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## STIPULATIONS AND MOTIONS

### 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 to extend or reopen times; that the total number of interrogatories which one party may serve upon another party in a proceeding may exceed the limitation specified in 37 CFR §2.120(d)(1); that the production of documents and things under the provisions of FRCP 34 may be made in a specified place and/or manner (*see* 37 CFR §2.120(d)(2)); to protective orders (*see* TBMP §416.02); to the facts in the case of any party (*see* 37 CFR §2.123(b)); that the testimony of witnesses may be submitted in affidavit form (*see* 37 CFR §2.123(b)); that a deposition may be taken at a particular place, or in a certain manner (*see* 37 CFR §2.123(b)); that the proceeding shall be ended in a specified way (*see* TBMP §605.03]; etc.

#### 501.02 Filing Stipulations

Stipulations which require action or consideration by the Board, such as stipulations to extend a defendant's time to file an answer to the complaint, stipulations to extend trial dates, stipulations relating to the form of testimony, stipulations to end a proceeding in a specified way, etc., must be filed with the Board. 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 which does not have to be filed, the better practice is to at least reduce the stipulation to writing, in order to avoid any misunderstanding between the parties as to the existence and terms thereof.

#### 501.03 Form of Stipulation

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

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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. 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. *See* 37 CFR §2.121(d), and *Jan Bell Marketing Inc. v. Centennial Jewelers Inc.*, 19 USPQ2d 1636 (TTAB 1990). Further, any stipulation to extend or reopen a time or times should be filed in multiple form, i.e., one copy of the stipulation for the Board proceeding file, plus as many additional copies as there are parties, so that if the stipulation is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party. *See* 37 CFR §§2.102(d) and 2.121(d), and *Jan Bell Marketing Inc. v. Centennial Jewelers Inc.*, *supra*.

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 approved by the Board, or upon motion granted by the Board, or by order of the Board. *See* 37 CFR §2.121(a), and TBMP §403.04.

### **502 Motions--In General**

#### **502.01 Available Motions**

There is a wide range of motions which may be filed in inter partes proceedings before the Board. Rule 2.116(a), 37 CFR §2.116(a), provides that "except 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, most 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 and 702.

For example, the Board does not preside at the taking of testimony. Instead, all 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. *See*

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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. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985); *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981); *New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co.*, 207 USPQ 954 (TTAB 1980); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 182 USPQ 572 (Comm'r 1974); *Clairol Inc. v. Holland Hall Products, Inc.*, 161 USPQ 616 (TTAB 1969); and *Cities Service Oil Co. v. Perfection American, Inc.*, 157 USPQ 209 (TTAB 1968). Therefore, the Board entertains only two motions for judgment relating to the sufficiency of trial period evidence, namely, the 37 CFR §§2.132(a) and (b) motions for involuntary dismissal for failure of the plaintiff to take testimony (for information concerning these motions, *see* TBMP §535). The motion under FRCP 41(b) for involuntary dismissal, and the motion under FRCP 50(a) for a directed verdict, are not available in Board proceedings. *See Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985); *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985); *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52 (TTAB 1983), *aff'd*, *Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984); *Cities Service Oil Co. v. Perfection American, Inc.*, 157 USPQ 209 (TTAB 1968); and Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983).

Although it would be impractical to try to discuss every motion which might be filed in an inter partes proceeding before the Board, this chapter includes discussions of those motions which most commonly arise in Board proceedings.

### 502.02 Form of Motions

**37 CFR §2.127(a)** *Every motion shall be made in writing, shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. ...*

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Every motion must conform to the requirements of 37 CFR §2.127(a). 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 motion which does not bear the correct proceeding number may never be associated with the file of the proceeding for which it is intended (and hence may never be considered by the Board).

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. *See* 37 CFR §2.119(e), and TBMP §106.02.

The certificate of mailing by first-class mail procedure provided under 37 CFR §1.8, and the certificate of "Express Mail" procedure provided under 37 CFR §1.10, are both available for the filing of motions. *See* 37 CFR §§1.8 and 1.10, and TBMP §§110 and 111.

