file a responsive pleading automatically extends the time to file a motion for a more definite statement, unless the Board orders otherwise.

Because a motion for a more definite statement raises issues regarding the complaint of such a nature that the responding party cannot reasonably be required to frame a responsive pleading, generally a party filing such a motion has not filed an answer. Consequently, the time for the parties to conduct their required discovery conference and all subsequent dates are effectively stayed because the pleadings must be complete and issues joined before the conference is held. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 12(e). *Cf. Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1700 (TTAB 2014) (Board required petitioner to provide a more definite statement of its request for a § 18 modification or restriction to registrant's registration, failing which, petition to cancel would be dismissed).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007) ("Because disclosure is tied to claims and defenses, … the filing of various pleading motions under Federal Rule 12 will effectively stay the parties' obligation to conference and, subsequently, make initial disclosures.").

505.03 Failure to Obey Order for More Definite Statement

If the Board, upon motion, issues an order for a more definite statement, and the order is not obeyed within the time specified by the Board, the Board may strike the pleading to which the motion was directed, or make such order as it deems just. [Note 1.]

NOTES:

1. Fed. R. Civ. P. 12(e).

506 Motion to Strike Matter From Pleading

Fed. R. Civ. P. 12(f) Motion to Strike. *The court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. The court may act: (1) on its own; or (2) on motion made by a party either before responding to the pleading or, if a response is not allowed, within 21 days after being served with the pleading.*

506.01 Nature of Motion

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. [Note 1.] The Board also has the authority to strike an impermissible or insufficient claim or portion of a claim from a pleading. [Note 2.]

Motions to strike are not favored, and matter usually will not be stricken unless it clearly has no bearing upon the issues in the case. [Note 3.] The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. [Note 4.] *See* TBMP § 309.03 (Substance of Complaint) and TBMP § 311.02 (Substance of Answer). Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. [Note 5.] A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. [Note 6.]

Nevertheless, the Board grants motions to strike in appropriate cases. [Note 7.]

NOTES:

1. Fed. R. Civ. P. 12(f); *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.) (insofar as during briefing of petitioner''s motion for summary judgment, respondent stated that it took no issue with the striking of respondent's affirmative defenses, the Board struck these defenses); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996) (on its own initiative, the Board struck paragraph Nos. 8 and 9 of the notice of opposition).

2. *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (motion to strike counterclaim ground that portion of mark is generic asserted against registration over five years old granted); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999) (motion to strike certain allegations in the counterclaim); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (motion to strike allegations of geographic descriptiveness asserted against registration over five years old granted).

3. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401, 402 (TTAB 1973); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1380 (3d ed. 2017).

4. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985).

5. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (applicant's affirmative defense amplifies denial of likelihood of confusion); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (reasonable latitude permitted in statement of claims).

6. 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1381 (3d ed. 2017).

7. *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (counterclaim ground stricken as time-barred); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292, 1295 n.16 (TTAB 1999) (estoppel may not be asserted as a defense against claims of mere descriptiveness or geographic descriptiveness; laches may not be maintained against fraud); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial); *American VitaminProducts, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (insufficient affirmative defenses stricken); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (ground for cancellation not available for registration over five years old); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571-72 (TTAB 1988) (immaterial allegation stricken); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (affirmative defense stricken because identical to counterclaim); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 794 (TTAB 1974) (complaint stricken for failure to comply with requirement of Fed. R. Civ. P. 10(b) that each numbered paragraph be limited to a single set of circumstances).

506.02 Time for Filing

A motion to strike matter from a pleading should be filed within the time for, and before, the moving party's responsive pleading. [Note 1.] However, a motion to strike matter from a pleading will not relieve the defendant from filing its responsive pleading. The issues raised in the motion to strike may be discussed in the discovery conference in the event the parties request Board participation therein; and the non-movant need not file a responsive brief in such a case. A Board attorney will participate in the discovery conference when timely requested to ensure the resolution of the matter. The parties are required to contact the assigned Board attorney to arrange the date and time of the conference. The parties are, of course, encouraged to resolve the issue prior to the case conference. Alternatively, and particularly in the event the parties do not request Board participation in a discovery conference, the parties may fully brief a motion to strike matter from a pleading and the Board will issue a written determination thereupon. If no responsive pleading is required, the motion should be filed within 21 days after service upon the moving party of the pleading that is the subject of the motion. [Note 2.]

However, the Board, upon its own initiative, and at any time, including during a discovery conference, may order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or scandalous matter. [Note 3.] Thus, the Board, in its discretion, may entertain an untimely motion to strike matter from a pleading. [Note 4.] If a motion to strike is filed after the discovery conference, it will be decided like any other pretrial motion.

NOTES:

1. Fed. R. Civ. P. 12(f); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990).

2. Fed. R. Civ. P. 12(f); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

3. Fed. R. Civ. P. 12(f); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995).

4. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1380 (3d ed. 2017).

506.03 Exhibits Attached to Pleadings

The Board usually will not strike exhibits submitted with pleadings since they are clearly contemplated by 37 CFR § 2.122(c) and Fed. R. Civ. P. 10(c). However, except for status and title copies or current printouts from the USPTO's electronic database records containing status and title information of a plaintiff's pleaded registrations filed by the plaintiff with its complaint pursuant to 37 CFR § 2.122(d)(1), exhibits attached to pleadings are not evidence on behalf of the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period. [Note 1.] *See* TBMP § 317 (Exhibits to Pleadings).

NOTES:

1. 37 CFR § 2.122(c).

507 Motion to Amend Pleading

507.01 In General

Fed. R. Civ. P. 15.

(a) ***Amendments Before Trial.***

(1) ***Amending as a Matter of Course.*** *A party may amend its pleading once as a matter of course within:*

(A) *21 days after serving it, or*

(B) *if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier.*

(2) ***Other Amendments.*** *In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.*

(3) ***Time to Respond.*** *Unless the court orders otherwise, any required response to an amended pleading must be made within the time remaining to respond to the original pleading or within 14 days after service of the amended pleading, whichever is later.*

(b) ***Amendments During and After Trial.***

(1) ***Based on an Objection at Trial.*** *If, at trial, a party objects that evidence is not within the issues raised in the pleadings, the court may permit the pleadings to be amended. The court should freely permit an amendment when doing so will aid in presenting the merits and the objecting party fails to satisfy the court that the evidence would prejudice that party's action or defense on the merits. The court may grant a continuance to enable the objecting party to meet the evidence.*

(2) ***For Issues Tried by Consent.*** *When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings. A party may move – at any time, even after judgment – to amend the pleadings to conform them to the evidence and to raise an unpleaded issue. But failure to amend does not affect the result of the trial of that issue.*

37 CFR § 2.107 ***Amendment of pleadings in an opposition proceeding.***

(a) *Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed, or to add a joint opposer.*

(b) *Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add grounds for opposition or goods or services beyond those identified in the notice of opposition, or to add a joint opposer. The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.*

37 CFR § 2.115 ***Amendment of pleadings in a cancellation proceeding.*** *Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.*

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. [Note 1.] *See* TBMP § 309.03(a) (Substance of Complaint - In General), TBMP § 311.02 (Substance of Answer), TBMP § 506.01 (Nature of Motion to Strike Matter from Pleading), and cases cited in the foregoing sections. The Board will not entertain claims or defenses that are not asserted in the pleadings as originally filed, or as amended or deemed amended. *See* TBMP § 314 (Unpleaded Matters).

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15. [Note 2.] Amendments in general are governed by Fed. R. Civ. P. 15(a). Amendments to conform the pleadings to trial evidence are governed by Fed. R. Civ. P. 15(b).

As a general rule, pleadings in an inter partes proceeding before the Board may be amended in the same manner and to the same extent as in a civil action in a United States district court. There are some exceptions to this rule: (1) after the close of the time for filing an opposition, the notice of opposition may not be amended to add to the goods or services opposed. or to add a joint opposer [Note 3.]; (2) an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not be amended to add a new ground for opposition, goods or services opposed, or a joint opposer [Note 4.]; (3) the scope of the

opposed goods and services for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is limited to the goods and services listed in the ESTTA cover sheet [Note 5.]; (4) the scope of the grounds for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) is limited to the grounds set out in the ESTTA cover sheet, notwithstanding what is set forth in the supporting pleading, [Note 6.]; and (5) the named opposers for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is limited to those opposers set out in the ESTTA cover sheet [Note 7.]. Thus, an opposition against a Trademark Act § 66(a) application may not be amended to add an entirely new claim; a claim based on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052(d) claim; a joint opposer; or additional goods and services. [Note 8.] Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. [Note 9.]

A signed copy of the proposed amended pleading should accompany a motion for leave to amend a pleading.

The Board recommends submission of a red-lined copy showing the proposed changes along with a clean copy of the proposed amended pleading.

NOTES:

1. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) ("... under the notice pleading rules applicable to this proceeding opposer is only required to state a valid claim.").

2. 37 CFR § 2.107, 37 CFR § 2.115, and 37 CFR § 2.116(a).

3. 37 CFR § 2.107(a). *See also Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 (TTAB 2007).

4. 37 CFR § 2.107(b). *See also O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1330 (TTAB 2010).

5. *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011).

6. *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011).

7. 37 CFR § 2.107(b). *Cf. Prosper Business Development Corp. v. International Business Machines Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014) (USPTO must notify International Bureau of certain required information found in Rule 17 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (as in force on Jan. 1, 2013), which includes, inter alia, name of opponent).

8. 37 CFR § 2.107(b).

9. RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT, 68 Fed. Reg. 55748, 55757 (September 26, 2003).

507.02 Amendments – General Rule – Fed. R. Civ. P. 15(a)

Pursuant to Fed. R. Civ. P. 15(a), a party to an inter partes proceeding before the Board may amend its pleading once as a matter of course within 21 days after serving it. If the pleading is one to which are responsive pleading is required, the pleading may be amended once as a matter of course at any time within 21 days after the responsive pleading is served, or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier. [Note 1.] As a practical matter, because the time to answer set by the Board's institution order is greater than 21 days, a plaintiff may amend its complaint once as a matter of course beyond the initial 21 days from serving it until the defendant files either an answer or a Rule 12(b), (e) or (f) motion. If proceedings are suspended during this period and later resumed with the time to answer reset, a plaintiff may amend its complaint once as a matter of course until the defendant files an answer or a Rule 12(b), (e) or (f) motion. An amendment filed as a matter of course need not be accompanied by a motion for leave to amend, although it should be captioned as an amended pleading. [Note 2.]

Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; and leave must be freely given when justice so requires. [Note 3.] In view thereof, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. [Note 4.] This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint, [Note 5.], including a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint. [Note 6.] However, the plaintiff in an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application (i.e., a Madrid Protocol application) may not amend the pleading to add an entirely new claim, seek to rely on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052(d) claim, or after the time for filing an opposition has expired, add a joint opposer or goods or services to the proceeding. [Note 7.] *See* TBMP § 507.01 for a further discussion on limitation to amendments in a notice of opposition against a Madrid application.

A proposed amendment need not set forth a new claim or defense; a proposed amendment may serve simply to amplify allegations already included in the moving party's pleading. [Note 8.] However, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. [Note 9.] *Cf.* TBMP § 503.03 (Leave to Amend Defective Pleading). On the other hand, whether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment, and the nonmoving party should not argue against granting the moving party leave to amend merely because the nonmoving party believes the moving party will not be able to prove the additional claim or allegations at trial. [Note 10.]

Generally, an amended pleading, if allowed, will supersede any prior pleadings, particularly an amended pleading that is complete in itself and does not adopt or make any reference to the earlier pleadings. [Note 11.]

NOTES:

1. Fed. R. Civ. P. 15(a).

2. Fed. R. Civ. P. 15(a).

3. Fed. R. Civ. P. 15(a). *See also Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) ("Trademark Rule 2.115, 37 CFR § 2.115, and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend pleadings, stating that 'leave shall be freely given when justice so requires.'").

4. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend); *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) ("In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings."); *ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1300 (TTAB 2012); *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) ("the Board does not grant such leave [to amend the pleading] when entry of the proposed amendment would be prejudicial to the right of the adverse party"); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006); *Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1383 (TTAB 1991); *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240, 1242 (Comm'r 1990); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1733-34 (TTAB 1990); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, 39-40 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986).

5. *Ashland Licensing & Intellectual Prop. LLC v. Sunpoint International Grou USA Corp.*, 119 USPQ2d 1125 (TTAB 2016) (petition to cancel filed when the subject registration is less than five years old tolls the five-year bar set forth in Trademark Act Section 14, 15 U.S.C. § 1064, for the purpose amending the petition to add new claims.); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007) (fraud claim added); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1738, 1785-86 (TTAB 2006) (new claim asserts that the requirements of Trademark Act § 44 had been violated); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000). *See also Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, 39-40 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 858-59 (TTAB 1986); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 (TTAB 1985); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 430-31 (TTAB 1985); *Gemini Engine Co. v. Solar Turbines Inc.*, 225 USPQ 620, 621 n.3 (TTAB 1985). *But see Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend).

6. *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1867 (Fed. Cir. 1991) (amendment to add later-acquired registration to tack on prior owner's use); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 (TTAB 1990) (notice of opposition amended during testimony period to add claim of ownership of newly issued registration); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); *Cudahy Co. v. August Packing Co.*, 206 USPQ 759, 759-60 nn. 2-3 (TTAB 1979); *Huffy Corp. v.*

Geoffrey, Inc., 18 USPQ2d 1240, 1241-43 (Comm'r 1990) (opposer's motion to amend to join party and claim ownership of registration granted). *But see UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (if a party pleads a pending application in the notice of opposition, it may make the resulting registration of record at trial without having to amend its pleading to assert reliance on the registration).

7. 37 CFR § 2.107(b). *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014) (because opposer identified Sections 2(d) and 43(c) as grounds for opposition in the ESTTA electronic opposition form, opposer is limited to those grounds for opposition against Madrid application; however, because those grounds were not limited in the form to any particular class or classes, opposer may seek leave to amend to assert those grounds against all of the three international classes in the involved application).

8. *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539, 541 (TTAB 1973) (allegations amplified). *Cf. ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1301 (TTAB 2012) (proposed alleged failure to function as a mark is a new ground, not an amplification of the existing ground that the mark is merely descriptive).

9. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990) (motion to amend to restrict goods would serve no purpose); *Embarcadero Technologies, Inc. v. Dephix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) (because proposed claims are untimely and futile, the motion for leave to amend denied); *The North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1221-22 (TTAB 2015) (motion for leave to amend answer to add affirmative defense that if the Board should find applicant not entitled to registration of the opposed mark with respect to some but not all goods or services listed in applications, then Applicant should be allowed to amend applications to conform to Board's findings denied for failure to identify goods or services to be deleted); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 (TTAB 2007); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002) (amendment denied because Board has no jurisdiction to decide issues arising under state dilution laws), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702-03 (TTAB 2002) (proposed amended pleading of abandonment insufficient and leave to amend denied as futile where opposer asserted applicant's lack of exclusive rights in the mark but failed to include allegation that mark had lost all capacity to act as a source indicator for applicant's goods); *Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead allowed); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541-42 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000) (motion to add counterclaim denied where mere allegation that opposer did not submit copy of foreign registration at time of examination is insufficient to state claim); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (opposers could not prevail on res judicata claim as a matter of law); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993) (claim of lack of bona fide intent to use found legally sufficient); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1786-87 (TTAB 1992) (opposer's attempt to amend answer to add counterclaim denied as inconsistent with notice of opposition).

10. *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989).

11. *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1858 (Fed. Cir. 2000) (citing, inter alia, *Kelley v. Crosfield Catalysts*, 135 F.3d 1202 (7th Cir. 1998)). *See, e.g., Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 n.10 (TTAB 2000).

507.02(a) Timing of Motion to Amend Pleading – In General

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. [Note 1.] A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely. [Note 2.]

In order to avoid any prejudice to the adverse party when a motion for leave to amend under Fed. R. Civ. P. 15(a) is granted, the Board may, in its discretion, reopen the discovery period to allow the adverse party to take discovery on the matters raised in the amended pleading. [Note 3.] Exercise of such discretion to reopen discovery, however, may not be necessary when the proposed additional claim or allegation concerns a subject on which the nonmoving party can be expected to have relevant information in hand. This is especially true when the factual basis for the motion to amend was obtained by the moving party through discovery taken from the nonmoving party.

NOTES:

1. *Ashland Licensing & Intellectual Prop. LLC v. Sunpoint International Grou USA Corp.*, 119 USPQ2d 1125 (TTAB 2016) (motion to amend petition granted where delay in filing motion was due to multiple intervening suspensions and, when not actually suspended, reason to believe proceedings would be suspended); *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014) (motion for leave to amend to file second amended notice of opposition granted where case was in pleading stage and nonmoving party could point to no specific prejudice in allowing the amendment); *ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1301 (TTAB 2012) (motion for leave to amend counterclaim denied on the bases of undue delay and prejudice to counterclaim defendant where brought after counterclaim plaintiff's pretrial disclosures were served, months after summary judgment motions involving the counterclaim, and months after settlement discussions ceased); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008) (motion for leave to amend to add claims of descriptiveness and fraud denied; petitioner unduly delayed in adding claims which were based on facts within petitioner's knowledge at time petition to cancel was filed); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) (opposer unduly delayed in filing motion for leave to amend during testimony period); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (motion to amend opposition denied where it was filed eight months after filing of notice of opposition, with no explanation for the delay, and appeared to be based on facts within opposer's knowledge at the time opposition was filed); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703-04 (TTAB 2000) (no undue delay because motion to add claim of dilution was promptly filed after such claim became available, albeit over two years after commencement of proceeding); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286-87 (TTAB 1998) (request raised for the first time in reply brief on counterclaim to further restrict pleaded registration denied since opposer had no notice of this issue); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C., Inc.*, 41 USPQ2d 1030, 1033 (TTAB 1996) (motion to add claim of fraud denied where petitioner was fully aware of all the facts it needed to add such claim over three years before filing motion to amend); *Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1206-07 (TTAB 1993) (motion filed after close of discovery to assert claim of res judicata based on a judgment entered in another case after the filing of opposition permitted since applicant was afforded adequate notice and no

further discovery would be necessary); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505-06 (TTAB 1993) (no undue delay in view of pending motion for summary judgment and discovery was still open when motion was filed); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (proceeding still in pretrial stage and discovery had been extended); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990) (opposer's motion to amend its pleading during its testimony period granted in the interests of justice and judicial economy and since any prejudice could be mitigated by reopening discovery solely for applicant); *Marshall Field & Co. v. Mrs. Field's Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) ("concept of 'undue delay' is inextricably linked with the concept of prejudice to the nonmoving party"); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1733-34 (TTAB 1990) (proceeding still in the discovery stage and no undue prejudice shown).

2. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008) (motion for leave to amend to add claims of descriptiveness and fraud denied; petitioner unduly delayed in adding claims which were based on facts within petitioner's knowledge at time petition to cancel was filed); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) (opposer unduly delayed in filing motion for leave to amend during testimony period); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006) (motion for leave to amend pleading granted because grounds for new claim was learned during discovery); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984) (plaintiff should plead any registrations it wishes to introduce as soon as possible after the omission, or newly issued registration, comes to plaintiff's attention).

3. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2008) ("the only way the Board could avoid prejudice to applicant would be by reopening the trial phase of this proceeding so that applicant could submit evidence addressing this ground [whether applicant had a *bona fide* intent to use its mark]"); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703-04 (TTAB 2000) (reopened for limited purpose of conducting discovery on new claim); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990) (reopened solely for applicant's benefit); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 431 (TTAB 1985) (applicant to advise whether it would need additional discovery).

507.02(b) Timing of Motion to Amend to Add Counterclaim

The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations. Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i). [Note 1.] As provided therein, if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned. [Note 2.] TBMP § 313.04 (Compulsory Counterclaims).

NOTES:

1. 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by 37 CFR § 2.106(b)(2)(i)). *Cf. See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989) (applied Fed. R.

Civ. P. 13(f) "when justice requires" standard where grounds for counterclaim were known at time of answer). **Please Note:** Fed. R. Civ. P. 13(f) was abrogated in 2009.

2. 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i); *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (asserting claim as separate petition to cancel rather than counterclaim does not obviate timeliness requirements of 37 CFR § 2.114(b)(2)(i)) redesignated § 2.114(b)(3)(i); *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008); *Turbo Sportswear Inc. v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1154 (TTAB 2005) ("we must determine whether applicant knew of the grounds at the time it filed its answers and, if not, whether applicant filed its counterclaims promptly upon learning of those grounds"); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1033 (TTAB 1996); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992) (filing of an answer is not a condition precedent to operation of 37 CFR § 2.106(b)(2)(i), redesignated § 2.106(b)(3)(i) where grounds are learned during course of proceeding), *summary judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *Marshall Field & Co. v. Mrs. Field's Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) (counterclaim was pleaded promptly after defendant obtained information through discovery concerning possible fraud).

507.03 Amendments to Conform to the Evidence - Fed. R. Civ. P. 15(b)

Fed. R. Civ. P. 15(b) Amendments During and After Trial.

(1) Based on an Objection at Trial. *If, at trial, a party objects that evidence is not within the issues raised in the pleadings, the court may permit the pleadings to be amended. The court should freely permit an amendment when doing so will aid in presenting the merits and the objecting party fails to satisfy the court that the evidence would prejudice that party's action or defense on the merits. The court may grant a continuance to enable the objecting party to meet the evidence.*

(2) For Issues Tried by Consent. *When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings. A party may move — at any time, even after judgment — to amend the pleadings to conform them to the evidence and to raise an unpleaded issue. But failure to amend does not affect the result of the trial of that issue.*

507.03(a) During Trial After Objection to Trial Evidence

If evidence is objected to at trial on the ground that it is not within the issues raised by the pleadings, the Board, upon motion, may allow the pleadings to be amended (except as prohibited by 37 CFR § 2.107) and will do so freely when the presentation of the merits of the case will be served thereby and the objecting party fails to satisfy the Board that the admission of such evidence would prejudice it in maintaining its action or defense upon the merits. [Note 1.] *See* TBMP § 315 (Amendment of Pleadings). See also TBMP § 507.01 regarding amendment of pleadings in an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application.

The motion for leave to amend should be filed promptly by the party offering the evidence after the objection is made by an adverse party. If the motion is granted, the Board may extend the objecting party's testimony period, or reopen discovery for that party, if necessary, to enable the objecting party to meet the evidence that was the subject of the objection. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 15(b); *Ercona Corp. v. JENAer Glaswerk Schott & Gen.*, 182 USPQ 573, 574 (TTAB 1974).

2. Fed. R. Civ. P. 15(b). *Cf. Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 431 (TTAB 1985); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434, 435 (TTAB 1975); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471, 473 (TTAB 1971).

507.03(b) To Add Issues Tried by Express or Implied Consent

When issues not raised by the pleadings are tried by the express or implied consent of the parties, unless prohibited by 37 CFR § 2.107, the Board will treat them in all respects as if they had been raised in the pleadings. [Note 1.] *See* TBMP § 315 and TBMP § 507.01 regarding amendment of pleadings in an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the result of the trial of these issues. [Note 2.]

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. [Note 3.] Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried.[Note 4.]

Inasmuch as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a Fed. R. Civ. P. 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing. [Note 5.] *Cf.* TBMP § 502.01 (Available Motions).

NOTES:

1. *See e.g.*, *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (prior to opening of the testimony period, leave to amend granted to add counterclaim to partially cancel registrations on basis of abandonment; parties briefed the counterclaim as a Section 18 restriction, and at oral hearing, party expressly consented to trying counterclaim in that manner; Board deemed pleadings amended under Fed. R. Civ. P. 15(b)(2)); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1306 (TTAB 2014) (nonownership claim tried by implied consent under Fed. R. Civ. P. 15(b)(2)); *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828-29 (TTAB 2013) (answer deemed amended to include a Section 18 affirmative defense); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009).

2. Fed. R. Civ. P. 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984) (motion to amend to add abandonment submitted after filing of trial briefs denied because the issue had not been tried); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1650, 1655-56 (TTAB 2010) (Board deemed unpleaded affirmative defense of tacking by prior use of an unpleaded mark to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b)), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1399 (TTAB 2009) (although opposer did not plead issue preclusion as a ground for opposition, because applicant did not object to opposer's assertion of that ground in its brief and, in fact, addressed the issue in its brief, the

Board deemed the pleadings to be amended pursuant to Fed. R. Civ. P. 15(b)); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1223 (TTAB 2005) (opposer introduced into evidence two unpleaded registrations and applicant did not object and treated them as of record, therefore, the Board deemed the pleading amended pursuant to Fed. R. Civ. P. 15(b)); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (opposition deemed amended to include opposer's claim of ownership of previously unpleaded registrations where opposer filed notice of reliance on those registrations at trial and applicant did not object thereto); *Linville v. Rivard*, 41 USPQ2d 1731, 1735 n.9 (TTAB 1996) (certain abandonment issues while not pleaded were clearly tried by the parties and argued in their trial briefs), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 (TTAB 1993) (functionality was tried by implied consent, such consent having been given by defendant prior to trial).

3. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.3 (TTAB 2011) (although opposer did not properly plead its fame for purposes of dilution, the Board deemed the dilution claim amended by implied consent); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1924-27 (TTAB 2011) (1. petitioner's rights in unpleaded marks tried by implied consent, and Board deemed pleadings to be amended to conform to the evidence, where plaintiff stated the relevance of the submissions under notices of reliance, emphasized its intention to rely on such marks through testimony, and where respondent did not object to the testimony at the time, was afforded an opportunity to cross-examine, and raised an untimely objection; 2. unpleaded tacking and prior registration defense were not tried by implied consent where petitioner not fully appraised of respondent's reliance on use and registration of another mark); *aff'd*, 188 F. Supp. 3d 22 (D.D.C. 2016); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-21 (TTAB 2008) (opposer objected to the testimony and argument regarding applicant's use of an unpleaded mark and therefore applicant's priority based on the use of that mark was not tried by implied consent), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (where opposer, during trial, filed notice of reliance on seven unpleaded registrations and where applicant did not object thereto, Board found parties had tried by implied consent, any issues arising from those registrations); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony but was not fairly apprised that evidence, which also related to existing claim, was being offered in support of unpleaded claim); *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464, 1471 n.11 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994) (party was not fairly apprised that evidence used for a pleaded claim of descriptiveness was also being offered in support of unpleaded Trademark Act § 2(d) claim); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ 2d 1501, 1504 (TTAB 1993) (defendant raised no objection to evidence on unpleaded issue but was fairly apprised of its purpose).

4. *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1107 (TTAB 2016) ("A plaintiff must plead ownership of a family of marks in its complaint in order to rely on the marks as a family as a basis for sustaining the opposition at trial or in a motion for summary judgment."); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (petitioner's "family of marks" claim, raised for the first time in its brief not considered because it was neither pleaded nor tried by the parties), *aff'd*, 188 F. Supp.3d 22, (D.D.C. 2016); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1034-35 (TTAB 2010) (applicant was not aware opposer intended to rely on registration to prove likelihood of confusion until opposer filed rebuttal notice of reliance); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009).

5. *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ 1628, 1629 (TTAB 1998) (consistent with its practice, the Board deferred ruling on the motion until final hearing); *Devries v. NCC Corp.*, 227 USPQ 705, 708 n.7 (TTAB 1985); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 1861-62 (TTAB 1981); *New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co.*, 207 USPQ 954, 956, 959 (TTAB 1980); *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 117 (TTAB 1978).

508 Motion for Default Judgment for Failure to Answer

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board, on its own initiative, may issue a notice of default allowing the defendant time to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response that does not show good cause, default judgment may be entered against it. [Note 1.] *See* TBMP § 312.

The issue of whether default judgment should be entered against a defendant when it fails to file a timely answer to the complaint may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its concurrently filed late answer be accepted. However the issue is raised, the standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the Fed. R. Civ. P. 55(c) standard, which requires that the defendant show good cause why default judgment should not be entered against it. *See* TBMP § 312.

If a plaintiff files a motion for default judgment for failure of the defendant to file a timely answer to the complaint, and the defendant fails to file a brief in opposition to the plaintiff's motion, default judgment may be entered against defendant. [Note 2.]

If a defendant files an answer after the due date therefor, but before the issuance by the Board of a notice of default, and also files a motion asking that the late-filed answer be accepted, and the plaintiff fails to file a brief in opposition to the defendant's motion, the motion may be granted as conceded. [Note 3.] *See* TBMP § 502.02(b).

Whenever a defendant is in default, and regardless of whether the issue is raised by notice of default from the Board, or one of the referenced motions addressing the issue, a defendant's failure to file a timely answer tolls all deadlines including the time for the parties to conduct the required discovery conference. When the Board addresses the default in a way that obviates the default, for example, by denying plaintiff's motion for a default judgment or by granting defendant's motion for acceptance of its late-filed answer, the Board will reset appropriate dates, including the deadline for the parties to conduct the discovery conference. [Note 4.]

For further information concerning default judgment for failure of the defendant to file a timely answer to the complaint, see TBMP § 312.

NOTES:

1. 37 CFR § 2.106(a) and 37 CFR § 2.114(a); Fed. R. Civ. P. 55(a) and 55(b); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (Board entered notice of default in consolidated cancellation, allowing defendant 30 days to show cause why judgment should not be entered for failure to

file an answer); *DeLorme Publishing Co. v. Eartha's, Inc.*, 60 USPQ2d 1222, 1223-24 (TTAB 2000) (good cause not shown where failure to answer was based on belief that notice of opposition was "incomplete").

2. Fed. R. Civ. P. 55(b) and 55(c); 37 CFR § 2.127(a) (the Board may treat the motion as conceded).

3. 37 CFR § 2.127(a).

4. 37 CFR § 2.106(a) 37 CFR § 2.114(a).

509 Motion to Extend Time; Motion to Reopen Time

Fed. R. Civ. P. 6(b) Extending Time.

(1) ***In General.*** *When an act may or must be done within a specified time, the court may, for good cause, extend the time:*

(A) *with or without motion or notice if the court acts, or if a request is made, before the original time or its extension expires; or*

(B) *on motion made after the time has expired if the party failed to act because of excusable neglect.*

(2) ***Exceptions.*** *A court must not extend the time to act under Rules 50(b) and (d), 52(b), 59(b), (d), and (e), and 60(b), except as those rules allow.*

37 CFR § 2.120(a) ***Discovery.***

(a) ***In general.***

(1) *… The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included within the notice of institution of the proceeding.*

(2)(i) *The discovery conference shall occur no later than the opening of the discovery period, …. The discovery period will be set for a period of 180 days.*

(ii) *Initial disclosures must be made no later than thirty days after the opening of the discovery period.*

(iii) *Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rules of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.*

(iv) *The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If the motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must*

always be scheduled prior to the close of discovery. If a stipulation or motion for modification is denied, disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.

***

(3) *A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. Discovery depositions must be properly noticed and taken during the discovery period. Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.*

37 CFR § 2.121 ***Assignment of times for taking testimony and presenting evidence.***

(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any subsequent remaining periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.*

* * * *

(c) *A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be shortened or extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or may be extended upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods and their associated pretrial disclosure deadlines may remain as set.*

(d) *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

(e) *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises., … If a party does not plan to take testimony from any witness, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have a remedy by way*

of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. ...

37 CFR § 2.127(a) ***[Motions]*** *... Except as provided in paragraph (e)(1) of the section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. ...*

509.01 Nature of Motions

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 CFR § 2.116(a), a party may file a motion for an extension of the time in which an act may or must be done. [Note 1.] If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is one to extend a period that has not yet closed (often referred to as a motion to "extend"), and the moving party need only show good cause for the requested extension. If, however, the motion is not filed until after the expiration of the period as originally set or previously extended, the motion is one to extend a period that has closed (often referred to as a motion to "reopen"), and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. [Note 2.] An exception to the usual requirement for showing excusable neglect when the period for taking an action has expired arises when a defendant is in default because its time to answer has expired. In such circumstances, the showing required is good cause to excuse the default. *See* TBMP § 312 and TBMP § 508.

NOTES:

1. *Compare* 37 CFR § 2.127(a) ("The time for filing a reply brief [on a motion] will not be extended or reopened.") *with* 37 CFR § 2.127(e)(1) ("The time for filing a motion under [Fed. R. Civ. P.] 56(d) will not be extended").

2. Fed. R. Civ. P. 6(b). *See also Vital Pharmaceuticals, Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 n.10 (TTAB 2011) ("The Board construes a motion to extend an expired period as a motion to reopen such period.").

509.01(a) Motions to Extend Time

A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient. [Note 1.]

Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. [Note 2.] The Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown. [Note 3.]

For further information concerning good cause for a motion to extend, see the cases cited in the note below. [Note 4.]

If a motion to extend the time for taking action is denied, the time for taking such action may remain as previously set. [Note 5.] If a defendant's motion to extend its time to file an answer is granted, the order granting the motion will usually include a resetting of all subsequent deadlines or dates, including the discovery conference, disclosures, discovery and testimony periods.

The time for filing a reply brief on a motion will not be extended, even upon the parties' consent. In addition, while the time for filing a brief in response to a motion for summary judgment may be extended, the time for filing, in lieu thereof, a motion for discovery under Fed. R. Civ. P. 56(d) will not be extended. [Note 6.] *See* TBMP § 528.06.

NOTES:

1. *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (opposers had not come forward with "detailed facts" required to carry their burden explaining their inaction); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducali SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) ("Opposer's counsel, in his declaration, has set forth the facts relating to his other litigation matters in sufficient detail to warrant a finding that good cause exists for at least a limited extension of opposer's testimony period"); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (motion denied where party failed to provide detailed information regarding apparent difficulty in identifying and scheduling its witnesses for testimony and where sparse motion, containing vague reference to possibility of settlement, demonstrated no expectation that proceedings would not move forward during any such negotiations); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause); *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.").

2. *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008) ("the Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extension is not abused" and the moving party has the burden of persuading the Board that it was diligent in meeting its responsibilities; motion denied because opposer failed to make the minimum showing necessary to establish good cause to extend discovery); *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (diligence not shown; discovery requests not served until last day of the discovery period); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant's motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time).

3. *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999).

4. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (an attorney has no right to assume that extensions of time will always be granted, and there appears no reason why a brief was not timely filed); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383-84 (TTAB 2001) (the press of other litigation may constitute good cause to extend but alleged deficiencies in discovery responses not good cause to extend discovery where timely motion to compel was not filed); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1543-44 (TTAB 2001) (petitioner failed to explain how activity of rearranging its laboratory facilities during relevant time period prevented taking testimony; no detailed

information regarding petitioner's apparent difficulty in preparing and submitting its evidence or why petitioner waited until the last day of its testimony period to request the extension); *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (attorney's unwarranted and untimely request for permission to withdraw from representation of party viewed as bad faith attempt to obtain an extension of time); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (mere existence of settlement negotiations or proposals, without more, would not justify delay in proceeding with testimony); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (while maternity leave may constitute good cause, in this case defendant's counsel knew that defendant would not be able to comply with deadline, yet waited until penultimate day of response period to file unconsented motion to extend time); *Instruments SA Inc. V. ASI Instruments, Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown); *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (plaintiff failed to set forth detailed facts concerning the circumstances - plaintiff's allegedly busy travel schedule - which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously-set discovery period).

5. 37 CFR § 2.120(a)(2)(iv) (discovery period); 37 CFR § 2.121(a) (testimony period); 37 CFR § 2.127(a) (time for responding to a motion); 37 CFR § 2.127(e)(1) (time for responding to a summary judgment motion); *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (in view of the denial of opposer's motion to extend discovery, "discovery dates remain as originally set and as a result, the discovery period is closed"); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (petitioner's testimony period consequently expired where motion to extend testimony period was denied and dates were left as originally set); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1479 (TTAB 2000); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999). *Cf. C.H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506, 507 (TTAB 1980) (three-day testimony period for opposer reset "putting opposer in the same position it would have been in had no motion to compel been filed."). *See also* NOTICE OF FINAL RULEMAKING, 63 Fed. Reg. 48081, 48091 (September 9, 1998).

6. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1). *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (parties' stipulation to add five days to service by email was improper agreement to automatically extend time to file reply brief or a motion under Fed. R. Civ. P. 56(d)).

509.01(b) Motions to Reopen Time

509.01(b)(1) In General

Where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion through ESTTA to reopen the time for taking that action. The movant must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B). But see discussion in TBMP § 508 regarding requirement only to show good cause to obtain reopening of time for defendant to file an answer to a complaint.

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Co. v. Brunswick Associates L.P.* , 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps* , 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the

delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. [Note 1.] See also cases cited throughout this section and in TBMP § 534.02 regarding motions to dismiss under 37 CFR § 2.132, and TBMP § 544 regarding motions for relief from final judgment.

The "prejudice to the nonmovant" contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage that it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses that otherwise would have been available to the nonmovant. [Note 2.]

It has been held that the third *Pioneer* factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. [Note 3.] Additionally, although many excusable neglect decisions which were issued prior to the Board's 1997 *Pumpkin* decision may no longer be controlling under the somewhat more flexible excusable neglect standard set out in *Pioneer* and *Pumpkin* (e.g., decisions holding that a failure to act due to counsel's docketing errors is, per se, not the result of excusable neglect), they nonetheless may be directly relevant to the Board's analysis under the third *Pioneer* excusable neglect factor. [Note 4.] For additional cases involving the excusable neglect standard, see TBMP § 534 (Motion for Judgment for Plaintiff's Failure to Prove Case) and TBMP § 544 (Motion for Relief from Final Judgment).

A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient. [Note 5.]

In addition, for purposes of making the excusable neglect determination, it is irrelevant that the failure to timely take the required action was the result of counsel's neglect and not the neglect of the party itself. Under our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel. [Note 6.]

NOTES:

1. *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380, 395 (1993); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) . *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1892-93 (TTAB 2010) (weighing all four factors together, motion to reopen discovery denied; opposer's "oversight" in failing to timely serve initial disclosures and seek an extension of the discovery period does not constitute excusable neglect).

2. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997) (citing *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997)); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

3. *See FirstHealth of the Carolinas Inc. v. CareFirst of Maryland Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921-22 (Fed. Cir. 2007) (Court affirmed finding of no excusable neglect based on second and third factors, with third weighed heavily in the analysis); *Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012) (applicant made a calculated strategic decision, within its control, not to take discovery in the hope opposer had lost interest in the case, even though the parties held settlement discussions and opposer requested an extension of the discovery period before it closed); *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702 (TTAB 2002); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 n.7 (TTAB 1997). *See also Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307-08 (TTAB 2007) (respondent's mistaken belief that counsel for petitioner would agree to an extension request did not

relieve respondent of its duty to adhere to appropriate deadlines); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (failed to provide specific reasons for former counsel's inaction); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (failed to provide evidence linking the reason for the delay with the expiration of movant's testimony period); *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859-60 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay).

4. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586-87 n.8 (TTAB 1997). Such pre- *Pioneer* cases include, *e.g., Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (no excusable neglect where plaintiff's counsel unreasonably relied on defendant's counsel to sign and file plaintiff's proposed stipulated motion to extend trial dates); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1315-16 (TTAB 1992) (defendant's desire to take follow-up discovery and its uncertainty regarding status of plaintiff's pending motion to strike affirmative defenses did not excuse respondent's neglect in failing to file timely motion to extend discovery); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (no excusable neglect where defendant's failure to timely respond to certain discovery requests was due to defendant's oversight or lack of care in reading discovery requests); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619, 621 (TTAB 1986) (no excusable neglect where defendant's failure to timely respond to summary judgment motion was due to counsel's press of other litigation); *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 223 USPQ 176 (TTAB 1984) (same).