Except as noted below, only one copy of a motion need be filed with the Board. 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. *See* 37 CFR §§2.119(a) and 2.119(b), and TBMP §113.

In the case of a consented motion to extend, or reopen, a time or times, the motion should specify the closing date for each rescheduled time. A consented motion to extend, or reopen, testimony periods, or the discovery period and testimony periods, should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. Further, any consented motion to extend, or reopen, a time or times should be filed in multiple form, i.e., one copy of the motion for the Board proceeding file, plus as many additional copies as there are parties, so that if the motion is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party. *See* 37 CFR §§2.102(d) and 2.121(d), and TBMP §§501.03 and 509.02. *Cf.* TBMP §403.03.

An unconsented motion to extend, or reopen, should be filed in single (not multiple) form. If the motion seeks an extension, or a reopening, of a testimony period or periods, or of the discovery period and testimony periods, it is preferable

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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.

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

### 502.03 Briefs on Motions

Every motion must embody or be accompanied by a brief. *See* 37 CFR §2.127(a).

Briefs on motions should not be filed in bound form. *See* TBMP §106.03.

A brief in response to a motion must be filed within 15 days from the date of service of the motion (20 days if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)), 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. *See* 37 CFR §2.127(a); FRCP 6(b); and TBMP §509.

If a party fails to file a brief in opposition to a motion, the Board, in its discretion, may treat the motion as conceded. *See*, for example, 37 CFR §2.127(a); *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (CCPA 1980); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990); *Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc.*, 223 USPQ 176 (TTAB 1984); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313 (TTAB 1976); *General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc.*, 189 USPQ 425 (TTAB 1975); *Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478 (TTAB 1975); *Gibson Greeting Cards, Inc. v. Associated Crafts, Inc.*, 182 USPQ 625 (TTAB 1974); and *Joy Manufacturing Co. v. Robbins Co.*, 181 USPQ 408 (TTAB 1974).

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There is no provision in the Trademark Rules of Practice for the filing of reply briefs on motions. On the other hand, they are not expressly prohibited. Thus, while the Board generally discourages the filing of reply briefs on motions (*see SDT Inc. v. Petterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991); *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); and *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987)), the Board may, in its discretion, entertain a reply brief if the Board finds that such a brief is warranted under the circumstances of a particular case. For example, the Board may entertain a reply brief if, in the Board's opinion, such a brief is necessary to permit the moving party to respond to new issues raised in, or new materials submitted with, an adversary's brief in opposition to the motion; or the issue to be determined is complex or needs to be further clarified; or certain arguments against the motion should be answered so as to assist the Board in arriving at a just conclusion on the motion. *See Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991); *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862 (TTAB 1991); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); *Avon Products, Inc. v. MarCon, Ltd.*, 225 USPQ 977 (TTAB 1985); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974); and *Goodyear Tire & Rubber Co. V. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974).

Because the Trademark Rules of Practice do not provide for the filing of reply briefs on motions, no time limit therefor is specified. However, when a reply brief is filed, it should be filed as promptly as possible; otherwise, the motion may be determined by the Board before the reply brief is received. At the very least, a reply brief should be filed within the time allowed for filing other responsive briefs on motions, i.e., within 15 days from the date of service of the paper to which the brief responds (20 days if service of the paper to which the brief responds was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)), 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. *See* 37 CFR §2.127(a), and *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 229 USPQ 860 (TTAB 1986), *rev'd on other grounds*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). *See*

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*also Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991), and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990).

### 502.04 Oral Hearings on Motions

An oral hearing is not held on a motion except by order of the Board. *See* 37 CFR §2.127(a). 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 issue or issues to be decided. Ordinarily, arguments on a motion may be adequately presented in the briefs thereon. Thus, the Board rarely grants a request for an oral hearing on a motion. *See Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660 (TTAB 1983); *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973); *Bacardi & Co. v. Ron Castillo, S.A.*, 178 USPQ 242 (TTAB 1973); *Electric Storage Battery Co. v. Mine Safety Appliances Co.*, 140 USPQ 671 (TTAB 1963); and *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 124 USPQ 343 (TTAB 1960), *rev'd on other grounds*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962). *Cf. Federal Trade Commission v. Formica Corp.*, 200 USPQ 182 (TTAB 1978) (request for oral hearing on motion granted).