5. *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (no specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case).

6. *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380, 396 (1993) (citing *Link v. Wabash R. Co.*, 370 U.S. 626 (1962) and *United States v. Boyle*, 469 U.S. 241 (1985)); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1373 (TTAB 2000); *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302-03 (TTAB 1999); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997).

509.01(b)(2) To Introduce Newly Discovered Evidence

If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence. [Note 1.] However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of the new evidence. The Board must also consider such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party. [Note 2.]

NOTES:

1. *Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 360-61 n.11 (TTAB 1984); *Rowell Laboratories, Inc. v. Canada Packers Inc.*,

215 USPQ 523, 529 n.2 (TTAB 1982) (improper to attempt to introduce newly discovered evidence by way of rebuttal testimony rather than moving to reopen testimony period); *Oxford Pendaflex Corp. v. Rolodex Corp.*, 204 USPQ 249, 254 n.5 (TTAB 1979); *Tektronix, Inc. v. Daktronix, Inc.*, 187 USPQ 588, 589 n.1 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 169 USPQ 510, 511-12 (TTAB 1971); *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495, 499 n.6 (TTAB 1970); *United States Plywood Corp. v. Modiglass Fibers, Inc.*, 125 USPQ 144, 145 (TTAB 1960).

2. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886-87 (TTAB 2008) (the Board declined to reopen applicant's testimony period after the briefs had been filed because (1) the newspaper article sought to be introduced into evidence was not probative of opposer's intent to abandon its mark and (2) an abandonment claim could only be entertained through a counterclaim to cancel opposer's registration which would be prejudicial to opposer at such a late date); *Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (newly discovered evidence was cumulative and redundant and did not have significant probative value to justify further delay of case) (newly discovered evidence was hearsay in nature and pertained to unpleaded defense) (citing *Canadian Tire Corp. Ltd. v. Cooper Tire & Rubber Co.*, 40 USPQ2d 1537, 1539 (Comm'r 1996)).

509.02 Form and Determination of Motions to Extend or Reopen

If a motion to extend or a motion to reopen is made with the consent of the nonmoving party, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its consent thereto. Parties may file a motion solely to extend or reopen, or caption and incorporate such a motion into another motion, e.g. to compel, strike, etc.

Ordinarily, a consented motion to extend or reopen will be granted by the Board. However, after an answer has been filed, the Board is unlikely to grant even a consented motion to extend the deadline for the parties to conduct the required discovery conference when the basis for the motion is the existence of settlement discussions. [Note 1.] Similarly, because all written discovery must be completed during the discovery period, the Board will not grant a motion to extend time to respond to discovery requests beyond the close of discovery, even upon consent or stipulation. If a party wishes to extend time to respond to discovery requests, and such an extension contemplates a date after the close of discovery, a party should concurrently move to extend the close of discovery. [Note 2.]

If the parties file a stipulation or consented motion to extend or reopen a defendant's time to file an answer to the complaint, the stipulation should specify the new due date for the answer, and all subsequent dates that require rescheduling when the due date for the answer is reset, including the deadline for the required discovery conference, disclosures, discovery and trial. A consented motion to extend or reopen testimony periods and the deadlines for pretrial disclosures, or the discovery period, testimony periods and deadlines for disclosures must be filed with the Board through ESTTA and should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. [Note 3.] If a consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, specifies only the closing date for the first period to be reset, and the motion is approved, the Board will automatically reschedule the subsequent periods as well, including the dates for remaining disclosures. [Note 4.] However, receipt by the parties of the Board's action on the motion will be delayed, because the Board will have to prepare an order specifying the closing date for each period being rescheduled.

When the parties agree to a new schedule of dates and file for approval using the "consent motions" option in ESTTA, the system will prompt the filer to enter new deadlines in a manner that will automatically

generate an appropriate schedule in the proper form. If the calculator provided by ESTTA does not reflect all or the correct deadlines required by the parties' agreed-upon schedule, the filing party should select the "general filings" option in ESTTA and attach or embed in the motion the agreed-upon schedule.

When the Board notes that a consented or stipulated motion to extend time is based on the asserted existence of the parties' settlement negotiations, the Board may suspend proceedings, sua sponte, for any suitable period of time, including up to six months, to enable the parties to concentrate on settlement and to obviate the filing of numerous extension requests. Such suspension shall be made subject to either party's right to request resumption of proceedings at any time. *See* TBMP § 510.03(a). However, after a period of time of extensions or suspension, the parties may be required to report on the progress of their settlement discussions; and periodically thereafter. While settlement is encouraged, the Board also has an interest in seeing its cases conclude in a timely manner. [Note 5.]

When a motion to extend, or a motion to reopen, is filed without the consent of the nonmoving party, the Board normally will defer action on the motion until after the expiration of the nonmoving party's time to file a brief in opposition to the motion. If the nonmoving party fails to file a brief in opposition thereto, the Board will normally grant the motion as conceded. [Note 6.] A motion not stated to be consented will not be granted as conceded until after passage of sufficient time for filing and receipt by the Board of a brief in response. In the case of a telephone conference, the responding party may be excused from filing a responsive brief. *See* TBMP § 502.06(a). If the nonmoving party contests a motion by filing a responsive brief or by presenting responsive arguments in a telephone conference, the Board will decide the motion on its merits. *See* TBMP § 502.02(b) (Briefs on Motions) and TBMP § 509.01 regarding the standards to be applied in deciding contested motions to extend or reopen time.

A party must not assume that its motion to extend (much less a motion to reopen) made without the consent of the adverse party will always be granted as a matter of course. [Note 7.] Moreover, while the Board attempts, where possible, to notify the parties of its decision on an unconsented motion to extend, or a motion to reopen, prior to expiration of the enlargement sought, the Board is under no obligation to do so, and in many cases cannot. [Note 8.] *Cf.* TBMP § 202.01. Therefore, it is preferable, at least where an unconsented motion seeks an extension or a reopening of a testimony period or periods and pretrial disclosures, or of the discovery period and testimony periods and disclosures, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion. However, in the event that the motion to extend or reopen time is denied, the time for taking required action may remain as previously set. [Note 9.]

When the Board resets the closing date for discovery, the expert disclosure deadline, which is 30 days prior to the close of the discovery period, and the testimony periods, including pretrial disclosure deadlines, will automatically be reset. However, the resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods-such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 10.]

A party should not presume that the Board will automatically reset discovery, disclosure and/or trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend discovery, disclosure and/or trial dates, the Board, in the exercise of its discretion, may or may not reset relevant dates. A party that wishes to have particular deadlines or periods reset upon the determination of a particular motion should file a motion requesting such action, or caption and include a request to reset the dates in its pending motion, further specifying the deadlines or periods that it wishes to have reset. [Note 11.]

Extensions of time to seek judicial review of a final decision of the Board (whether by way of appeal to the Court of Appeals for the Federal Circuit or by way of a civil action) may be granted by the Director upon written request, which should be directed to the Office of the Solicitor, not the Board. [Note 12.] *See* TBMP § 902.02 (Time for Filing Notice of Appeal) and TBMP § 903.04 (Time for Filing Civil Action).

NOTES:

1. *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008) ("It is unlikely the Board will find good cause for a motion to extend or suspend for settlement if the motion is filed after answer but prior to the discovery conference, precisely because the discovery conference itself provides an opportunity to discuss settlement.") (citing MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007)).

2. 37 CFR § 2.120(a)(3).

3. 37 CFR § 2.121(d).

4. 37 CFR § 2.121(a).

537 CFR § 2.117(c). *Cf. Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 n.2 (Fed. Cir. 2004) ("RHL's applications languished at the United States Patent and Trademark Office ("PTO") for nearly two decades as the result of the parties' failure to move the applications and corresponding oppositions forward.")

6. 37 CFR § 2.127(a).

7. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891-92 (CCPA 1980) (after granting numerous extensions of time to respond to motion for summary judgment, last request denied and motion for summary judgment granted as conceded).

8. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980); *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999) (waiting for Board approval of previous extension request insufficient to justify resetting of dates). *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275-76 (Fed. Cir. 1984); and *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992).

9. *See* 37 CFR § 2.120(a), 37 CFR § 2.120(a)(1), 37 CFR § 2.121(c), 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1). *See also Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999).

10. 37 CFR § 2.120(a)(2)(iv) 37 CFR § 2.121(a)and37 CFR § 2.121(a)(3).

11. *See, e.g.*, 37 CFR § 2.120(a)(3); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 n.6 (TTAB 2013) (party should not presume that Board will automatically reset discovery when it determines a pending motion, where motion filed one day prior to the closing date of the discovery period).

12. 37 CFR § 2.145(e).

510 Motion to Suspend; Motion to Resume

37 CFR § 2.117 ***Suspension of proceedings.***

(a) *Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.*

(b) *Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.*

(c) *Proceedings may also be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board. Many consented or stipulated motions to suspend are suitable for automatic approval by ESTTA, but the Board retains discretion to condition approval on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate.*

37 CFR § 2.120(f)(2) *When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion to compel is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

37 CFR § 2.127(d) *When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

37 CFR § 2.146(g) *The mere filing of a petition to the Director will not act as a stay in any ... inter partes proceeding that is pending before the Trademark Trial and Appeal Board ... except when a stay is specifically requested and is granted ...*

37 CFR § 2.124(d)(2) *... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.*

510.01 In General

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board. [Note 1.] Some of the most common reasons for suspension are discussed below.

NOTES:

1. *See* 37 CFR § 2.117; *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009); *Carrini, Inc. v. Carla Carini, S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000); *Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021, 2029 (D.N.J. 1990) ("The power to stay a cancellation proceeding resides only in the Board itself.") (citing *The Other Tel. Co. v. Conn. National Tel. Co.*, 181 USPQ 779, 782 (Comm'r 1974)), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

510.02 Suspension Pending Outcome of Another Proceeding; Resumption

510.02(a) Suspension

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action that may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. [Note 1.]

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court. Although the Supreme Court held that issue preclusion can be based on a decision by the Board in a case in which the ordinary elements of issue preclusion are met, the Board's policy to suspend in favor of a civil action has not changed. A civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond right to registration and, therefore, judicial economy is usually served by suspension. [Note 2.]

Further, pursuant to 37 CFR § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved [Note 3.], or a civil action pending between the parties in a state court [Note 4.], or a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the other party's subject application is based [Note 5.], or even another proceeding in which only one of the parties is involved. [Note 6.]

Unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board. [Note 7.]

The Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration, and asserting unrelated claims, absent the consent of the other parties. [Note 8.]. An exception may be made for purposes of consistency and economy where there are common claims in the separate proceedings. The Board may then order suspension of the other proceedings pending disposition of the proceeding that appears closest to issuance of a final decision. [Note 9.] If the multiple proceedings are at the same stage of litigation and plead the same claims, the Board may order consolidation. [Note 10.]

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board [Note 11.], nor do parties or their attorneys. [Note 12.] However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding.

When a motion to suspend pending the outcome of a civil action is filed, the Board normally will require that a copy of the operative pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action may have a bearing on the issues before the Board. [Note 13.] This requirement ordinarily is waived if all parties consent to the suspension. *See* TBMP § 502. When the suspension is consented to by all parties, use the "consent motions" option in ESTTA, which requires that the filer certify that the adverse party has consented to the suspension. If an adverse party has not consented, the filing must still be made via ESTTA, but the filer should select the "general filings" option from the drop-down menu instead of the "consent motions" option. *See* 37 CFR § 2.126(a), TBMP § 110 and http://estta.uspto.gov for information regarding filing via ESTTA.

The Board does not usually require that an issue be joined (i.e., that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. [Note 14.] Such a requirement is made only in those cases where there is no stipulation to suspend and it is not possible for the Board to ascertain, prior to the filing of an answer in one or both proceedings, whether the final determination of the other proceeding may have a bearing on the issues before the Board.

If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion that is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. [Note 15.] The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.

NOTES:

1. 37 CFR § 2.117(a). *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689, 692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974); *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806-07 (TTAB 1971).

2. *See, e.g., B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015) ("[A] court should give preclusive effect to TTAB decisions if the ordinary elements of issue preclusion are met." (2048); "When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB's analysis, the TTAB gives preclusive effect to the court's judgment." (2053); and "So long as the other ordinary elements of issue preclusion are met, when the usages adjudicated by the TTAB are materially the same as those before the district court, issue preclusion should apply." (2056)); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the USPTO); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208, 1211 (D. Minn. 1986) (primary jurisdiction should not be invoked where, inter alia, a stay of the district court action is more likely to prolong the dispute than lead to its economical disposition and where the district court action includes claims which cannot be raised before the Board); *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1253-54 (TTAB 2011) (no claim preclusion based on district court's determination because civil action focused on respective uses and rights to use while Board proceeding focus on right to registration; issue preclusion based on district court determination found); *New Orleans Louisiana Saints LLC v. Who*

Dat? Inc., 99 USPQ2d 1550, 1552 (TTAB 2011) (decision by district court may be binding on the Board, but determination by the Board of a defendant's right to obtain or maintain a registration would not be ... res judicata in the court proceeding); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689, 692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977).

Cf. Zachry Infrastructure LLC v. American Infrastructure Inc., 101 USPQ2d 1249, 1253 n.6 (TTAB 2011) (district court may have lacked jurisdiction to entertain a counterclaim to refuse registration because the involved mark was the subject of an application, not a registration); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1844-45 (TTAB 1995) (district court finding concerning priority of use not binding in view of differences in interpretation of Trademark Act § 7(c) by Board and court, and finding regarding priority of secondary meaning not binding because said issue was not involved in the Board proceeding).

3. *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending outcome of ex parte prosecution of opposer's application).

4. *See Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 395 (Fed. Cir. 1983) (noting stay based in part on state court infringement action); *Professional Economics Incorporated v. Professional Economic Services, Inc.*, 205 USPQ 368, 376 (TTAB 1979) (decision of state court, although not binding on the Board, was considered persuasive on the question of likelihood of confusion); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (state court action to determine ownership of applicant's mark and authority of applicant to file application).

5. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (Board suspended proceedings pending receipt of pleadings and other documentation to determine whether proceeding in the United Kingdom may have a bearing in Board proceeding); *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793-94 (TTAB 1993) (opposition suspended pending decision of German court on validity of foreign registration which is the basis of the U.S. application involved in the opposition).

6. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (Board suspended proceedings pending receipt of pleadings and other documentation to determine whether proceeding in the United Kingdom may have a bearing in Board proceeding); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (state court action between applicant and third party to determine ownership of applicant's mark).

7. 37 CFR § 2.117(a). *See, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have a bearing on issues before the Board); *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992) (relief sought in federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board), *pet. denied*, 181 USPQ 779 (Comm'r 1974). *See also Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806-07 (TTAB 1971); *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

But see Boyds Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017, 2018-19 (TTAB 2003) (petitioner's motion to suspend filed after trial denied as untimely, and in any event, petition was dismissed since petitioner's only proffered evidence had been stricken); *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 USPQ 807, 808 n.3 (TTAB 1978); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*,

178 USPQ 429, 430 (TTAB 1973) (in each case, a motion to suspend filed after the conclusion of testimony and briefing periods, when the Board proceeding was ready for decision, was denied).

8. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1551 (TTAB 2011).

9. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

10. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

11. *See Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990) (district court has no control over Board docket and no power to stay Board proceedings), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

12. *See Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

13. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (party ordered to submit status of and pleadings from a foreign action between the parties so Board may ascertain whether final determination of that proceeding may have a bearing on the issues before the Board); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (Board will scrutinize pleadings in civil action to determine if the issues before the court may have a bearing on the Board's decision); *Forest Laboratories Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1060 (TTAB 1999) (parties required to submit a copy of the complaint in the civil action so that Board may determine whether suspension is warranted); *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 415 (TTAB 1975), *appeal dismissed*, 189 USPQ 15 (CCPA 1976).

14. *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974).

15. *See* 37 CFR § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018-19 (TTAB 2003) (motion to strike petitioner's notice of reliance, its only evidence in the case, decided before motion to suspend, and granted).

510.02(b) Resumption

When a proceeding before the Board has been suspended pending the outcome of another proceeding, and that other proceeding has been finally determined, the interested party should promptly notify the Board in writing of the disposition of the other proceeding, and request that further appropriate action be taken in the Board proceeding. Usually, the interested party requests, as a result of the decision in the other proceeding, that judgment be entered in its behalf on one or more issues in the Board proceeding. [Note 1.] A copy of the decision in the other proceeding should accompany the notification. The Board will then issue a show cause order as to why judgment on the identified issues should not be entered in favor of the moving party. Absent any such notification as to the final determination of the civil action, cases that have been suspended pending civil action will usually remain in a suspended status for one year before the Board will issue an order requiring the parties to provide the status of the civil action.

A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired.

NOTES:

1. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) ("Within twenty days after the final determination of the civil action, opposer must so notify the Board so that this case may be called up for appropriate action.").

510.03 Suspension for Other Reasons; Resumption

510.03(a) Suspension

The Board suspends proceedings in cases before it for a wide variety of reasons including those discussed below.

Upon motion or upon stipulation. Proceedings may be suspended for good cause upon motion or stipulation of the parties approved by the Board. [Note 1.] For example, proceedings may be suspended, upon motion or stipulation under 37 CFR § 2.117(c), for purposes of settlement negotiations, subject to the right of either party to request resumption at any time. [Note 2.] However, the Board generally will not approve a motion or stipulation to suspend filed after answer and before the discovery conference without a sufficient showing of good cause. The mere desire to engage in settlement discussions is unlikely to constitute good cause for a suspension of the deadline for the discovery conference because the discovery conference itself provides the parties an opportunity to discuss settlement. [Note 3.] In addition, if, during the course of the proceedings, a motion to extend time indicates that the parties are negotiating for settlement, the Board may, in lieu of granting the requested extension, suspend proceedings for a specified time, usually six months, subject to resumption by either party at any time. *See* TBMP § 509.02.

Note, however, that the Board will not suspend proceedings indefinitely upon allegations of settlement talks, discovery activities, or trial activities. After a period of time, the Board may require the parties to file a detailed report on the progress of their settlement, discovery, or trial activities. Further, the Board may, in its discretion, deny further suspension when the parties have already been granted a reasonable time to engage in settlement, discovery, or trial activities. While parties are encouraged to settle their cases and have a duty to cooperate in the discovery process, the Board has an interest in seeing its cases conclude in a timely manner. [Note 4.]

The parties may also agree to suspend proceedings for consideration of a matter by an examining attorney, including the disposition of a party's application before the examining attorney. [Note 5.]

Bankruptcy. The Board will issue an order suspending proceedings if it comes to the attention of the Board that the defendant has filed a petition for bankruptcy. [Note 6.] Under the automatic stay provisions of Section 362 of the United States Bankruptcy Code, 11 U.S.C. § 362, a petition for bankruptcy (filed under Section 301, 302, or 303 of the Code, 11 U.S.C. § 301, 302, or 303) operates as a stay, inter alia, of the commencement or continuation of a judicial, administrative, or other action or proceeding against the debtor that was or could have been commenced before the commencement of the bankruptcy case. However, if it is the plaintiff in the Board proceeding, rather than the defendant, who has filed a petition for bankruptcy, the automatic stay provisions do not mandate the suspension of the Board proceeding unless there is a counterclaim in the Board proceeding for cancellation of the plaintiff's registration(s). Nonetheless, for good cause shown, the Board may suspend a proceeding based upon a plaintiff's bankruptcy.

Withdrawal of counsel. If, in a Board proceeding, a party's attorney or other authorized representative files a request to withdraw as counsel for the party, and the request is granted, the Board will suspend proceedings

and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it intends to represent itself (i.e., proceed pro se), failing which the Board may issue an order to show cause why default judgment should not be entered against the party. [Note 7.] *See*, with respect to withdrawal of counsel, TBMP § 116.02-TBMP § 116.05 and TBMP § 513.01. For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP § 510.03(b). A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance on the party's behalf in the proceeding. *See* TBMP § 114.03 (Representation by Attorney). *See also* TBMP § 114.04 (Representation by Non-Lawyer) and TBMP § 114.05 (Representation by Foreign Attorney).

Potentially dispositive motion. When a party to a Board proceeding timely files a motion that is potentially dispositive of the proceeding, such as a motion to dismiss, [Note 8.] a motion for judgment on the pleadings, or a motion for summary judgment, the case is considered automatically suspended by operation of 37 CFR § 2.127(d) with respect to all matters not germane to the motion. [Note 9.]

The timely filing of such a potentially dispositive motion itself operates to suspend a case. When issuing its suspension order or subsequent order on the motion, the Board will ordinarily treat the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion. [Note 10.] In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures. On a case-by-case basis, however, the Board may find that the filing of a potentially dispositive motion does not provide a party with good cause for failing to comply with an otherwise outstanding obligation. [Note 11.]

Once a timely filed potentially dispositive motion operates to suspend proceedings in a case, no party should file any paper that is not germane to the motion, except as otherwise may be specified in a Board order. [Note 12.]

Motion to compel. Pursuant to 37 CFR § 2.120(f) when a party files a motion to compel initial disclosures, expert disclosures or discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, [Note 13.] and no party should file any paper that is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition that had been duly noticed prior to the filing of the motion to compel, nor does it excuse a party from making any required discovery disclosures. When the motion to compel is filed after discovery has closed, the parties need not make pretrial disclosures until directed to do so by the Board. [Note 14.] *See* TBMP § 523 regarding motions to compel.

Motion to divide. A registration or application that is the subject of a Board inter partes proceeding may be divided into two or more separate applications or registrations. Any request to divide out the unopposed goods or services will routinely be granted. A request to divide generally will not result in suspension of the proceeding. For more information on motions to divide, see TBMP § 516.

Petition to the Director. In general, the mere filing of a petition to the Director seeking review of an interlocutory decision or order of the Board will not act as a stay of the Board proceeding pending disposition of the petition. *See generally* TBMP § 905. Such a stay must be specifically requested of the Board and granted by the Board. [Note 15.] The decision as to whether to grant such a stay is within the Board's discretion. Until and unless the Board issues a suspension order, all times continue to run as previously set or reset by the Board.

Testimonial depositions on written questions. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions pursuant to 37 CFR § 2.124, the Board will suspend or reschedule other deadlines or time periods in the case to allow for the orderly completion of the depositions upon written questions. [Note 16.] *See* TBMP § 703.02(c).

Discovery depositions on written questions. Upon receipt of written notice that one or more discovery depositions are to be taken upon written questions pursuant to 37 CFR § 2.124(b)(2), the Board may suspend or reschedule other deadlines or time periods in the case to allow for the orderly completion of the depositions upon written questions. *See* TBMP § 404.07(e).

To conduct discovery of expert witness: The Board may suspend proceedings to provide for the taking of any necessary discovery of a proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. [Note 17.] *See* TBMP § 408.01(b). For further information regarding expert disclosures, see TBMP § 401.03

NOTES:

1. 37 CFR § 2.117(c).

2. *See Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (it may be the safest course of action for parties engaged in settlement to file a consented motion or stipulation to suspend proceedings); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (order suspending proceedings for settlement vacated once it came to Board's attention that adverse party objected to suspension on such basis). *See also Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1704 (TTAB 2002) (proceedings are not suspended automatically when parties are discussing settlement and a party that fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk).

3. *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008).

4. 37 CFR § 2.117(c). *Cf. Shen Manufacturing Co. v. Ritz Hotel Ltd*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 n.2 (Fed. Cir. 2004) ("RHL's applications languished at the United States Patent and Trademark Office ("PTO") for nearly two decades as the result of the parties' failure to move the applications and corresponding oppositions forward."); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008) ("The Board has adopted the practice of discovery conferences to avoid needless disputes and motions and to facilitate a smooth and timely conclusion to Board proceedings.").

5. *See, e.g., The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending consideration of consent agreement by examining attorney).

6. *See, e.g., In re Checkers of North America Inc.*, 23 USPQ2d 1451, 1452 (Comm'r 1992) (noting that case was previously suspended where debtor's (petitioner's) pleaded registration was the subject of a counterclaim) *aff'd sub nom. Checkers Drive-In Restaurants, Inc. v. Comm'r*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995).

7. *See, e.g., University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468-69 (TTAB 2008) (request to withdraw as counsel granted, proceedings suspended, and party allowed time to either appoint new counsel or file submission stating it will represent itself).

8. The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. *See* Fed. R. Civ. P. 12(b); *Hollow form Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

9. 37 CFR § 2.127(d); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962, 69967 (Oct. 7, 2016) ("[A]n amendment to § 2.127(d) specifies that a case 'is suspended' when a party timely files a potentially dispositive motion."; "The Office is amending § 2.127(d) to clarify that a case is suspended when a party timely files any potentially dispositive motion."). *Cf. Electronic Industries Association. v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (suspended pending disposition of motion for discovery sanctions which included request for entry of judgment); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1438 (TTAB 1995) (suspended pending disposition of motion for judgment on the pleadings); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 n.7 (TTAB 1985) (suspended pending motion for summary judgment, and subsequent motion to suspend for civil action deferred until after decision on summary judgment); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross motion for summary judgment is germane to a pending motion for summary judgment). *Cf. SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 (TTAB 1994) (motion for leave to amend a notice of opposition is not a potentially dispositive motion which would warrant suspension under 37 CFR § 2.127(d)).

10. *See Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1305-06 (TTAB 2002); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999).

11. *See Leeds Technologies Ltd v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1306, 1307-08 (TTAB 2002) (time for opposer to serve discovery responses reset following decision on opposer's motion for judgment on pleadings). *But see Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1136 (TTAB 2010) (filing of motion for summary judgment one day before Board ordered discovery responses were due did not establish good cause for failure to comply with discovery obligations under Board order granting discovery sanctions), *clarified*, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011) (however, entry of judgment as a sanction for a party's failure to abide by the Board's practice regarding suspension is not supported).

12. 37 CFR § 2.127(d); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 n.7 (TTAB 1985) (motion to suspend for civil action not considered); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment germane to pending summary judgment motion).

13. *See, e.g., Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430 (TTAB 1998) (proceedings deemed suspended as of the filing of the motion).

14. 37 CFR § 2.120(f).

15. 37 CFR § 2.146(g).

16. 37 CFR § 2.124(d)(2).

17. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See, e.g., Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1564-65 (TTAB 2014); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

510.03(b) Resumption

Settlement negotiations. When proceedings are suspended for purposes of settlement negotiations, the Board normally sets a specific period of suspension (up to six months) and provides a new trial schedule that will take effect upon resumption. Each party has the right to request resumption at any time during the suspension period. [Note 1.] If no word is heard from either party prior to the expiration of the suspension period, the new trial schedule automatically goes into effect when the suspension period expires, and if a fully briefed motion was pending before the Board suspended proceedings, the Board ordinarily will decide the motion after the suspension period expires. In addition to, or instead of, resetting trial dates, the Board may reset the time for the parties to take other appropriate action in the case.

Matter before the examining attorney. If proceedings have been suspended for consideration of a matter by the examining attorney, including the disposition of a party's application before the examining attorney, and the matter does not resolve the case, the Board will issue an order resuming proceedings and taking further appropriate action. [Note 2.]

Bankruptcy. When the Board has suspended proceedings because a defendant in a Board proceeding or plaintiff whose registration is the subject of a counterclaim has filed a petition for bankruptcy, the Board periodically (normally, once a year) inquires as to the status of the bankruptcy case. In order to expedite matters, however, when the bankruptcy case has been concluded, or the involved application or registration of the bankrupt party has been transferred to some other person, the interested party should immediately file a paper notifying the Board thereof. Once the Board has been notified of the outcome of the bankruptcy case, and/or of the disposition of the bankrupt's involved application or registration, the Board will resume proceedings and take further appropriate action.

Withdrawal of counsel. If proceedings have been suspended in order to allow a party, whose attorney or other authorized representative has withdrawn, a period of time in which to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself (i.e., proceed "pro se"), and that party so informs the Board, the Board will resume proceedings, and go forward with the party proceeding pro se or with the newly-appointed counsel representing the party. *See* TBMP § 510.03(a). A party proceeding pro se may employ a new attorney or other authorized representative at any time thereafter. If the party fails, during the time allowed, to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself, the Board may issue an order noting that the party appears to have lost interest in the case, and allowing the party time in which to show cause why default judgment should not be entered against it. [Note 3.] If the party, in turn, files a response indicating that it has not lost interest in the case, default judgment will not be entered against it. If the party fails to file a response to the show cause order, default judgment may be entered against it.

Potentially dispositive motion. When proceedings have been suspended pending determination of a potentially dispositive motion, and the determination of the motion does not dispose of the case, the Board, in its decision on the motion, will issue an order resuming proceedings and taking further appropriate action including resetting appropriate dates. [Note 4.]

NOTES:

1. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings suspended subject to the right of either party to request resumption).

2. *See, e.g., The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings to be resumed if consent agreement did not overcome examining attorney's Trademark Act § 2(d) refusal).

3. *See, e.g., Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1224-25 (TTAB 1993).

4. *See* 37 CFR § 2.127(d). *See also e.g., Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (dates reset beginning with the period that was running when the potentially dispositive motion was filed).

511 Motion to Consolidate

Fed. R. Civ. P. 42(a) Consolidation. *If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary cost or delay.*

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. [Note 1.] In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. [Note 2.] Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered [Note 3.], it is not always necessary. [Note 4.] Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. [Note 5.]

Generally, the Board will not consider a motion to consolidate until an answer has been filed (i.e., until issue has been joined) in each case sought to be consolidated. However, the Board may, in its discretion, order cases consolidated prior to joinder of issue. [Note 6.] *See* TBMP § 305 (Consolidated and Combined Complaints).

When cases have been ordered consolidated, they may be presented on the same record and briefs. [Note 7.] Papers should only be filed in the "parent" case of the consolidated proceedings unless otherwise advised by the Board, but the caption of each paper filed with the Board should reference the individual proceeding numbers with the parent case listed first. [Note 8.] Ordinarily, the lowest numbered opposition of the consolidated cases is treated as the "parent" case when an opposition is involved, and the lowest numbered cancellation is the parent if there are only cancellations.

When actions by different plaintiffs are consolidated, and the plaintiffs are represented by different counsel, the plaintiffs may be required to appoint one lead counsel to supervise and coordinate the conduct of the plaintiffs' cases and to provide one point of contact with the Board. *See* TBMP § 117.02.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires the filing of separate pleadings and entry of a separate judgment. [Note 9.] Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated.

Where a final disposition has been entered as to some, but not all, of the cases in a consolidated proceeding, the remaining cases will no longer be considered consolidated with the cases for which a final disposition has been entered. [Note 10.]

NOTES:

1. *See* Fed. R. Civ. P. 42(a); *Wise F&I, LLC, et al. v. Allstate Insurance Co.*, 120 USPQ2d 1103, 1105 (TTAB 2016) (sua sponte consolidation due to common questions of law and fact); *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1149 (TTAB 2014) (Board ordered consolidation of opposition and cancellation proceedings because cancellation was "effectively a compulsory counterclaim"); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008) (proceeding involved identical parties, identical registrations and related issues); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); *Ritchie v. Simpson*, 41 USPQ2d 1859, 1860 (TTAB 1996) (cases consolidated despite variations in marks and goods), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n. 1 (TTAB 1993) (opposition and cancellation consolidated); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991) (opposition and cancellation consolidated); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). (opposition and cancellation consolidated). *See also Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989) (stipulation to consolidate); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (proceedings consolidated pursuant to joint motion); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985); (oppositions consolidated); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1201 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464 (TTAB 1983) (three oppositions consolidated).

2. *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to consolidate granted); *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1982) (consolidation denied where one case was just in pleading stage, and testimony periods had expired in other); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same); *World Hockey Association v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441-42 (TTAB 1973) (consolidation denied where issues differed).

3. *See Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 (TTAB 1989) (consolidation ordered in view of identity of parties and similarity of issues); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (consolidation ordered in view of identity of parties and similarity of issues).

4. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (if multiple oppositions brought by different opposers are at the same stage of litigation and plead the same claims, the Board may consolidate for consistency and economy); 9A C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 2382, 2384 (3d ed. 2017).

5. *See, e.g., Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016) (motion to consolidate granted); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (same); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007) (consolidation ordered sua sponte); *8440 LLC v. Midnight Oil Co.*, 59 USPQ2d 1541, 1541 n.1 (TTAB 2001) (opposition and cancellation proceedings consolidated on Board's own initiative); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (motion); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.2 (TTAB 1993) (stipulation); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991)

(Board's initiative); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989) (stipulation).

6. *Cf.* 37 CFR § 2.106(b); 37 CFR § 2.114(b).

7. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, n.2 (TTAB 1996); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helen Curtis Industries, Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB1989).

8. *See, e.g., S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 n.4 (TTAB 1997) and *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993).

9. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

10. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1300 (TTAB 2016) (two cases no longer consolidated after final disposition entered in one); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1115 (TTAB 2011) (because two of three cancellations dismissed, remaining cancellation no longer considered to be consolidated and shall proceed as a single proceeding).

512 Motion to Join or Substitute

512.01 Assignment of Mark

When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. [Note 1.]

When a mark that is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Trademark Act § 10, 15 U.S.C. § 1060, any action with respect to the application or registration that may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded with the USPTO or that proof of the assignment has been submitted in the Board proceeding record. [Note 2.]

Please Note: Trademark Act § 10, 15 U.S.C. § 1060, and part 3 of 37 CFR are not applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations. [Note 3.] Except in limited circumstances, [Note 4.] requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau. [Note 5.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded with the International Bureau. [Note 6.]

If the mark in an application or registration that is the subject matter of an inter partes proceeding before the Board is assigned, together with the application or registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding; or as a junior or senior party, as the case may be, in an interference or concurrent use proceeding) upon the filing with the Board of a copy of the assignment. When the assignment is recorded in the Assignment Recordation Branch of the USPTO [Note 7.], the assignee may be substituted as a party if the assignment occurred prior to the commencement

of the proceeding [Note 8.], the assignor is no longer in existence, the plaintiff raises no objections to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. [Note 9.]

If a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted for the originally named party if the assignment occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or if the defendant raises no objection to substitution; otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence. [Note 10.] *See* TBMP § 303.05(b) (Opposition Filed by Privy). The assignment does not have to be recorded with respect to a plaintiff's pleaded application or registration before substitution or joinder (whichever is appropriate) is made. However, recordation in the Assignment Recordation Branch of the USPTO is advisable because it will aid the assignee in its effort to prove ownership of the application or registration at trial. [Note 11.]

If the mark of an excepted common law user (that is not the owner of an involved application or registration) in a concurrent use proceeding is assigned, the assignee will be joined or substituted as party defendant upon notification to the Board of the assignment. [Note 12.]

Alternatively, if there has been an assignment of a mark that is the subject of, or is relied upon in, a proceeding before the Board, and the Board does not order that the assignee be joined or substituted in the proceeding, the proceeding may be continued in the name of the assignor. [Note 13.]

Further, the fact that a third party related to the plaintiff, such as a parent or licensor of the plaintiff, may also have an interest in a mark relied on by the plaintiff does not mean that the third party must be joined as a party plaintiff. [Note 14.]

A joint applicant may assign an intent-to-use application for registration of a mark to a second joint applicant without violating Trademark Act § 10(a)(1), 15 U.S.C. § 1060(a)(1). [Note 15.]

NOTES:

1. *See, e.g., NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 n.1 (TTAB 2008) (Board will not add or substitute an opposition applicant without motion and submission of either proof of name change assignment or proof of recordation of same with the USPTO). *See also Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1910 n.1 (TTAB 2000) (assignee joined at final decision).

2. *See* 37 CFR § 3.71; 37 CFR § 3.73(b).

3. *See* 37 CFR § 7.22 *et seq.* for information on recording changes to Trademark Act § 66(a),15 U.S.C. § 1141f(a) applications and registrations.

4. *See* 37 CFR § 7.23; 37 CFR § 7.24.

5. *See* Trademark Act § 72, 15 U.S.C. § 1141l; 37 CFR § 7.22. *See also* TMEP § 1904.06 (Assignment of Extension of Protection to the United States).

6. *See* TMEP § 501.07 (Assignment of Extension of Protection of International Registration to the United States); TMEP § 1904.06 (Assignment of Extension of Protection to the United States).

7. With respect to Trademark Act § 66(a), 15 U.S.C. § 1141f (a) applications and registrations, the USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. *See* TMEP § 501.07; TMEP § 1904.06

8. *Cf. Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.1 (TTAB 2007) (opposition captioned in name of new opposer where assignment of pleaded registrations recorded prior to filing of notice of opposition).

9. *See, e.g.,* 37 CFR § 2.113(c)(1), 37 CFR § 2.113(d), 37 CFR § 3.71(d), and 37 CFR § 3.73(b); Fed. R. Civ. P. 17 and 25; *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.2 (TTAB 2007) (applicant's motion to join another defendant granted where assignment of application occurred after commencement of proceeding); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993) (joinder after assignment); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1138 n.4 (TTAB 1990) (assignee joined after filing copy of an assignment which occurred subsequent to commencement of proceeding); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 857 n.1 (TTAB 1986) (assignee joined where papers filed by parties indicated registration had been assigned). *See also Huffy Corp. v. Geoffrey Inc.*, 18 USPQ2d 1240, 1242 (Comm'r 1990) (joinder); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1222 n.2 (TTAB 1987) (joinder after assignment); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 nn.2-3 (TTAB 1985) (substitution due to reincorporation and merger); *E.E. Dickinson Co. v. T.N. Dickinson Co.*, 221 USPQ 713, 715 n.1 (TTAB 1984) (joinder of successor-in-interest); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.1 (TTAB 1982) (substitution resulting from partnership incorporating under the same name).

10. *See, e.g.,* 37 CFR § 2.113(c); 37 CFR § 2.113(d); 37 CFR § 3.71(d); 37 CFR § 3.73(b); Fed. R. Civ. P. 17 and 25; 37 CFR § 2.102(b); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.1 (TTAB 2007) (opposition captioned in name of new opposer where assignment of pleaded registrations recorded prior to filing of notice of opposition); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1872-73 (TTAB 1994) (substitution of opposer appropriate where assignment occurred prior to commencement); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993) (motion to substitute filed during testimony period granted to the extent that successor was joined); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079-80 (TTAB 1992) (opposer's motion to substitute granted where copy of assignment was filed and applicant did not object); *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1035 n.2 (TTAB 1988) (survivor of merger substituted at final decision).