### 502.05 Determination of Motions

**37 CFR §2.127(c)** *Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Member of the Trademark Trial and Appeal Board or by an Attorney-Examiner of the Board to whom authority so to act has been delegated.*

Interlocutory motions which are not actually or potentially dispositive of a proceeding may be acted upon by a single Board administrative trademark judge (formerly referred to as a Board member), or by a single interlocutory attorney to whom such authority has been delegated. *See* 37 CFR §2.127(c), and TBMP

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§102.03. Motions which are actually or potentially dispositive of a proceeding are determined by a panel of at least three Board members. *See* Section 17 of the Act, 15 U.S.C. §1067. For information concerning the remedies available to a party which is dissatisfied with a decision on a motion, *see* TBMP §518. *See also* TBMP §905.

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), 2.114(c), 2.134(a), or 2.135). Ordinarily, a consented motion will be granted by the Board.

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 motion may be granted by the Board as conceded. *See* 37 CFR §2.127(a), and TBMP §502.03.

If a motion is contested by the nonmoving party, the Board will decide the motion on its merits.

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

### **502.06 Attorneys' Fees, etc., on Motions**

The Board does not have authority to hold any person in contempt, or to award attorneys' fees, other expenses, or damages to any party. *See generally* 37 CFR §§2.120(f); 2.120(g)(1); 2.120(h); and 2.127(f). *See also Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993); *Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990); *Fort*

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*Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191 (TTAB 1984); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

### **502.07 Telephone and Pre-Trial Conferences**

#### **502.07(a) Telephone Conferences**

**37 CFR 2.120(i)(1)** *Whenever it appears to the Trademark Trial and Appeal Board that a motion filed in an inter partes proceeding is of such nature that its resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, resolve the motion by telephone conference.*

Under the circumstances described in 37 CFR §2.120(i)(1), a motion filed with the Board may be resolved by telephone conference call involving the parties or their attorneys and an interlocutory attorney, or an administrative trademark judge, of the Board. *See* 37 CFR §2.120(i)(1). *See also* *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991) *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990); *Fort Howard Paper Co. V. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1553 (TTAB 1987); and Abraham Bogorad, *The Impact of the Amended Rules Upon Discovery Practice Before the Trademark Trial and Appeal Board*, 66 Trademark Rep. 28, 37 (1976). Immediately after the resolution of a motion by telephone conference, the Board will issue a written order confirming its decision on the motion.

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. However, the Board will not resolve a motion by telephone conference until a copy of the motion has been received by the Board. A copy of the motion should also have been received by every other party to the proceeding.

To expedite matters, the moving party may hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned. Alternatively, if the motion has been filed with the Board by some (acceptable) method other than hand delivery to the interlocutory attorney, but has not yet

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actually been received by the Board and/or entered in the proceeding file for which it is intended, the moving party may call the interlocutory attorney and request permission to fax a copy of the motion to the Board. *See* TBMP §107.

### **502.07(b) Pre-trial Conferences**

*37 CFR §2.120(i)(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 be likely to be facilitated by a conference in person of the parties or their attorneys with a Member or Attorney-Examiner of the Board, the Board may, upon its own initiative or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a pre-trial conference.*

Because the pre-trial 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 (particularly if there is such hostility between the parties and/or their attorneys that they are unable to work out a resolution of any of their differences). *See* Abraham Bogorad, *The Impact of the Amended Rules Upon Discovery Practice Before the Trademark Trial and Appeal Board*, 66 Trademark Rep. 28, 37 (1976).

### **502.08 FRCP 11 Applicable**

For information concerning the applicability of the provisions of FRCP 11 to motions filed in proceedings before the Board, *see* TBMP §529.01.

## **503 Motion to Dismiss for Failure to State a Claim**

### **503.01 Time for Filing**

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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. *See* FRCP 12(b); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1871 (TTAB 1994); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990); and *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). 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. *See William & Scott Co. v. Earl's Restaurants Ltd.*, *supra*.