See also Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003, 1004 n.1 (TTAB 1984) (substitution as party defendant after recordation of chain of title in the Office); *Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc.*, 217 USPQ 810, 812 n.3 (TTAB 1982) (substitution after testimony periods had expired; assignment document showing nunc pro tunc assignment to the day preceding the filing date of the application); *Liberty & Co. v. Liberty Trouser Co.*, 216 USPQ 65, 66 n.1 (TTAB 1982) (substitution of party defendant as reflected in assignment records in the Office); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (joinder of defendant instead of substitution; upon filing of assignment with the Assignment Recordation Branch, substitution may occur due to transfer of ownership

prior to institution of cancellation); *Aloe Creme Laboratories, Inc. v. Aloe 99, Inc.*, 188 USPQ 316, 322 n.12 (TTAB 1975) (reference to applicant in decision refers to both applicant of record and successor-in-interest in view of testimony regarding transfer of ownership of mark). *Cf. SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708-09 (TTAB 1994) (motion to join licensee as "co-opposer" denied since right to oppose may be transferred but not shared unless timely opposition is filed); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1076-77 (TTAB 1993) (substitution of proper party in interest not permitted in view of misidentification of original party).

11. With respect to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations, the USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. *See* TMEP §501.07;TMEP § 1904.06.

12. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993) (joinder); *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1134 n.3 (TTAB 1982) (substitution of successor-in-interest as party defendant).

13. *See* Fed. R. Civ. P. 25(c); *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1311 n.1 (TTAB 1999) (decision will be binding upon the assignee); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.1 (TTAB 1982) (same).

14. *See Avia Group International Inc. v. Faraut* , 25 USPQ2d 1625, 1626-27 (TTAB 1992) (respondent's motion to join petitioner's licensor as party plaintiff denied). *Cf.* 37 CFR § 2.107(a) and 37 CFR § 2.107(b) (if no assignment of a pleaded mark, opposition may not be amended to add a joint opposer after close of time for filing opposition).

15. *Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1871 (TTAB 2010).

512.02 Change of Name

If the name of a party to an inter partes proceeding before the Board is changed, the title of the Board proceeding may be changed, upon motion or upon the Board's own initiative, to reflect the change of name, provided that appropriate evidence thereof is made of record in the proceeding. Such evidence may consist, for example, of a copy of the name change document, or the reel and frame numbers at which such document is recorded in the Assignment Recordation Branch of the USPTO. [Note 1.] If no such evidence is made of record in the proceeding, the proceeding may be continued in the party's old name. [Note 2.] *See* note to TBMP § 512.01 regarding assignments of Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations.

A name change document does not have to be recorded in the Assignment Recordation Branch of the USPTO with respect to a defendant's involved application or registration, or a plaintiff's pleaded application or registration, in order for the Board proceeding title to be changed to reflect the new name. However, recordation is advisable because it facilitates proof of ownership of the application or registration, and because filing for recordation is one of the 37 CFR § 3.85 requirements for an applicant that desires, if it prevails in the proceeding, to have its registration issue in its new name. [Note 3.] *See* TBMP § 512.03 (Issuance of Registration to Assignee, or in New Name).

NOTES:

1. *See, e.g., Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1546 n.1 (TTAB 2011) (changing caption to reflect change of corporate entity after conversion; best practice is to file a separate submission with the Board advising of the change); *WMA Group Inc. v. Western International Media Corp.*, 29 USPQ2d 1478, 1479 n.3 (TTAB 1993) (changing caption to reflect change of corporate name of party); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.1 (TTAB 1992) (caption to be changed if document evidencing change of name is submitted); *NutraSweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964, 1964 n.2 (TTAB 1987) (although no request to substitute was filed, where the change of name was recorded and there was no dispute as to facts and circumstances surrounding name change, opposer under new name was substituted as plaintiff); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1004 n.1 (TTAB 1984) (substitution of defendant due to recordation of merger, assignment and change of name in Office). *Cf. In re Brittains Tullis Russell Inc.*, 23 USPQ2d 1457, 1458 n.1 (Comm'r 1991) (in petition to Commissioner to accept Trademark Act §§ 8 & 15 affidavit, registration file evidenced change of registrant's name and claim of ownership accepted).

2. *See, e.g., Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736, 737 n.3 (TTAB 1983) (caption was not changed to reflect name change where no supporting documents submitted); *National Blank Book Co. v. Leather Crafted Products*, 218 USPQ 827, 827 n.2 (TTAB 1983) (opposer's change of name). *Cf.* Fed. R. Civ. P. 25(c).

3. *See* TMEP § 502.03. *Cf.* TMEP § 1906.01(a) and TMEP § 1906.01(c) for assignments and changes of names involving international registrations on the International Register.

512.03 Issuance of Registration to Assignee, or in New Name

37 CFR § 3.85 ***Issue of registration to assignee.*** *The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.*

Even where the assignee of an application that is the subject matter of a Board inter partes proceeding has been joined or substituted as a party to the proceeding, *see* TBMP § 512.01, any registration issued from the application may issue in the name of the assignor unless the assignee complies with the requirements of 37 CFR § 3.85. Specifically, to ensure that the registration will issue in its name, the assignee must file a written request in the application (or in the Board proceeding, if that proceeding has not yet ended), by the time the application is being prepared for issuance of the certificate of registration that the registration be issued in its name. [Note 1.] In addition, an appropriate document must be of record in the Assignment Recordation Branch of the USPTO, or the written request must state that the document has been filed for recordation. Finally, the address of the assignee must be made of record in the application file.

Similarly, even though the title of an inter partes proceeding before the Board may have been changed to reflect a name change of an applicant whose application is the subject of the proceeding, any registration issued from the application may issue in the applicant's original name unless the applicant complies with the requirements of 37 CFR § 3.85. [Note 2.] If an assignment or change of name document is recorded in the Assignment Recordation Branch well prior to the time the subject application is prepared for issuance of a registration, the registration may issue in the name of the assignee, or in the new name, even if no 37

CFR § 3.85 request is filed. However, the registration may issue in the name of the assignor or in the old name. The purpose of the written request is to call the attention of the USPTO to the assignment or change of name and thus to ensure that the registration issues in the name of the assignee or in the new name. Accordingly, it is sufficient for the purpose if applicant files a paper referring to the assignment or change of name and the assignment or change of name document has either been recorded, or applicant states that the document has been submitted for recording. [Note 3.]

Please Note: Trademark Act § 10, 15 U.S.C. § 1060, and part 3 of **37 CFR** are not applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications and registrations. [Note 4.] Except in limited circumstances [Note 5.], requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau. [Note 6.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. [Note 7.]

NOTES:

1. *Smart Inventions Inc. v. TMB Products LLC*, 81 USPQ2d 1383, 1384 n.3 (TTAB 2006) (new owner can help ensure issuance of registration in its name by recording assignment in USPTO and filing request that registration issue in new owner's name).

2. *See Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1134 n.1 (TTAB 1992).

3. *See* 37 CFR § 2.171 for procedures to receive a new certificate of registration on change of ownership or when ownership with respect to some, but not all, of the goods and/or services has changed.

4. *See* 37 CFR § 7.22 *et seq.* for information on recording changes to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations.

5. *See* 37 CFR § 7.23; 37 CFR § 7.24.

6. *See* Trademark Act § 72, 15 U.S.C. § 1141l; 37 CFR § 7.22, TMEP § 501.07, and TMEP § 1904.06.

7. *See* TMEP § 501.07 and TMEP § 1904.06.

512.04 Misidentification

Fed. R. Civ. P. 15(a) Amendments Before Trial.

(1) ***Amending as Matter of Course.*** *A party may amend its pleading once as a matter of course within: (A) 21 days after serving it, or (B) if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule. 12(b), (e), or (f), whichever is earlier.*

(2) ***Other Amendments.*** *In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.*

15 U.S.C. § 1063(a) … *An opposition may be amended under such conditions as may be prescribed by the Director.*

When the plaintiff in a Board inter partes proceeding misidentifies itself or the mark or registration upon which it relies in the complaint, if the plaintiff can establish to the Board's satisfaction that this misidentification was merely a non-substantive mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest. [Note 1.] *See* TBMP § 303.05(c) (Misidentification of Opposer).

When the plaintiff in a Board inter partes proceeding misidentifies an application or registration number that is the subject of the Board proceeding, and the plaintiff can establish, in a timely manner and to the Board's satisfaction that this misidentification was a non-substantive mistake, the Board may allow amendment of the complaint (and of the Board proceeding title) to correct the misidentification of the subject application or registration. [Note 2.] However, if a notice of opposition misidentifies the application number(s) against which the opposition is intended, and the defect is not corrected within the time for filing an opposition against the intended application(s) under Trademark Act § 13(a), 15 U.S.C. § 1063(a), this defect cannot be cured. The opposition against the misidentified application will be dismissed and an opposition against the intended application will not be instituted because it would be untimely. [Note 3.] *See also* TBMP § 306.04. Similarly, if a petition to cancel misidentifies the registration number against which the cancellation is intended, and the defect is not corrected within the time for petitioning to cancel the intended registration under Trademark Act § 14, 15 U.S.C. § 1064, this defect cannot be cured. The petition to cancel the misidentified registration will be denied and a petition to cancel the intended registration will not be instituted because it would be untimely.

An applicant may correct a defect in identifying itself by name or legal entity in the application where it is a single, continuing commercial entity and was the owner of the mark as of the filing date of the application and that entity in fact filed the application. [Note 4.] Also, where a merger occurred prior to filing an application, but the pre-merger corporation and owner of the mark has ceased to exist and is identified as the applicant, the corporation that remains after the merger may correct this defect by identifying itself as applicant. [Note 5.]

NOTES:

1. *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.* , 225 USPQ 956, 957 n.3 (TTAB 1985) (deeming pleadings amended to recite opposer's correct name; *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap* , 184 USPQ 505, 505-06 (TTAB 1974) (amendment granted to reflect proper party in interest); *Lone Star Manufacturing Co. v. Bill Beasley, Inc.* , 176 USPQ 426, 426 (TTAB 1972) (amendment granted to correct corporate title), *rev'd on other grounds* , 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Davidson v. Instantype, Inc.* , 165 USPQ 269, 270-71 (TTAB 1970) (amendment granted to substitute proper party in interest); *Pyco, Inc. v. Pico Corp.* , 165 USPQ 221, 221-22 (TTAB 1969) (amendment granted to substitute real party in interest; *Raker Paint Factory v. United Lacquer Manufacturing Corp.* , 141 USPQ 407, 408-09 (TTAB 1964) (amendment granted to substitute proper party; *Textron, Inc. v. Gillette Co.* , 177 USPQ 530, 531-32 (Comm'r 1973) (name of party in interest may be corrected by amendment. *Cf.* 37 CFR § 2.102(b); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1076-77 (TTAB 1993) (amendment to correct misidentification and substitute proper party in interest not permitted).

2. *See Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ 1443, 1445-46 (TTAB 1996) (applicant's misidentification of itself as a corporation was harmless mistake); *Argo & Co. v. Springer*, 198 USPQ 626, 635 (TTAB 1978) (Board allowed substitution of three individuals for a legally defective corporate applicant finding no mistake as to the true owner of the mark but rather only a mistake as to legal form or identity of that owner); *Argo & Co. v. Springer, et al.*, 189 USPQ 581, 582 (TTAB 1976); *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" was correctable mistake). *Cf.* TMEP § 803.06, TMEP § 1201.02(b), and TMEP § 1201.02(c); *Huang v. Tzu Wei Chen Food*

Co., 849 F.2d 1458, 7 USPQ2d 1335, 1335-36 (Fed. Cir. 1988) (application filed by individual void where owner was corporation, even though individual was affiliated with corporation).

Compare to the following ex parte decisions involving mistakes as to applications and renewals, *e.g.*, *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690-91 (TTAB 1991) (correction of application not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078, 1078 (Comm'r 1990)(correction of declaration under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§ 1058 & 1065); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 619-20 (TTAB 1982); *In re Eucryl Ltd.*, 193 USPQ 377, 378 (TTAB 1976).

3. *Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004).

4. *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1444-45 (TTAB 1996) (corporation formed by merger of four separate companies which did not survive the merger, was proper person to file even if corporation did not exist at time of filing). *Cf. Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1240 (TTAB 2007) (application void ab initio where two separate commercial entities were in existence on application filing date and application was filed in name of wrong entity).

5. *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1444-45 (TTAB 1996).

513 Motion to Withdraw as Representative; Petition to Disqualify

513.01 Motion to Withdraw as Representative

37 CFR § 2.19(b) ***Withdrawal of Attorney.*** *If the requirements of § 11.116 of this chapter are met, a practitioner authorized to represent an applicant, registrant or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. ...*

37 CFR § 11.116 ***Declining or terminating representation.***

(a) *Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:*

(1) *The representation will result in violation of the USPTO Rules of Professional Conduct or other law;*

(2) *The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or*

(3) *The practitioner is discharged.*

(b) *Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:*

(1) *Withdrawal can be accomplished without material adverse effect on the interests of the client;*

(2) *The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;*

(3) *The client has used the practitioner's services to perpetrate a crime or fraud;*

(4) *A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;*

(5) *The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;*

(6) *The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or*

(7) *Other good cause for withdrawal exists.*

(c) *A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.*

(d) *Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.*

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR § 11.116(a) and 37 CFR § 11.116(b).

Moreover, the practitioner must comply with the requirements of 37 CFR § 11.116(c) and 37 CFR § 11.116(d). [Note 1.] In accordance with that rule, a request for permission to withdraw should include: (1) a specification of the basis for the request; (2) a statement that the practitioner has notified the client of his or her desire to withdraw from employment, and has allowed time for employment of another practitioner; (3) a statement that all papers and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (4) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded, or, if appropriate a statement that no fees have been paid in advance and not refunded; and (5) proof of service of the request upon the client itself and upon every other party to the proceeding. [Note 2.] The facts establishing these elements should be set out in detail. [Note 3.] Moreover, a request to withdraw from representation may not be used as a subterfuge to obtain an extension or reopening of time that a party would not otherwise be entitled to. [Note 4.]

If the request to withdraw is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it desires to represent itself. If the party fails to take such action, the Board may issue an order to show cause why default judgment should not be entered against the party based on the party's apparent loss of interest in the case. [Note 5.]

A request for permission to withdraw as counsel in an application that is the subject of a potential opposition (i.e., an application as to which a request for extension of time to file an opposition is pending) is determined by the Board, not the Trademark Operation, and it should be filed with the Board to insure prompt processing. *See* TBMP § 212.01.

A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance in the party's behalf in the proceeding. *See* TBMP § 114.03. *See also* TBMP § 114.04.

For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP § 510.03(b). For further information concerning withdrawal of counsel, see TBMP § 116.02, TBMP § 116.03, TBMP § 116.04, and TBMP § 116.05. *Cf.* TMEP § 607.

Effective May 3, 2013, the United States Patent and Trademark Office adopted new USPTO Rules of Professional Conduct that are based on the American Bar Association's Model Rules of Professional Conduct. Prior to this date, the requirements for withdrawing as an attorney were set forth in 37 CFR § 10.40. They are now set forth in 37 CFR § 11.116. Cases decided prior to May 3, 2013 refer to the USPTO Rules of Professional Responsibility that were in effect at that time. These earlier cases continue to be instructive.

NOTES:

1. *See* 37 CFR § 2.19(b) and 37 CFR § 11.116; *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 (TTAB 2008) (request to withdraw granted); *SFW Licensing Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372, 1373-74 (TTAB 2001) (request to withdraw denied as prejudicial to client where it was filed on last day of client's testimony period, although grounds for withdrawal were known months earlier).

Cf. In re Slack , 54 USPQ2d 1504, 1507 (Comm'r 2000) (request to withdraw during ex parte prosecution granted where requirements of 37 CFR § 10.40 [removed and replaced with 37 CFR § 11.116] were satisfied and attorney filed the request within a reasonable time after notifying applicant of his intent to withdraw).

2. 37 CFR § 11.116. *Cf.* TMEP §607 (Withdrawal of Attorney of Record [during ex parte examination]).

3. *See* 37 CFR § 2.127(a) (motions must contain a "full statement of the grounds"). *Cf. SFW Licensing Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372, 1373-74 (TTAB 2001).

4. *Cf. SFW Licensing Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372, 1373-74 (TTAB 2001).

5. *See University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468-69 (TTAB 2008) (request to withdraw as counsel granted, proceedings suspended, and party allowed time to either appoint new counsel or file submission stating it will represent itself); *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302-03 (TTAB 1999) (motion to set aside judgment denied since opposer is as equally accountable as attorney who failed to withdraw from case for lack of attention to case); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1224-25 (TTAB 1993) (discharging order to show cause that issued for loss of interest after withdrawal of counsel).

513.02 Petition to Disqualify

37 CFR § 11.19(c) *Petitions to disqualify a practitioner in ex parte or inter partes matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.*

If a party to an inter partes proceeding before the Board believes that a practitioner representing another party to the proceeding should be disqualified (due, for example, to a conflict of interest, or because the practitioner should testify in the proceeding as a witness on behalf of his client), the party may file a petition to disqualify the practitioner. [Note 1.]

Petitions to disqualify are not disciplinary proceedings and hence are not governed by 37 CFR § 11.19–37 CFR § 11.60. Rather, petitions to disqualify are governed by 37 CFR § 11.19(c) and are determined in the manner specified in that rule.

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition. After the petition has been determined or dismissed, the Board issues an action resuming proceedings in the case and taking further appropriate action therein. Petitions to disqualify in matters before the Board are currently determined by the Chief Administrative Trademark Judge under authority delegated by the Director. The Chief Administrative Trademark Judge may further delegate his/her responsibility to a Board judge or Board attorney for signature.

For examples of cases involving petitions to disqualify, see the decisions cited in TBMP § 114.08.

NOTES:

1. With respect to disqualification where the attorney is a witness in the case, such as giving testimony on behalf of the client, *see* 37 CFR § 11.307; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992); *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ 2d 1663, 1663 nn.4-5 (TTAB 1988) (generally not prudent for an attorney to verify answers to interrogatories since it could expose him or her to additional discovery and even disqualification); *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989) petition to disqualify counsel on basis that counsel would be called as adverse witness denied. *Cf. In re Gray*, 3 USPQ2d 1558, 1560 (TTAB 1987) (no weight given to counsel's affidavit concerning secondary meaning because it would impermissibly make him a witness in the case).

514 Motion to Amend Application or Registration

37 CFR § 2.133 ***Amendment of application or registration during proceedings.***

(a) *An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board.*

(b) *If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the application or registration, the Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party.*

(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

(d) *A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.*

514.01 In General

The amendment of any application or registration that is the subject of an inter partes proceeding before the Board is governed by 37 CFR § 2.133. Thus, an application that is the subject of a Board inter partes

proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. [Note 1.] An unconsented motion to amend in substance is generally deferred until final decision or until the case is decided upon summary judgment. [Note 2.] However, if the proposed amendment limits the identification of goods or services and the applicant consents to the entry of judgment on the grounds for opposition with respect to the broader identification, it may be approved, even where an opposer objects. [Note 3.]

A registration that is the subject of a Board inter partes proceeding may not be amended or the mark disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. [Note 4.] Additionally, under 37 CFR § 2.173(b), a request to amend an involved registration must (a) include the fee required by 37 CFR § 2.6(a)(11), (b) be verified and signed in accordance with 37 CFR § 2.193(e)(6); and (c) if the amendment involves a change of the mark, the request must include (1) one new specimen per class showing the mark as used on or in connection with the goods, services, or collective membership organization, (2) a verified statement that the specimen was in use in commerce at least as early as the filing date of the amendment, and (3) a new drawing of the amended mark.

For information regarding amendments to applications that are subject to a pending request for an extension of time to oppose, *see* TBMP § 212. For information concerning amendments to delete one or more classes from a multiple-class application or registration subject to an inter partes proceeding, see TBMP § 602.01.

The Board recommends submission of a red-lined copy of the proposed amendment clearly showing the proposed changes followed by a clean copy of the proposed amendment. Such a submission will assist Board personnel in determination and, should the motion be granted, entry of the amendment.

A proposed amendment to any application or registration that is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions. [Note 6.] These include 37 CFR § 2.71-37 CFR § 2.75, in the case of a proposed amendment to an application; 37 CFR § 2.173 and Trademark Act § 7(e), 15 U.S.C. § 1057(e), in the case of a proposed amendment to a registration. Thus, for example, a proposed amendment that involves an addition to the identification of goods or services, or that materially alters the character of the subject mark, will not be approved by the Board. However, an otherwise appropriate amendment to an application will ordinarily not be rejected by the Board solely on the basis that the amendment would require republication of the mark. [Note 7.] Republication may not be available for applications filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) due to the time requirements of the Madrid Protocol. [Note 8.]

A proposed amendment to an intent-to-use application involved in an opposition to seek registration on the Supplemental Register cannot be entertained by the Board until a statement of use has been filed and approved. *See* TMEP § 1102.03. Because a notice of allowance will not issue unless and until the opposition is dismissed, a statement of use filed during the pendency of an opposition will be rejected as premature. If the parties agree that such an amendment would resolve the issues in the opposition, they may file a consented motion to dismiss the opposition without prejudice, and applicant may file a use-based application on the Supplemental Register. *See* TBMP § 219.

A request to amend an application or registration that is the subject of a Board inter partes proceeding should bear at its top both the number of the subject application or registration, and the Board proceeding number and title. In addition, the request should include proof of service of a copy thereof upon every other party to the proceeding. [Note 9.] *See* TBMP § 113. A request to amend an application involved in a Board proceeding must be filed with the Board, not with the Trademark Operation. Similarly, a request to amend a registration involved in a Board proceeding must be filed with the Board, not with the Post Registration

Section or, in the case of a § 66(a) registration when only the registration extension of protection to the United States is to be amended, not with the International Bureau. Failure to file such a request with the Board will result in unnecessary delay and may result in the loss or misplacement of the amendment request. The Board will act on the amendment and, if appropriate, enter it into the application or registration file and into the record for the Board proceeding. [Note 10.]

Occasionally WIPO will inform the USPTO that the international registration forming the basis of a § 66(a) application or registration is amended during a proceeding. This can happen for a number of reasons, including corrections, restriction of the basic application in the country of origin (either by voluntary amendment or by a "central attack"), or by voluntary amendment of the extension filed with WIPO. The circumstances under which an amendment, or request to amend, a § 66(a) application or registration arise will dictate whether the amendment must or may be entered and whether the Board has discretion to disallow or defer that amendment until final decision or until the case is decided upon summary judgment. For example, WIPO controls the classification, which can only be amended upon receipt of correction from the International Bureau. [Note 11.] Similarly, cancellation in part of the goods and services of an international registration due to the ceasing of effect of the basic registration must be entered. [Note 12.] However, if the holder of an international registration voluntarily limits its list of goods and services, and such limitation affects the extension of protection to the United States, the USPTO may declare that the limitation has no effect. [Note 13.] Similarly, if the proposed amendment affects only the extension of protection to the United States, the proposed amendment may be considered. [Note 14.] Where the Board is not able to act on a proposed amendment, or defer the proposed amendment until final decision or until the case is decided upon summary judgment, as appropriate, the Board will issue an order requiring the defendant to show cause why the Board should not enter judgment as to any goods that were deleted by the amendment and then ask the plaintiff whether it wants to continue with the proceeding. [Note 15.] For a further discussion involving deletions of goods and services in § 66(a) registrations, see TBMP § 602.02(a). For a further discussion involving amendments to § 66(a) applications and registrations, see TMEP § 1904.02(c), TMEP § 1904.02(e), TMEP § 1904.02(j), TMEP § 1904.13, TMEP § 1904.14, and TMEP § 1904.15.

When the Board grants a request to amend a registration that is the subject of a Board inter partes proceeding, the file is forwarded to the Post Registration Section of the Office for entry of the amendment of the registration. The action by the Post Registration Section is limited to the ministerial duty of ensuring that the authorized change to the registration is made. [Note 14.]

NOTES:

1. *See, e.g., Gallagher's Restaurants, Inc. v. Gallagher's Farms, Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (amendment to named excepted users in a concurrent use application); *Giant Food Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 631 (TTAB 1986) (amendment to identification of goods); *Greyhound Corp. and Armour and Co. v. Armour Life Insurance Co.*, 214 USPQ 473, 475 (TTAB 1982) (amendment to dates of use).

2. *See Zachry Infrastructure LLC v. American Infrastructure, Inc.*, 101 USPQ2d 1249, 1255-56 (TTAB 2011) (unconsented motion to amend to Supplemental Register deferred until summary judgment or final hearing); *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (motion to amend dates of use deferred); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same).

3. *Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (approving applicant's motion to amend identifications where applicant consented to judgment and amendments served to change the nature and character of the goods so as to introduce a substantially different issue for trial); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (approving applicant's motion to amend the identification of goods in its application and accepting applicant's consent to judgment with respect to the broader identification of goods, entering judgment as to broader identification of goods); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (proposed amendment not approved because applicant did not consent to entry of judgment as to the broader recitation of services; in addition, specimens of record must support the amended identification of goods, and the applicant must introduce evidence during its testimony period to use of its mark on the amended goods or services prior to the relevant date determined by the basis of the application); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 963-64 (TTAB 1986) (discussing Board's adoption of practice of permitting limiting amendments to the identification of goods and/or services made prior to trial even when opposer objects if applicant consents to judgment on the question of likelihood of confusion between the parties' marks and the broader identification of goods).

4. *See* Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 CFR § 2.173.

5. *See* 37 CFR § 2.74(a)

6. *See* Trademark Act §7(e), 15 U.S.C. § 1057(e); 37 CFR § 2.71; 37 CFR § 2.72; 37 CFR § 2.173; *Couture v. Playdom, Inc.*, 113 USPQ2d 2042, 2044 (Fed. Cir. 2015) (amendment to substitute basis under 37 CFR § 2.35(b) contemplates substitution of basis during the pendency of the application, not after registration; no error in denial of amendment); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435-36 (TTAB 2007) (amendment to identification not supported by specimens of use); *Vaughn Russell Candy Co. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635, 1636 (TTAB 1998) (material alteration); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1749 (TTAB 1992) (summary judgment granted in part), 26 USPQ2d 1926, 1930 (TTAB 1993) (expansion of scope of goods); *Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration).

7. *See* TMEP § 1505.03(a) (When Republication Is Required) and TMEP § 1505.03(b) (When Republication Is Not Required).

8. *See* Trademark Act § 68, 15 U.S.C. § 1141h and Trademark Act §69, 15 U.S.C. § 1141i.

9. 37 CFR § 2.119(a); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (an unconsented motion to amend an application should be made prior to trial, in order to give the other party fair notice thereof.)

10. *See Hachette Filipacchi Presse v. Elle Belle LLC*, 85 USPQ2d 1090, 1095 (TTAB 2007) (Board has jurisdiction to determine propriety of amendment; subsequent attempt by registrant to delete goods on which mark has never been used through the Post Registration Section Branch is irrelevant); *In re Pamex Foods, Inc.*, 209 USPQ 275, 277 (Comm'r 1980) (Trademark Examining Operation acted beyond its authority in denying amendment to registration which Board had already approved).

11. 37 CFR § 2.85(d), TMEP § 1402.03(d); and TMEP § 1904.03(b).

12. *See* TMEP § 1904.03(g) and TMEP § 1904.15.

13. *See* TMEP § 1904.03(g) and TMEP § 1904.15.

14. *See* TMEP § 1904.02(c), TMEP § 1904.02(e) and TMEP § 1904.13(a).

15. *Cf.* 37 CFR § 2.134(b).

16. *See* 37 CFR § 7.22.

514.02 Amendment With Consent

When a request to amend an application or registration that is the subject of a Board inter partes proceeding is made with the consent of the other party or parties, and the proposed amendment is in accordance with the applicable rules and statutory provisions, the request ordinarily will be approved by the Board. However, if the application or registration is the subject of other inter partes proceedings, the consent of the other parties in each of those other proceedings must be of record before the amendment may be approved. [Note 1.]

When a consented motion to amend the application or registration that is the subject of a Board inter partes proceeding is filed in lieu of an answer, the parties should not file a subsequent scheduling motion until the Board determines the motion to amend. In such a situation, when a consented motion to amend is pending, the Board will not issue a notice of default. [Note 2.]

NOTES:

1. *See Vaughn Russell Candy Co. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635, 1636 (TTAB 1998) (proposed amendment not approved when no consent from opposers in two other oppositions against the application). *See also New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1550-51 (TTAB 2011) (where one application subject to multiple, unrelated oppositions, any amendment to opposed application would have to be made with the consent of all opposers).

2. *Cf.* TBMP § 312.01.

514.03 Amendment Without Consent

The Board, in its discretion, may grant a motion to amend an application or registration that is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto. [Note 1.]

When a motion to amend an application or registration in substance is made without the consent of the other party or parties, it ordinarily should be made prior to trial, in order to give the other party or parties fair notice thereof. An unconsented motion to amend that is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b). [Note 2.] *Cf.* TBMP § 314 (Unpleaded Matters), and TBMP § 507 (Motion to Amend Pleading).

The Board generally will defer determination of a timely filed (i.e., pretrial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment. [Note 3.]

If a defendant, whose application or registration is the subject of a Board inter partes proceeding, wishes to defend by asserting that it is at least entitled to a registration with a particular restriction, the defense should

be raised either in the defendant's answer to the complaint, or by way of a timely motion to amend the application or registration to include the restriction. [Note 4.] A request by a defendant to restrict its identification of goods or services under Trademark Act § 18, 15 U.S.C. § 1068 may be made by way of a motion under 37 CFR § 2.133 or raised as an affirmative defense in the answer (as originally filed, as amended, or as deemed amended) by alleging that the restriction will avoid a likelihood of confusion, and alleging that plaintiff is not using the mark on the products or services being excluded from the registration. [Note 5.] *See* TBMP § 311.02(b). The proposed restriction should be described in sufficient detail to give the plaintiff fair notice thereof. [Note 6.] *See* TBMP § 311.02(b).

If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction that was timely proposed by the defendant, the proposed restriction will be approved and entered. [Note 7.] If a further refinement thereof is found necessary by the Board, and is within the scope of the notice given to plaintiff by defendant, or was tried with the express or implied consent of plaintiff, defendant will be allowed time in which to file a request that its application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party. [Note 8.] If, on the other hand, the Board ultimately finds that defendant is entitled to registration even without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered.

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding. [Note 9.] *See* TBMP § 1101.02. Moreover,Trademark Act § 7, 15 U.S.C. § 1057(e), and 37 CFR § 2.173 cannot be used to impose concurrent use restrictions on registrations. [Note 10.] However, an applicant whose geographically unrestricted use-based application is the subject of an opposition proceeding may file a motion to amend its application to one for a concurrent use registration, with the opposer being recited as the exception to the applicant's right to exclusive use. If the proposed amendment is otherwise appropriate, and is made with the consent of the opposer, the opposition will be dismissed without prejudice in favor of a concurrent use proceeding. If the opposer does not consent to the amendment, the amendment may nevertheless be approved and entered, and a concurrent use proceeding instituted, provided that applicant agrees to accept entry of judgment against itself in the opposition with respect to its request for a geographically unrestricted registration. [Note 11.] *See* TBMP § 1113.

An amendment that is actually a correction is to be submitted to the Board for an application or registration that is the subject matter of an inter partes proceeding. The proposed amendment must meet the standards for a correctable mistake. The consent of the adverse party is not required. Ordinarily an amendment seeking to correct a mistake addresses errors in how the applicant or registrant is identified. [Note 12.]

NOTES:

1. 37 CFR § 2.133(a). *See Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (noting principle that an acceptable amendment to the identification may be permitted despite opposer's objection if amendment limits identification and applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification). *See also, e.g., Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (applicant consented to judgment on the grounds for opposition with respect to the broader identifications of goods); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (applicant willing to accept judgment with respect to broader identification of goods); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993) (where applicant consented to entry of judgment against itself with respect to a geographically unrestricted registration).

2. *See, e.g., Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435-36 (TTAB 2007) (amendment denied, specimens did not support proposed amendment and applicant did not consent to judgment; but applicant may file renewed motion with appropriate documentation); *Personnel Data Systems, Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863, 1865 (TTAB 1991) (defendant's motion to restrict identification of goods in involved registration, filed with brief on case, denied); *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320, 321 n.2 (TTAB 1985) (same); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods). *Cf. Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1128 (TTAB 1990) (amendment after trial permitted to allege new defense allowed, but defense rejected on the merits).

3. *See Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1255-56 (TTAB 2011) (unconsented motion to amend to Supplemental Register deferred to summary judgment or final hearing); *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1307 (TTAB 2002) (motion to amend to substitute a basis deferred to final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554-55 (TTAB 1987) (motion to amend dates of use deferred); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same). *But see Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (contested motion to amend granted where applicant consented to judgment on the grounds for opposition with respect to the broader identifications of goods); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (same); *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (same).

4. *See Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392 (TTAB 2016) (applicant's motion to amend to Supplemental Register filed for first time in its main brief on the case deemed untimely where issue was neither raised prior to or during trial nor tried by implied consent).

5. *See* 37 CFR § 2.133(a) and 37 CFR § 2.133(b); *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (ideally, Section 18 affirmative defense should be made in answer to put plaintiff on notice followed by a motion to amend the application or registration); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863, 1864-65 (TTAB 1991) (due to lack of notice to plaintiff, Board would not entertain request to restrict defendant's identification of goods made for first time in trial brief); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972-73 (TTAB 1991) (although applicant filed no motion or amendment to narrow its identification, after granting summary judgment on identification of goods as published, the Board allowed applicant time to file a request to amend identification to accurately reflect goods sold under the mark); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220-21 n.5 (TTAB 1990) (applicant may make a request to restrict goods set forth in its own application by way of affirmative pleading in answer, an amended pleading, or by way of motion).

6. *See Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828-29 (TTAB 2013) (Section 18 affirmative defense, and corresponding motion to amend the application or registration, should be made early to put plaintiff on notice); *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007) (proposed restriction must be stated with precision); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220-21 n.5 (TTAB 1990) (request for relief under Section 18 may be made by way of an affirmative pleading or by motion). *See also Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972-73 (TTAB

1991) (Board allowed applicant time to amend identification to restrict goods after entry of summary judgment on original identification).

7. *See Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1841 (TTAB 2013) (Section 18 defense raised in alternative is relevant, motion to amend involved applications is granted, oppositions are dismissed). *But see Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1031 n.152 (TTAB 2015) (applicant not allowed time to amend application where no specific restriction was suggested or tried by any party), *aff'd*, 652 F. App'x 971 (mem.) (Fed. Cir. 2016)

Please Note: Except in limited circumstances, requests to record changes to a Trademark Act § 66(a) registration must be filed with the International Bureau. *See* 37 CFR § 7.22. *See also* TMEP § 1904.06 andTMEP § 1904.13.

8. *See* 37 CFR § 2.133(b). *See also*, Trademark Act § 18, 15 U.S.C. § 1068.

9. *See* 37 CFR § 2.133(c); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) (counterclaim for partial cancellation by limiting geographic area denied); *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1815 (TTAB 1990) (allegations of abandonment in a particular geographic location constitute an insufficient pleading).

10. *See In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984) (petition to Commissioner to territorially restrict a registration denied); and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987).

11. *See Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 919-20 (TTAB 1983).

12. *See, e.g.*, TMEP §1201.02(c) (Correcting Erroes in How the Applicant is Identifiedl) and TMEP §1609.10 (Correction to Mistake in Registration).

514.04 Amendment to Allege Use; Statement of Use

For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application that is the subject of the opposition, see TBMP § 219.

515 Motion to Remand Application to Examining Attorney

37 CFR § 2.130 ***New matter suggested by the trademark examining attorney.*** *If, while an inter partes proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the examining attorney, render the mark in the application unregistrable, the examining attorney should request that the Board remand the application. The Board may suspend the proceeding and remand the application to the trademark examining attorney for an ex parte determination of the question of registrability. A copy of the trademark examining attorney's final action will be furnished to the parties to the inter partes proceeding following the final determination of registrability by the trademark examining attorney or the Board on appeal. The Board will consider the application for such further inter partes action as may be appropriate.*

37 CFR § 2.131 ***Remand after decision in inter partes proceeding.*** *If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they*

might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in the light of the matter referenced by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

If, during the pendency of an opposition, concurrent use, or interference proceeding involving an application under Trademark Act § 1, 15 U.S.C. § 1051 or Trademark Act § 44, 15 U.S.C. § 1126, the examining attorney learns of facts that, in his or her opinion, render the mark of the involved application unregistrable, the examining attorney may file a request that the Board suspend the inter partes proceeding and remand the application to the examining attorney for further ex parte examination. [Note 1.] An application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not be remanded under 37 CFR § 2.130 or 37 CFR § 2.131. [Note 2.]

There is no provision under which such a remand may be made upon motion by a party to the proceeding. Moreover, a request to amend an application that is the subject of an inter partes proceeding before the Board is not remanded to the examining attorney for consideration, but rather is considered and determined by the Board. [Note 3.] *See* TBMP § 514.

However, if, during the course of an opposition, concurrent use, or interference proceeding, involving an application under Trademark Act § 1, 15 U.S.C. § 1051 or Trademark Act § 44, 15 U.S.C. § 1126, facts are disclosed that appear to render the mark of the involved application unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to Fed. R. Civ. P. 15(b), the Board, in its decision in the proceeding, will, in addition to determining the pleaded matters, include a statement that in the event applicant ultimately prevails in the inter partes proceeding, the examining attorney shall reexamine the application in light of the disclosed facts. [Note 4.] A 37 CFR § 2.131 remand may be made by the Board upon its own initiative, or upon request granted by the Board. Thus, if a party to the proceeding believes that the facts disclosed therein appear to render the mark of an involved application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR § 2.131 remand to the examining attorney. The request may be made in the party's brief on the case, at oral hearing, or by separate motion. An application under § 66(a) may not be remanded under 37 CFR § 2.130 or 37 CFR § 2.131. [Note 5.]

NOTES:

1. 37 CFR § 2.130.

2. *See* 37 CFR § 2.130 and 37 CFR § 7.25 (Sections of part 2 applicable to extension of protection).

3. *See generally* 37 CFR § 2.133(a).

4. *See, e.g.,* 37 CFR § 2.131; *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1636 n.6 (TTAB 1988) (remand for consideration of evidence regarding applicant's date of first use); *West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1309 n.5 (TTAB 1987) (remand for determination of status of underlying foreign registration); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 686 n.10 (TTAB 1984) (remand for consideration of evidence regarding applicant's use of mark prior to application filing date); *Wilderness Group, Inc. v. Western Recreational*

Vehicles, Inc., 222 USPQ 1012, 1014-15 n.6 (TTAB 1984) (if applicant ultimately prevails, Board recommends that registration be withheld pending reexamination for clarification as to whether applicant has abandoned the mark as to certain goods as well as deletion from the identification of any goods for which applicant has non-use); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936, 941, 944-45 n.11 (TTAB 1983) (if applicant ultimately prevails, registration should be deferred pending reexamination of the application under Trademark Rule 2.131); *Antillian Cigar Corp. v. Benedit Cigar Corp.*, 218 USPQ 187, 189 n.2 (TTAB 1983) (if applicant ultimately prevails, Board recommends registration be withheld pending reexamination of Section 2(a) ground for refusal).

5. *See* 37 CFR § 7.25.

516 Motion to Divide Application or Registration

An application that is the subject of an inter partes proceeding before the Board may be divided into two or more separate applications upon motion granted by the Board, and payment of the required fee. [Note 1.]

For example, if an application that is the subject of an opposition includes multiple classes, not all of which have been opposed, the applicant may file a motion to divide out the unopposed classes. If applicant seeks to divide out an entire class or classes, a fee for dividing the application must be submitted for each new application to be created by the division. [Note 2.]

Similarly, if an application which is the subject of an opposition includes more than one item of goods, or more than one service, in a single class, and the opposition is not directed to all of the goods or services, the applicant may file a motion to divide out the unopposed goods or services. [Note 3.] Applicant must submit both a fee for dividing the application, and an application filing fee, for each new application to be created by the division. [Note 4.]

In both cases, when the motion to divide is granted, notification is sent to the USPTO's ITU/Divisional Unit for processing of the divisional request. After the applications have been divided, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Trademark Act § 1(b), 15 U.S.C. § 1051(b), for issuance of a notice of allowance. The Board will be notified when division of the original application containing the opposed classes has occurred, and the original application will remain the subject of the opposition proceeding. [Note 5.]

Any request to divide an application that is the subject of a Board inter partes proceeding will be construed by the Board as a motion to divide, and every other party to the proceeding will be allowed an opportunity to file a brief in opposition thereto. Nonetheless, the circumstances under which the Board will deny a request to divide are extremely rare.

A registration that is the subject of an inter partes proceeding before the Board may be divided into two or more separate registrations upon motion granted by the Board, and payment of the required fee, when ownership has changed with respect to some, but not all, of the goods and/or services. [Note 6.]

For further information concerning division of an application, see TMEP § 1110.

NOTES:

1. 37 CFR § 2.87. *Cf. In re Little Caesar Enterprises Inc.*, 48 USPQ2d 1222 (Comm'r 1998) (regarding request to divide filed during pendency of request to extend time to oppose but prior to commencement of opposition).

2. *See* 37 CFR § 2.87(a) and 37 CFR § 2.87(b).

3. *Cf. Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1547, n.3 (TTAB 2011) (if applicant believes opposer's objection to registration is limited to some, but not all, of the goods in a single class, applicant could avail itself of the divisional procedure to avoid the opposition being sustained against the entire class, should opposer prevail).

4. *See* 37 CFR § 2.87(a) and 37 CFR § 2.87(b).

5. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 n.10 (TTAB 2007).

6. 37 CFR § 2.171(b).

517 Motion to Strike Brief on Motion

Specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion, a brief in opposition to a motion, and a reply brief in further support of the motion. No further papers will be considered regarding the motion. [Note 1.] *See* TBMP § 502.02(b).

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief any argument it feels will be to its advantage. Accordingly, when a moving brief, an opposition brief, or a reply brief on a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof. Rather, any objections that an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the original motion, and any portions of the brief that are found by the Board to be improper will be disregarded. When filing trial briefs pursuant to 37 CFR § 2.128, a party has the option of making evidentiary objections in a main brief or in a separate statement, as may be done in a responsive brief. The Board will not strike an entire brief based on evidentiary objections. [Note 2.] *See* TBMP § 801.

If a brief in opposition to a motion, or a reply brief in support of the motion, is not timely filed, it may be stricken, or given no consideration, by the Board. [Note 3.] Whether the Board decides to grant a motion as conceded or consider the motion on its merits is a matter of discretion. [Note 4.] Surreply briefs will be given no consideration by the Board. [Note 5.] Accordingly, it is not necessary (and the Board discourages) the filing of a motion to strike a surreply brief or any other briefs beyond a reply brief filed on a motion, since such papers will not be considered whether or not a motion to strike is filed. Furthermore, the Board may sua sponte strike or give no consideration to any briefs on a motion that exceed the page limit set forth in 37 CFR § 2.127. [Note 6.] *See* TBMP § 502.02(b).

NOTES:

1. *See* 37 CFR § 2.127(a).

2. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753-54 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.) (denying motion to strike trial brief based on appendix being "a subterfuge to avoid page limit;" appendix was devoted solely to evidentiary objections); *Corporacion Habanos S.A. v. Guantanamera Cigars*, 86 USPQ2d 1473, 1474 (TTAB 2008) (motion to strike reply brief that included a separate statement of evidentiary objections denied as party has option of making evidentiary objections in a separate statement).

3. *See, e.g., Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 620 (TTAB 1986).

4. *See, e.g., DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1947 n.3 (TTAB 2008) (late opposition brief considered where motion raised claim and issue preclusion, distinguishing other cases in which briefs are not considered due to tardiness); *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 620 (TTAB 1986).

5. *See* 37 CFR § 2.127(a).

6. *See* 37 CFR § 2.127(a) (opposition briefs limited to 25 pages, reply briefs to 10 pages). *See also Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478 (TTAB 2008); *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220, 1222 (TTAB 2003).

518 Motion for Reconsideration of Decision on Motion

37 CFR § 2.127(b) *Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within twenty days from the date of the service of the request.*

A request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date of the order or decision. [Note 1.] Unless the Director, upon petition, waives the time requirement of 37 CFR § 2.127(b), the Board need not consider a request for reconsideration or modification filed more than one month from the date of the order or decision complained of. [Note 2.] Nor does the rule contemplate a second request for reconsideration of the same basic issue. [Note 3.] However, the Board may, on its own initiative, reconsider and modify one of its orders or decisions if it finds error therein, and the Board may also, in its discretion, consider an untimely request for reconsideration or modification. [Note 4.]

Any brief in response to a request for reconsideration or modification of an order or decision issued on a motion must be filed within 20 days from the date of service of the request. [Note 5.]

When a party upon which a motion has been served fails to file a brief in response, and the Board grants the motion as conceded pursuant to 37 CFR § 2.127(a), the non-responding party cannot use a request for reconsideration as a second opportunity to file a brief in opposition to the motion. [Note 6.]

Generally, the premise underlying a motion for reconsideration, modification or clarification under 37 CFR § 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not 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. Rather, the motion 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. [Note 7.] *Cf.* TBMP § 543 (Motion for Reconsideration of Final Decision).

An interlocutory motion, request, or other matter that is not actually or potentially dispositive of a proceeding, may be acted upon by a single Board judge, attorney, or paralegal to whom authority so to act has been delegated, or by ESTTA. [Note 8.] *See also* TBMP § 502.04. When one or more parties is dissatisfied with the Board action, they may seek review thereof by requesting reconsideration under 37 CFR § 2.127(b), and/or by filing a petition to the Director for review of the decision under 37 CFR § 2.146(e)(2). *See* TBMP § 905. A request that the action of a single Board judge, or attorney be reviewed by one or more other judges of the Board is improper and will be denied. However, at final hearing, the Board panel to which the case is assigned for decision may review an interlocutory ruling and reverse it, if appropriate. [Note 9.]

NOTES:

1. 37 CFR § 2.127(b). *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

2. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974).

3. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 631 n.11 (TTAB 1986); *Avedis Zildjian Co. v. D.G. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974).

4. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974).

5. *See* 37 CFR § 2.127(b).

6. *See Joy Manufacturing Co. v. Robbins Co.*, 181 USPQ 408, 409 (TTAB 1974). *Cf. General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc.*, 189 USPQ 425, 427 (TTAB 1975).

7. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015) (reconsideration denied because there is no requirement that Board repeat or address irrelevant arguments in entertaining a motion); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (reconsideration denied because Board did not err in considering disputed evidence).

8. *See* 37 CFR § 2.127(c).

9. *See, e.g., AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1832 (TTAB 2013) (reviewing interlocutory ruling striking certain testimonial exhibits, but denying reversal of decision); *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986) (although an interlocutory decision had excluded certain documentary evidence, opposer did not object to its admission by applicant at trial and the Board deemed the evidence as stipulated to by the parties).

519 Motion for Leave to Serve Additional Interrogatories, Requests for Production of Documents, or Requests for Admission

37 CFR § 2.120(d) ***Interrogatories.*** *The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion,*

may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. ...

37 CFR § 2.120(e) ***Requests for production.*** *The total number of requests for production which a party may serve upon another party pursuant to Rule 34 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. ...*

37 CFR § 2.120(i) ***Requests for admission.*** *The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. ...*

A motion under 37 CFR § 2.120(d) for leave to serve additional interrogatories, 37 CFR § 2.120(e)for leave to serve additional requests for production, or 37 CFR § 2.120(i)for leave to serve additional requests for admission must be filed and granted prior to service of the proposed additional interrogatories, requests for production, or requests for admission; and must be accompanied both by a copy of any interrogatories requests for production, or requests for admission which have already been served by the moving party, and by a copy of the interrogatories requests for production, or requests for admission proposed to be served. [Note 1.]

Good cause for the service of additional interrogatories, requests for production, or requests for admission will generally be found only where it is shown that there is a legitimate need for further written discovery. [Note 2.] The mere fact that the additional interrogatories requests for production, or requests for admission may be relevant and narrowly drawn to a single issue, or that they may be easy to answer is insufficient, in and of itself, to show good cause for the service of the additional written discovery. [Note 3.] Given the Board's limited jurisdiction and the generous number of interrogatories, requests for production, or requests for admission provided under the Rules, such motions for leave to serve additional written discovery are disfavored.

For further information concerning good cause for a motion to serve additional interrogatories, requests for production, and requests for admission, see TBMP § 405.03(c), TBMP § 406.05(c) and TBMP § 407.05(c), respectively. For information concerning the interrogatory, document request, and request for admission limits specified in 37 CFR § 2.120(d), 37 CFR § 2.120(e) and 37 CFR § 2.120(i), see TBMP § 405.03, TBMP § 406.045 and TBMP § 407.05.

NOTES:

1. 37 CFR § 2.120(d); 37 CFR § 2.120(f); and 37 CFR § 2.120(i). *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1398 (TTAB 1990); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479, 1480 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990); NOTICE OF FINAL RULEMAKING, 56 Fed. Reg. 46376 (September 12, 1991), as corrected at 56 Fed. Reg. 54917 (October 23, 1991).

2. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1466-67 n.5 (TTAB 1990). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (Oct. 7, 2016) ("[E]xamples that may support a showing of good cause [for additional requests for admission] include cases involving foreign parties from whom oral discovery may be unavailable, or requests intended to narrow the issues in dispute in proceedings involving multiple marks and applications or registrations with lengthy identifications of goods and services.").

3. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1466-67 n.5 (TTAB 1990) (fact that interrogatories are relevant and narrowly drawn to a single issue does not in and of itself demonstrate good cause for additional interrogatories); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1399 (TTAB 1990) (fact that interrogatories are easy to answer does not in and of itself constitute good cause for additional interrogatories); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990) (fact that the interrogatories are relevant to the proceeding does not in and of itself constitute good cause for additional interrogatories).

520 Motion to Take Foreign Deposition Orally

37 CFR § 2.120(c)(1) *The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.*

37 CFR § 2.123(a)(2) *Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness.*

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in 37 CFR § 2.124. [Note 1.] *See also* TBMP § 404.03(b). Moreover, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. [Note 2.] *See* TBMP § 404.03(b).

However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the discovery deposition, when taken in a foreign country, may be taken by oral examination provided that the taking of

said deposition complies with Convention on the Taking of Evidence Abroad in Civil or Commercial Matters ("Hague Convention") if the foreign country is a signatory thereto. *See* TBMP § 404.03(b). The Board will also, upon a showing of good cause, permit the deposition to be taken by telephone pursuant to Fed. R. Civ. P. 30(b)(4) [Note 3.] so long as the deposition complies with the procedures set forth in the Hague Convention and local laws.

The Hague Convention provides two procedures through which parties to a proceeding in one country may obtain evidence from a witness in another: (1) by letter of request (or a letter rogatory) sent to the contracting state's Central Authority (Chapter I of the Hague Convention), or (2) by taking evidence through diplomatic officers and consular agents of the requesting country or through a commissioner appointed by a court of the foreign state where the parties seek the evidence (Chapter II). [Note 4.]

A discovery deposition taken in a foreign country must be taken upon written questions in the manner described in 37 CFR § 2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination, which is to be in compliance with local laws. Trial testimony in a foreign country may be taken either (1) upon written questions in the manner described in 37 CFR § 2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination (which is to be in compliance with local laws), or (2) by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination upon written questions of that witness. [Note 5.]

In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country. [Note 6.] *See* TBMP § 521 (Motion to Quash) and TBMP § 531 (Motion that Deposition Upon Written Questions Be Taken Orally).

NOTES:

1. 37 CFR § 2.120(c)(1).

2. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). *See also Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1391 (4th Cir. 2007) (a district court could issue a subpoena for the deposition of a foreign party in the United States in connection with a Board case).

3. *Hewlett-Packard Co. v. Healthcare Personnel, Inc.*, 21 USPQ2d 1552, 1152-53 (TTAB 1991).

4. *See* 37 CFR § 2.120(c)(1); *Orion Group Inc. v. Orion Ins. Co. P.L.C.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause to take oral deposition of witness in England); and *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (stipulation to take oral deposition in Canada).

5. 37 CFR § 2.123(a)(2). *See Jain v. Ramparts*, 49 USPQ2d 1429, 1431 (TTAB 1998).

6. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (discovery depositions of foreign-resident witnesses may be taken only by way of written questions, unless the parties stipulate otherwise or unless the Board, upon motion for good cause shown, orders that the deposition be taken orally in the foreign country); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause found in view of circumstances and since fares to England were not that much greater than fares within the U.S. and no translation was required). *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990) (applicant would be prejudiced by rebuttal testimonial deposition on

written questions of opposer's survey expert who was present in U.S.), *corrected*, 19 USPQ2d 1479 (TTAB 1990).

521 Motion to Quash Notice of Deposition

A party to an inter partes proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimonial deposition, to quash the notice of deposition. Alternatively, in the case of a notice of discovery deposition and under appropriate circumstances, the party may file a motion for a protective order. *See* TBMP § 410.

A motion to quash may be filed on a variety of grounds. For example, a party may move to quash a notice of deposition on the ground that: (1) the proposed deposition is untimely [Note 1.]; (2) the proposed deposition constitutes harassment or is without proper basis [Note 2.]; (3) in the case of a discovery deposition to be taken in the United States, the deposition is not scheduled to be taken in the federal judicial district where the proposed deponent resides or is regularly employed, or at another place agreed upon by the parties in writing [Note 3.]; (4) in the case of a deposition to be taken in a foreign country, the deposition is scheduled to be taken orally in violation of 37 CFR § 2.120(c) or 37 CFR § 2.123(a)(2) [Note 4.]; (5) the deposing party has noticed depositions for more than one place at the same time, or so nearly at the same time that reasonable opportunity for travel from one place of examination to another is not available [Note 5.]; (6) there was not due (i.e., reasonable) notice in writing of the proposed deposition [Note 6.], *see* TBMP § 404.05 and TBMP § 703.01(e); (7) the taking of the deposition should be deferred until after determination of a certain motion pending before the Board, such as a motion for summary judgment; (8) the deposing party improperly seeks to force a foreign natural person to come to the United States for the taking of his or her deposition [Note 7.], *see* TBMP § 404.03(b); (9) a testimonial deposition scheduled to be taken upon written questions should be taken orally (usually, this motion is titled as a motion that a deposition be taken orally) [Note 8.]; (10) the deposing party's pretrial disclosures are insufficient, untimely or otherwise technically deficient [Note 9.]; or (11) the deposing party seeks to take the testimonial deposition of a witness who was not identified or who was improperly identified in that party's pretrial disclosures. [Note 10.]

However, the Board has no jurisdiction over nonparty depositions, or adverse witness depositions, taken by subpoena, and thus has no authority to quash such subpoenas. [Note 11.] *See* TBMP § 404.03(a)(2) and TBMP § 703.01(f).

A motion to quash a notice of deposition should be filed promptly after the grounds therefor become known to the moving party. In the situation where a party becomes aware that a noticed testimonial deposition is of a party not identified in the pretrial disclosures, the preferred practice is to file a motion to quash rather than a motion to strike the deposition after the testimonial deposition has occurred. When time is of the essence, the moving party should telephone the Board attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call. [Note 12.] The Board has discretion to decide a motion by telephone conference prior to the expiration of the written briefing period for a response and reply. Telephone conference procedures on motions are fully discussed in TBMP § 413 and TBMP § 502.06(a).

NOTES:

1. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (notice for deposition to be taken outside discovery period quashed when served on last day of discovery); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1298 (TTAB 1997) (notice was reasonable and timely; no scheduling conflict with depositions in civil action); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notices of 13 depositions on written questions served eight months after original opening of testimony period, but within ten days of latest extension, were timely);

Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372, 373 (TTAB 1978) (deposition noticed during discovery but scheduled for date after discovery closed was untimely).

2. *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (notice to take deposition of CEO merely to discuss settlement was found baseless); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (written discovery requests directed to assignor need not be answered where assignment occurred prior to institution of proceeding). *Cf. Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1565 (TTAB 2014) (motion to quash deposition of consulting expert noticed without subpoena).

3. *See* 37 CFR § 2.120(b).

4. *See Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373-74 (TTAB 1978).

5. *See* 37 CFR § 2.123(c).

6. *See* 37 CFR § 2.123(c); Fed. R. Civ. P. 30(b) and 31(a); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (six days notice reasonable); *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1695 (TTAB 2007) (two days notice unreasonable; *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (whether notice is reasonable depends upon the circumstances of each case; one and two-day notices were not reasonable without compelling need for such haste, but three-day notice was reasonable).

See also, where objection to notice was raised by other means, *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice unreasonable and failure of opposing counsel to attend was excused); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

7. *Cf. Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430-31 (TTAB 1998) (issue raised by motion to compel). *See also Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1391 (4th Cir. 2007) (a district court could issue a subpoena for the deposition of a foreign party in the U.S. in connection with a Board case).

8. *See* 37 CFR § 2.123(a)(1); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990) (good cause shown for oral deposition), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 590-91 (TTAB 1980) (good cause shown for oral deposition).

9. *See Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242-43 (TTAB 2012) (witness first identified in pretrial disclosure not previously identified in initial disclosures, discovery responses, or any disclosure or discovery supplements).

10. 37 CFR § 2.121(e). *Cf. Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1328 (TTAB 2011) (motion to quash and exclude testimony of witnesses identified for first time in amended and supplemental pretrial disclosures granted); *Jules Jurgenson/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444-45 (TTAB 2009) (motion to strike testimony of witness not identified in pretrial disclosures).

11. *See Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (if subpoena accompanies notice of deposition, motion to quash would be filed in district court for which subpoena issued, not with the Board); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (Board has no jurisdiction over third-party subpoenas). *See also Highbeam Marketing LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1906-07 (TTAB 2008) (failure to have subpoena for discovery deposition quashed resulted in sanction precluding party from using survey evidence at trial).

12. *See* 37 CFR § 2.120(i)(1). *See also Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1240 (TTAB 2012) (judicial economy served by promptly filing a motion to quash).

522 Motion for Order re Manner or Place of Document Production

37 CFR § 2.120(e) *... The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.*

In an inter partes proceeding before the Board, the place where documents and things are to be produced is governed by 37 CFR § 2.120(e). The responding party is obligated to make the documents and materials responsive to the requests available for inspection where the documents and materials are kept in the ordinary course of business. [Note 1.] In Board proceedings, the responding party generally extends the courtesy of copying and sending the documents to the requesting party at the requesting party's expense. [Note 2.] For a discussion of the elements of a request for production and place of production see TBMP § 406.03. [Note 3.]

Accordingly, upon motion, the Board, in its discretion, may make any appropriate order concerning the place and/or manner of production of documents and things. [Note 4.]

NOTES:

1. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

2. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

3. *See also M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1048 (TTAB 2008) *(citing No Fear v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000)) (improper to object regarding place of production when ordered to provide responses without objection); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1014-15 (TTAB 1983) (while normal practice is for party to produce documents at the place where they are kept, Board ordered respondent to make copies and mail to petitioner's attorney at petitioner's expense or hand-deliver the documents to petitioner's attorney); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976) (documents to be produced as part of a discovery deposition would be produced where they are located).

4. *See Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1014-15 (TTAB 1983). *See also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (applicant ordered to copy responsive documents and forward them to opposer at applicant's expense as discovery sanction); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1432 (TTAB 1998).

523 Motion to Compel Disclosure or Discovery

523.01 In General

37 CFR § 2.120(f) ***Motion for an order to compel disclosure or discovery.***

(1) *If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically stored information, or tangible thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy…*

(2) *When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion to compel is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

In inter partes proceedings before the Board, a motion to compel is available in the event of a failure to provide required disclosures or discovery requested by means of discovery depositions, interrogatories, and requests for production of documents and things. [Note 1.] A motion to compel is also available to compel attendance at a discovery conference [Note 2.] or to compel a party to supplement inadequate disclosures or sanction a party for failing to make initial disclosures after being ordered to do so. [Note 3.] For further information regarding the duty to hold a discovery conference, see TBMP § 408.01(a).

Motions to compel are also available to compel an answer to a deposition question. Because discovery depositions are taken out of the presence of the Board, if a witness being deposed, or the attorney for the witness, believes a question is improper, an objection may be stated, but the question normally should be answered subject to the stated objection. *See* TBMP § 404.08(c). However, if a witness being deposed objects to, and refuses to answer, a particular question, and if the deposition is being taken pursuant to a subpoena, the propounding party may attempt to obtain an immediate ruling on the propriety of the objection, by adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. *See* TBMP § 404.09 and TBMP § 411.03. In the absence of a court order compelling an answer, the propounding party's only alternative, if it wishes to compel an answer, is to complete the deposition and then file a motion to compel with the Board. [Note 4.]

Further, a party who fails to provide its initial disclosures will be barred from propounding discovery requests, whether interrogatories, requests for production or requests for admission, and may not file a motion to compel to obtain responses to improperly propounded discovery requests. [Note 5.]

In accordance with 37 CFR § 2.120(f), when a party files a motion to compel disclosures or discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, and no party should file any paper that is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to make required disclosures or respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel. When the motion to compel is filed after discovery has closed, but prior to the deadline for pretrial disclosures for the first testimony period, the time period for making pretrial disclosures will be suspended and dates will be reset after the motion to compel is decided. [Note 6.]

37 CFR § 2.120(f) provides that a motion to compel initial disclosures must be filed within thirty days after the deadline therefor, a motion to compel expert testimony disclosure must be filed prior to the close of the discovery period, and a motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset. 37 CFR § 2.120(i)(1) provides that a motion to determine the sufficiency of an answer or objection to a request for admission must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. These rules are designed to ensure that all discovery disputes are resolved prior to the commencement of trial. A motion to compel discovery or to test the sufficiency of an answer or objection to a request for admission is untimely if filed on or after the deadline for pretrial disclosures for the first testimony period, even if the deadline for pretrial disclosures is subsequently reset. [Note 7.] *See* TBMP § 523.03.

The motion to compel procedure is not applicable to requests for admission. The procedure to be followed in the case of requests for admission is as set forth in 37 CFR § 2.120(i)(1) and Fed. R. Civ. P. 36(a). *See also* TBMP § 411.03 (Requests for Admission) and TBMP § 524 (Motion to Test Sufficiency of Response to Admission Request).

For information concerning the effect of a party's failure to timely respond to interrogatories and document requests, see TBMP § 403.03 (Time for Service of Discovery Responses), TBMP § 405.04(a) (Time for Service of Responses), TBMP § 406.04(a) (Time for Service of Responses), and TBMP § 411 (Remedy for Failure to Provide Disclosures or Discovery); and see TBMP § 523 (Motion to Compel Discovery Responses) and TBMP § 524 (regarding motion to test sufficiency of responses to admission requests).

NOTES:

1. *See* 37 CFR § 2.120(f). *See also, e.g., Johnson and Johnson and Roc International S.A.R.L. v. Obschestvo s Oranitchennoy; Otvetstvenn Ostiu "Wds,"* 95 USPQ2d 1567, 1570 (TTAB 2010) (TTAB 2010) (motion to compel applicant to supplement interrogatory responses granted); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (motion to compel available remedy when adverse party fails to provide initial or expert disclosures); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1436 (TTAB 1998) (interrogatories and document requests); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1298 (TTAB 1997) (discovery deposition); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (interrogatories); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384, 384 (TTAB 1976) (motion for sanctions treated as motion to compel); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127, 128 (TTAB 1976) (party may file motion to compel if it believes objections to discovery requests to be improper). *See also Spa International, Inc. v. European Health Spa, Inc.*, 184 USPQ 747, 747 (TTAB 1975) (discussing when it is appropriate to file a motion to compel or a motion for discovery sanctions); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 616 (TTAB 1974) (motion to compel is not untimely simply because it is made after discovery period has expired, merely because it relates back to earlier timely request; motion for discovery sanctions denied

because no discovery order has issued); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (motion to compel production of documents, *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171-72 (TTAB 1975); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126, 127 (TTAB 1974) (Board can rule on objections to request for production in connection with the filing of a motion to compel). *Cf.* Fed. R. Civ. P. 37(a)(3)(B).

2. *Promgirl Inc. v. JPC Co.* , 94 USPQ2d 1759, 1762-63 (TTAB 2009) (plaintiff's motion for sanctions in the form of judgment for defendant's failure to participate in discovery conference denied, but alternative motion to compel attendance at a discovery conference granted). Note, however, that a motion to compel a party to participate in a discovery conference is not a prerequisite to filing a motion for sanctions under 37 CFR § 2.120(h).

3. *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) (motion to compel available for inadequate expert disclosures); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.3 (TTAB 2008) (motion to compel available for inadequate initial disclosures).

4. *See* 37 CFR § 2.120(f); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171-72 (TTAB 1975.

5. 37 CFR § 2.120(a)(3); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705-06 (TTAB 2009) (a party that wishes to object to discovery on the ground that its opponent failed to make its required initial disclosures prior to serving the discovery must assert that basis for objection to the discovery clearly and specifically); *MySpace, Inc. v. Donnell Mitchell*, 91 USPQ2d 1060, 1060 (TTAB 2009) (defendant's motion to compel denied because defendant had not made the required initial disclosures).

6. *See* 37 CFR § 2.120(f). ("If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board."). *See also HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1907 (TTAB 2008) (motion to compel attendance of employees for depositions granted where moving party made good faith effort to schedule depositions but opposer failed to cooperate).

7. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (motion for summary judgment filed during the period for taking testimony untimely).

523.02 Special Requirements for Motion

37 CFR § 2.120(f) ***Motion for an order to compel disclosure or discovery.***

(1) ... *A motion to compel discovery shall include a copy of the request for designation of a witness or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents, electronically stored information, or tangible things that were not produced for inspection and copying. A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication..*

A motion to compel must include a copy of the request for discovery and the response thereto, as specified in 37 CFR § 2.120(f). [Note 1.]

In addition, the motion to compel disclosures or discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. [Note 2.] The statement should contain a recitation of the communications conducted including dates, a summary of telephone conversations, and where applicable, copies of any correspondence exchanged such as email and letters, or notes to the file. [Note 3.]

In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete. [Note 4.]

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing, filed through ESTTA, of the issues in the motion that no longer require determination. [Note 5.]

For information concerning the special requirements for a motion to compel answers to interrogatories, or to produce documents, ESI or tangible things that are the subject of a general objection on the ground of excessive number, see TBMP § 405.03(e) and TBMP § 406.03(e). *Cf.* TBMP § 526.

NOTES:

1. *See Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127, 128 (TTAB 1976) (Board must be able to render a meaningful decision on a motion to compel); *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 506-07 (TTAB 1974); *Helene Curtis Industries, Inc. v. John H. Breck, Inc.*, 183 USPQ 126, 126 (TTAB 1974) (party must submit a copy of actual written objections to interrogatories along with motion to compel).

2. 37 CFR § 2.120(f). *See Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081-82 (TTAB 2014) (discussing generally good faith effort requirement; finding single email exchange between the parties insufficient to establish good faith effort as it was incumbent upon applicant to make at least one additional inquiry); *Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (good faith effort requirement); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 n.11 (TTAB 2005) (motion to compel demonstrated good faith effort and included copies of relevant document requests and responses); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) (failed to submit documentary evidence of good faith effort); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties must narrow disputed requests for discovery to a reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (nature and the number of discovery requests clearly demonstrated that no good faith effort had been made); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979) (good faith effort is required where there has been a complete failure to respond to discovery; telephone call to counsel sufficient); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (same; a statement that discovery has not been responded to is insufficient).

3. *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

4. *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

5. 37 CFR § 2.120(f). *See, e.g., Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (late responses rendered motion to compel, based on complete non-responsiveness, moot).

523.03 Time for Filing Motion

37 CFR § 2.120(f) ***Motion for an order to compel disclosure or discovery.***

(1) *... A motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosure(s), if any, and a motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset.. …*

A motion to compel initial disclosures must be filed within thirty days after the deadline therefor to allow time for the non-compliant party to conduct discovery after making its disclosures. [Note 1.] A motion to compel expert testimony disclosures must be filed prior to the close of the discovery period. [Note 2.]

A motion to compel discovery does not necessarily have to be filed during the discovery period. [Note 3.] However, the motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate and must, in any event, be filed before the deadline for pretrial disclosures for the first testimony period. [Note 4.] A moving party should also wait a reasonable time after the responses are due to file a motion to compel, to allow time for receipt of responses. [Note 5.] If the deadline for pretrial disclosures for the first testimony period is reset prior to the deadline for pretrial disclosures for the first testimony period, a motion to compel filed before the rescheduled or reset deadline for pretrial disclosures for the first testimony period is timely. However, as of the deadline for pretrial disclosures for the first testimony period, a motion to compel filed is untimely, even if it is filed prior to the opening of a rescheduled or reset deadline for pretrial disclosures for the first testimony period. [Note 6.] There is no provision in the rule for Board discretion to consider an untimely motion to compel. Trial schedules include a forty-five day period between the close of discovery and the deadline for pretrial disclosures for the first testimony period to allow time for the filing of any necessary discovery motions.

NOTES:

1. 37 CFR § 2.120(f).

2. 37 CFR § 2.120(f).

3. *See H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1719 n.10 (TTAB 2008); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974).

4. 37 CFR § 2.120(e).

5. *See* 37 CFR § 2.120(e); *MySpace, Inc. v. Donnell Mitchell*, 91 USPQ2d 1060, 1061 n.2 (TTAB 2009) (because timely-served discovery responses might not arrive until after deadline, receiving party should wait a reasonable time beyond service date before making a motion alleging failure to serve). *See, e.g., Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383 (TTAB 2001) (deficiencies in applicant's discovery responses should have been addressed by timely filing of properly-supported motion to compel discovery). **Please Note:** The deadlines for filing motions to compel were changed in the January 14, 2017 revisions to 37 CFR § 2.120(e) renumbered

as § 2.120(f). Prior Board decisions may cite to former deadlines no longer applicable in inter partes proceedings.

6. To be clear, if the deadline for pretrial disclosures was reset after the deadline was past, a motion to compel would be untimely. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 234-36 (Comm'r 1976) (motion for summary judgment filed during the period for taking testimony untimely.

523.04 Failure to File Motion to Compel

If a party that served a request for discovery receives a response thereto that it believes to be inadequate, but fails to file a motion to challenge the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. [Note 1.] *Accord* TBMP § 524.04 (regarding failure to file motion regarding sufficiency of admission responses). *Cf.* TBMP § 527.01(e) (Estoppel Sanction).

NOTES:

1. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (Board did not abuse its discretion by refusing to strike plaintiff's evidence where defendant failed to follow up on plaintiff's offer to produce the evidence at a mutually agreeable time and place and in view of defendant's failure to file a motion to compel); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1719 (TTAB 2008) (party that receives response it believes inadequate but fails to file a motion to test sufficiency of response, may not thereafter complain about its insufficiency); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (objections that discovery requests are, for example, ambiguous or burdensome, are not of a nature which would lead propounding party to believe that the requested information does not exist and party should have filed motion to compel), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *overruled on other grounds, The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009) *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery deposition without motion to compel complete responses and violation of an order compelling answers). *See also Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383 (TTAB 2001) (motion to compel time-barred).

524 Motion to Test Sufficiency of Response to Requests for Admission

524.01 In General

Fed. R. Civ. P. 36(a)(3) Time to Respond; Effect of Not Responding.

A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney. A shorter or longer time for responding may be stipulated to under Rule 29 or be ordered by the court.

Fed. R. Civ. P. 36(a)(6) Motion Regarding the Sufficiency of an Answer or Objection. *The requesting party may move to determine the sufficiency of an answer or objection. Unless the court finds an objection justified, it must order that an answer be served. On finding that an answer does not comply with this rule, the court may order either that the matter is admitted or that an amended answer be served. ...*

37 CFR § 2.120(i) ***Request for admissions.***

...

(2) *When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response. [Note 1.] *Cf.* TBMP § 523.01 (Motion to Compel Discovery – In General).

If the Board, upon motion to test the sufficiency of a response to a request for admission, determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. [Note 2.]

Generally, if there is an admission or a denial, the Board will not find the response to be insufficient even if the responding party included an explanation or clarification of the admission or denial, or admitted after first denying. [Note 3.] If no response is timely served to a request for admission, the matter is automatically deemed admitted, and no motion is necessary. [Note 4.] See TBMP § 525 and TBMP § 527.01(d) for further discussion.

NOTES:

1. *See* 37 CFR § 2.120(i); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.* , 188 USPQ 690, 691 (TTAB 1975); *Watercare Corp. v. Midwesco-Enterprise, Inc.* , 171 USPQ 696, 698 n.7 (TTAB 1971). *Cf.* 37 CFR § 2.120(f).

2. Fed. R. Civ. P. 36(a).

3. *Cf.* Fed. R. Civ. P. 36(a)(4 – 6) Committee Notes on Rules - 1970 amendment regarding improper responses which may be considered effective admissions.

4. Fed. R. Civ. P. 36(a)(3).

524.02 Special Requirements for Motion

37 CFR § 2.120(i)(1) ***Request for admissions.***

(1) *... The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party showing that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.*

A motion to determine the sufficiency of a response to a request for admission must include a copy of the request for admission (and any exhibits thereto) and of the answer or objection. [Note 1.]

In addition, the motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. [Note 2.] *Cf.* TBMP § 523.02.

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should immediately inform the Board in writing, filed through ESTTA, of the issues in the motion that no longer require determination. [Note 3.]

NOTES:

1. 37 CFR § 2.120(i). *Cf.* 37 CFR § 2.120(f).

2. 37 CFR § 2.120(i). *Cf.* 37 CFR § 2.120(f); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

3. 37 CFR § 2.120(i). *Cf.* 37 CFR § 2.120(f).

524.03 Time for Filing Motion

37 CFR § 2.120(i) ***Request for admissions.***

(1) *Any motion by a party to determine the sufficiency of an answer or objection, including testing the sufficiency of a general objection on the ground of excessive number, to a request made by that party for an admission must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. ...*

(2) *When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

A motion to test the sufficiency of a response to a request for admission does not necessarily have to be filed during the discovery period, but it should be filed within a reasonable time after service of the response believed to be inadequate and, in any event, must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. [Note 1.] As with a motion to compel, a motion to test the sufficiency not filed before the deadline for pretrial disclosures for the first testimony period is untimely, even if the deadline for pretrial disclosures for the first testimony period is subsequently reset. If the deadline for pretrial disclosures for the first testimony period is reset prior to the deadline for pretrial disclosures for the first testimony period as originally set, a motion to test sufficiency will be timely if it is filed before the rescheduled deadline for the pretrial disclosures for the first testimony period. However, as of the deadline for pretrial disclosures for the first testimony period, a motion to test sufficiency filed thereafter is untimely, even if it is filed prior to the rescheduled or reset deadline for pretrial disclosures for the first testimony period. [Note 2.] There is no provision in the rule for Board discretion to consider an untimely motion to test the sufficiency of a response to a request for admission. Trial schedules include a forty-five-day period between the close of discovery and deadline for pretrial disclosures for the first testimony period to allow time for the filing of any necessary discovery motions. *Cf.* TBMP § 523.03.

NOTES:

1. 37 CFR § 2.120(i)(1); *Cf. Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974) (motion to compel timely even if filed after close of discovery).

2. To be clear, if the deadline for pretrial disclosures was reset after the deadline was past, a motion to test the sufficiency of admission response would be untimely.37 CFR § 2.120(h)(1); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697-98 n.7 (TTAB 1971) (opposer's motion at final hearing seeking ruling on propriety of applicant's responses to requests for admission was manifestly untimely; discovery is a pre-trial procedure and all matters pertinent thereto should be resolved prior to trial); *Cf. La Maur, Inc. v. Bagwells Enterprises Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (motion for summary judgment filed during the period for taking testimony untimely). **Please Note:** The deadlines for filing motions to test the sufficiency were changed in the January 14, 2017 revisions to 37 CFR § 2.120. Prior Board decisions may cite to former deadlines no longer applicable in inter partes proceedings.

524.04 Failure to File Motion

If a party that served a request for admission receives a response thereto that it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. [Note 1.] *Cf.* TBMP § 523.04.

NOTES:

1. 37 CFR § 2.120(i)(1); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697-98 n.7 (TTAB 1971).

525 Motion to Withdraw or Amend Admission

Fed. R. Civ. P. 36(b) Effect of an Admission; Withdrawing or Amending It. *A matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended. ...[T]he court may permit withdrawal or amendment if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in*

maintaining or defending the action on the merits. An admission under this rule is not an admission for any other purpose and cannot be used against the party in any other proceeding.

Fed. R. Civ. P 6(b)(1)(B) Extending Time.

(1) ***In General.*** *When an act may or must be done within a specified time, the court may, for good cause, extend the time:*

(B) on motion made after the time has expired if the party failed to act because of excusable neglect.

Any matter admitted under Fed. R. Civ. P. 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. [Note 1.] *See* TBMP § 407.04. This applies both to matters expressly admitted; and to those deemed admitted for failure to timely respond to a request for admission, where there is no persuasive showing that the failure to timely respond was the result of excusable neglect. [Note 2.] *See* TBMP § 407.03(a) and TBMP § 407.04. For this reason, in instances where a party fails to respond to a request for admission, the serving party need not file a motion requesting that the matter be deemed admitted.

In order to avoid admissions resulting from a failure to respond, a responding party may pursue two separate avenues for relief, namely: a party may either (1) move to reopen its time to serve responses to the outstanding admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B), or (2) the moving party implicitly acknowledges that the responses are late, deemed admitted, and moves to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b). The crucial distinction is that under Fed. R. Civ. P. 6(b)(1)(B), the moving party is seeking to be relieved of the untimeliness of its response, so that the admissions would not be deemed admitted as put. [Note 3.]

Upon motion under Fed. R. Civ. P. 36(b), the Board may permit withdrawal or amendment of an admission when the presentation of the merits of the proceeding will be subserved thereby, and the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits. [Note 4.] The timing of a motion to withdraw or amend an admission plays a significant role in the Board's determination of whether the propounding party will be prejudiced by withdrawal or amendment. [Note 5.] *Cf.* TBMP § 507.02.

NOTES:

1. *See* Fed. R. Civ. P. 36(b).

2. *See* Fed. R. Civ. P. 6(b)(1)(B) and Fed. R. Civ. P. 36.