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 Hollowform, Inc. v. Delma Aeh, supra*. If the motion is filed before the movant's answer, and is denied, the Board will reset the time for filing an answer.

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, or by a motion for summary judgment. *See* FRCP 12(h)(2), and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1357 (1990). *See also Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990).

### 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. *See, for example, Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985). In order to withstand such a motion, a pleading 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 cancelling the subject registration (in the case of a cancellation proceeding). *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v.*

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*Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985); and *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512 (TTAB 1984).

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not respond by submitting proofs in support of its pleading. 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. See *Caron Corp. v. Helena Rubinstein, Inc.*, 193 USPQ 113 (TTAB 1976); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); and *Syndicat de la Parfumerie Francaise v. Scaglia*, 173 USPQ 383 (TTAB 1972). Cf. *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, *supra*; *Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *Stanspec Co. v. American Chain & Cable Co.*, *supra*; *Kelly Services Inc. v. Greene's Temporaries Inc.*, *supra*; *Space Base Inc. v. Stadis Corp.*, *supra*; *Stabilisierungsfonds fur Wein v. Zimmermann-Graeff KG*, 199 USPQ 488 (TTAB 1978); and *National Ass'n of Blue Shield Plans v. Standard Mattress Co.*, 176 USPQ 29 (TTAB 1972).

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 liberally, as required by FRCP 8(f), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to

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the relief sought. *See Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993); *Delta Tire Corp. v. Sports Car Club of America, Inc.*, 186 USPQ 431 (TTAB 1975); and *National Semiconductor Corp. v. Varian Associates*, 184 USPQ 62 (TTAB 1974).

### 503.03 Leave to Amend Defective Pleading

A plaintiff may amend its complaint once as a matter of course at any time before an answer thereto is served, and may amend its complaint thereafter with the written consent of every adverse party or by leave of the Board, which is freely given when justice so requires. *See* TBMP §507.02. 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 the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot.

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. *See, for example, Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985); and *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

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. *See, for example, FRCP 15(a); Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984) (amendment would serve no useful purpose); and *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985) (plaintiff had been allowed two opportunities to perfect its pleading, and it would not be in the interests of justice to allow further leave to amend). *Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986); and TBMP §507.02.

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### 503.04 Matters Outside the Pleading

If, on a motion to dismiss for failure to state a claim upon which relief can be granted, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under FRCP 56. Ordinarily, the parties to the proceeding will be notified that the motion to dismiss is being treated as a motion for summary judgment, and they will be given reasonable opportunity to present all material made pertinent to such a motion by FRCP 56. *See, for example*, FRCP 12(b); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985); and *Exxon Corp. v. National Foodline Corp.*, 196 USPQ 444 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978). *Cf. Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988).

Such notice may be unnecessary, however, in those cases 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. *See Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983).

### 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. *See* FRCP 12(c). In Board inter partes proceedings, 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. *See* 37 CFR §2.116(e); *Von Schorlemer*

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*v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986); and *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976). Thus to be timely, a motion for judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period, as originally set or as reset. *Cf.* 37 CFR §2.127(e)(1); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, supra*; *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299 (TTAB 1986), *aff'd*, *Vesper Corp. v. Lukens Inc.*, 831 F.2d 306 (Fed. Cir. 1987); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *La Maur, Inc. v. Bagwells Enterprises, Inc., supra*; *Peterson's Ltd. v. Consolidated Cigar Corp.*, 183 USPQ 559 (TTAB 1974); and *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 182 USPQ 572 (Comm'r 1974).

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 trial, the motion may be construed by the Board as a motion for judgment on the pleadings. *See Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990). *Cf.* TBMP §503.01.

### 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. *See 2A Moore's Federal Practice* ¶12.15 (2d ed. 1985).

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 which have been denied (or which are taken as denied, pursuant to FRCP 8(d), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); *2A Moore's Federal Practice* ¶12.15 (2d ed. 1985); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1367 *et seq.* (1990). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *See Baroid Drilling Fluids Inc. v. Sun Drilling Products, supra*; *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992); and Wright & Miller, *supra*.