3. *Giersch v. Scripps*, 85 USPQ2d 1306, 1307-09 (TTAB 2007) (respondent sought to show both excusable neglect to be relieved of the untimeliness of its responses under Fed. R. Civ. P. 6(b)(2) and, alternatively, to withdraw the effective admissions under Fed. R. Civ. P. 36(b) and have responses accepted; Board granted the motion under Fed. R. Civ. P. 36(b)). **Please Note:** as part of general restyling, effective December 1, 2007, former Fed. R. Civ. P. 6(b)(2) is now Fed. R. Civ. P. 6(b)(1)(B).

4. Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1308-09 (TTAB 2007) (motion to withdraw effective admissions granted); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (amendment permitted where the requested admissions were ambiguous and conclusory and possible prejudice avoided by extending discovery period); *Johnston Pump/General*

Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by relieving opposer of admission on relevant issue and prejudice avoided by allowing applicant limited discovery as to the amended answer); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235-36 (TTAB 1979) (motion to withdraw admissions by default denied, but to extent admissions are contradicted by evidence, they will not be relied on for purposes of deciding whether entry of summary judgment is appropriate). *See also American Automobile Association (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144-45 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend).

5. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (motion to withdraw admissions granted when propounding party's testimony period had not yet opened); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (motion to withdraw admissions granted when case was still in pretrial stage).

526 Motion for a Protective Order

37 CFR § 2.120(g) ***Motion for a protective order.*** *Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.*

In inter partes proceedings before the Board, motions for a protective order are governed by 37 CFR § 2.120(g).

It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those which it believes to be improper. [Note 1.] *See* TBMP § 410 (Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery) and TBMP § 412.06 (Protective Orders Limiting Discovery).

Moreover, if a party upon which interrogatories, requests for production, or request for admission have been served believes that the number of interrogatories, requests for production, or requests for admission served exceeds the limitation specified in 37 CFR § 2.120(d),37 CFR § 2.120(e), or 37 CFR § 2.120(i), and is not willing to waive this basis for objection, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, requests for production, or requests for admission, or a motion for a protective order, serve a general objection on the ground of their excessive number, leaving the inquiring party with the burden of filing a motion to compel if it believes that the objection is not well taken. For a discussion regarding excessive discovery requests, *see* TBMP § 405.03(e), TBMP § 406.05(e) and TBMP § 407.05(e). *Cf.* TBMP § 523.02. [Note 2.]

Nevertheless, there are certain situations (such as, for example, when a request for discovery constitutes clear harassment, or when a party has not provided its initial disclosures, or when a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest) in which a party may properly respond to a request for discovery by filing a motion

for a protective order that the discovery not be had, or be had only on specified terms and conditions. [Note 3.]

Except in situations such as those described above, a motion for a protective order ordinarily should be filed in a Board proceeding only in response to a motion to compel where, for example, matter sought to be discovered assertedly constitutes trade secret or confidential information, or cannot be provided without undue burden or expense. [Note 4.]

Under appropriate circumstances, the Board has the discretion to order a deposition not be had or to limit a deposition. [Note 5.] **Please Note:** The Board does not have jurisdiction to grant protective relief for depositions noticed under subpoena.

Please Note: There is a distinction between a motion for a protective order to address over-reaching discovery, and a motion for a protective order relating to facilitating the exchange of discovery in connection with the Board's standard protective order, which provides tiers of protection to confidential information.

For a detailed discussion concerning motions for protective orders and the Board's standard protective order, see TBMP § 412.

NOTES:

1. *See Luemme Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999).

2. *See* 37 CFR § 2.120(e).

3. *See, e.g.,* 37 CFR § 2.120(g); Fed. R. Civ. P. 26(c); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (protective order granted against 707 requests for admission, 247 document requests, and 26 enumerated interrogatories); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (protective order granted as to 94 requests for admissions which were either duplicative or sought admissions regarding unpleaded registrations); *Weatherford/Lamb Inc. v. C&J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 n.3 (TTAB 2010) (protective order granted that petitioner need only produce limited or representative samples of responsive documents); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (protective order granted as to discovery relating to foreign activities); *C.H. Stuart Inc. v. S.S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (protective order granted as to discovery not tailored to issues in Board proceeding, including those seeking information regarding whether officers of applicant had been convicted of a crime or subject to a proceeding before the U.S. government); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where obligation to respond to discovery requests rested with assignee).

4. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1674-77 (TTAB 1988).

For other examples of cases involving a motion for a protective order relating to discovery, see generally *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1611-12 (TTAB 1991) (request for protective order that discovery be governed by the Hague Convention) and *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141, 144 (TTAB 1975) (motion for protective order that discovery not be taken pending Board's determination of motion to dismiss).

5. *See, e.g., Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014) (protective order granted with regard to taking noticed deposition of expert after redesignation by party as non-testifying expert); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1673-77 (TTAB 2004) (protective order granted to prevent the taking of additional depositions as to three of six employees); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high level executive granted); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (granting protective relief in connection with a deposition on written questions in that party is free to object and refuse to answer those questions that it believes are not relevant; denying protective relief to the extent that the Board will review questions at issue to determine if they are relevant to the proceeding).

527 Motion for Sanctions

527.01 Motion for Discovery Sanctions

527.01(a) For Failure to Comply With Board Discovery Order

37 CFR § 2.120(h) ***Sanctions.***

(1) *If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure. A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.*

If a party fails to comply with an order of the Board relating to discovery, including a protective order or an order compelling discovery, the Board may enter appropriate sanctions, as defined in 37 CFR § 2.120(h)(1). [Note 1.] In the case of a protective order, the Board may enter these sanctions against a party if the party or any attorney, agent, or designated witness of the party fails to comply with the protective order. [Note 2.]

Sanctions may also be appropriate when a party refuses to participate in a discovery conference under 37 CFR § 2.120, without the need for the moving party to first file a motion to compel its adversary's attendance at a discovery conference. [Note 3]. *See* TBMP § 401.01 and TBMP § 408.01(a) for further information on discovery conferences and the duty to cooperate. If the deadline for the required discovery conference passes and a party informs the Board of the opposing party's failure to participate in a discovery conference, the non-cooperating party may be warned that it may be subject to a motion for sanctions under 37 CFR § 2.120(h)(1). The Board may impose any of the sanctions provided in Fed. R. Civ. P. 37(b)(2) for failure to participate in a discovery conference, including judgment. [Note 4.] *See* TBMP § 408.01(a). While a motion to compel a party to participate in a discovery conference is not a prerequisite to filing a motion for sanctions under 37 CFR § 2.120(h)(1), the moving party must provide evidence of a good faith effort to schedule the conference in order to prevail on a motion for sanctions. [Note 5.]

The sanctions that may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering

judgment against the disobedient party. [Note 6.] Default judgment is a harsh remedy, but may be justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. [Note 7.] However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 8.] *See* TBMP § 502.05.

The motion for sanctions for failure to comply with an order of the Board lies only when the Board has entered an order relating to discovery (i.e., an order compelling discovery or a protective order) and the order has been violated. [Note 9.] Unlike a motion to compel discovery, there is no requirement to make a good faith effort to resolve the parties' dispute prior to filing a motion for discovery sanctions. [Note 10.] Sanctions are not available under 37 CFR § 2.120(h)(1) with respect to initial disclosures unless a Board order granting a prior motion to compel initial disclosures has been violated, or a party has expressly stated to its adversary that it does not intend to meet its obligation. [Note 11.] *See also* TBMP § 403.03. The notice of institution of the proceeding does not constitute an order of the Board relating to disclosures within the contemplation of 37 CFR § 2.120(h)(1). [Note 12.]

The motion for sanctions for failure to comply with an order of the Board relating to discovery does not apply in situations involving requests for admission. Sanctions in those situations are governed by Fed. R. Civ. P. 36, except that the Board will not award any expenses, including attorneys' fees, to any party. [Note 13.] *See* TBMP § 502.05. For information concerning sanctions for failure to respond, or respond properly, to requests for admission, see TBMP § 527.01(d).

NOTES:

1. 37 CFR § 2.120(h)(1). *Cf. Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1450-51 (Fed. Cir. 1988) (question of proper sanction committed to sound discretion of the court); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (sanction of dismissal denied as premature when no Board order compelling discovery present); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (trial evidence not stricken as discovery sanctions when no order to compel discovery had been violated).

2. 37 CFR § 2.120(h)(1).

3. *Cf. Promgirl, Inc., v. JPC Co., Ltd.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

4. 37 CFR § 2.120(h)(1). *See Promgirl Inc. v. JPC Co., Ltd.*, 94 USPQ2d 1759, 1762 n.8 (TTAB 2009) (sanction for failure to comply with discovery conference rules should relate to that failure); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 n.4 (TTAB 2008) ("when a party fails to participate in the required discovery conference, an adverse party may move for entry of sanctions under Trademark Rule 2.120(g)(1) even in the absence of a Board order compelling participation"). **Please Note:** effective January 14, 2017, former 37 CFR § 2.120(g)(1) was redesignated 37 CFR § 2.120(h)(1).

5. *See, e.g., Promgirl, Inc. v. JPC Co., Ltd.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (opposer's motion for sanctions in the form of judgment denied where parties were engaged in settlement discussions and opposer did not broach the subject of scheduling the discovery conference until the deadline date, and only after opposer's settlement offer was rejected); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008) (motion for sanctions denied; moving party could have made additional efforts with adverse party to schedule conference, including requesting Board participation in the discovery conference, but failed to do so).

6. *See Benedict v. Superbakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011) (affirming Board's entry of judgment as a discovery sanction for repeated failures to comply with Board's reasonable orders), *aff'g* 96 USPQ2d 1134 (TTAB 2010); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1048 (TTAB 2008) (documents produced following sanctions will be accepted as admissible and authentic at trial if offered by non-sanctioned party; sanctioned party prohibited from relying on documents it produced only after sanctions entered); *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1905 (TTAB 2008) (opposer may not rely at trial on discovery materials disclosed only after entry of sanctions against it); *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477, 1478-79 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (pattern of dilatory conduct indicated willful disregard of Board order and resulted in entry of judgment); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (applicant ordered to copy and forward documents to opposer at applicant's expense); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (where applicant, in violation of order, served objections to discovery requests, judgment was denied as too harsh but applicant was ordered to provide new and complete responses without objection, to copy documents and forward to opposer, and to study sections of TBMP and certify completion to the Board).

See also Unicut Corp. v. Unicut, Inc., 222 USPQ 341, 344 (TTAB 1984) (respondent's continued refusal to obey Board orders sanctioned by entry of judgment) and *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1014-15 (TTAB 1983) (respondent sanctioned by order to produce documents by mailing them to petitioner's attorney at petitioner's expense); *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99, 100 (TTAB 1976) (judgment entered where applicant provided no reason for not complying with Board order compelling discovery). *Cf. Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1451-52 (Fed. Cir. 1988) (failure to comply based on confusion or sincere misunderstanding of court's order does not warrant dismissal); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (petitioner failed to file motion to compel discovery; thus, there is no procedural basis for petitioner's motion for sanctions); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (sanction of presuming substantial actual confusion best left to situations where witness fails or refuses to answer during testimonial as opposed to discovery deposition).

7. *See Benedict v. Superbakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011) (entry of judgment warranted in view of repeated failures to comply with reasonable orders of the Board and no lesser sanction would be effective), *aff'g* 96 USPQ2d 1134 (TTAB 2010); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000); and other cases cited in previous note.

8. *See* 37 CFR § 2.120(h)(1) and 37 CFR § 2.127(f).

9. *See, e.g., Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (request to preclude party from submitting trial evidence as a sanction for its alleged failure to comply with discovery obligations was procedurally baseless where no discovery order was violated or even issued); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953-54 (TTAB 1979) (Board did not issue order compelling discovery but had only resumed proceedings after apparent failure of settlement negotiations and reset time to respond to discovery); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384, 384 (TTAB 1976) (motion for summary judgment on basis of petitioner's failure to answer interrogatories denied); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 616 (TTAB 1974) (motion for judgment denied).

10. *See HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008).

11. 37 CFR § 2.120(h)(2) *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

12. *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

13. *See* 37 CFR § 2.120(i).

527.01(b) If Party Says It Will Not Respond to Discovery Request or Make Required Disclosures

37 CFR § 2.120(h)(2) *If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section. If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section.*

The motion for sanctions under 37 CFR § 2.120(h)(2) is available for discovery depositions, interrogatories, and requests for production of documents and things, and lies where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made. A motion for sanctions for failure to provide initial disclosures may be made when a party has expressly stated to its adversary that it does not intend to meet its obligation. [Note 1.] Similarly, a motion for sanctions for failure to provide expert disclosures may be made when a party has expressly stated to its adversary that required disclosures will not be made. Parties should not file a motion for sanctions under 37 CFR § 2.120(h)(2) where the Board has previously entered an order compelling discovery or disclosures. The appropriate remedy is rather a motion for sanctions pursuant to 37 CFR § 2.120(h)(1), discussed in TBMP § 527.01(a).

The sanctions that may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 2.] *See* TBMP § 502.05.

The motion for sanctions under 37 CFR § 2.120(h)(2) does not apply in situations involving requests for admission. For information concerning sanctions for failure to respond, or respond properly, to requests for admission, see TBMP § 527.01(d).

NOTES:

1. *Kairos Institute of Sound Healing LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541, 1542-43 (TTAB 2008).

2. *See* 37 CFR § 2.120(h)(1); 37 CFR § 2.120(h)(2); and 37 CFR § 2.127(f).

527.01(c) Untimely Response to Discovery Requests

A party that fails to respond to a request for discovery (except for a request for admission) during the time allowed therefor, and that is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. [Note 1.] *See* TBMP § 403.03Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence. [Note 2.] Objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. [Note 3.]

NOTES:

1. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (circumstances do not justify waiver of right to object in view of confusion regarding time to respond); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449-50 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (even where there is complete failure to respond to discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel); *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691-92 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose").

2. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

3. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (party will generally not be found to have waived the right to make objections on the basis of privilege, confidentiality, or attorney work product).

527.01(d) In the Case of Requests for Admission

The entry of sanctions for failure to respond, or respond properly, to requests for admission is governed by 37 CFR §2.120(i) and Fed. R. Civ. P. 36, except that the Board will not award expenses to any party. [Note 1.] *See* TBMP § 502.05.

If a party upon which requests for admission have been served fails to serve a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 CFR § 2.120(k)(3)(1), unless the party upon which the requests were served is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board. *See* Fed. R. Civ. P. 6(b) and 36(a) and TBMP § 407.03(a). When no response has been served, it is not necessary or appropriate for the propounding party to file a motion to deem the requests admitted. For information concerning motions to withdraw or amend admissions, see TBMP § 525.

If a party upon which requests for admission have been served responds by serving answers and/or objections thereto, and the propounding party believes that one or more of the answers and/or objections is insufficient, the propounding party may file a motion with the Board to determine the sufficiency of the answers and/or objections believed to be insufficient. [Note 2.] If the Board determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that

an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. [Note 3.] For information concerning motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.

NOTES:

1. *See* 37 CFR § 2.120(i).

2. *See* 37 CFR § 2.120(i); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690, 691 (TTAB 1975); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 698 n.7 (TTAB 1971).

3. *See* Fed. R. Civ. P. 36(a).

527.01(e) Estoppel Sanction

A party that responds to a request for discovery by indicating that it does not have the information sought, or by stating objections thereto, may be barred by its own action from later introducing the information sought in the request as part of its evidence on the case, [Note 1.] provided that the propounding party raises the matter by objecting to the evidence in question on that ground, and preserves the objection in its brief on the case (it is not necessary that the objecting party file a motion asking for application of this sanction). [Note 2.] A party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial unless the failure to disclose was substantially justified or is harmless. [Note 3.] In instances where a party does not "unequivocally refuse" to provide information in response to discovery requests, the preclusion sanction under Fed. R. Civ. P. 37(c)(1) may not apply. [Note 4.] *See* TBMP § 523.04 (Failure to File a Motion to Compel).

Supervision of discovery, and in particular the application of the preclusion sanction, lies within the Board's discretion. [Note 5.]

NOTES:

1. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009) (documents not produced until after the start of trial stricken).

2. *See, e.g., General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1593-94 (TTAB 2011) (trial testimony and exhibits stricken where applicant waited over two years to supplement responses and opposer lodged objection and cross-examined under protest, but no waiver of privilege), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1455 (Fed. Cir. 1988); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 828-29 (CCPA 1980) (applicant's representations in objecting to interrogatories that facts other than those already litigated in prior proceedings were irrelevant and not discoverable gave rise to equitable estoppel preventing applicant from introducing testimony about those other facts); *Super Valu Stores Inc. v. Exxon Corp.*, 11 USPQ2d 1539, 1543 (TTAB 1989) (party may not refuse to answer interrogatories by claiming confidentiality and then introduce responsive information during its trial period); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988) (trademark search report not produced under attorney-client privilege, albeit rightfully withheld, still cannot be relied upon to support motion for summary judgment); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987) (exhibits demonstrating pronunciation not produced during discovery, though encompassed by

discovery requests, excluded from consideration); *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration).

Cf. Rocket Trademarks Pty. Ltd. v. Phard S.p.A., 98 USPQ2d 1066, 1071-72 (TTAB 2011) (objected-to documents were obtained or created by applicant in anticipation of trial and were not responsive documents that were already in its possession or control when it responded to document requests); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (no estoppel; party should have filed motion to compel where objections that discovery requests are, for example, ambiguous or burdensome, or are otherwise not of a nature which would lead propounding party to believe that the requested information does not exist), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (no estoppel; where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *overruled on other grounds, The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery deposition without motion to compel complete responses and violation of an order compelling answers); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (in that party need not specify evidence it intends to present, failure to identify witness in response to interrogatory seeking identification of all witnesses who would testify at trial, did not preclude testimony of such witness).

3. *See Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1346 (TTAB 2013) (applying " *Great Seats* factors," opposer's failure to supplement its discovery responses or initial disclosures with respect to third-party use found harmless); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013) (where party did not supplement its discovery responses prior to taking trial testimony of non-parties, Board declined to apply estoppel sanction with regard to trial exhibits), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242, 1246 (TTAB 2012) (party that fails to provide information via disclosure or discovery or supplements may be precluded from using that information or witness at trial unless failure was substantially justified or harmless; opposer's failure to identify witness prior to pretrial disclosure was neither harmless nor substantially justified); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011) (opposer's identification of 26 additional witnesses for the first time in its amended and supplemental pretrial disclosures was neither harmless nor substantially justified).

4. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (Board did not abuse its discretion by refusing to strike plaintiff's evidence where plaintiff objected to production, did not represent that responsive documents did not exist but defendant failed to follow up on plaintiff's offer to produce the evidence at a mutually agreeable time and place and in view of defendant's failure to file a motion to compel); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (opposer's request for reconsideration of Board order denying its motion for summary judgment denied; Board properly considered applicant's declaration provided on summary judgment, reasoning that it would be "unfair to foreclose applicant from the opportunity to amplify the assertions made in his previous discovery responses in order to defend against opposer's motion for summary judgment"). *Cf. General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (motion to exclude expert testimony denied where timely-served but deficient expert disclosures were promptly supplemented; failure to notify the Board of service of expert disclosure is not a ground to exclude the testimony of the expert witness).

5. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012).

527.01(f) Motions in Limine

It is not the Board's practice to make prospective or hypothetical evidentiary rulings. Further, the Board will not screen all of a party's proffered evidence before trial. Thus, the Board will deny a motion to prospectively exclude evidence that might be introduced at trial and that might be inconsistent with discovery responses or other material not provided during discovery. [Note 1.] Rather than requesting a discovery sanction prospectively, the better practice is to file a motion to strike or otherwise object to such evidence after it is introduced, identifying the specific evidence objected to and the asserted basis for exclusion thereof. If the objection is one that cannot be cured promptly, the adverse party may wait and raise the objection in or with its main brief on the case. [Note 2.] *See* TBMP § 707.

NOTES:

1. *See Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995).

2. *See, e.g., Hunter Industries Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014) (as Board does not entertain motions in limine, opposer was unable to raise the matter by motion until applicant submitted declarations during its testimony period), *on appeal*, No. 14-CV-4463 (D. Minn.); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493-94 (TTAB 2013) ("Board does not make prospective or hypothetical evidentiary rulings."); *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942 (TTAB 2013) (Board does not entertain motions in limine or otherwise exclude evidence prospectively); *Carl Karcher Enters. Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372 n.3 (TTAB 2011) ("While the pretrial disclosures in court may be important to the resolution of motions in limine handled prior to trial, the Board does not hear and resolve such motions in its practice."); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893-94 (TTAB 2011) (Board does not hear motions in limine; whether expert is qualified cannot be imputed from technical deficiencies in originally served expert disclosure but may be raised later at the appropriate time); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010) ("Turning next to applicant's motion to exclude, the motion is not construed as a motion in limine, which the Board does not hear. Rather, under the circumstances of this case, applicant's motion is more akin to a motion to quash a notice of testimonial deposition based on insufficient or unreasonable notice.") (citing *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995)).

527.02 Motion for Fed. R. Civ. P. 11 Sanctions

Fed. R. Civ. P. 11…

(b) ***Representations to Court.*** *By presenting to the court a pleading, written motion, or other paper--whether by signing, filing, submitting, or later advocating it--an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:*

(1) *it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;*

(2) *the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;*

(3) *the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

(4) *the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.*

(c) ***Sanctions.***

(1) ***In General.*** *If, after notice and a reasonable opportunity to respond, the court determines that Rule 11(b) has been violated, the court may impose an appropriate sanction on any attorney, law firm, or party that violated the rule or is responsible for the violation. Absent exceptional circumstances, a law firm must be held jointly responsible for a violation committed by its partner, associate or employee.*

(2) ***Motion for Sanctions.*** *A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates Rule 11(b). The motion must be served..., but it must not be filed or be presented to the court if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service or within another time as the court sets. ...*

(3) ***On the Court's Initiative.*** *On its own, the court may order an attorney, law firm, or party to show cause why conduct specifically described in the order has not violated Rule 11(b).*

(4) ***Nature of a Sanction.*** *A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated. The sanction may include nonmonetary directives...*

…

(6) ***Requirements for an Order.*** *An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.*

(d) ***Inapplicability to Discovery.*** *This rule does not apply to disclosures and discovery requests, responses, objections, and motions under Rules 26 through 37.*

37 CFR § 11.18 ***Signature and certificate for correspondence filed in the Patent and Trademark Office.***

(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, ... except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1), § 1.4(d)(2), or § 2.193(a) of this chapter.*

(b) *By presenting to the Office … (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) *All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper, and*

(2) *To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,*

(i) *The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;*

(ii) *The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

(iii) *The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

(iv) *The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

(c) *Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of-*

(1) *Striking the offending paper;*

(2) *Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;*

(3) *Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;*

(4) *Affecting the weight given to the offending paper, or*

(5) *Terminating the proceedings in the Office.*

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action.*

The quoted provisions of Fed. R. Civ. P. 11 are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. [Note 1.] Thus, if a paper filed in an inter partes proceeding before the Board violates the provisions of Fed. R. Civ. P. 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction. The Board may find a Fed. R. Civ. P. 11 violation, and impose an appropriate sanction, not only upon motion, but also upon its own initiative, following issuance of an order to show cause and an opportunity for the party to be heard. [Note 2.]

Moreover, Fed. R. Civ. P. 11 certification standards apply to parties as well as attorneys. [Note 3.]

While Fed. R. Civ. P. 11 provides, inter alia, for the imposition of monetary sanctions, the Board will not impose monetary sanctions, or award attorneys' fees or other expenses to any party. [Note 4.] *See* TBMP § 502.05. However, the Board may enter other appropriate sanctions, up to and including the entry of judgment, against a party that violates Fed. R. Civ. P. 11. [Note 5.]

Fed. R. Civ. P. 11(c)(2) provides a "safe harbor" provision allowing the party or attorney an opportunity to withdraw or correct a challenged submission. This provision delays filing of a motion for sanctions before the Board for twenty-one days after service of the motion and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected within those twenty-one days or within another time that the Board may set. The Board will deny motions for Fed. R. Civ. P. 11 sanctions that fail to comply with this requirement.

A motion for sanctions under Fed. R. Civ. P. 11(c) is governed by, and should not be filed in violation of, Fed. R. Civ. P. 11(b). If the Board finds that a motion for Fed. R. Civ. P. 11(c) sanctions itself violates the provisions of Fed. R. Civ. P. 11(b), an appropriate Fed. R. Civ. P. 11(c) sanction may be entered against the party that filed the motion.

The provisions of 37 CFR § 11.18 largely pattern Fed. R. Civ. P. 11 and are also applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. [Note 6.] Any practitioner who

knowingly violates the provisions of that rule is subject to disciplinary action and any appropriate complaint should be brought to the attention of the Office of Enrollment and Discipline. [Note 7.] *See* TBMP § 115.02.

NOTES:

1. *See* 37 CFR § 2.116(a); *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1038 (TTAB 2014) (in applying Rule 11 sanctions, considering not just the pleading in the form of a petition to cancel but party's conduct in other Board proceedings); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (considering not only the pleading in the form of a notice of opposition but extensions of time to oppose as potential basis for applying Rule 11 sanctions); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (filing of notice of reliance on third-party discovery deposition constitutes certificate that circumstances exist which justify acceptance of the evidence).

2. *See* Fed. R. Civ. P. 11(c)(2) and (3); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2023 (TTAB 1998) (order to show cause issued where, although Fed. R. Civ. P. 56(f) (restyled by amendment as Fed. R. Civ. P. 56(d)) motion was granted, party responded to summary judgment without taking the requested discovery); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 634 n.19 (TTAB 1986) (Rule 11 permits court to enter sanctions sua sponte).

3. *See Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.* , 498 U.S. 533, 547 (1991); *Central Manufacturing Inc. v. Third Millennium Technology Inc.* , 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). *See also* 37 CFR § 11.18(c).

4. *See* 37 CFR § 2.127(f). *Compare* 37 CFR § 2.120(g) and 37 CFR § 2.120(h)(1); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001).

5. *See* 37 CFR § 2.116(a); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1596 n.19 (TTAB 2011) (in earlier order, Board imposed sanction prohibiting applicant from objecting to opposer's evidence), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2023 (TTAB 1998) (sanctions included requirement that law firm include express provision in all subsequent filings acknowledging Rule 11(b) and 37 CFR § 11.18(a) and stating that motion was read, has a sound legal basis and is not interposed for delay, harassment or other improper purpose); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1221 (TTAB 1990) (Rule 11 not designed to punish semantic errors; applicant had reasonable basis for allegations in its pleading); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (filing of discovery motions without reasonable basis in law or in fact resulted in Rule 11 sanctions precluding applicant from filing further discovery motions and from filing any motion without prior leave of Board); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 634 n.19 (TTAB 1986) (applicant's frivolous request for reconsideration of order imposing Rule 11 sanctions resulted in entry of judgment); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 967-68 (TTAB 1986) (applicant warned that any other filing deemed frivolous would result in judgment).

6. *See Carrini Inc. v. Carla Carini, Srl*, 57 USPQ2d 1067, 1071 (TTAB 2000) (Board has discretion under Rule 11 to impose sanctions for filings that are presented to the Board for any improper purpose).

7. *See* 37 CFR § 11.18. *See, e.g., ITC Entertainment Group Ltd. v. Nintendo of America Inc.* , 45 USPQ2d 2021, 2023 (TTAB 1998). For information concerning disciplinary proceedings, *see* 37 CFR § 11.19, *et seq.* In addition, conduct in violation of the Disciplinary Rules set forth in 37 CFR part 11 may be referred

to the Office of Enrollment and Discipline for appropriate action. *See* 37 CFR § 11.18(d) and 37 CFR § 11.20, *et seq.*

527.03 Inherent Authority to Sanction

Flowing from the Board's inherent authority to manage the cases on its docket is the inherent authority to enter sanctions against a party. [Note 1.] The Board's exercise of this authority is clearly permitted in a variety of situations where the conduct in question does not fall within the reach of other sanctioning provisions of the rules. [Note 2.]

For example, when a party to an inter partes proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and request entry of judgment in its favor. If, as is usually the case, the motion is uncontested, the Board normally will grant it. [Note 3.]

Similarly, if a registrant (having been served by the Board with a notice of institution and a web link or web address to access a petition to cancel its registration on TTABVUE) or any other party to an inter partes proceeding before the Board, relocates, and fails to inform its attorney (if it is represented by an attorney) or the Board or any adverse party of its new address, with the result that the party cannot be found, and papers relating to the proceeding cannot be served upon it, any adverse party may file a motion asserting such fact and requesting entry of judgment in its own favor. Again, if the motion is uncontested, the Board normally will grant it. Alternatively, under these or similar circumstances indicating that a party is no longer interested in the case, the Board may, either upon motion by the adverse party or upon its own initiative, issue an order that the party show cause why the Board should not enter judgment in view of the party's apparent loss of interest in the case. If the party files no response to the order, judgment will normally be entered. Furthermore, inasmuch as the assigned Board attorney has the authority to act upon on motions, requests, and other matters not actually or potentially dispositive of a proceeding, the assigned Board attorney has the discretion to issue sanctions addressing party conduct with respect to motions, requests, and other matters not actually or potentially dispositive of a proceeding. *See* 37 CFR § 2.127(c).

Other circumstances involving the Board's inherent power to sanction are set forth in the cases cited in the note below. [Note 4.]

NOTES:

1. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 49 (1991) (stating that this inherent power "stems from the very nature of courts and their need to be able to manage their own affairs so as to achieve the orderly and expeditious disposition of the cases") (citations omitted).

2. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 50 (1991) (stating that "[i]f in the informed discretion of the court, neither the statute nor the Rules are up to the task, the court may safely rely on its inherent power."); *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1038 (TTAB 2014) (entering sanction of entry of judgment for bad-faith litigation under both the Board's inherent authority to sanction and Rule 11); *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1906-07 (TTAB 2008) (sanction of precluding use of testimony granted where attorney ensured witness would not appear); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (applying sanction for bad-faith conduct under the Board's inherent authority to sanction, regardless of whether sanctions available under Fed. R. Civ. P. 11); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72

(TTAB 2000) (opposer's conduct did not "fall within reach" of Rule 11 but resulted in judgment under Board's inherent power to sanction).

3. *See* 37 CFR § 2.127(a).

4. *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009) (Board required party to obtain permission before filing any unconsented or unstipulated motion); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (following opposer's third motion to compel, Board prohibited opposer from filing any further motions to compel without prior Board permission); *Central Manufacturing Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210, 1212-13 (TTAB 2001) (extensions of time based on false allegations of continuing settlement negotiations resulted in imposition of continuing sanctions in future cases); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's "callous disregard for Board orders and ignorance of warnings" including violation of order prohibiting filing of any further papers without prior leave, resulted in order dismissing opposition without prejudice, and holding opposed application abandoned without prejudice); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (opposer's counsel warned that Board would not tolerate any further "game playing" or evasiveness in discovery). *Cf. Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 n.2 (TTAB 1985) (Board, while noting that it did not condone applicant's repeated failure to comply with the requirements of 37 CFR § 2.119(a) and 37 CFR § 2.119(b) found that, in absence of any prejudice to opposer, such conduct did not justify the harsh result of entry of default judgment).

528 Motion For Summary Judgment and Accelerated Case Resolution (ACR)

Fed. R. Civ. P. 56. Summary Judgment

(a) ***Motion for Summary Judgment or Partial Summary Judgment.*** *A party may move for summary judgment, identifying each claim or defense — or the part of each claim or defense — on which summary judgment is sought. The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. The court should state on the record the reasons for granting or denying the motion.*

…

(c) ***Procedures.***

(1) ***Supporting Factual Positions.*** *A party asserting that a fact cannot be or is genuinely disputed must support the assertion by:*

(A) *citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials; or*

(B) *showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact.*

(2) ***Objection That a Fact Is Not Supported by Admissible Evidence.*** *A party may object that the material cited to support or dispute a fact cannot be presented in a form that would be admissible in evidence.*

(3) ***Materials Not Cited.*** *The court need consider only the cited materials, but it may consider other materials in the record.*

(4) ***Affidavits or Declarations.*** *An affidavit or declaration used to support or oppose a motion must be made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant or declarant is competent to testify on the matters stated.*

(d) ***When Facts Are Unavailable to the Nonmovant.*** *If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:*

(1) *defer considering the motion or deny it;*

(2) *allow time to obtain affidavits or declarations or to take discovery; or*

(3) *issue any other appropriate order.*

(e) ***Failing to Properly Support or Address a Fact.*** *If a party fails to properly support an assertion of fact or fails to properly address another party's assertion of fact as required by Rule 56(c), the court may:*

(1) *give an opportunity to properly support or address the fact;*

(2) *consider the fact undisputed for purposes of the motion;*

(3) *grant summary judgment if the motion and supporting materials — including the facts considered undisputed — show that the movant is entitled to it; or*

(4) *issue any other appropriate order.*

(f) ***Judgment Independent of the Motion.*** *After giving notice and a reasonable time to respond, the court may:*

(1) *grant summary judgment for a nonmovant;*

(2) *grant the motion on grounds not raised by a party; or*

(3) *consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute.*

(g) ***Failing to Grant All the Requested Relief.*** *If the court does not grant all the relief requested by the motion, it may enter an order stating any material fact — including an item of damages or other relief — that is not genuinely in dispute and treating the fact as established in the case.*

(h) **Affidavit or Declaration Submitted in Bad Faith.** *If satisfied that an affidavit or declaration under this rule is submitted in bad faith or solely for delay, the court — after notice and a reasonable time to respond — may order the submitting party to pay the other party the reasonable expenses, including attorney's fees, it incurred as a result. An offending party or attorney may also be held in contempt or subjected to other appropriate sanctions.*

* * * *

528.01 General Nature of Motion

The motion for summary judgment is a pretrial device to dispose of cases in which "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." [Note 1.] "A party asserting that a fact cannot be or is genuinely disputed must support the assertion by: A) citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials; or B) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact." [Note 2.] The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine dispute of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case. [Note 3.]

The summary judgment procedure is regarded as "a salutary method of disposition," and the Board does not hesitate to dispose of cases on summary judgment when appropriate. [Note 4.]

A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment as a matter of law. [Note 5.] This burden is greater than the evidentiary burden at trial. [Note 6.] The burden of the moving party may be met by showing "that there is an absence of evidence to support the nonmoving party's case." [Note 7.]

If the moving party meets its burden, that is, if the moving party has supported its motion with affidavits or other evidence that, if unopposed, would establish its right to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. [Note 8.] A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the nonmoving party. [Note 9.]

In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine disputes of material fact to be tried. [Note 10.] The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. [Note 11.]

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings." [Note 12.] However, a dispute over a fact that would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. [Note 13.] Further, even a genuine dispute over a fact relating only to an issue that is not the subject of the summary judgment motion will not preclude determination of the motion. [Note 14.]

Where both parties have moved for summary judgment, the mere fact that they have done so does not necessarily mean that there are no genuine disputes of material fact, or authorize the resolution of such disputes, or dictate that judgment should be entered in favor of one of them. [Note 15.]

A party moving for summary judgment should specify, in its brief in support of the motion, the material facts that are undisputed. The nonmoving party, in turn, should specify, in its brief in opposition to the motion, the material facts that are in dispute. [Note 16.]

If the Board concludes that there is no genuine dispute of material fact, but that the nonmoving party is the one entitled to judgment as a matter of law, the Board may, after giving notice and a reasonable time to respond, grant summary judgment in favor of the nonmoving party, grant the motion on grounds not raised by a party, or consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute. [Note 17.]

Briefs in support of a motion for summary judgment and briefs in response or cross-motions for summary judgment on the same issue are limited to 25 pages, and a reply brief shall not exceed 10 pages in length. The brief in support of a cross-motion on a separate issue will not count against the page limit applicable to the response to the original motion only in situations where the original summary judgment motion and cross-motion involve separate issues. Exhibits submitted in support of or in opposition to the motion are not deemed to be part of the brief for purposes of determining the length of the brief. [Note 18.] A motion for summary judgment should be filed in single (not multiple) form.

The Board's determination on summary judgment is interlocutory in nature except for a grant of a summary judgment motion entering judgment that is a final disposition of all issues in the proceeding. The time for seeking judicial review of such a decision shall expire sixty-three (63) days from the date on which a final

order is entered in the case. Any appeal prior to that time is premature. [Note 19.] *See* TBMP § 518 and TBMP § 901.

Where appropriate, partial summary judgment may be entered as to separate classes of goods or services. [Note 20.] If, in a case involving multiple grounds, the Board enters partial summary judgment on one ground, it may dispose of the case on that basis without considering the other grounds. [Note 21.]

NOTES:

1. Fed. R. Civ. P. 56(a). **Please Note:** The 2010 amendments to Fed. R. Civ. P. 56 changed the terminology in the summary judgment standard from genuine "issues" to genuine "disputes" to better reflect the focus of a summary judgment determination. *See* Fed. R. Civ. P. 56, Fed. R. Civ. P. 56(a) Advisory Committee's notes (2010 amendment). Consequently, cases determined before the amendments went into effect use the earlier terminology, e.g., "genuine issues of material fact" rather than "genuine disputes of material fact."

2. Fed. R. Civ. P. 56(c)(1). *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986); *see also T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1049 (Fed. Cir. 1991); and *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1297-98 (Fed. Cir. 1991). *See also Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1783 (Fed. Cir. 1990); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-96 (Fed. Cir. 1987); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 221 USPQ 151, 154 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Flatley v. Trump*, 11 USPQ2d 1284, 1287 (TTAB 1989); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376, 1378 (TTAB 1986); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986).

3. *See, e.g., Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) (TTAB properly determined that evidence which might be adduced at trial would not change result given the differences in the goods of the parties), *aff'g* 221 USPQ 151 (TTAB 1983); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ 1840, 1843 (TTAB 1995) (where issue involved collateral estoppel); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1390-91 (TTAB 1994) (parties submitted voluminous evidence in support of their cross-motions for summary judgment).

4. *See, e.g., Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) (conclusory statements and denials do not raise genuine issues of material fact); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 941 (Fed. Cir. 1984) (response contained only unsupported arguments and conclusions); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1102 (TTAB 1996) (question of legal effect of assigning ITU application is one of law). *But see In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (reversing *Bose Corp. v. Hexawave, Inc.*, 88 USPQ2d 1332 (TTAB 2007) and remanding in light of finding no willful intent to deceive by party against whom summary judgment granted on ground of fraud); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298-99 (Fed. Cir. 1991) (factual question of intent regarding misuse of registration symbol is particularly unsuited to disposition on summary judgment); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507-08 (TTAB 1993) (question of intent regarding filing of ITU application generally unsuitable for disposal by summary judgment).

5. *See, e.g., Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298-99 (Fed. Cir. 1991) (moving party's conclusory statement as to intent insufficient); *Kelly Services, Inc. v. Creative Harbor, LLC*, 121 USPQ2d 1357, 1363 (TTAB 2017) (moving party has initial burden); *Corporate Document*

Services Inc. v. I.C.E.D. Management Inc., 48 USPQ2d 1477, 1479 (TTAB 1998) (moving party established that no genuine issue of material fact remains for trial).

6. *See, e.g., Gasser Chair Co. v. Infanti Chair Manufacturing Corp.*, 60 F.3d 770, 34 USPQ2d 1822, 1824 (Fed. Cir. 1995) (in addition to proving elements of laches by preponderance of the evidence, moving party must also establish no genuine issue of material fact as to those elements).

7. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986) (no requirement that moving party support its motion with affidavits or other similar materials negating the opponent's claim but may be based on nonmovant's failure to make sufficient showing as to its own case on which it has burden of proof); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256-57 (1986) (movant has burden of showing the absence of a genuine issue of fact, but nonmovant is not relieved of its own burden to produce evidence pointing to genuine issue); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1540 (TTAB 2009) (nonmovant must proffer countering evidence to show existence of genuine factual dispute for trial); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) (although listing of allegedly undisputed facts is often submitted and is preferred, no requirement that movant set forth such listing of allegedly undisputed facts in its summary judgment motion). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548, 1550-51 (Fed. Cir. 1988); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-96 (Fed. Cir. 1987).

8. Fed. R. Civ. P. 56(c)(1). *See also Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (nonmoving party's response was not supported by contradictory facts, but merely expressed disagreement with facts); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) ("Mere conclusory statements and denials do not take on dignity by placing them in affidavit form"); *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) (non-moving party failed to rebut moving party's evidence or raise genuine dispute of material fact); *Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007) ("The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.").

9. *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (nonmovant not required to present entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987) (dispute is genuine "only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the nonmovant"); *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001) (if moving party meets burden of demonstrating absence of genuine issue of material fact, nonmoving party must present evidence that one or more material facts is at issue); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1299 (TTAB 2016) (Where the moving party "has supported its motion by demonstrating the lack of any evidence that it intended to create an association with [nonmovant's marks], the burden then shifts to [the nonmovant] to demonstrate the existence of a genuine dispute of material fact to be resolved at trial.").

10. *See Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

11. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993) (impermissible inferences against nonmovant); *Opryland USA Inc. v. The Great American Music Show*

Inc., 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (evidence submitted by nonmovant is to be believed and all justifiable inferences drawn in its favor); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992) (impermissible inferences in favor of movant); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991) (reasonable inferences as to intent could have been drawn in nonmovant's favor); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1034 (TTAB 1996) (Board accepted nonmovant's version of the facts for purposes of deciding motion); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (on opposer's motion for summary judgment, applicant's evidence of statement of use filed in connection with another of its applications covering many of same goods as in opposed application created inference of bona fide intent to use present mark despite absence of any documents regarding its intent to use present mark). *Cf. Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) (factual question of intent generally unsuited to disposition on summary judgment, however, unexplained lack of documentary evidence regarding nonmovant's bona fide intent to use mark in commerce sufficient to prove that nonmovant lacks such intention).

12. *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (dispute is genuine if evidence could lead reasonable finder of fact to decide question in favor of nonmovant); *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1879 (TTAB 1998) (fact is material when its resolution would affect the outcome of the case).

13. *See, e.g., Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result), *aff'd*,14 USPQ2d 1545 (TTAB 1990); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1292-1294 (TTAB 2016) (same). *See also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1879 (TTAB 1998).

14. *See United States Olympic Committee v. O-M Bread Inc.*, 29 USPQ2d 1555, 1557 n.5 (TTAB 1993) (genuine issues of fact as to grounds which were asserted in opposition but were not grounds for summary judgment were irrelevant).

15. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

16. Fed. R. Civ. P. 56(c)(1).

17. Fed. R. Civ. P. 56(f). *Cf. Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1209 n.10 (TTAB 2003) (in considering whether to enter summary judgment in favor of petitioner as nonmoving party, Board treated respondent's statements as it would those of a nonmovant and accepted the statements as true); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1104 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor).

18. 37 CFR § 2.127(a). *See Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (cross-motions for summary judgment denied without prejudice because briefs exceeded page limits; page limits include, if submitted, table of contents, index of cases, description of record, statement of issues, recitation of facts, argument and summary).

19. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564-65(Fed. Cir. 1989). *See also Hewlett-Packard Development Co., L.P. v. Vudu, Inc.*, 92 USPQ2d 1630, 1632 n.5 (TTAB 2009); *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1579 n.6 (TTAB 2008).

20. *Hewlett-Packard Development Co. v. Vudu, Inc.*, 92 USPQ2d 1630, 1634 (TTAB 2009) (opposer's motion for summary judgment on its Trademark Act § 2(d) claim granted as to International Class 9 goods but denied as to services in International Classes 35, 38, 41 and 42).

21. *Compare Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013) (where summary judgment entered on fewer than all pleaded grounds, Board might dispose of case without considering alternate grounds) with *SARL Corexco v. Webid Consulting Ltd.*, 110 USPQ2d 1587, 1591 (TTAB 2014) (when party moved for summary judgment on both pleaded grounds, Board granted summary judgment on one ground and allowed party time to inform Board whether the party wished to proceed with the other ground).

528.02 Time For Filing Motion

37 CFR § 2.127(e)(1) *A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial and Appeal Board. A motion for summary judgment must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.*

A motion for summary judgment generally may not be filed until after the moving party has made its initial disclosures. [Note 1.] However, as provided in 37 CFR § 2.127(e)(1), the Board may entertain a summary judgment motion filed prior to initial disclosures that is based upon lack of jurisdiction, res judicata (claim preclusion), or collateral estoppel (issue preclusion). [Note 2.]

Moreover, the motion for summary judgment must be filed before the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. The motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. [Note 3.] Therefore, any motion for summary judgment must be filed before the deadline for pretrial disclosures for the first testimony period. If the deadline for pretrial disclosures for the first testimony period is reset prior to the deadline for pretrial disclosures for the first testimony period as originally set, a motion for summary judgment will be timely. [Note 4.] As of the deadline for pretrial disclosures for the first testimony period, however, any summary judgment motion filed thereafter is untimely, even if filed prior to a rescheduled deadline for pretrial disclosures for the first testimony period. [Note 5.]

When a motion for summary judgment is filed, a brief in response, or a motion under Fed. R. Civ. P. 56(d), must be filed within 30 days from the date of service of the motion. A reply brief, if any, must be filed within 20 days from the service date of the brief in response. The time for filing a reply brief will not be extended or reopened. [Note 6.] The time for filing a responsive brief may be extended, but the time for filing a motion under Fed. R. Civ. P. 56(d) in lieu thereof, will not be extended or reopened. *See* TBMP § 528.06.

Parties are encouraged to contact the assigned Board attorney immediately after a cross-motion for summary judgment is filed so that the Board attorney may issue an appropriate order clarifying brief due dates and page limits. [Note 7.] *See* TBMP § 528.01

NOTES:

1. 37 CFR § 2.127(e)(1). *See Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures).

2. 37 CFR § 2.127(e)(1); *Unrock Network, LLC v. Sulpasso* , 115 USPQ2d 1409, 1410 n.5 (TTAB 2015) (motion to dismiss considered as one for summary judgment where it asserts claim preclusion); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.* , 98 USPQ2d 1106, 1108 n.4 (TTAB 2011) (same); *Compagnie Gervais Danone v. Precision Formulations LLC* , 89 USPQ2d 1251, 1255 n.7 (TTAB 2009) ("if a party moves for summary judgment prior to the deadline for making initial disclosures it should indicate in its motion that the disclosures have been made, or are not required because the motion seeks judgment on claim or issue preclusion or on a jurisdictional issue"); *NH Beach Pizza LLC v. Cristy's Pizza Inc.* , 119 USPQ2d 1861, 1862 n.1 (TTAB 2016) (construing motion to dismiss filed in lieu of answer as motion for summary judgment on issue preclusion). *See also* 37 CFR § 2.120(a). For information concerning the application of issue or claim preclusion in Board proceedings at summary judgment, *see Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1375-77 (Fed. Cir. 2008); *Mayer/Berkshire Corp. v. Berkshire Fashions*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005); *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765 (TTAB 2015).

3. *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986); *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1631 (TTAB 2009).

4. 37 CFR § 2.127(e)(1).

5. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235-36 (Comm'r 1976) (motion filed before reset testimony period opened but after previous testimony period opened was untimely; petition to Commissioner to reverse Board action denied).

6. 37 CFR § 2.127(e)(1).

7. 37 CFR § 2.127(e)(1). *See, e.g., Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (the page limitation for a "brief in response to a motion" applies to a brief in which an opposition to a motion and a cross-motion are combined but address the same issues; in other words, one cannot exceed the page limitation for a brief by combining an opposition brief and cross-motion addressing the same issue).

528.03 Suspension Pending Determination of Motion

37 CFR § 2.127(d) *When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

When a party files a timely motion for summary judgment, the case is suspended by the Board with respect to all matters not germane to the motion. [Note 1.] The filing of an untimely motion generally will not be considered grounds for suspension. If the motion was untimely filed, the Board may issue an immediate

action denying the motion for that reason. For a discussion regarding suspension of proceedings following the filing of a potentially dispositive motion, see TBMP § 510.03.

Once the Board has suspended proceedings in a case pending the determination of a motion for summary judgment, no party should file any paper that is not germane to the motion. [Note 2.] Examples of papers that are or may be germane to a motion for summary judgment include a brief in opposition to the summary judgment motion, a motion for an extension of time in which to respond to the summary judgment motion, a motion under Fed. R. Civ. P. 56(d) for discovery needed to enable the nonmoving party to respond to the summary judgment motion, a cross-motion for summary judgment, a motion for leave to amend a party's pleading or a motion to amend or withdraw requests for admissions. [Note 3.] *See* TBMP § 507 (Motion to Amend Pleading), TBMP § 509 (Motion to Extend Time), TBMP § 525 (Motion to Withdraw or Amend Admission), TBMP § 528.06 (Request for Discovery to Respondent to Summary Judgment), and TBMP § 528.07 (Unpleaded Issue).

In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures.

Extensions of time will not be granted for a motion under Fed. R. Civ. P. 56(d) for discovery or for the moving party to file a reply brief. The Board will consider no further papers beyond a timely reply brief in support of or in opposition to a motion for summary judgment. [Note 4.]

If the Board's determination of the summary judgment motion does not dispose of the case, the Board ordinarily will issue an order resuming proceedings. [Note 5.]

NOTES:

1. *See* 37 CFR § 2.127(d) and 37 CFR § 2.127(e)(1). *See also Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986) (motion to compel deferred pending ruling on summary judgment motion).

2. *See* 37 CFR § 2.127(d). *See also Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (motion for discovery sanctions not considered).

3. *See International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1603-04 (TTAB 2002) (motion to amend opposition germane inasmuch as it related to the issue of whether applicant's motion is one for complete or partial summary judgment); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1032 (TTAB 1996) (motion to amend pleading to add new claim); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (motion to amend to amplify pleading); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment is a proper filing even after proceeding is suspended).

4. *See* 37 CFR § 2.127(e)(1).

5. 37 CFR § 2.127(d).

528.04 Miscaptioned Motion

The circumstances in which the Board will treat as a motion for summary judgment either a motion to dismiss under Fed. R. Civ. P. 12(b)(6) relying on matters outside the pleadings, or a motion for judgment

on the pleadings under Fed. R. Civ. P. 12(c), filed prior to the moving party's service of initial disclosures and relying on matters outside the pleadings, are very limited. A party may not file a motion for summary judgment until it has made its initial disclosures and such disclosures are not made until after the pleadings have closed and issues have been joined. Thus, consideration of either a motion to dismiss under Fed. R. Civ. P. 12(b)(6) or a motion for judgment on the pleadings under Fed. R. Civ. P. 12(c) as a motion for summary judgment generally would result in a premature motion for summary judgment. [Note 1.] As a result, the Board generally will not construe either a motion to dismiss or a motion for judgment on the pleadings, filed prior to initial disclosures, as a motion for summary judgment.

Conversely, a motion for summary judgment without supporting evidence is the functional equivalent of a motion to dismiss for failure to state a claim upon which relief can be granted, see TBMP § 503, or of a motion for judgment on the pleadings.[Note 2.] *See* TBMP § 504.

NOTES:

1. *See* 37 CFR § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment in opposition). *But see NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1862 n.1 (TTAB 2016) (construing motion captioned as motion to dismiss filed in lieu of answer as motion for summary judgment on issue preclusion).

2. *See S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987) (motion for summary judgment was unsupported and whether movant was entitled to judgment as a matter of law could not be determined on pleadings alone). *See also* 5B C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2722 (3d ed. 2017).

528.05 Summary Judgment Evidence

528.05(a)

528.05(a)(1) In General

The types of evidence that may be submitted in support of, or in opposition to, a motion for summary judgment include "depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials," affidavits or declarations, and other materials in the record. [Note 1.]

The evidentiary record upon summary judgment in an inter partes proceeding before the Board also includes, without action by any party, the pleadings, the file of any application or registration that is the subject of the proceeding as provided in 37 CFR § 2.122(b) [Note 2.] and a copy of any registration pleaded and made of record by the plaintiff with its complaint, in the manner prescribed in 37 CFR § 2.122(d)(1). In addition, a party may make of record, for purposes of summary judgment, copies of other registrations; disclosure materials; documents or things produced in response to a request for production; official records, if competent evidence and relevant to an issue; printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public that is relevant under an issue, if the publication is competent evidence and relevant to an issue; and testimony from other proceedings, so far as relevant and material. [Note 3.] Additionally, a party may make of record documents obtained during settlement negotiations so long as those documents are otherwise discoverable. [Note 4.] A party need not submit these materials under a notice of reliance in order to make them of record

for purposes of a summary judgment motion. Rather, the materials may be submitted as attachments or exhibits to a party's brief or affidavit in support of the motion. *Cf.* TBMP § 700.

In addition, the Board may grant a party's request or otherwise exercise its discretion to take judicial notice of appropriate dictionary definitions, translations, and other facts that are germane to a summary judgment motion. [Note 5.] *See* TBMP § 704.12. The parties further may bring to the attention of the Board supplemental legal authority issuing after briefing of the summary judgment motion, e.g., a precedential decision from the Federal Circuit or Board that is relevant to the issues under consideration, along with a brief description of its significance. [Note 6.] However, such a submission may not be used as a subterfuge to avoid the prohibition on filing surreplies or further briefing of such motions.

In a Board proceeding, the only evidentiary materials likely to be already of record when a motion for summary judgment is filed are the pleadings, the file of any application or registration that is the subject matter of the proceeding [Note 7.], and any registration pleaded and made of record by the plaintiff with its complaint. Any other evidence, that a party wishes to have considered upon summary judgment must usually be submitted in connection with the summary judgment motion. [Note 8.]

Because it is not the practice of the Board to make evidentiary rulings prior to briefing and determination of summary judgment motions, the Board will not entertain a motion in limine to preclude a party from presenting certain types or categories of evidence at summary judgment or, for that matter, at trial. [Note 9.] *See* TBMP § 527.01(f). Objections to evidence may be made in a party's responsive brief, if one is permitted. [Note 10.]

Evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. [Note 11.] However, the parties may stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. [Note 12.] Moreover, the parties may, if they so desire, stipulate that the summary judgment motion and evidence be treated as the final record and briefs in the case. [Note 13.] *See* TBMP § 528.05(a)(2).

NOTES:

1. Fed. R. Civ. P. 56(c)(1)(A).

2. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009) (the entire file of a subject registration, including any evidence made of record during prosecution of the underlying application, is part of the record in a cancellation proceeding without any action of the parties). *See also Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1507 n.221 (TTAB 2017) (entire opposed application file is automatically part of the record in an opposition proceeding); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 (TTAB 2010) (record includes pleadings and file of the opposed application).

3. *See* 37 CFR § 2.122(b), 37 CFR § 2.122(d)(2), 37 CFR § 2.122(e), 37 CFR § 2.122(f), and 37 CFR § 2.127(e)(2). *See also Raccioppi v. Apogee Inc.*, 47 USPQ 1368, 1369-70 (TTAB 1998) (party may rely on documents admissible under 37 CFR § 2.122(e)).

4. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930-31 (TTAB 2015) (Fed. R. Evid. 408(a) does not preclude use of documents because they are provided during the course of compromise negotiations if the evidence is otherwise discoverable).

5. *See generally University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). *See also Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1542 (TTAB 2009); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 (TTAB 2009).

6. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016) (party may bring supplemental legal authority to the attention of the Board after briefing of a summary judgment motion).

7. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009) (the entire file of a subject registration, including any evidence made of record during prosecution of the underlying application, is part of the record in a cancellation proceeding without any action of the parties).

8. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

9. *See Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995).

10. *See* Fed. R. Civ. P. 56(c)(2); Fed. R. Civ. P. 56(c)(2) Committee Notes on Rules - 2010 amendment ("Subdivision (c)(2) provides that a party may object that material cited to support or dispute a fact cannot be presented in a form that would be admissible in evidence. … There is no need to make a separate motion to strike.").

11. *See Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1115 n.10 (TTAB 2011) (evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of such motion); *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 n.7 (TTAB 2008); *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 n.4 (TTAB 2008); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994) (declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during applicant's testimony period); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983) (affidavit offered with response to motion for summary judgment became part of trial record when witness identified it during testimony deposition and adverse counsel cross-examined witness about statements in the affidavit); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981) (material in support of untimely summary judgment motion not trial evidence absent agreement of parties).

12. *See, e.g., Frito-Lay N. America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1951 (TTAB 2014) (parties stipulated that they could rely at trial on materials submitted in support of and against each party's motion for summary judgment), *vacated on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

13. *See, e.g., Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986).

528.05(a)(2) Accelerated Case Resolution (ACR)

Parties to Board inter partes proceedings may stipulate to pretrial final disposition on the merits (as well as abbreviated trial on the merits, see TBMP § 702) of inter partes cases via Accelerated Case Resolution (ACR). [Note 1.] In that regard, ACR expands upon earlier Board practice allowing parties to stipulate that their summary judgment motions and accompanying evidence be treated as the final record and briefs in a case. [Note 2.] ACR is available in all cases.

Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of the proceeding, including permitting the Board to resolve issues of fact at summary judgment and to treat the parties' summary judgment motion papers and evidence as the final record and briefs on the merits of the case. In addition, parties may stipulate to the following: abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration without cross-examination. [Note 3.]

To optimize ACR efficiencies and streamline the case at final decision, parties should avoid excessive evidentiary objections and those contrary to the parties' stipulations as well as avoid submission of excessive documentary evidence. [Note 4.]

Unlike summary judgment decisions, which are interlocutory in nature, the Board's decision in a proceeding utilizing ACR is final, and thus, is judicially reviewable as set forth in 37 CFR § 2.145. [Note 5.] *See* TBMP § 528.01 and TBMP § 901.

Parties may stipulate to ACR at any time during the pretrial phase of the proceeding. Thus, parties that have been in contact prior to commencement of an opposition or cancellation may stipulate to ACR as early as the filing and service of their pleadings. Parties that have not been in prior contact may stipulate to ACR during their discovery conference, or at any time prior to the opening of testimony. Thereafter, parties still may agree to abbreviating trial and briefing schedules, limiting the types and methods of introduction of evidence, and stipulating to facts. [Note 6.] Oral hearings are available in ACR cases in accordance with 37 CFR § 2.129(a). *See* TBMP § 802.

Parties may stipulate to ACR by informing the Board attorney assigned to their case during a telephone conference or by filing a stipulation. In any event, parties must either alert the assigned attorney by telephone that the parties are seeking ACR, in which case the attorney will issue an order outlining the parties' agreement, or submit a stipulation in writing memorializing and outlining their agreement. [Note 7.] Failure to do so may result in delays in implementing ACR and the disposition of the proceeding.

Although ACR generally will be available to any parties seeking to avail themselves of accelerated resolution of their proceedings, the ultimate decision as to whether the parties may proceed by means of ACR lies with the discretion of the Board. In most cases it is anticipated that decisions on ACR cases will be rendered within fifty days of the scheduled due date of a reply brief or hearing. [Note 8.]

What follows in TBMP § 528.05(b) through TBMP § 528.05(f) is a more detailed discussion of some of the types of evidence that may be submitted in connection with a summary judgment motion, or a case in which the parties seek expedited determination under ACR.

For a further discussion regarding other ACR models, *see* TBMP § 702.04 and TBMP § 705.

NOTES:

1. *See M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (Board's first, non-precedential, ACR decision in Opposition No. 91158118 affirmed by Federal Circuit). *See also Weatherford/Lamb, Inc. v. C& J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 (TTAB 2010) (parties stipulated to ACR after filing cross motions for summary judgment); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to ACR). *See also Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016) ("In order to take advantage of any form of ACR, the parties must stipulate that the Board may resolve any genuine disputes of material fact in the context of something less than a full trial.").

2. *See, e.g., Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 (TTAB 2014) (parties agreed to try case using cross-motions for summary judgment ACR model); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016 (TTAB 2014); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1827-28, 1830 (TTAB 2012) (parties may stipulate that their cross motions for summary judgment be the ACR record); *Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986). *See also Bond v. Taylor*, 119 USPQ2d 1049, 1501 (TTAB 2016).

3. *See* 37 CFR § 2.120(a)(2)(iv) ("The parties may stipulate to a shortening of the discovery period."); *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that testimony could be submitted by declaration or affidavit subject to cross-examination upon request, and all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *on appeal*, No. 14-CV-4463 (D. Minn.); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of produced documents and waiver of objections based on authenticity or hearsay); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts and a stipulation to seek a determination through ACR); *Brooks v. Creative Arts by Calloway LLC*, 93 USPQ2d 1823, 1825-26 (TTAB 2009) (parties stipulated to 14 paragraphs of facts, submission of testimony of certain witnesses in declaration form, and that sole issue to be decided at final was priority), *aff'd on other grounds, Creative Arts by Calloway LLC v. Brooks*, 09-cv-10488 (S.D.N.Y. December 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013); *Eveready Battery Co. v. Green Planet, Inc.* 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in

connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to 13 paragraphs of facts). *See also Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

4. *See Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916, (TTAB 2015) (parties utilized ACR process and submitted clean and concise record); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 n.3 (TTAB 2014) (ACR proceeding experienced delay in issuing decision due to the number and nature of objections and precedential nature of decision), *on appeal*, No. 14-CV-4463 (D. Minn.); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873-75 (TTAB 2011) (efficiencies of parties' stipulations as to evidentiary record defeated by submission of excessive records, more than necessary to establish party's position; although parties stipulated to testimony by declaration to streamline proceeding, numerous objections to evidence subverted the parties' stipulations).

5. *Cf. Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564-65 (Fed. Cir. 1989); *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1579 n.6 (TTAB 2008).

6. *See Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).

7. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829-30 n.9 (TTAB 2012) (although the parties crafted and proceeded with their own ACR approach, better practice is to contact the assigned Board attorney when the parties elect to pursue ACR); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 (TTAB 2008) (parties must inform Board by stipulation or motion any time they agree to modify their obligations under the rules regarding disclosure and discovery or deadlines involving disclosure, discovery, trial or briefing).

8. *See Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 n.3 (TTAB 2014) (ACR proceeding experienced delay in issuing decision due to precedential nature of decision and the number and nature of objections), *on appeal*, No. 14-CV-4463 (D. Minn.).

528.05(b) Affidavits and Accompanying Exhibits

Fed. R. Civ. P. 56(c)(4) Affidavits or Declarations. *An affidavit or declaration used to support or oppose a motion must be made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant or declarant is competent to testify on the matters stated.*

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (l) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. However, an adverse party may have an opportunity for direct examination of the affiant, if a Fed. R. Civ. P. 56(d) motion to take the discovery deposition of the affiant is made and granted. [Note 1.] *See* TBMP § 528.06.

The Board may permit affidavits submitted in connection with a summary judgment motion to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. [Note 2.]

Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit. [Note 3.] An affidavit that is not supported by documentary evidence may nevertheless be given consideration if the statements contained in the affidavit are clear and convincing in character, and uncontradicted. [Note 4.]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20. [Note 5.]

Although submissions to the Board by external storage media or devices (e.g., CD-ROM, flash drives, etc.) are not permitted, (*see* TBMP § 106.03, exhibits to affidavits consisting of recordings of commercials, demonstrations, etc., may be transferred to an appropriate electronic format such as a CD-ROM, for submission to the Board. *See, e.g.,* TBMP § 703.01(i). Flash drives are not accepted because of the security risks to USPTO systems, including the potential for introduction of viruses and worms.

NOTES:

1. *See* Fed. R. Civ. P. 56(c)(4). *See also Sweats Fashions Inc. v. Pannill Knitting Co.,* 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) (moving party's affidavit and other evidence were not contradicted by nonmoving party); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.,* 113 USPQ2d 1575, 1578 (TTAB 2015) (Fed. R. Civ. P. 56(c)(4) allows testimony from personal knowledge based on review of files and records or position with company, and Board may not consider portions of affidavit or declaration not based on personal knowledge); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.,* 84 USPQ2d 1856, 1864 n.8 (TTAB 2007) (self-serving declaration permissible on summary judgment despite absence of opportunity for cross-examination of declarant); *Westrex Corp. v. New Sensor Corp.,* 83 USPQ 1215, 1217 (TTAB 2007) (declaration submitted with summary judgment motion clarifies discrepancies in discovery deposition); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.,* 48 USPQ2d 1477, 1479 (TTAB 1998) (use of standard language in declaration did not raise genuine issue as to personal knowledge); *C & G Corp. v. Baron Homes, Inc.,* 183 USPQ 60, 60 (TTAB 1974) (affidavit is competent evidence); *John T. Clark Co. v. Colgate-Palmolive Co.,* 176 USPQ 93, 94 (TTAB 1972) (affidavit was not made on personal knowledge and there was no foundation for statements made therein); *4U Co. of America, Inc. v. Naas Foods, Inc.,* 175 USPQ 251, 253 (TTAB 1972) (issue of credibility raised as to one affiant but statements by another affiant were competent and uncontradicted and suspicion alone is insufficient to invalidate).

2. *See* Fed. R. Civ. P. 56(c). *See also Shalom Children's Wear Inc. v. In-Wear A/S,* 26 USPQ2d 1516, 1517 (TTAB 1993) (additional affidavit submitted with reply brief considered).

3. *See Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc.,* 6 USPQ2d 1028, 1030 n.9 (TTAB 1988) (documents were related to information given in affidavit, but were not specifically identified therein).

4. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.,* 60 USPQ2d 1733, 1736 (TTAB 2001) (opposer's declaration, while not accompanied by any documentary evidence, was internally consistent, not characterized by uncertainty and was unchallenged by applicant); *4U Co. of America, Inc. v. Naas Foods, Inc.,* 175 USPQ 251, 253 (TTAB 1972) (fact that allegations in affidavit not supported by invoice does not undermine the testimony when uncontradicted). *Cf., e. g.,* with respect to testimony depositions, *Liqwacon Corp. v. Browning-Ferris Industries, Inc.,* 203 USPQ 305, 307 n.1 (TTAB 1979); *GAF Corp. v. Anatox Analytical Services, Inc.,* 192 USPQ 576, 577 (TTAB 1976); *Clubman's Club Corp. v. Martin,* 188 USPQ 455, 458 (TTAB 1975); *Rite Aid Corp. v. Rite-Way Discount Corp.,* 182 USPQ 698, 702 n.5 (TTAB 1974), *aff'd,* 508 F.2d 828, 184 USPQ 351 (CCPA 1975).

5. Fed. R. Civ. P. 56(c)(4). *See* 37 CFR § 2.20. *See also Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

6. *See Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654-55 (TTAB 2014) (parties may not override Trademark Rule 2.126 provisions for form of submissions by agreement; however, video and audio recordings of evidence such as commercials may be submitted on CD-ROM), *on appeal*, No. 14-CV-4463 (D. Minn.).

528.05(c) Discovery Responses and Disclosures

37 CFR § 2.127(e)(2) *For purposes of summary judgment only, the Board will consider any of the following, if a copy is provided with the party's brief on the summary judgment motion: written disclosures or disclosed documents, a discovery deposition or any part thereof with any exhibit to the part that is filed, an interrogatory and answer thereto with any exhibit made part of the answer, a request for production and the documents or things produced in response thereto, or a request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.*

37 CFR § 2.120(k)(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

See also TBMP § 409. *Cf.* 37 CFR § 2.120(k), governing the use of discovery responses as trial evidence, and TBMP § 704.09,TBMP § 704.11 regarding the introduction of depositions, interrogatory responses, responses to requests for admissions, and produced documents.

528.05(d) Registrations

37 CFR § 2.122(d)(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).*

If a plaintiff's registration is pleaded and made of record pursuant to 37 CFR § 2.122(d)(1), the registration is of record for all purposes, including a summary judgment motion.

Alternatively, a plaintiff may make its pleaded registration of record, for purposes of summary judgment only, by filing a status and title copy thereof, or a current printout of information from the USPTO electronic database records showing the status and title thereof, with its brief on the summary judgment motion. [Note 1.] A registration owned by a defendant may be made of record in the same manner for purposes of summary judgment or Accelerated Case Resolution (ACR), if consistent with the parties' ACR stipulation. *See* TBMP § 528.05(a)(2). A copy printed from the USPTO's TSDR or TESS database is sufficient for this purpose.

A party may make a third-party registration of record, for purposes of summary judgment only, by filing a copy thereof with its brief on the summary judgment motion; the copy need not be a certified copy, nor need it be a status and title copy. [Note 2.] A copy printed from the USPTO's TSDR or TESS database likewise is sufficient for this purpose.

For purposes of summary judgment only, a copy of a trademark search report, made of record as an exhibit to an affidavit, or as part of a discovery response, submitted in opposition to a summary judgment motion, may be sufficient to raise a genuine dispute of material fact as to the nature and extent of third-party use of a particular designation. [Note 3.]

NOTES:

1. *See Bongrain International (American) Corp. v. Moquet Ltd.* , 230 USPQ 626, 628 n.3 (TTAB 1986). *Cf.* 37 CFR § 2.122(d)(2).

2. *See Interbank Card Association v. United States National Bank of Oregon* , 197 USPQ 123, 124 n.6 (TTAB 1977) (third-party registrations may be plain copies). *See also* 37 CFR § 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete TRAM records of third-party registrations not sufficient).

3. *See, e.g., Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993) (search reports and telephone directory listings sufficient to raise genuine issue regarding strength of mark). With respect to third-party applications, see also *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467-68 n.6 (TTAB 2003) (third-party applications which were published for opposition, submitted in response to motion for summary judgment, were considered by the Board, but failed to raise a genuine issue of material fact).

528.05(e) Printed Publications and Official Records

37 CFR § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

Printed publications, as described in 37 CFR § 2.122(e), include such materials as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding. [Note 1.] *See* TBMP § 704.08. The term "official records," as used in 37 CFR § 2.122(e), refers not to a party's company business records, but

rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer. [Note 2.] *See* TBMP § 704.07.

Materials that qualify as printed publications or official records under 37 CFR § 2.122(e) are considered essentially self-authenticating, that is, the nonoffering party is readily able to verify the authenticity of the proffered materials. [Note 3.] As such, these materials may be relied on for purposes of summary judgment without further evidence of authenticity. [Note 4.] A party may introduce evidence of this nature in connection with a summary judgment motion, if the evidence is competent and relevant, by: specifying the official record or printed publication (including, with respect to the printed publication, information sufficient to identify the source and date of the publication) and the pages to be read; indicating generally the relevance of the material being offered; and including a copy of the proffered material with the party's brief. [Note 5.]

The material need not be submitted under a notice of reliance or in connection with the affidavit or declaration of a witness, and may simply be submitted as an attachment or exhibit to a party's supporting brief.

Internet evidence. Materials obtained from the Internet that identify: (1) dates they were accessed; and (2) their source (e.g., the URL), are considered to be self-authenticating and may be admitted into evidence in the same manner as a printed publication in general circulation in accordance with 37 CFR § 2.122(e). [Note 6.] TBMP § 704.08(b). In all cases, printed publications are only admissible for what they show on their face, and not as proof of any facts asserted therein. [Note 7.] *See* TBMP § 704.08.

Materials that are not self-authenticating. Materials that do not fall within 37 CFR § 2.122(e), that is, materials which are not self-authenticating in nature, may nonetheless be admissible as evidence in connection with a summary judgment motion, if competent and relevant, provided they are properly authenticated by an affidavit or declaration pursuant to Fed. R. Civ. P. 56(c)(4). *See* TBMP § 528.05(b). Such materials may, on summary judgment, be introduced by the affidavit or declaration of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials. [Note 8.]

For further information concerning official records and printed publications, including the probative value of such evidence, see TBMP § 704.07 and TBMP § 704.08. [Note 9.]

NOTES:

1. *See* 37 CFR § 2.122(e). *See also Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007).

2. *See Brooks v. Creative Arts by Calloway LLC*, 93 USPQ2d 1823, 1825-26 (TTAB 2009) (applicant's own file copies of briefs from district court case not proper under notice of reliance as official records), *aff'd on other grounds, Creative Arts by Calloway, LLC v. Brooks*, 09-cv-10488 (SDNY December 27, 2012), dismissed, No. 13-147 (unpublished) (2d Cir. March 7, 2013).

3. *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

4. *See* 37 CFR § 2.122(e).

5. *Cf. Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as

evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source).

6. 37 CFR § 2.122(a). *See Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). *See also Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (documents obtained from Internet admitted even though witness did not personally obtain or download documents); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007) (article from a trade magazine is admissible under 37 CFR § 2.122(e) because, "[o]n its face, it identifies the publication and the date published").

Cf. International Association of Fire Chiefs v. H. Marvin Ginn Corp., 225 USPQ 940, 942 n.6 (TTAB 1985), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (excerpts of printed articles from electronic database were admissible through notice of reliance because the materials "clearly identify the excerpted articles by their dates of publication and sources, all of which are readily available in published materials"). *See also In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984), *rev'd on other grounds*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1085) (magazine articles obtained through search of electronic database admissible because they were clearly identified and therefore there was "no credibility problem"); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 n.3 (TTAB 1983) (printed articles from electronic database are clearly identified by name and date; therefore applicant could have easily checked the articles).

7. *See Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2008); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974).

8. *See* Fed. R. Civ. P. 56(c)(1)(A) and Fed r. Civ. P. P. 56(c)(4); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007); *Westrex Corp. v. New Sensor Corp.*, 83 USPQ 1215, 1217 (TTAB 2007). **Please Note:** The 2010 amendment to Fed. R. Civ. P. 56(c)(2) "eliminated the unequivocal requirement that documents submitted in support of a summary judgment motion must be authenticated." *Akers v. Beal Bank*, 845 F. Supp. 2d 238, 243 (D.D.C. 2012). The lack of authentication is now grounds for objection, but only on the basis that the evidence cannot be presented in a form that would be admissible in evidence. Fed. R. Civ. P. 56(c)(2), Committee Notes on Rules - 2010 amendment ("The objection functions much as an objection at trial, adjusted for the pretrial setting. The burden is on the proponent to show that the material is admissible as presented or to explain the admissible form that is anticipated.").

9. *See Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) for a discussion of the probative weight given evidence obtained from the Internet.

528.05(f) Testimony from Another Proceeding

37 CFR § 2.122(f) ***Testimony from other proceedings.*** *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

Upon motion granted by the Board, testimony taken in another proceeding, or in a suit or action in a court, between the same parties or their privies, may be used in connection with a summary judgment motion in a pending Board proceeding, to the extent that the testimony is relevant and material. The use of such

testimony, however, is subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." [Note 1.] Any motion made to enter testimony from another proceeding should be accompanied by a copy of the testimony sought to be entered in the record together with clear arguments as to its relevance and materiality. Relevance and materiality frequently hinge upon the marks and goods or services involved in the two proceedings. *See* TBMP § 530.

When the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony, and any testimony taken upon recall of the same witness for examination or cross-examination, or in rebuttal thereof, is of record only for purposes of the motion for summary judgment; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, upon motion granted by the Board, during the appropriate trial period, or the parties stipulate to its use at trial. [Note 2.] *See* TBMP § 528.05(a)(1).

NOTES:

1. 37 CFR § 2.122(f).

2. *See, e.g., Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (regarding parties' stipulation that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

528.06 Request For Discovery to Respond to Summary Judgment

Fed. R. Civ. P. 56(d) When Facts Are Unavailable to the Nonmovant. *If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:*

(1) *defer considering the motion or deny it;*

(2) *allow time to obtain affidavits or declarations or to take discovery; or*

(3) *issue any other appropriate order.*

37 CFR § 2.127(e)(1) …*A motion under Rule 56(d) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(d) will not be extended or reopened.* …

Please Note: Former subdivision (f) of Fed. R. Civ. P. 56 has been carried forward by the 2010 amendments to the Federal Rules of Civil Procedure as subdivision (d). The textual differences between current Rule 56(d) and former Rule 56(f) are purely stylistic. Case law developed under the earlier version remains authoritative. [Note 1.]

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion. [Note 2.]

In the event the moving party fails to support its Fed. R. Civ. P. 56(d) motion by an affidavit, the motion generally will be denied. It is not sufficient that a nonmoving party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(d) that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial. [Note 3.] If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment. [Note 4.] The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment. [Note 5.]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20. [Note 6.]

When a request for discovery under Fed. R. Civ. P. 56(d) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, broader requests for discovery outstanding, and those requests remain unanswered.

A request for Fed. R. Civ. P. 56(d) discovery, if filed, must be filed within 30 days of the date of service of the summary judgment motion. [Note 7.] No extensions of time will be granted to file a motion under Fed. R. Civ. P. 56(d), nor may the time to file a motion under Fed. R. Civ. P. 56(d) be reopened. The affidavit in support of the request may be signed either by the requesting party or by its counsel, as appropriate.

A request for Fed. R. Civ. P. 56(d) discovery should be clearly made, and certainly not buried somewhere in a responsive brief or other paper, and should not be filed as a "throw away" alternative accompanying a response to the motion for summary judgment on the merits. When a party faced with a summary judgment motion files a combined request for Fed. R. Civ. P. 56(d) discovery and response on the merits of the motion, the Board ordinarily will deem the Fed. R. Civ. P. 56(d) discovery request moot, and decide the summary judgment motion on the merits thereof. [Note 8.] Moreover, if a party's request for discovery under Fed. R. Civ. P. 56(d) is granted by the Board, and the party thereafter files a response to the summary judgment without taking the requested discovery, the filing of the Fed. R. Civ. P. 56(d) motion may be viewed as sanctionable conduct under Fed. R. Civ. P. 11. [Note 9.]

NOTES:

1. *See* Fed. R. Civ. P. 56(a) Advisory Committee's notes (2010 amendment); *Godin v. Schencks*, 629 F.3d 79, 90-91 n.19 (1st Cir. 2010) ("The substance of the rule has not materially changed.").

2. *See* Fed. R. Civ. P. 56(d); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992) (finding sufficient need for additional discovery); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (unfocused requests for discovery; Rule 56(f) makes no distinction between whether no discovery has been taken and whether additional discovery is needed); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548, 1551 (Fed. Cir. 1988) (complaint that summary judgment was granted before it could take discovery unavailing where party failed to seek Rule 56(f) protection); *Spectra Corp. v. Lutz*, 839 F.2d 1579, 5 USPQ2d 1867, 1868-69 n.4 (Fed. Cir. 1988) (discovery properly denied where plaintiff had conducted 11 months of discovery and was allowed to continue taking discovery pending decision on defendant's motion for summary judgment and failed to file Rule 56(f) affidavit); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion in brief of need for

discovery insufficient); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) (nonmoving party may respond to summary judgment motion by filing motion for Rule 56(f) discovery).