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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. *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); 2A *Moore's Federal Practice* ¶12.15 (2d ed. 1985); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1367 *et seq.* (1990).

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. *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992), and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1368 (1990).

### 504.03 Matters Outside the Pleadings

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 FRCP 56. 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 reasonable opportunity to present all material made pertinent to such a motion by FRCP 56. *See* FRCP 12(c), and *Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); and *Exxon Corp. v. National Foodline Corp.*, 196 USPQ 444 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978).

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

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motion on that basis. *See Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983).

### **505 Motion for a More Definite Statement**

#### **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. *See* FRCP 12(e), and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1376 (1990). *Cf. CBS Inc. v. Mercandante*, 23 USPQ2d 1784, at fn.8 (TTAB 1992). 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. *See* FRCP 12(e), and Wright & Miller, *supra*, at §1378.

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. *See* Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1376-1377 (1990). 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 FRCP 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. *See* Wright & Miller, *supra*, at §1376.

A motion for a more definite statement may not be used to obtain discovery. The only information which a movant may obtain by this motion is that which it needs to make its responsive pleading. *See* 2A *Moore's Federal Practice* ¶12.18[1] (2d ed. 1985), and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1376-1377 (1990).

#### **505.02 Time for Filing**

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A motion for a more definite statement, if filed, must be filed within the time for, and before, the moving party's responsive pleading. *See* FRCP 12(e), and 2A *Moore's Federal Practice* ¶12.19 (2d ed. 1985). 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. *See Moore's Federal Practice, supra.*

### **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. *See* FRCP 12(e).

### **506 Motion to Strike Matter From 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. *See* FRCP 12(f).

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973); 2A *Moore's Federal Practice* ¶12.21[2] (2d ed. 1985); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* §1380 (1990). The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See* TBMP §§312.03 and 318.02(b); *Harsco Corp. v. Electrical Sciences Inc.*, *supra*; and *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985). *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). 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. *See Harsco Corp. v.*

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*Electrical Sciences Inc., supra*, and *Moore's Federal Practice, supra*. 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. *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828 (TTAB 1994).

Nevertheless, the Board grants motions to strike in appropriate cases. *See, for example, American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (insufficient affirmative defenses stricken); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (pleaded ground for cancellation stricken because not available, respondent's registration being more than five years old); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988) (immaterial allegation stricken; however, other allegations which bore directly on issues in case, were not prejudicial to defendant, and gave defendant more complete notice of plaintiff's claim, not stricken); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822 (TTAB 1984) (affirmative defense stricken because identical to counterclaim asserted in same case); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977) (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim asserted in same case); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794 (TTAB 1974) (complaint stricken for failure to comply with requirement of FRCP 10(b) that each numbered paragraph be limited to a single set of circumstances, but plaintiff allowed opportunity to submit substitute complaint); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152 (TTAB 1973) (allegations in answer which merely reiterated denial of likelihood of confusion without adding anything of substance thereto stricken as redundant; however, other allegations which amplified the denial of likelihood of confusion, and thus served to apprise plaintiff with greater particularity of defendant's position, not stricken); *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973) (affirmative defense attacking validity of plaintiff's pleaded registration stricken since such an allegation may be entertained only if presented as counterclaim); *S. C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973) (affirmative defense of failure to state a claim upon which relief can be granted stricken since complaint did state such a claim); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959) (recital of evidentiary material, namely, list in defendant's pleading of more than 50 asserted third-party registrants and users, stricken). *Cf. Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973) (allegations pertinent to the issues in the case not stricken).

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### 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. *See* FRCP 12(f), and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990). If a motion to strike matter from a complaint is filed with an answer to the complaint, the motion to strike is construed by the Board as having been filed first.

If no responsive pleading is required, the motion should be filed within 20 days after service upon the moving party of the pleading which is the subject of the motion (25 days, if service of the pleading was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)). *See* FRCP 12(f). *See also* *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992).