See also Institut National des Appellations d'Origine v. Brown-Forman Corp., 47 USPQ2d 1875, 1896 n.13 (TTAB 1998) (assertion in response to summary judgment motion that opposers intend to conduct further discovery was not proper request for Fed. R. Civ. P. 56(f) discovery); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (motion for Rule56(f) discovery denied where applicant also filed a response to the summary judgment motion on the merits); *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1476 (TTAB 1992) (failure to file Rule 56(f) motion creates presumption party did not consider such discovery essential); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1924-25 (TTAB 1989) (Rule 56(f) declaration sufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077, 2081 (TTAB 1989) (mere unsupported assertion of desire to take deposition inadequate).

3. *See Dyneer Corp. v. Automotive Products*, 37 USPQ2d 1251, 1253 (TTAB 1995) (Rule56(f) motion denied where applicant failed to show need for discovery as to specific issues, not merely a showing that it deferred taking discovery it otherwise would have taken had it known a motion for summary judgment would be filed). *See also* cases cited in previous note.

4. *See Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989).

5. *See Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (unfocused requests for discovery are insufficient); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion that discovery is necessary is insufficient); *Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309, 1311 n.6 (TTAB 1990) (affidavit stating that, during discovery, party will seek to elicit information on likelihood of confusion insufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077, 2081 (TTAB 1989) (Rule 56(f) motion, to the extent it could be construed as such, was not supported by required affidavit); *J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697, 701 (TTAB 1986) (statement by applicant of need to take discovery on validity of assignment was unsupported speculation).

6. Fed. R. Civ. P. 56(d). *Cf. Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

7. 37 CFR § 2.127(e)(1).

8. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2D 1925, 1930 (TTAB 2015) (Fed. R. Civ. P. 56(d) motion denied as moot because party filed substantive response to summary judgment motion); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015) (same); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2012 n.8 (TTAB 2002) (same).

9. *See ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (order to show cause issued where, although Rule 56(f) motion was granted, party responded to summary judgment without taking the requested discovery).

528.07 Unpleaded Issue

528.07(a) Not Basis for Entering Summary Judgment

A party may not obtain summary judgment on an issue that has not been pleaded. [Note 1.] Moreover, at the summary judgment stage of a proceeding before the Board, there has not yet been a trial of any issue, whether pleaded or unpleaded, and therefore the requirements of Fed. R. Civ. P. 15(b) for an amendment to conform the pleadings to the evidence cannot have been met. [Note 2.]

Generally, a party that seeks summary judgment on an unpleaded issue may simultaneously move to amend its pleading to assert the matter. [Note 3.] Alternatively, if the parties, in briefing a summary judgment motion, have treated an unpleaded issue on its merits, and the nonmoving party has not objected to the motion on the ground that it is based on an unpleaded issue, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter. [Note 4.] For purposes of determining the summary judgment motion, the Board will deem such new allegations to be denied if no amended answer is accepted and of record at the time. However, an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f (a) application may not be amended (or deemed amended) to assert an entirely new claim or to rely on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052 claim. [Note 5.] There are other limitations on amendments to a notice of opposition against a § 66(a) application. *See* TBMP § 314 and TBMP § 507.01.

NOTES:

1. *See* Fed. R. Civ. P. 56(a); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2, 1292 (TTAB 2016) (applicant may not obtain summary judgment on unpleaded defense); *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009) (petitioner cannot obtain summary judgment on an insufficiently pleaded fraud claim); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.12 (TTAB 2007); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 n.8 (TTAB 1991); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 628 (TTAB 1986); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619, 621 (TTAB 1986).

2. *See, e.g., Vaughn Russell Candy Co. and Toymax Inc. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1635 (TTAB 1998) (attempt to amend pleadings under Fed. R. Civ. P. 15(b) denied since there had not yet been a trial, but allowed time to move to amend under Fed. R. Civ. P. 15(a)).

3. *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 n.3 (TTAB 2007) (Board sua sponte allowed movant time to amend pleading to assert matter raised at summary judgment); *Vaughn Russell Candy Co. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1635 (TTAB 1998) (allowed time to file motion to amend pleading to add new grounds and to renew summary judgment motion); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (motion to amend, filed after summary judgment on unpleaded issue had been denied, was granted); *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 n.4 (TTAB 1989) (motion to amend to add new ground, filed simultaneously with motion for summary judgment, granted and allegations in new ground deemed denied).

4. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 82 n.3 (TTAB 1984) (pleading deemed amended where nonmoving party did not object to motion on unpleaded claim and treated it on its merits). *Cf. Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 n.5 (TTAB 1995) (not permitted where nonmoving party objected to inclusion of unpleaded grounds even though party responded to motion on unpleaded grounds on merits).

5. *See* 37 CFR § 2.107(b). *See* RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT, 68 Fed. Reg. 55748, 55757 (September 26, 2003); *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151 (TTAB 2014) (opposition against § 66(a) application, once filed, cannot be amended to add grounds for opposition or to add the goods or services subject to opposition beyond those to which the IB has been notified); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011) (scope of grounds against a § 66(a) application governed by ESTTA cover sheet not by supporting pleading); *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329-30 (TTAB 2010) (cannot amend notice of opposition to add a claim against a § 66(a) application).

528.07(b) Not Defense Against Summary Judgment

A party may not defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact as to an unpleaded claim or defense. [Note 1.]

However, a party that seeks to defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact regarding an unpleaded claim or defense, may move to amend its pleading to allege the matter. [Note 2.] Alternatively, if a party seeks to defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact regarding an unpleaded claim or defense, and the party moving for summary judgment treats the unpleaded matter on its merits, and does not object thereto on the ground that the matter is unpleaded, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter. *Cf.* TBMP § 528.07(a). However, an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application, may not be amended (or deemed amended) to assert a new ground for opposition. [Note 3.] *See* TBMP § 314 and TBMP § 507.01.

NOTES:

1. *See Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) (may not assert unpleaded Morehouse defense); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.2 (TTAB 1992) (no consideration given to three unpleaded grounds asserted by opposer in response to applicant's motion for summary judgment).

2. *See United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993).

3. *See* 37 CFR § 2.107(b).

528.08 Entry of Summary Judgment in Favor of Nonmoving Party

Fed. R. Civ. P. 56 (f) Judgment Independent of the Motion. *After giving notice and a reasonable time to respond, the court may:*

(1) *grant summary judgment for a nonmovant;*

(2) *grant the motion on grounds not raised by a party;or*

(3) *consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute.*

If the Board concludes, upon motion for summary judgment, that there is no genuine dispute of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, after giving notice and a reasonable time to respond, in appropriate cases, grant summary judgment in favor of the nonmoving party (that is, enter summary judgment in favor of the nonmoving party even though there is no cross-motion for summary judgment). [Note 1.]

NOTES:

1. *See, e.g., Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1446 (TTAB 1996) (nonmovant entitled to summary judgment where question was one of law); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1106 nn. 17 and 18 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 858-59 (TTAB 1986) (granted to nonmovant as to its standing); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (granted to nonmovant applicant because application elements allegedly missing from application were not required by Paris Convention); *Visa International Service Assn v. Life-Code Systems, Inc.*, 220 USPQ 740, 744-45 (TTAB 1983) (nonmovant entitled to judgment as a matter of law on issues of abandonment, non-use and fraud).

529 Motion to Offer Discovery Deposition of Self or Nonparty

37 CFR § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission or written disclosure.***

(1) *The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.*

(2) *Except as provided in paragraph (k)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed when the party makes its pretrial disclosures, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, even though such deadline has passed, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.*

Ordinarily, the discovery deposition of a party or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated by a party pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(4), may be offered in evidence only by an adverse party; a party may not, in the first instance, offer in evidence a discovery deposition taken of itself or of its officer, director, managing agent, etc. by an adverse party, except by stipulation of the parties approved by the Board, or by order of the Board on motion. Similarly, no party may offer into evidence the discovery deposition of a

nonparty witness, except by stipulation of the parties approved by the Board, or by order of the Board on motion. [Note 1.] *See* TBMP § 704.09.

A motion for leave to offer in evidence a discovery deposition taken by an adverse party of the moving party itself (or of an officer, director, managing agent, etc., of the moving party), or the discovery deposition of a nonparty witness, must show that:

(1) The person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition) [Note 2.]; or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or

(2) Such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. [Note 3.]

A motion based on one of the first grounds listed above must be filed when a party makes its pretrial disclosures. A motion based on the second ground must be filed promptly after the circumstances claimed to justify use of the deposition become known. [Note 4.]

NOTES:

1. 37 CFR § 2.120(k)(2). *See Harry Winston, Inc. v. Bruce Winston Gem Corp.* , 111 USPQ2d 1419, 1425 n.21 (TTAB 2014) (discovery depositions of opposers' own officers submitted by parties' stipulation); *McDonald's Corp. v. McSweet, LLC* , 112 USPQ2d 1268, 1274 n.5 (TTAB 2014) (parties stipulated to discovery depositions of nonparty witnesses as testimony. *Cf.* 37 CFR § 2.120(k)(4) (fairness exception provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce any other part of the deposition which should be considered so as to make not misleading what was offered by the submitting party).

2. *See Galaxy Metal Gear Inc. v. Direct Access Technology, Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (discovery deposition of foreign nonparty witness admissible at trial given that witness lives outside United States and does not plan to be present during trial); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (opposer established that one third-party witness was out of the country during its testimony period).

3. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (opposer established that one third-party witness was out of the country during its testimony period but failed to establish that another witness was either a "party" as contemplated by 37 CFR § 2.120(j)(1) [now 2.120(k)(1)], at the time of deposition or the existence of exceptional circumstances). *Cf. Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of nonparty witness properly entered given the stipulation of the parties approved by the Board); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.4 (TTAB 1986) (deposition of opposer's nonparty witness taken by opposer during discovery treated as testimony deposition taken by stipulation of the parties prior to trial); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (discovery deposition of nonparty treated as stipulated in the record where applicant had not objected to opposer's notice of reliance upon the deposition).

4. 37 CFR § 2.120(K)(2).

530 Motion to Use Testimony From Another Proceeding

37 CFR § 2.122(f) ***Testimony from other proceedings.*** *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

The use, in an inter partes proceeding before the Board, of testimony taken in another Board proceeding, or testimony taken in a suit or action in a court, is governed by 37 CFR § 2.122(f). *Cf.* TBMP § 704.11.

A party may seek, by motion, to use testimony from another proceeding, either as evidence on its behalf upon summary judgment or as part of its evidence on trial of the case. *See* TBMP § 528.05(f) and TBMP §704.11 [Note 1.] A motion for leave to use testimony from another proceeding as evidence on the case may be filed during discovery, the time between the close of discovery and the beginning of testimony, or the testimony period of the moving party. [Note 2.] The better practice is to file the motion as early as possible, in order to minimize the resulting delay in the proceeding. Such a motion would not usually result in suspension of the proceeding; if the motion is made without the consent of every adverse party and filed during the testimony period, and if the moving party believes that it will need additional time to present evidence if the motion is denied, the moving party should file a motion to extend its testimony period with its motion under 37 CFR § 2.122(f).

However, 37 CFR § 2.122(f) does not require that a motion for leave to use testimony from another proceeding be filed during the testimony period of the moving party, and it is not unreasonable for a party to want to ascertain, prior to the opening of its testimony period, whether it will be allowed to rely on such testimony. Thus, a motion under 37 CFR § 2.122(f) filed prior to the opening of the moving party's testimony period will not be denied as untimely. [Note 3.]

A motion for leave to use testimony from another proceeding should be accompanied by a copy of the testimony, and accompanying exhibits, sought to be introduced. A copy of the motion, testimony, and accompanying exhibits should be served on every other party to the proceeding. [Note 4.]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony [Note 5.] or a discovery deposition that was used, by agreement of the parties, as trial testimony in the other proceeding.

NOTES:

1. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1467 n.4 (TTAB 2016) (granting motions for leave to use testimony and evidence from civil action and considering as part of evidence on trial).

2. *Cf.* 37 CFR § 2.120(k)(2).

3. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992) (motion to admit testimony from prior opposition filed during discovery period).

4. *See* 37 CFR § 2.119(a); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992).

5. *See Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1035 n.8 (TTAB 2010); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1316-17 (TTAB 1992).

531 Motion That Deposition Upon Written Questions Be Taken Orally

37 CFR § 2.123(a)(1) ***Trial testimony in inter partes cases.***

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.*

(a)(2) *Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

Testimonial depositions taken in a foreign country shall be taken by deposition upon written questions. [Note 1.] The Board may, depending upon the particular facts and circumstances in each case, upon motion for good cause, order that the deposition be taken by oral examination. Trial testimony in a foreign country may be taken by affidavit or declaration (subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness). [Note 2.]

A party served with a notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present in the United States or any territory which is under the control and jurisdiction of the United States, may file within twenty days from the date of service of the notice a motion with the Board showing good cause for an order that the deposition be taken on oral examination. [Note 3.]

NOTES:

1. 37 CFR § 2.123(a)(2) *See* 37 CFR § 2.124.

2. *See* 37 CFR § 2.123(a)(2). *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1525-26 (TTAB 1989) (good cause to take oral discovery deposition of witness in England).

2. 37 CFR § 2.123(a)(2)

532 Motion to Strike Notice of Reliance

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. For a discussion of the introduction of evidence, see TBMP § 700. 37 CFR § 2.120(k) provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, admission or written disclosure; but specifically states that documents obtained by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR § 2.122(e). 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. 37 CFR § 2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. *See* TBMP § 704.03(b); TBMP § 704.07; and TBMP § 704.11.

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance and, thus, the evidence submitted thereunder, in its entirety, as untimely. *See* TBMP § 707.02(c).

An adverse party may also move to strike a notice of reliance, in whole or in part, on the ground that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted. For example, a party may move to strike a notice of reliance on a printed publication pursuant to 37 CFR § 2.122(e), on the ground that it does not include a copy of the printed publication, or does not indicate the general relevance thereof, *see* TBMP § 707.02(b)(2), or that the proffered materials are not appropriate for introduction by notice of reliance. [Note 1.] *See* TBMP § 707.02(b)(2). If, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party that filed the notice of reliance time within which to cure the defect, failing which the notice will stand stricken. [Note 2.]

Objections to a notice of reliance on substantive grounds, such as objections on the grounds that evidence offered under a notice of reliance constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, normally need not and should not be raised by motion to strike. Rather, such objections should be raised in the objecting party's brief on the case, unless the ground for objection is one that could have been cured if raised promptly by motion to strike. [Note 3.] *See* TBMP § 707.02(c).

It is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. *See* TBMP § 502.01. Thus, if a motion to strike cannot be resolved simply by reviewing the face of the notice of reliance and attached documents, but instead would require a review of testimony or other evidence, determination of the motion will be deferred by the Board until final hearing. [Note 4.]

Evidence timely and properly introduced by notice of reliance under the applicable Trademark Rules of Practice generally will not be stricken, but the Board will consider any objections thereto in its evaluation of the probative value of the evidence at final hearing. [Note 5.] *See* TBMP § 707.02(c).

NOTES:

1. *See, e.g., FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (notice of reliance failed to sufficiently indicate the relevance of the material being offered by not specifying the relevance of the voluminous web pages submitted under two exhibits); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654 (TTAB 2014) (evidence submitted on flash drive stricken from record, parties

may not by agreement override 37 CFR § 2.126 provisions prescribing form of submission), *on appeal*, No. 14-CV-4463 (D. Minn.); *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1093 (TTAB 2012) (objection that relevance of evidence not identified waived where raised for first time with brief because procedural deficiency could have been cured if objection had been raised seasonably); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (improper rebuttal evidence stricken); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance). *See also Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ 1492, 1497-1500 (Board ruled on multiple motions to strike numerous notices of reliance or portions thereof).

2. 37 CFR § 2.122(g) ("[f]ailure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured"). *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (motion to strike exhibits under notice of reliance granted with leave to cure); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (allowed 20 days to correct deficiencies); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (where registrant was given leave to amend notice of reliance to correct deficiencies but failed to do so, documents remained stricken).

3. *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (evaluation of various documents submitted under notice of reliance); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *but see The Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1468-69 (TTAB 1990). *See also Seaward Corp. v. Seaward International, Inc.*, 223 USPQ 48, 49 n.4 (TTAB 1984); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310, 313 n.4 (TTAB 1975).

4. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (motion to strike unpleaded registration deferred as admissibility depends on purpose for which it was submitted); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 n.2 (TTAB 1990) (questions of admissibility of documents based on hearsay and lack of authentication deferred). *See also Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371-72 n.2 (TTAB 2011) (it is not the Board's policy to read trial testimony or other trial evidence prior to final decision).

5. *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 n.2 (TTAB 1990).

533 Motion to Strike Trial Testimony Deposition

533.01 On Ground of Untimeliness

37 CFR § 2.121(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. …*

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 1.] *See* TBMP § 701.

When there is no such approved stipulation, granted motion, or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the testimony deposition, in its entirety, as untimely. [Note 2.] Alternatively, the adverse party may raise this ground for objection in its brief on the case. [Note 3.] *See* TBMP § 707.03(b)(1).

NOTES:

1. 37 CFR § 2.121(a). *Cf. Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1651 (TTAB 2007) (objection to notice of deposition based on timeliness overruled because the deposition was noticed and taken during the assigned testimony period).

2. *See* 37 CFR § 2.121(a); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (testimonial deposition taken outside testimony period stricken); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1072-23 (TTAB 1990) (motion to strike testimony for insufficient notice construed as motion to strike testimony taken out of time).

3. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of testimony deposition two days prior to opening of testimony period could have been corrected upon seasonable objection).

533.02 On Other Grounds

533.02(a) On Ground of Improper or Inadequate Notice

37 CFR § 2.123(c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. ...*

37 CFR § 2.123(e)(3) ***Examination of witnesses.*** *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

If pretrial disclosures or the notice of examination of witnesses by oral testimony served by a party is improper or inadequate with respect to any witness, *e.g.*, does not give due (i.e., reasonable) notice, or does not identify a witness whose oral deposition is to be taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the oral deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. [Note 1.] When testimony is presented by affidavit or

declaration, but was not covered by an earlier pretrial disclosure, the remedy is the prompt filing of a motion to strike. [Note 2.]

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. [Note 3.]

Parties should note that objections to an oral testimony deposition based upon improper or inadequate pretrial disclosures or notice may also be raised by a motion to quash. [Note 4.] *See* TBMP § 521. Raising such objections by means of a motion to quash may avoid the time and expense of taking the deposition in the event the motion is granted, and further leaves open the possibility that such deposition could be rescheduled with more appropriate notice. If the matter is raised by a motion to quash, parties are encouraged to contact the assigned Board attorney by telephone, and ask that the matter be resolved by telephone conference, as time is of the essence with such a motion. For information on telephone conferences with Board attorneys concerning motions, see TBMP § 413.01 and TBMP § 502.06(a).

Parties also should note that the majority of disputes arising from the improper or inadequate notice of trial testimony depositions may be avoided by early communication regarding the planning and scheduling of such depositions. Parties may discuss scheduling of testimonial depositions early in the pretrial phase of the proceeding, e.g., when serving their pretrial disclosures. In any event, the Board expects a reasonable degree of cooperation and flexibility in scheduling to avoid such disputes.

NOTES:

1. *See* 37 CFR § 2.123(e)(3); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1652-53, (TTAB 2007) (reasonableness of notice based upon calendar days and not business days, six calendar days in this case is reasonable notice); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1704 (TTAB 1990) (one day notice not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (substitute witness not identified but adverse party failed, after deposition, to move to strike); *Home Juice Co. v. Runglin Cos. Inc.*, 231 USPQ 897, 898 n.4 (TTAB 1986) (motion to strike filed four months after testimony taken was untimely); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (where applicant attended deposition and objected to its consideration on ground that it was taken on two-days notice, Board found that notice, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

See also, e.g., *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007) (motion to strike testimony deposition granted where there was no attempt to contact adversary regarding an individual's deposition until two days before the testimony period closed); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable and opposing counsel's failure to appear was excused); *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness available again at a future date).

2.*See* 37 CFR § 2.121(e); 37 CFR § 2.123(e)(3)(i). *See* TBMP § 533.02(b).

3. *See* 37 CFR § 2.123(e)(3).

4. *See* 37 CFR § 2.123(c); Fed. R. Civ. P. 30(b) and Fed. R. Civ. P. 31(a); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (on a motion to quash five testimony depositions, whether notice is reasonable depends upon the circumstances of each case; one and two-day notices were not reasonable without compelling need for such haste, but three-day notice was reasonable.)

533.02(b) On Ground of Failure to Disclose Witness in Expert or Pretrial Disclosures

37 CFR § 2.120(a)(1) ***In general.*** *...The Board will specify the deadline … for making … expert disclosure.*

37 CFR § 2.121(e) ***Assignment of times for taking testimony and presenting evidence.*** *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123 and 2.124.*

37 CFR § 2.123(e)(3) ***Examination of Witnesses.*** *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

Although a party need not identify particular individuals as prospective trial witnesses through its mandatory initial disclosures, it must identify "each individual likely to have discoverable information along with the subjects of that information that the disclosing party may use to support its claims or defenses." [Note 1.] The deadline for expert disclosure will be set by the Board in the notice of institution. [Note 2.] If the expert is retained after the deadline for the disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. [Note 3.] Pretrial disclosures require that a party, in advance of the presentation of its testimony, inform its adversary of the names of, and certain minimal identifying information about, the individuals who are expected to, or may, if the need arises, testify at trial. [Note 4.]

If timely-served expert disclosures are deficient, the Board expects the parties to cooperate to resolve the matter. It is not the Board's policy to exclude either the testimony to be proffered by the expert witness or the information originally excluded when there has been supplementation of the deficient expert disclosure, either upon the initiative of the disclosing party or after notification by the adverse party that the disclosure was incomplete. [Note 5.]

A disclosing party's failure to inform the Board of timely disclosure of an expert witness is not a ground to exclude the testimony of such witness. [Note 6.]

If pretrial disclosures are improper or inadequate with respect to a particular witness, in the case of an oral testimony deposition, the adverse party may cross-examine that witness under protest while reserving its

right to object to receipt of the testimony into evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. [Note 7.] When testimony is presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy is the prompt filing of a motion to strike. [Note 8.]

Parties should note that, in accordance with the above discussion, objections to an oral testimony deposition based upon improper or inadequate notice may also be raised by a motion to quash. It is best to raise the matter promptly to avoid expending resources associated with taking a deposition should a motion to quash or strike pretrial disclosures be granted. [Note 9.] *See* TBMP § 521 and TBMP § 533.02(a).

If the matter is raised by a motion to quash, parties are encouraged to contact the assigned Board attorney by telephone, and ask that the matter be resolved by telephone conference, as time is of the essence with such a motion. For information on telephone conferences with Board attorneys concerning motions, see TBMP § 413.01and TBMP § 502.06(a).

The Board, depending on the circumstances presented,may be guided by the following five-factor test: "1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence." [Note 10.]

The Board often allows parties to cure technical deficiencies in connection with otherwise timely matters. If technical deficiencies with pretrial disclosures are raised promptly, the matter may be resolved, either between the parties or with Board intervention, before the parties incur the expense associated with taking a testimonial deposition. [Note 11.]

NOTES:

1. Fed. R. Civ. P. 26(a)(1). *See* 37 CFR § 2.116(a); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1443 n.1 (TTAB 2009).

2. 37 CFR § 2.120(a)(1)

3. *See* 37 CFR § 2.120(a)(2).

4. *See* 37 CFR § 2.121(e); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371-72 n.1 (TTAB 2011); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).

5. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

6. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

7. *See* 37 CFR § 2.123(e)(3); *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1298-1300 (TTAB 2015) (exhibits attached to respondent's testimony deposition, as well as portions of testimony that refer to the exhibits, stricken since respondent failed to identify properly, in his pretrial disclosures, the types of documents he intended to introduce as exhibits); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98

USPQ2d 1370, 1373-74 n.4 (TTAB 2011); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1445 (TTAB 2009) (testimony deposition of witness stricken where witness was not identified in pretrial or initial disclosures). *Cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not renewed in main brief and raised for first time in rebuttal brief), *aff'd*, 188 F. Supp. 3d 22 (D.D.C. 2016).

8. *See* 37 CFR § 2.121(e); 37 CFR § 2.123(e)(3)(i). *See* TBMP §533.02(b).

9 37 CFR § 2.121(e). *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1240 (TTAB 2012) (judicial economy served by promptly filing a motion to quash or to strike the pretrial disclosures as insufficient before the deposition takes place).

10. *See Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592, 597 (4th Cir. 2003). *See also MicroStrategy, Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1357, 77 USPQ2d 1001, 1009-10 (Fed. Cir. 2005) (applying *Southern States* factors in excluding non-expert damages evidence as a sanction for late disclosure); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (after conducting analysis, the Board concluded that opposer's failure to identify witness prior to pretrial disclosure was neither harmless nor substantially justified; combined motion to strike pretrial disclosure and to quash notice of testimony granted); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011) (after conducting the analysis, the Board found that opposer's failure to name one witness until original pretrial closures and twenty-six witnesses until supplement to amended pretrial disclosures was neither harmless nor substantially justified and motion to quash granted as to twenty-six witnesses but testimony of one witness, identified months before in original pretrial disclosure, not excluded provided adverse party be given an opportunity to take a discovery deposition).

11. *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1373-74 n.4 (TTAB 2011).

533.03 When Motion to Strike Should Not Be Filed

The Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony at final hearing. [Note 1.] Objections to testimony depositions on grounds other than the ground of untimeliness, or the ground of improper or inadequate notice, generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the applicable rules, and orally "on the record" at the taking of the deposition, as appropriate. [Note 2.] *See* TBMP § 707.03(c). Such objections must be maintained in the objecting party's brief, or they are considered to have been waived. [Note 3.]

NOTES:

1. *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

2. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990).

3. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived).

534 Motion For Judgment For Plaintiff's Failure to Prove Case

534.01 In General

37 CFR § 2.132 ***Involuntary dismissal for failure to take testimony.***

(a) *If the time for taking testimony by any party in the position of plaintiff has expired and it is clear to the Board from the proceeding record that such party has not taken testimony or offered any other evidence, the Board may grant judgment for the defendant. Also, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have twenty days from the date of service of the motion to show cause why judgment should not be rendered dismissing the case. In the absence of a showing of excusable neglect, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.*

(b) *If no evidence other than Office records showing the current status and title of plaintiff's pleaded registration(s) is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have twenty days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all testimony periods have passed. If judgment is not rendered on the motion to dismiss, testimony periods will be reset for the party in the position of defendant and for rebuttal.*

(c) *A motion filed under paragraph (a) or (b) of this section must be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion grant a motion under paragraph (a) even if the motion was filed after the opening of the testimony period of the moving party.*

When a party has not taken testimony or offered any other evidence the Board may grant judgment for the defendant sua sponte. [Note 1.] In addition, the Trademark Rules of Practice permit the filing of a motion for judgment directed to the sufficiency of a plaintiff's trial evidence in two particular situations, described in 37 CFR § 2.132(a) and 37 CFR § 2.132(b). Only in these two situations will the Board entertain such a motion. *See* TBMP § 534.04. *But cf.* TBMP § 527.03.

NOTES:

1. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.132(a) to clarify that, if a plaintiff has

not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant sua sponte.”).

534.02 Motion For Judgment Under 37 CFR § 2.132(a)

The first situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff’s trial evidence, is when the plaintiff’s testimony period has passed, and the plaintiff has not taken testimony or offered any other evidence. [Note 1.] In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal for failure of the plaintiff to prosecute. [Note 2.] A motion for judgment under 37 CFR § 2.132(a) should be filed before the opening of the moving party’s testimony period, but the Board may, in its discretion, grant the motion even if it is filed thereafter. [Note 3.]

When a motion for judgment under 37 CFR § 2.132(a) has been filed by a defendant, the plaintiff has 20 days from the date of service of the motion in which to respond and show cause why judgment should not be rendered against it. In the absence of a showing of excusable neglect, judgment may be rendered against the plaintiff. [Note 4.]

The “excusable neglect ” standard, in the context of this rule, is equivalent to the “excusable neglect” standard that would have to be met by any motion under Fed. R. Civ. P. 6(b) to reopen the plaintiff’s testimony period. [Note 5.]

For examples of cases involving the question of whether excusable neglect has been shown for a plaintiff’s failure to offer any evidence, see note below. [Note 6.] For a complete discussion of excusable neglect and the standard to be applied, see TBMP § 509.01(b) regarding motions to reopen, and cases cited therein.

If a timely motion under 37 CFR § 2.132(a) is denied because plaintiff has shown excusable neglect, the result is that plaintiff’s testimony period will be reopened, and testimony periods will be reset for the plaintiff and defendant, and for rebuttal. [Note 7.] The deadlines for defendant’s pretrial disclosures and plaintiff’s rebuttal disclosures will be reset as well.

The purpose of the motion under 37 CFR § 2.132(a) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff has failed to offer any evidence during its testimony period. [Note 8.] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. [Note 9.] If no motion under 37 CFR § 2.132(a) is filed, trial and pretrial disclosure dates will continue to run, and the case may be determined at final hearing. In those cases where plaintiff did, in fact, fail to offer any evidence during its testimony period, plaintiff cannot prevail and, thus, defendant need not offer evidence either. [Note 10.]

The fact that a defendant may have previously sought judgment under 37 CFR § 2.132(b) does not preclude it from thereafter seeking judgment under 37 CFR § 2.132(a). [Note 11.]

NOTES:

1. *See* 37 CFR § 2.132(a); *Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012) (“ . . . the clear language of Trademark Rule 2.132(a) indicates that it applies only where the plaintiff has not introduced “any” evidence, i.e., no evidence of any kind, and here opposer has introduced something, regardless of whatever is found with respect to its ultimate impact.”); *Loren Cook Company v. The Acme Engineering and Manufacturing Corp.*, 216 USPQ 517, 519 (TTAB 1982) (“The [motion for judgment]

rule is limited to situations where the plaintiff presents no evidence (2.132(a)) or where only Patent and Trademark Office records are of record (2.132(b)).").

2. *See* 37 CFR § 2.132(a). *See also,e.g.,* *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (Board did not abuse discretion in denying motion to reopen testimony and dismissing proceeding on motion to dismiss where plaintiff submitted no evidence and failed to make a prima facie case); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (motion to extend testimony period denied; motion to dismiss granted); *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1374 (TTAB 2001) (same); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) (motion to extend testimony period granted, motion to dismiss denied); *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1860 (TTAB 1998) (motion to reopen discovery and testimony periods denied, motion to dismiss granted); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 n.4 (TTAB 1990) (respondent advised that if petitioner continued to show no interest and failed to take testimony, applicant may avail itself of 37 CFR § 2.132(a)); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1845-46 (TTAB 1987) (where opposer failed to offer evidence during its testimony period, applicant could have filed motion to dismiss instead of offering its own evidence); *Loren Cook Co. v. Acme Engineering and Manufacturing Corp.*, 216 USPQ 517, 519 (TTAB 1982) (where evidence was presented by plaintiff, motion for judgment under 37 CFR § 2.132 was not entertained).

3. *See* 37 CFR § 2.132(c). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991); *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1860 (TTAB 1998).

4. *See* 37 CFR § 2.132(a). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) ("While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines"); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601-02 (TTAB 2014) (granting 37 CFR 2.132(a) motion to dismiss for failure to prosecute where opposer took no testimony and plain copy of pleaded registration was attached to notice of opposition – registration not properly of record, and applicant's admission in answer that opposer "is listed" as the owner does not establish opposer's current ownership of the pleaded registration); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002) (Board is justified in enforcing procedural deadlines). *Cf. Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509, 512 (TTAB 1976) (although no testimony or other evidence was introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing). *But see Cutino v. Nightlife Media, Inc.*, 575 F. App'x 888 (Fed. Cir. 2014) (applicant admitted in its answer that opposer was the owner of the mark, and did not deny in the answer that opposer owned the pleaded registration sufficient to be an admission regarding ownership and status of the pleaded registration).

5. 37 CFR § 2.132(a). The 2017 amendments to 37 CFR § 2.132(a) changed the terminology in the applicable standard from "good and sufficient cause" to "excusable neglect." *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is further amending §2.132(a) to clarify that the standard for the showing required not to render judgment dismissing the case is excusable neglect.") Consequently, cases determined before the amendments went into effect may use the earlier terminology, e.g., "good and sufficient cause" but they remain authoritative. *See also PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1860-61 (TTAB 2002) (good and sufficient cause standard in context of motion to dismiss under 37 CFR § 2.132(a) is excusable neglect standard); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) (good and sufficient cause standard is equivalent of excusable neglect because response to motion to dismiss is essentially motion to reopen testimony); *Grobet File Co. of America Inc. v. Associated Distributors Inc.*,

12 USPQ2d 1649, 1651 (TTAB 1989) (showing of good and sufficient cause is equivalent of excusable neglect because it requires the reopening of the testimony period to introduce the evidence).

6. *See Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380, 395 (1993) (Supreme Court articulates present standard for excusable neglect – cases decided prior to *Pioneer* may no longer be correct); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) (Board adopts *Pioneer* standard that excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith).

See also Vital Pharmaceuticals Inc. v. Kronholm, 99 USPQ2d 1708, 1711 (TTAB 2011) (no excusable neglect to reopen testimony based on purported settlement discussions); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541-42 (TTAB 2010) (excusable neglect not found where reason for delay was opposer's mistaken belief that proceedings were suspended); *Old Nutfield Brewing Co., Ltd. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1703 (TTAB 2002) (excusable neglect not found where opposer waited four months after close of testimony period to file motion to reopen and where reason for delay was based on, inter alia, opposer's asserted failure to receive answer to opposition); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1860-61 (TTAB 2002) (excusable neglect not found where motion to reopen was filed nearly one month after close of testimony period and was based on mistaken belief that extension of time to respond to discovery extended testimony period and on fact that petitioner was gathering information to respond to discovery); *Jain v. Ramparts*, 49 USPQ2d 1429, 1431 (TTAB 1998) (pendency of plaintiff's motion to compel and extend trial dates after ruling on such motion sufficient cause for failure to try case); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) (plaintiff provided no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case); *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859-60 (TTAB 1998) (mere existence of settlement negotiations insufficient).

7. *See* 37 CFR § 2.132(a).

8. *See Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012) (Supplemental Registration of record is evidence of record such that a motion under 37 CFR § 2.132(a) is not available, though a motion under 37 CFR § 2.132(b) may be available); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 428, 430-31, *recon. denied*, 190 USPQ 431 (TTAB 1976).

9. *See Pfaltzgraf v. William Davies Co.*, 175 USPQ 620, 620-21 (TTAB 1972).

10. *See, e.g., Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1645-46 (TTAB 1987) (opposition dismissed where applicant filed evidence instead of a motion to dismiss and opposer filed improper rebuttal); *Pfaltzgraf v. William Davies Co. Inc.*, 175 USPQ 620, 620-21 (TTAB 1972).

11. *See W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118, 119-20 (TTAB 1973).

534.03 Motion For Judgment Under 37 CFR § 2.132(b)

The second situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence is when the plaintiff's testimony period has passed, and the plaintiff has offered no evidence other than a copy or copies of USPTO records. Such records include originals or

copies of a plaintiff's pleaded registration prepared and issued by the USPTO showing status and title thereof, or a current printout obtained from the USPTO database records showing status and title thereof. In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the plaintiff has shown no right to relief. [Note 1.] A motion for judgment under 37 CFR § 2.132(b) must be filed before the opening of the moving party's testimony period. [Note 2.]

When a motion for judgment under 37 CFR § 2.132(b) has been filed by a defendant, the plaintiff has 20 days from the date of service of the motion to file a brief in response. [Note 3.]

In determining a motion under 37 CFR § 2.132(b), the Board may either render judgment against the plaintiff, or decline to render judgment until all of the evidence is in the record and decide the case on its merits. [Note 4.]

If a timely motion under 37 CFR § 2.132(b) is denied, testimony periods and pretrial disclosure deadlines will be reset for the defendant and for rebuttal. [Note 5.]

The purpose of the motion under 37 CFR § 2.132(b) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff, during its testimony period, has offered no evidence other than copies of USPTO records, and those records do not make out a prima facie case. [Note 6.] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. [Note 7.]

The fact that a defendant may have previously sought judgment under 37 CFR § 2.132(a) does not preclude it from thereafter seeking judgment under 37 CFR § 2.132(b). [Note 8.]

NOTES:

1. *See* 37 CFR § 2.132(b).

2. *See* 37 CFR § 2.132(c).

3. *See* 37 CFR § 2.132(b).

4. 37 CFR § 2.132(b). *See Merker Counter Co. v. Central Counter Co.*, 310 F.2d 746, 135 USPQ 433, 434-35 (CCPA 1962) (declined to render judgment); *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325, 1329 (TTAB 2013) (dismissed opposition with prejudice with respect to unproven common law rights (likelihood of confusion) and dilution claim; denied motion with respect to pleaded registration which was of record since prima facie case of likelihood of confusion established); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (judgment entered where marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313, 315 (TTAB 1976) (motion granted as conceded but even if denied, petition to cancel would have been dismissed on the merits). *Cf. Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509, 512 (TTAB 1976) (where 37 CFR § 2.132(a) motion was filed, although no testimony or other evidence had been introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing).

5. 37 CFR § 2.132(b).

6. *See, e.g., Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1256 (TTAB 2012) (Supplemental Registration insufficient to establish that opposer owns a proprietary right); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 434 (TTAB 1976) (Board will not use judicial notice to remedy plaintiff's failure to present adequate evidence). *Cf. Benedict v. Super Bakery Inc.*, 665 F3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011) (Board did not abuse discretion in entering default judgment under 37 CFR § 2.132(b) against registrant who "continually failed to comply with Board orders, and had hampered reasonable procedures appropriate to resolution of this trademark conflict").

7. *Cf. Pfaltzgraf v. William Davies Co.*, 175 USPQ 620, 621 (TTAB 1972) (respondent under no obligation to move for judgment under 37 CFR § 2.132(a)).

8. *See W.R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118, 119-20 (TTAB 1973); *see also Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313, 315 (TTAB 1976) (entertaining motion under 37 CFR § 2.132(b) after the filing of a motion under 37 CFR § 2.132(a)).

534.04 Motion Under Fed. R. Civ. P. 41(b) or Fed. R. Civ. P. 50(a) Not Available

Trial testimony, in Board inter partes proceedings, is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence, prior to its final deliberations in the proceeding. *See* TBMP § 502.01.

Accordingly, the only means available for testing the sufficiency of trial evidence in an inter partes proceeding before the Board are the motions described in 37 CFR § 2.132(a) and 37 CFR § 2.132(b) TBMP §534.02. [Note 1.] *See* TBMP §534.02 and TBMP § 534.03. The motion under Fed. R. Civ. P. 41(b) for involuntary dismissal, and the motion under Fed. R. Civ. P. 50(a) for judgment as a matter of law during and following jury trials (also referred to as a "directed verdict"), are not available in Board proceedings. *See* TBMP § 502.01. [Note 2.]

NOTES:

1. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (motion for involuntary dismissal under 37 CFR § 2.132(a) denied; six days notice reasonable for testimony deposition that took place during opposer's testimony period).