However, the Board, upon its own initiative, and at any time, may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See* FRCP 12(f). Thus, the Board, in its discretion, may entertain an untimely motion to strike matter from a pleading. *See* 2A *Moore's Federal Practice* ¶12.21[1] (2d ed. 1985); Wright & Miller, *Federal Practice and Procedure: Civil* 2d §1380 (1990); *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990).

### 506.03 Exhibits Attached to Pleadings

Exhibits submitted with pleadings will not be stricken by the Board since they are clearly contemplated by 37 CFR §§2.104(a), 2.105, 2.112(a), 2.113, and 2.122(c). However, except for status and title copies 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 in behalf of the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period. *See* 37 CFR §2.122(c), and TBMP §313.

### 507 Motion to Amend Pleading

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### 507.01 In General

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See* TBMP §§312.03, 318.02(b), 506.01, and cases cited in the foregoing sections. *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). Claims or defenses which are not asserted in the pleadings as originally filed, or as amended or deemed amended, will not be entertained by the Board. *See* TBMP §321, and cases cited therein.

Amendments to pleadings in inter partes proceedings before the Board are governed by FRCP 15. *See* 37 CFR §§2.107, 2.115, and 2.116(a). Amendments in general are governed by FRCP 15(a). Amendments to conform the pleadings to trial evidence are governed by FRCP 15(b).

A motion for leave to amend a pleading should be accompanied by a signed copy of the proposed amended pleading. *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

### 507.02 Amendments--General Rule--FRCP 15(a)

A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course at any time before a responsive pleading is served. If the pleading is one to which no responsive pleading is permitted, it may be amended once as a matter of course at any time within 20 days after it is served. *See* FRCP 15(a). An amendment filed as a matter of course need not be accompanied by a motion for leave to amend. *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; leave must be freely given when justice so requires. *See* FRCP 15(a). 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. *See, for example, Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *United States*

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*Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240 (Comm'r 1990); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990); *Marmark Ltd. v. Nutrexp S.A.*, 12 USPQ2d 1843 (TTAB 1989); *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395 (TTAB 1989); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974); *Johnson & Johnson v. Cenco Medical Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint (*see, for example Marmark Ltd. v. Nutrexp S.A.*, 12 USPQ2d 1843 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Gemini Engine Co. v. Solar Turbines Inc.*, 225 USPQ 620 (TTAB 1985); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974); and *Johnson & Johnson v. Cenco Medical Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973)), including a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint (*see Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240 (Comm'r 1990); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *Cudahy Co. v. August Packing Co.*, 206 USPQ 759 (TTAB 1979)).

The timing of a motion for leave to amend under FRCP 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. *See Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205 (TTAB 1993) (amendment by opposer, just after close of discovery, to assert res judicata, based on a judgment entered in another

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case after the filing of the subject opposition, would not be unfair, since applicant has been afforded adequate notice, and no further discovery will be necessary); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (no prejudice to applicant--discovery still open when motion filed, and opposer agreed to allow applicant further time for follow-up discovery on new claim); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993) (applicant would not be prejudiced because proceeding still in pre-trial stage and discovery had been extended); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (where opposer filed motion to amend its pleading during its testimony period, motion nevertheless granted since the interests of justice and judicial economy would best be served thereby, and since any prejudice suffered by applicant could be mitigated by reopening discovery solely for applicant); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990) (ordinarily, leave to amend should be granted whenever, inter alia, doing so will not unduly delay trial--here, proceeding was still in the discovery stage, and respondent had not shown that any undue prejudice would result from the amendment of the petition to cancel); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (since cases were still in the discovery stage, respondent would not be prejudiced by allowance of amendment); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (no substantial prejudice to applicant by allowance of amendment--proceeding remained in a fairly early stage); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had as yet taken testimony); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975) (since proceeding was still in the pre-trial stage, amendment of the pleadings could not prejudice opposer); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) (since, inter alia, the trial period had not yet commenced, no prejudice to applicant); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974) (applicant would not be unduly prejudiced by entry of the proposed amendment since no testimony had as yet been taken); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971) (where applicant filed motion to amend its pleading after the close of opposer's testimony period, but before the opening of applicant's testimony period, Board found that opposer would not be prejudiced by entry of the amendment if, inter alia, opposer was allowed to take discovery thereon); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). Cf. *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (where plaintiff filed motion to amend after close of its testimony period, motion

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denied as untimely to extent it sought amendment under FRCP 15(a)); and *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982) (opposer's motion to amend to rely on 8 additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed, and the discovery period had already been extended several times at opposer's request--allowance of the amendment at that late date would be prejudicial to applicant).