2. *See Kasco Corp. v. Southern Saw Service, Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993) (Fed. R. Civ. P. 50(a) motion unavailable); *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 506 n.2 (TTAB 1985) (Fed. R. Civ. P. 41(b) motion unavailable).

535 Motion For Order to Show Cause Under 37 CFR § 2.134(b)

37 CFR § 2.134(b) *After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted its involved registration to be cancelled under section 8 or section 71 of the Act of 1946, or has failed to renew its involved registration under section 9 of the Act of 1946, or has allowed its registered extension of protection to expire under section 70(b) of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation, failure to renew, or expiration should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should*

not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

It is generally the responsibility of a petitioner for cancellation to keep track of the status of the respondent's subject registration, and to file a motion for an order to show cause under 37 CFR § 2.134(b) if such registration is cancelled under Trademark Act § 8, 15 U.S.C. § 1058 or Trademark Act § 9, 15 U.S.C. § 1059, after the commencement of the proceeding. However, if the cancellation of the registration under Section 8 or 9 of the Trademark Act comes to the attention of the Board in another manner, the Board may issue an order to show cause upon its own initiative.

The purpose of 37 CFR § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding and avoid judgment by deliberately failing to file a required affidavit of use under § 8 or renewal application under § 9. [Note 1.]

In those cases where the Board finds that respondent has not acted deliberately to avoid judgment and thereby has shown good and sufficient cause why judgment should not be entered against it under 37 CFR § 2.134(b), petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. If respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding, but rather was the result, for example, of a two-year period of non-use which commenced well before registrant learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment. [Note 2.] In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner will be given time in which to elect whether it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. TBMP § 602.02(b).

For further information concerning orders to show cause under 37 CFR § 2.134(b), and related orders to show cause in the case of Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications or registrations, see TBMP § 602.01 and TBMP § 602.02(b).

NOTES:

1. *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (failure to file Section 8 affidavit occurred prior to commencement of proceeding and therefore not to avoid judgment.)

2. *See C.H. Guenther & Son, Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 n.4 (TTAB 1988).

536 Motion For Order to Show Cause Under 37 CFR § 2.128(a)(3)

37 CFR § 2.128(a)(3) *When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that plaintiff has lost interest in the case, judgment may be entered against plaintiff. If a plaintiff files a response to the order showing good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered against plaintiff for failure to take testimony or submit any other evidence.*

When a plaintiff fails to file a main brief on the case, it is the normal practice of the Board to issue, sua sponte, an order to show cause why the failure to file a brief should not be treated as a concession of the case. If such an order is not issued by the Board sua sponte, or if an adverse party finds that the Board has inadvertently overlooked a plaintiff's failure to file a main brief, the adverse party may file a motion for an order to show cause. In contrast, because a defendant in a Board inter partes proceeding is not obligated to file a brief, or, for that matter, to take discovery or offer testimony or other evidence, there is no procedure by which the Board will issue a show cause order based upon a defendant's failure to take discovery, offer testimony, or file a brief.

The principal purpose of 37 CFR § 2.128(a)(3) is to save the Board the burden of determining a case on the merits where the parties have entered into a final settlement of the matter, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is not the policy of the Board to enter judgment against a plaintiff for failure to file a main brief on the case if the plaintiff still wishes to obtain an adjudication of the case on the merits. [Note 1.] If a show cause order is issued under 37 CFR § 2.128(a)(3), and the plaintiff files a response indicating that it has not lost interest in the case, the show cause order will be discharged by Board order, and judgment will not be entered against plaintiff based on the presumption of lack of interest stemming from its failure to file a main brief. [Note 2.] Even if the show cause order is discharged, the plaintiff may not be accorded an opportunity to present a brief for consideration because a late-filed brief may not be accepted and the time for filing a brief may not necessarily be reset. [Note 3.] In addition, even if the show cause order is discharged, the plaintiff's claims may be dismissed if plaintiff placed no evidence in the record. In other words, even if a plaintiff avoids entry of judgment based on loss of interest, it may still face dismissal for failure to prosecute unless it files, and the Board grants, a motion to reopen the plaintiff's testimony period, and the plaintiff files admissible evidence or testimony during its reopened testimony period. *See* TBMP § 509.01(b)(1). If the plaintiff files no response to the show cause order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff. [Note 4.]

When the Board discharges a 37 CFR § 2.128(a)(3) order to show cause, plaintiff's time for filing its brief necessarily will have passed. Therefore, notwithstanding that plaintiff may have shown that it is still interested in having the Board decide the case on its merits, unless plaintiff has included with its response a motion to reopen its time for filing its brief, plaintiff may not have a second chance to file a brief. [Note 5.] If the plaintiff files a motion to reopen that is granted by the Board (based on plaintiff's showing of excusable neglect, or on consent, or because the motion is conceded), plaintiff will then be afforded an opportunity to file its main trial brief, and the Board will reset the times for filing that brief and all remaining briefs on the case. If, however, plaintiff included a copy of its brief with its motion to reopen, and the Board issues an order granting the motion and accepting the brief, then the Board will reset remaining briefing deadlines beginning with the deadline for defendant's brief. In instances where the show cause order has been discharged and the plaintiff has submitted its main brief without including a motion to reopen its time to file the main brief under Fed. R. Civ. P. 6(b)(1)(B), the plaintiff's main brief will be given no consideration, even if the defendant raises no objection thereto, and the Board may reset the times for filing remaining briefs beginning with the deadline for defendant's brief, if evidence is in the record. [Note 6.]

It is not unusual for a plaintiff to file a response to the Board's 37 CFR § 2.128(a)(3) order to show cause in a case in which the plaintiff cannot bear its burden of proof, regardless of whether the Board reopens the time for the plaintiff to file its brief. If the record shows (1) that plaintiff failed, during its testimony period, to take any testimony or offer any other evidence in its behalf, (2) that plaintiff failed to make (if applicable) a pleaded registration properly of record with its complaint, and (3) that defendant in its answer did not admit to any dispositive allegations, the Board, in lieu of reopening the briefing schedule, may proceed to enter judgment against plaintiff for failure to prove its case, absent the filing of, and granting of, a motion to reopen testimony brought by plaintiff. [Note 7.] Where plaintiff has made its pleaded registrations of

record and/or defendant has made admissions in its answer, the Board may make a determination without the need for defendant to file a brief. [Note 8.]

Thus, all times for filing briefs on the case will be reset, commencing with the deadline for plaintiff's main brief, only in instances where the plaintiff includes with its response to the show cause order a motion under Fed. R. Civ. P. 6(b)(1)(B) to reopen its time to file a main brief (*see* TBMP § 509), and the motion is granted (either on the merits, as consented or as conceded) and there is evidence in the record. In instances where plaintiff argues that it has established excusable neglect to reopen its testimony period without filing a formal motion under Fed. R. Civ. P. 6(b)(1)(B) to reopen, the Board may in its discretion set a time for defendant to file a response to the motion.

NOTES:

1. *See* NOTICE OF FINAL RULEMAKING, 48 Fed. Reg. 23122, 23132 (May 23, 1983); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1709-10 (TTAB 2011).

2. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011).

3. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011).

4. *See, e.g., CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (no response filed).

5. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710-11 (TTAB 2011).

6. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011) (explanation of briefing schedule had motion to reopen testimony and/or alternative motion to reopen time to file a brief been granted).

7. 37 CFR § 2.128(a)(3). *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (show cause order discharged but plaintiff failed to show excusable neglect to reopen case). *Cf. Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1704 (TTAB 2002) (judgment entered against opposer under 37 CFR § 2.132(a) where opposer's motion to reopen its testimony period denied for failure to establish excusable neglect).

8. *See Vital Pharmaceuticals, Inc. v. Kronholm*, 99 USPQ2d 1708, 17111-12 (TTAB 2011) (opposer's pleaded registrations of record with notice of opposition and applicant made limited admissions in its answer).

537 Motion For Leave to Exceed Page Limit For Brief On Case

37 CFR § 2.128(b) ***Briefs at final hearing.*** *... Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit. Any brief beyond the page limits and any brief with attachments outside the stated requirements may not be considered by the Board.*

Motions for leave to file a brief on the case in excess of the page limit are disfavored by the Board and rarely granted. Because the Board is an administrative tribunal of limited jurisdiction, empowered to determine only the right to register, very few of the cases before it are of such a nature as to require a brief on the case which exceeds the 37 CFR § 2.128(b) page limit. Further, one of the primary purposes of the rule is to assist the Board in managing its workload, and to encourage litigants to focus their arguments and eliminate needless verbiage. [Note 1.] Thus, a party seeking leave to file a brief on the case with more than the allowed number of pages must obtain "prior leave" from the Board to do so. [Note 2.] The motion must be submitted on or before the date that the brief is due. [Note 3.] This is so even in those cases where the motion is filed with the consent of the adverse party or parties. 37 CFR § 2.128(b) is for the benefit of the Board, and it is only with the Board's permission, timely sought, that a brief exceeding the page limit will be entertained.

The preferred practice, when a timely motion for leave to exceed the page limit is filed, is that the proposed over-length brief not be filed with the motion. If the moving party refrains from filing its brief with the motion, and the motion is granted, the Board in its decision on the motion will allow time for the filing of the brief and specify the number of additional pages granted. Alternatively, if the motion is denied, the Board, in its decision, will allow time for the filing of a brief that does not exceed the page limit specified in 37 CFR § 2.128(b). On the other hand, if the proposed overlength brief is filed with a timely motion, and the motion is granted, the Board will accept the brief. If a timely motion is denied, the overlength brief submitted with the motion will be given no consideration, and the Board will allow time for the filing of a brief that conforms to the page limit set out in 37 CFR § 2.128(b). [Note 4.]

A timely motion to exceed the specified page limit need not be accompanied by a motion to extend the time for filing the subject brief. As noted in the preceding paragraph, when the Board rules upon the motion to exceed the page limit, it will reset the due date for the brief which is the subject of the motion, along with the due dates for any remaining briefs on the case, whether or not the motion is granted.

If a party files a brief that exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken in its entirety, without leave to file a substitute brief that meets the limit. [Note 5.]

A motion for leave to file a brief exceeding the page limit is evaluated on the basis of the reasonableness of the request in light of such factors as the number of additional pages sought, the novelty and/or complexity of the issues in the case, the extent of the trial record, and any other relevant facts or circumstances that may serve to demonstrate why additional pages are necessary. [Note 6.] *Cf.* TBMP § 541.02.

For information concerning the parts of a brief that fall within the page limit, see TBMP § 801.03.

For information concerning the page limits for briefs on motions, see TBMP § 502.02(b). The Board generally does not extend page limits for briefs on motions.

NOTES:

1. *See First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1336 n.4 (TTAB 2005), *rev'd on other grounds*,476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007). *Cf. Fleming v. County of Kane*, 855 F.2d 496, 497 (7th Cir. 1988) (same concerns underlie appellate page limitations).

2. *See* 37 CFR § 2.128(b). *See, e.g., Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1604 n.4 (TTAB 1999).

3. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1542 (TTAB 1994).

4. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1542-43 (TTAB 1994) (filing overlength brief with motion is potentially disadvantageous as movant may end up having to redo brief if motion is denied).

5. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1543 (TTAB 1994).

6. *See United Foods Inc. v. United Air Lines Inc.* , 33 USPQ2d 1542, 1543 (TTAB 1994), (30-page reply brief unnecessary where main brief was 18 pages and responsive brief was 37 pages); and *U.S. Navy v. United States Manufacturing Co.* , 2 USPQ2d 1254, 1255 (TTAB 1987) (due to size of record, parties allowed to file overlength briefs). *Cf.* 37 CFR § 2.129(a).

538 Motion For Leave to File Amicus Brief

Amicus briefs are neither provided for nor prohibited in the rules governing practice in Board proceedings. Thus, the Board may, in its discretion, entertain an amicus brief if the Board finds that such a brief is warranted under the circumstances of a particular case. [Note 1.]

An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. The motion may be accompanied by the proposed brief. An amicus brief should be filed within the time allowed the party whose position the brief serves to support, unless all parties consent otherwise, or the Board, upon motion for good cause shown, permits a later filing. [Note 2.]

A motion for leave to file an amicus brief may not be used as a substitute for a timely notice of opposition or petition for cancellation.

Motions for leave to file an amicus brief are rarely filed in Board proceedings, and the granting thereof by the Board is even rarer. The Board will determine whether the proposed brief will aid the Board in resolving issues of law, whether the moving party is effectively seeking a role in the proceeding beyond arguing questions of law, and is effectively arguing factual matters, and whether any partisan arguments would prejudice a party to the proceeding. [Note 3.]

NOTES:

1. *See, e.g., Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998) (leave to file amicus brief denied as unnecessary to resolve issues which have been adequately addressed by parties); Federal Circuit Rule 29 (governing the filing of amicus briefs in appeals to the Court of Appeals for the Federal Circuit).

2. *Cf.* Federal Circuit Rule 29.

3. *See Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998) (motion denied where Board, noting "intimate" relationship between movants and petitioners, found that movants were seeking to introduce new evidence and advance partisan arguments).

539 Motion to Strike Brief On Case

The Trademark Rules of Practice specifically provide for the filing of briefs on the case, namely, the main brief of the party in the position of plaintiff, the answering brief of the party in the position of defendant, and the reply brief of the party in the position of plaintiff. [Note 1.] *See* TBMP § 801.02.

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it believes will be to its advantage. [Note 2.] Accordingly, when a brief on the case has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof. Rather, any objections that an adverse party may have to the contents of such a brief should be stated in a responsive brief, if allowed, and will be considered by the Board in its determination of the case, and any portions of the brief that are found by the Board to be improper will be disregarded.

However, if a brief on the case is not timely filed, or violates the length limit or other format requirements specified in 37 CFR § 2.128(b), it may be stricken, or given no consideration, by the Board. [Note 3.] *See* TBMP § 537 and TBMP § 801.03. If a brief is stricken because of a format violation, the Board may, in its discretion, allow the offending party time to submit a substitute brief complying with the requirements of 37 CFR § 2.128(b). *But see* TBMP § 537.

Because the rules do not provide for the filing of a surreply or rejoinder brief by a party in the position of defendant, any such brief will be stricken, or given no consideration, by the Board. [Note 4.]

Evidence may not be submitted with a brief, with the exception of a proper request for judicial notice. [Note 5.] Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party. If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike or otherwise. [Note 6.]

NOTES:

1. *See* 37 CFR § 2.128(a).

2. *See Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (motion to strike portions of plaintiff's trial brief denied; issues sought to be stricken are possible factors in considering likelihood of confusion and Board is capable of weighing relevance and strength or weakness of arguments presented in briefs).

3. 37 CFR § 2.128(b). *See Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250, 250 (TTAB 1972) (brief filed three weeks late stricken); *American Optical Corp. v. Atwood Oceanics, Inc.*, 177 USPQ 585, 586 (Comm'r 1973) (brief that was too long and not in proper form was not considered).

4. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.3 (TTAB 1993) (motion to strike portions of opposer's reply brief on the case given no consideration since motion was essentially attempt by applicant to file a surreply brief), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994) ; *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 863 n.3 (TTAB 1985) (defendant's rejoinder brief stricken). *See also Hydrotechnic Corp. v. Hydrotech International, Inc.*, 196 USPQ 387, 389 n.2 (TTAB 1977); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254, 255 n.2 (TTAB 1975); *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.4 (TTAB 1973).

5. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008).

6. *See, e.g., Lincoln National Corp. v. Anderson*, 110 USPQ2d 1271, 1274 n.5 (TTAB 2014) (evidence submitted for the first time with applicant's trial brief not considered); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to brief given no consideration); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978) (applicant's exhibits attached to its brief cannot be considered). *See also Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976) ("Evidence submitted by opposer for the first time with its brief has not been considered because it was not regularly made of record during its testimony period in chief or rebuttal testimony period."); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254, 255 (TTAB 1975) (same); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 589 n.1 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.3 (TTAB 1973).

540 Motion For Augmented Panel Hearing

"The Trademark Trial and Appeal Board shall include the Director, Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Director." [Note 1.] Each case before the Board is heard by a panel of at least three judges. [Note 2.] In addition, cases before the Board may be heard by panels including one or more of the above-noted senior executive officials of the USPTO. [Note 3.] Further, the Board may use an augmented panel to hear a case. [Note 4.] An augmented panel may include any number of Board judges exceeding three, that is, from four to the entire body of judges and one or more of the above-noted senior executive officials of the USPTO. [Note 5.]

A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding. A motion requesting that a case be heard by an augmented panel should be filed no later than the time for requesting an oral hearing on the case (i.e., no later than 10 days after the due date for the filing of the last reply brief in the proceeding- *see* 37 CFR § 2.129(a)).

An augmented panel is used by the Board only in extraordinary cases, involving precedent-setting issues of exceptional importance, or when consideration by an augmented panel is necessary to secure or maintain uniformity of Board decisions. [Note 6.]

NOTES:

1. Trademark Act § 17(b), 15 U.S.C. § 1067(b).

2. *See, e.g.,* 37 CFR § 2.129(a) and 37 CFR § 2.142(e)(1). *See also* Trademark Act § 17, 15 U.S.C. § 1067.

3. 37 CFR § 2.129(a)

4. *See, e.g., In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Section 7 grants Director the authority to designate the members of a panel and expanded panel including senior executive officials of the USPTO); *see also In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1215, 1220 (TTAB 2010) (augmented panel of five judges used in the disparagement case; two judges dissented); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1267 (TTAB 1995) (augmented panel of nine judges in announcing Board's policy with respect to cancellation premised on Trademark Act § 18, 15 U.S.C. § 1068); *In re Ferrero S.p.A.*, 22 USPQ2d 1800, 1800 (TTAB 1992) (augmented panel used to overrule previous

Board decision barring examining attorneys from requesting reconsideration), recon. denied, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1409 (TTAB 1988) (oral hearing held before augmented panel of eight Board members "[i]n view of the issues presented by this case"); *In re McDonald's Corp.*, 230 USPQ 210, 212 n.5 (TTAB 1986) (augmented five-member panel used for rehearing in consolidated cases); *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services).

5. For information concerning the constitution of USPTO Board panels, see *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Director has authority to constitute a new panel for purposes of reconsideration).

6. *See, e.g., In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010); *In re Active Ankle Systems, Inc.*, 83 USPQ2d 1532, 1534 (TTAB 2007); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1995); *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1409 (TTAB 1988); *In re McDonald's Corp.*, 230 USPQ 210, 212 n.5 (TTAB 1986); *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985). *See also* Federal Circuit Rule 35; and *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 909 n.1 (TTAB 1984) (augmented panel of eight-members because of the importance of the issues). *Cf. Fioravanti v. Fioravanti Corrado S.R.L.*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel) denying reconsideration of 230 USPQ 36 (TTAB 1986).

541 Motion to Change Oral Hearing Date; For Additional Time

541.01 Motion to Change Oral Hearing Date

If a party to a proceeding before the Board desires to present oral argument (i.e., oral hearing) at final hearing, including a case decided under Accelerated Case Resolution (ACR), *see* TBMP § 528.05(a)(2), the party must file a request therefor, by separate submission, not later than 10 days after the due date for the filing of the last reply brief in the proceeding. *See* TBMP § 802. When a request for an oral hearing is filed, the Board will issue an order acknowledging receipt of the request and allowing time for submission of several potential dates for the hearing, agreed upon by both parties. The response also should indicate whether either party will attend the oral hearing by video conference. The Board will then set the date and time for the hearing, and send each party written notice thereof. [Note 1.] Ordinarily, oral hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Time). The Board normally expects the parties, or their attorneys or other authorized representatives, to confer with each other to determine at least three convenient dates and times for the hearing within the foregoing parameters, and to provide that information to the Board with the request for oral hearing.

The date or time of an oral hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives if there is a reasonable basis for the request. Absent compelling circumstances, a hearing date will not be changed if the request for rescheduling is made within two weeks of the scheduled hearing date unless both parties agree to the change. [Note 2.] When parties agree to the resetting of an oral hearing, they should determine a new date and time convenient to every party and then contact the Board's Hearings and Decisions Specialist by phone, well prior to the scheduled hearing date, to request that the hearing be reset for the new date and time. The parties should also file a written stipulation or consented motion confirming their agreement. If parties agree to the resetting of an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations. If agreement cannot be reached, the party that wishes to have the hearing reset should file a motion therefor.

When one or more of the parties does not consent to the resetting of an oral hearing, the party that wishes to have the hearing reset must file a motion therefor, showing good cause. [Note 3.] *See* TBMP § 509. The motion should be filed well in advance of the scheduled hearing date. Further, to ensure that the motion is determined (by telephone conference call, if necessary) prior to the scheduled hearing date, the moving party should file its motion through ESTTA, and telephone the Board's Hearings and Decisions Specialist. *See* TBMP § 502.06(a). An unconsented motion to reset an oral hearing should not be filed merely because another date would be more convenient. The process of scheduling an oral hearing is a time-consuming task for the Board. Because of the inherent difficulties in arranging a date for an oral hearing, an unconsented motion to reset the hearing should be filed only for the most compelling reasons. Examples thereof include the onset of serious illness, nonelective surgery, death of a family member and similar unanticipated or unavoidable events. [Note 4.]

The Board may deny a request to reset a hearing date for lack of good cause or if multiple requests, including stipulations and consented requests, for rescheduling have been filed. [Note 5.]

For further information concerning oral hearings, see TBMP § 802.

NOTES:

1. *See* 37 CFR § 2.129(a).

2. *See* 37 CFR § 2.129(b).

3. *See* Fed. R. Civ. P. 6(b).

4. *See, e.g., In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule oral hearing three hours before hearing due to "a sudden conflict of time" denied).

5. 37 CFR § 2.129(b).

541.02 Motion For Additional Time For Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal. [Note 1.] *See* TBMP § 802.05. If, because of the novelty or complexity of the issues, the extent of the record, the presence of a counterclaim involving different issues than those involved in the original proceeding, etc., a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time. [Note 2.] Parties will note, however, that such motions are disfavored.

If the request is granted, each party will be allowed the same amount of time for oral argument. In addition, the panel hearing the oral argument may, during the course thereof, sua sponte extend the parties' time to present their arguments.

Ideally, a request for additional time should be included with the request for oral hearing. If a party determines after that time that it needs additional time for oral argument, the party should immediately call the Board and notify the Board that it intends to file a request for additional time. This early notification is necessary to ensure that there will be time in the Board's hearing schedule for an extended oral hearing, and also to ensure that the request will be considered and determined prior to the date of the oral hearing. *Cf.* TBMP § 541.01.

NOTES:

1. *See* 37 CFR § 2.129(a).

2. *See* 37 CFR § 2.129(a); *U.S. Navy v. United States Manufacturing Co.* , 2 USPQ2d 1254, 1225 (TTAB 1987) (additional time for arguments allowed in view of voluminous record). *Cf.* 37 CFR § 2.128(b).

542 Motion For Leave to Record Oral Hearing

Upon prior arrangement, the Board will usually permit a party to make an audio recording of an oral hearing. A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, an oral hearing before the Board may not be videotaped or otherwise electronically recorded. Any motion for leave to videotape an oral hearing will be denied.

Such a recording is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board).

Leave to make an audio recording of an oral hearing is secured by filing a motion therefor showing good cause (such as, that the audio recording is desired by the requesting attorney, or the requesting attorney's firm, for personal use in evaluating the performance of the attorney as an advocate). The motion should be filed well in advance of the date set for the oral hearing, so that if an adverse party raises any objections, the Board will have time to rule upon the motion prior to the oral hearing.

Where permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audio recording equipment in an unobtrusive manner.

In addition, parties seeking to remotely attend an oral hearing by means of one of the Board's hearing facilities that is capable of remote, electronic, attendance by a party or Board judge must contact by telephone the Board's Hearings and Decisions Specialist in order to schedule such attendance.

543 Motion For Reconsideration of Final Decision

37 CFR § 2.129(c) *Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within twenty days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.*

The filing of a request for rehearing, reconsideration, or modification of a decision issued after final hearing is governed by 37 CFR § 2.129(c). [Note 1.] *See* TBMP § 518.

There is no requirement that an adverse party file a brief in response to a request for rehearing, reconsideration, or modification of a decision issued after final hearing. However, it is the better practice to do so. [Note 2.] If a responsive brief is filed, it must be filed within 20 days from the date of service of the request.

Although 37 CFR § 2.129(c) makes no provision for the filing of a reply brief on a request for rehearing, reconsideration, or modification of a decision issued after final hearing, the Board may, in its discretion, consider such a brief. If a reply brief is filed, it must be filed within 20 days from the date of service of the responsive brief. [Note 3.]

Generally, the premise underlying a request for rehearing, reconsideration, or modification under 37 CFR § 2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence [Note 4.], nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. [Note 5.]

If a request for rehearing, reconsideration, or modification of a decision after final hearing is timely filed, the time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire sixty-three (63) days after action on the request. [Note 6.] *See* TBMP § 902.02 and TBMP § 903.04.

A second or subsequent request for reconsideration is not permitted, and if filed, does not toll the time for filing an appeal of the final decision or commencing a civil action.

NOTES:

1. *Cf.* 37 CFR § 2.127(b).

2. *See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 410, 411 (TTAB 1979) (serious questions raised by applicant's request for reconsideration ought to have generated response by opposer).

3. *See, e.g., Kappa Books Inc. v. Herbko International Inc.* , 60 USPQ2d 1765, 1766 n.2 (TTAB 2001) ("While there is no provision in the Trademark Rules of Practice for the submission of a reply brief in connection with a request for reconsideration (see Trademark Rule 2.127(b)), we have exercised our discretion and considered the reply brief in this case."), *rev'd on other grounds,* 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.* , 185 USPQ 61, *recon. denied* , 185 USPQ 176, 177 n.2 (TTAB 1975) (reply brief considered only to the extent it addressed arguments in responsive brief), *aff'd,* 530 F.2d 1396, 189 USPQ 138 (CCPA 1976). *See also* 37 CFR § 2.127(a).

4. *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126, 127-28 (TTAB 1978) (motion for reconsideration requesting introduction of survey evidence available during movant's testimony period denied).

5. For examples of cases in which a request for reconsideration of a decision after final hearing has been granted, see *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *reh'g granted*, 3 USPQ2d 1708, 1710 (TTAB 1984); *Cf. In re Kroger Co.*, 177 USPQ 715, 717 (TTAB 1973). *Cf. Conwood Corp. v. Loew's Theatres, Inc.*, 173 USPQ 829, 830 (TTAB 1972) (denying petition to reconsider).

6. *See* 37 CFR § 2.145(d)(1).

544 Motion For Relief From Final Judgment

Fed. R. Civ. P. 60(b) Grounds for Relief from a Final Judgment, Order, or Proceeding.

On motion and just terms, the court may relieve a party or its legal representative from a final judgment, order, or proceeding for the following reasons:

(1) *mistake, inadvertence, surprise, or excusable neglect;*

(2) *newly discovered evidence that, with reasonable diligence, could not have been discovered in time to move for a new trial under Rule 59(b);*

(3) *fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party;*

(4) *the judgment is void;*

(5) *the judgment has been satisfied, released, or discharged; it is based on an earlier judgment that has been reversed or vacated; or applying it prospectively is no longer equitable; or*

(6) *any other reason that justifies relief.*

Fed. R. Civ. P. 60(c)(1) Timing. *A motion under Rule 60(b) must be made within a reasonable time — and for reasons (1), (2), and (3) no more than a year after the entry of the judgment or order or the date of the proceeding.*

Fed. R. Civ. P. 6(b)(2) Extending Time; Exceptions *A court must not extend the time to act under Rules 50(b)* and *(d), 52(b), 59(b), (d), and (e), and60(b).*

Motions to set aside or vacate a final judgment rendered by the Board are governed by Fed. R. Civ. P. 60(b). [Note 1.] Thus, upon such terms as are just, the Board, on motion, may relieve a party from a final judgment for one of the reasons specified in Fed. R. Civ. P. 60(b).

Fed. R. Civ. P. 60(b), as made applicable by 37 CFR § 2.116(a), applies to all final judgments issued by the Board, including default and consent judgments, grants of summary judgments, and judgments entered after trial on the merits. As a practical matter, motions to vacate or set aside a final Board judgment are usually based upon the reasons set forth in subsections (1), (2) and/or (6) of Fed. R. Civ. P. 60(b).

For examples of cases involving a motion for a relief from a final judgment of the Board, see cases cited in the note below. [Note 2.]

A motion for relief from judgment must be made within a reasonable time; and if the motion is based on reasons (1), (2), and/or (3), it must be filed not more than one year after the judgment was entered – the time will not be extended. [Note 3.] The filing of the motion will not affect the finality of the judgment or suspend its operation. [Note 4.]

Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances or when other equitable considerations exist. [Note 5.] The determination of whether a motion under Fed. R. Civ. P. 60(b) should be granted is a matter that lies within the sound discretion of the Board. [Note 6.]

Where a motion for relief from judgment is made without the consent of the adverse party or parties, it must persuasively show (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in Fed. R. Civ. P. 60(b).

Because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) and Fed. R. Civ. P. 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments. [Note 7.] *See* TBMP § 312.03. Among the factors to be considered in determining a motion to vacate a default judgment for failure to answer the complaint are (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action. [Note 8.] *See* TBMP § 312.03.

If, in a cancellation proceeding, a petition to the Director is filed concurrently with a Fed. R. Civ. P. 60(b) motion to the Board for relief from judgment, and the petition and motion seek the same relief and require

review of the same set of facts, the Board will rule first upon the motion for relief from judgment. [Note 9.] If the Board grants the motion, the Director, as a ministerial act, will reinstate the subject registration. [Note 10.]

Where the parties are agreed that the circumstances warrant the vacating or setting aside of a final judgment, a stipulation or consented motion for relief from the judgment should be filed. The stipulation or consented motion should set forth in detail the reasons why the parties believe that the vacatur or setting aside of a judgment is warranted under one or more of the subsections of Fed. R. Civ. P. 60(b) or under the Board's general equitable authority. [Note 11.] The Board does not automatically approve such stipulations or consented motions, but independently determines whether vacatur is warranted. [Note 12.] **Please Note:** That the parties have agreed to vacatur does not, by itself, warrant vacatur of a Board decision on the substantive merits of a dispute under the Board's general equitable authority. [Note 13.] Where, however, the parties stipulate or agree that the judgment was entered by mistake or is unwarranted in light of newly-discovered evidence, the requested vacatur may be supportable under Fed. R. Civ. P. 60(b)(1) or 60(b)(2).

Occasionally, a party files a Fed. R. Civ. P. 60(b) motion with the Board contemporaneously with, or during the pendency of an appeal. The Board has jurisdiction to entertain the motion. If the Board determines that the motion is to be denied, it will enter the order denying the motion. Any appeal of the denial may be consolidated with the appeal of the underlying order. If the Board is inclined to grant the Fed. R. Civ. P. 60(b) motion, it will issue a short memorandum so stating. The movant can then request a limited remand from the appellate court for that purpose. [Note 14.]

NOTES:

1. *See* 37 CFR § 2.116(a); *see also Board of Trustees of the University of Alabama v. Pitts*, 115 USPQ2d 1099, 1102-03 (TTAB 2015) (motions for relief from judgment normally made under Fed. R. Civ. P. 60(b)).

2. *See 3PMC, LLC v. Huggins*, 115 USPQ2d 1488 (TTAB 2015) (following remand, granting relief from judgment by affirming Board's holding in *In re First Nat'l Bank of Boston*, 199 USPQ 296 (TTAB 1978) which held that the Board will not take cognizance of fractions of a day and will assume that an opposition and express abandonment, filed on the same day, were filed at the same instant, and therefore, concluding that application was not subject to an opposition when abandoned.); *Rolex Watch USA Inc. v. AFP Imaging Corp.*, 107 USPQ2d 1626 (TTAB 2013) (after remand, granting relief from judgment, under *United States Bancorp Mortgage Co. v. Bonner Mall Partnership*, 513 U.S. 18 (1994); *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009) (Fed. R. Civ. P. 60(b)(2) motion denied because registration not yet in existence at time of Board's decision not "newly discovered evidence;" motion not brought within reasonable time; and evidence relied upon merely cumulative or not of a type that would change the result); *Kraft Foods, Inc. v. Desnoes & Geddes Ltd.*, 64 USPQ2d 1154 (TTAB 2002) (motion for relief from judgment under Fed. R. Civ. P. 60(b)(4), Fed. R. Civ. P. 60(b)(5) and Fed. R. Civ. P. 60(b)(6) denied); *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (Fed. R. Civ. P. 60(b)(1) motion denied; counsel and client share duty "to remain diligent in prosecuting or defending the client's case") (finding that *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992) is no longer good law in light of the Supreme Court's decision in *Pioneer Investment. Services Co. v. Brunswick Associates. Ltd. Partnership*, 507 U.S. 380, 396-97 (1993)); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997) (Fed. R. Civ. P. 60(b)(1) motion granted; petitioner contributed to respondent's delay and confusion); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952-54 (TTAB 1997) (Fed. R. Civ. P. 60(b)(4) and Fed. R. Civ. P. 60(b)(6) motion, based on alleged failure to receive correspondence from Board, denied, given presumption of receipt of correspondence, passage of 12 years, and resulting hardship to third parties); *Consorzio del Prosciutto di*

Parma v. Parma Sausage Products Inc., 23 USPQ2d 1894, 1896 (TTAB 1992) (Fed. R. Civ. P. 60(b)(6) motion granted; petition withdrawn based on apparent acceptance by examining attorney of settlement agreement obviating basis for refusal of petitioner's applications); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted; respondent's failure to answer resulted from mistake due to involvement in numerous Board proceedings); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted; respondent's employees had limited knowledge of English and were unaware cancellation and opposition were separate proceedings). *Cf. In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r 1989) (denying petition to file a late response to Office action withholding decision on §§ 8 & 15 declaration where declarant was not registrant of record despite argument that attorney never so informed registrant).

3. *See* Fed. R. Civ. P. 60(b); Fed. R. Civ. P. 6(b)(2); *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093, 1094-96 (TTAB 2009) (Fed. R. Civ. P. 60(b)(2) motion based on registration that issued after cancellation was ordered was denied because the evidence was not new, because motion was not filed until 6 months after new registration issued); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) based on excusable neglect was timely when filed only 15 days after entry of default judgment); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (Fed. R. Civ. P. 60(b)) motion denied as untimely where judgment was entered under 37 CFR § 2.135 and applicant was mistaken as to consent to abandonment by opposer but delayed over a year to file motion).

4. *See* Fed. R. Civ. P. 60(c).

5. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991).

6. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991); *see also Board of Trustees of University of Alabama v. Pitts*, 115 USPQ2d 1099, 1104 (TTAB 2015) (where opposer did not invoke Fed. R. Civ. P. 60(b), opposer's request for vacatur was assessed under the Board's "general equitable authority" because vacatur is an equitable remedy) (citing *U.S. Bancorp Mortg. Co. v. Bonner Mall Partnership*, 513 U.S. 18, 26-27 (1994)) (further citations omitted).

7. *See Information Sys. and Networks Corp. v. United States*, 994 F.2d 792, 795 (Fed. Cir. 1993) ("Rule 60(b) is applied most liberally to judgments in default.") (quoting *Seven Elves, Inc. v. Eskenazi*, 635 F.2d 396, 403 (5th Cir. 1981)).

8. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted pending showing of meritorious defense where other two elements were established); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1155-56 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted; excusable neglect shown where respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings, potential defense was meritorious, and no substantial prejudice to opposing party). *Compare Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952-54 (TTAB 1997) (Fed. R. Civ. P. 60(b)(6) motion denied as untimely when filed 12 years after cancellation; (Fed. R. Civ. P. 60(b)(4) motion denied because judgment was not void).

9. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61, 61-62 (Comm'r 1985).

10. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61, 62 (Comm'r 1985).

11. *See Board of Trustees of University of Alabama v. Pitts*, 115 USPQ2d 1099, 1102-04 (TTAB 2015) (denying an opposer's unopposed request for vacatur pursuant to an agreement settling opposer's district court case, under 15 U.S.C. § 1071(b), challenging the Board's dismissal of opposition, where opposer's request did not rest upon any provisions of Fed. R. Civ. P. 60(b), nor had opposer demonstrated exceptional circumstances or any other equitable considerations warranting the use of the Board's general equitable authority to issue vacatur orders). *Cf. Ballet Tech Found. Inc. v. The Joyce Theater Found. Inc.*, 89 USPQ2d 1262 (TTAB 2008) (consolidated Opposition No. 91180789 and Cancellation No. 92042019) (not a precedent), final judgment vacated as moot upon settlement on appeal, *Ballet Tech Found. Inc. v. The Joyce Theater Found. Inc.*, (TTAB November 14, 2013) (vacatur was necessary to prevent cancellation of Respondent's registrations and allow its application for registration to go forward.).

12. *See* TBMP §501.01 (stipulations subject to Board approval).

13. *Cf. U.S. Bancorp Mortg. Co. v. Bonner Mall Partnership*, 513 U.S. 18, 29 (1994) (under 28 U.S.C. § 2106, "mootness by reason of settlement does not justify vacatur of a judgment under review" in the absence of "exceptional circumstances") (cited in *Board of Trustees of University of Alabama v. Pitts*, 115 USPQ2d 1099, 1102 (TTAB 2015)). The Board also applies its equitable discretion to party-agreed vacaturs entered in the form of signed consent judgments in civil actions contesting Board decisions. The Board generally will give effect to such vacaturs only if they reflect the court's resolution of the dispute on the merits. But the Board generally will not give effect to party-agreed vacaturs in consent judgments that reflect only the parties' agreement to settle the dispute. Compare *United States v. City of Detroit*, 329 F.3d 515, 523-24 (6th Cir. 2003) (en banc) (agreed vacatur of decision of lower tribunal was appropriate because it reflected parties' agreement on a critical fact upon which liability turned) with *Ass'n for Retarded Citizens of Conn., Inc. v. Thorne*, 30 F.3d 367, 370 (2d Cir. 1994) (where agreed vacatur in consent judgment reflected only parties' agreement to settle and did not reflect an agreed adjudication on the merits, the vacatur bound only the parties themselves). *See also* 15 U.S.C. § 1071(b)(1) (empowering district courts to review Board decisions by "adjudg[ing]" certain matters); 5 U.S.C. § 706 (requirement for any court review of an agency decision is that the reviewing court "shall review the whole record or those parts of it cited by a party"). The Federal Circuit, the Board's primary reviewing court, generally does not enter consented orders requiring the Board to vacate the decision on review, but instead usually remands the case back to the Board for initial determination of whether vacatur is appropriate. *See In re Carmine's Broadway Feast Inc.*, 423 F. App'x 981 (Fed. Cir. 2011) (citing *U.S. Bancorp*, 513 U.S. at 29); *MidAmerican Energy Co. v. Mid-America Energy Resources, Inc.*, 250 F.3d 754 (Fed. Cir. 2000) (table), (citing *U.S. Bancorp*, 513 U.S. at 29).

14. *See Home Products International v. U.S.*, 633 F.3d 1369, 1378 n.9 (Fed. Cir. 2011); *Pramil S.R.L. v. Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009).