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. 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, but after answer, 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. See 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i); TBMP §319.04, and cases cited therein; and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

In granting a motion for leave to amend under FRCP 15(a), the Board may, in its discretion, reopen the discovery period so as to avoid any prejudice to the adverse party by reason of the amendment. See *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

A proposed amendment need not of itself set forth a claim or defense; a proposed amendment may serve simply to amplify allegations already included in the moving party's pleading. See *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973). 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. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987); *American Hygienic Labs, Inc.*

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*v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986); and *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977). Cf. TBMP §503.03.

### **507.03 Amendments to Conform to the Evidence--FRCP 15(b)**

#### **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, and will do so freely when the presentation of the merits of the case will be subserved 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. See FRCP 15(b), and *Ercona Corp. v. JENAer Glaswerk Schott & Gen.*, 182 USPQ 573 (TTAB 1974).

The motion for leave to amend should be filed promptly after the objection is made. See Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). 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 which was the subject of the objection. See FRCP 15(b). Cf. *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); and *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (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, the Board will treat them in all respects as if they had been raised in the pleadings. 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. See, for example, FRCP 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978);

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*Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1993); *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600 (TTAB 1987); *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984); *Color Key Corp. v. Color I Associates, Inc.*, 219 USPQ 936 (TTAB 1983); *ABC Moving Co. v. Brown*, 218 USPQ 336 (TTAB 1983); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748 (TTAB 1978); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977); *Bekaert Steel Wire Corp. v. S.p.A. Officine Maccaferri Gia' Raffaele Maccaferri & Figli*, 196 USPQ 558 (TTAB 1977); *Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc.*, 190 USPQ 158 (TTAB 1976); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); *Dap, Inc. v. Litton Industries, Inc.*, 185 USPQ 177 (TTAB 1975); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973), *aff'd without opinion*, *Uptowner Inns, Inc. v. Downtowner Corp.*, 508 F.2d 847, 183 USPQ 427 (CCPA 1974); *Smith Kline & French Laboratories v. USV Pharmaceutical Corp.*, 175 USPQ 666 (TTAB 1972); *Conwood Corp. v. Loew's Theatres, Inc.*, 173 USPQ 829 (TTAB 1972); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

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. *See, for example, Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600 (TTAB 1987); *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985); *Color Key Corp. v. Color I Associates, Inc.*, 219 USPQ 936 (TTAB 1983); *ABC Moving Co. v. Brown*, 218 USPQ 336 (TTAB 1983); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982); *Marcal Paper Mills, Inc. v. American Can Co.*, 212

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USPQ 852 (TTAB 1981); *Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc.*, 190 USPQ 158 (TTAB 1976); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973), *aff'd without opinion*, *Uptowner Inns, Inc. v. Downtowner Corp.*, 508 F.2d 847, 183 USPQ 427 (CCPA 1974); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

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 FRCP 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. *See Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981); *New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co.*, 207 USPQ 954 (TTAB 1980); *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111 (TTAB 1978); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). *Cf.* TBMP §502.01.

### **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 20 days from the mailing date of the notice in which 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 which does not show good cause, default judgment may be entered against it. *See* 37 CFR §§2.106(a) and 2.114(a); FRCP 55(a) and 55(b); and TBMP §317.

The issue of whether default judgment should be entered against a defendant, for failure 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 late-filed 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 FRCP

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55(c) standard, which requires that the defendant show good cause why default judgment should not be entered against it. *See* TBMP §317, and authorities cited therein.

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. *See* FRCP 55(b) and 55(c), and 37 CFR §2.127(a).

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. *See* 37 CFR §2.127(a), and TBMP §502.03.

For further information concerning default judgment for failure of the defendant to file a timely answer to the complaint, *see* TBMP §317.

### **509 Motion to Extend Time; Motion to Reopen Time**

*FRCP 6(b) Enlargement.* *When by these rules or by a notice given thereunder or by order of court an act is required or allowed to be done at or within a specified time, the court for cause shown may at any time in its discretion (1) with or without motion or notice order the period enlarged if request therefor is made before the expiration of the period originally prescribed or as extended by a previous order, or (2) upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect; but it may not extend the time for taking any action under Rules ... 60(b) ... except to the extent and under the conditions stated in them.*

#### **509.01 Nature of Motions**

A party may file a motion for an enlargement of the time in which an act is required or allowed to be done. If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is 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 a motion to reopen, and the

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moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. *See, for example*, *FRCP 6(b)*; *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc.*, 223 USPQ 176 (TTAB 1984); *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982); *Terra Products Corp. v. Comez*, 206 USPQ 1033 (TTAB 1979); and *Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509 (TTAB 1976).

For further information concerning good cause for a motion to extend, *see* *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (CCPA 1980); *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582 (TTAB 1976); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); and *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556 (TTAB 1975).

For further information concerning excusable neglect for a motion to reopen, *see* *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619 (TTAB 1986); *Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc.*, 223 USPQ 176 (TTAB 1984); *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982); *Terra Products Corp. v. Comez*, 206 USPQ 1033 (TTAB 1979); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r 1977); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 428 (TTAB 1976), *recon. denied*, 190 USPQ 431 (TTAB 1976); *Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509 (TTAB 1976); *Volkswagenwerk Aktiengesellschaft v. Advance Welding & Mfg. Corp.*, 184 USPQ 367 (TTAB 1974); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973); *Perfect Film & Chemical Corp. v. Society Ordinastral*, 172 USPQ 696 (TTAB 1972); *American Home Products Corp. v. David Kamenstein, Inc.*, 172 USPQ 376 (TTAB 1971); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 169 USPQ 510 (TTAB 1971); and *Clairol Inc. v. Holland Hall*

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*Products, Inc.*, 161 USPQ 616 (TTAB 1969). *Cf. Williams v. Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975), and *In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r 1989).

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. *See, for example Rowell Laboratories, Inc. v. Canada Packers Inc.*, 215 USPQ 523 (TTAB 1982); *Oxford Pendaflex Corp. v. Roladex Corp.*, 204 USPQ 249 (TTAB 1979); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 169 USPQ 510 (TTAB 1971); and *United States Plywood Corp. v. Modiglass Fibers, Inc.*, 125 USPQ 144 (TTAB 1960). *See also Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354 (TTAB 1984); *Tektronix, Inc. v. Daktronix, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495 (TTAB 1970).

### 509.02 Form and Determination of Motions

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 oral consent thereto. Ordinarily, a consented motion to extend or reopen will be granted by the Board.

Any consented motion to extend or reopen a time or times should be filed in multiple form, i.e., one copy of the stipulation for the Board proceeding file, plus as many additional copies as there are parties, so that if the stipulation is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party. *See* 37 CFR §§2.102(d) and 2.121(d), and TBMP §§501.03 and 502.02. *Cf.* TBMP §403.03.

Further, a consented motion to extend or reopen a time or times should specify the closing date for each rescheduled time. A consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. *See* 37 CFR §2.121(d). If a consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, specifies

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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. *See* 37 CFR §2.121(a). However, receipt by the parties of the Board's action on the motion will be delayed, because the Board will not be able to simply stamp the motion "Approved" and return the copies to the parties, but rather will have to prepare a letter indicating that the motion has been approved and specifying the closing date for each period being rescheduled.

When a motion to extend, or a motion to reopen, is filed without the consent of the nonmoving party, it should be filed in single (not multiple) form. 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. *Cf.* 37 CFR §2.127(a). If the nonmoving party fails to file a brief in opposition thereto, the motion normally will be granted by the Board as conceded. *See* 37 CFR §2.127(a), and TBMP §502.03. If the motion is contested by the nonmoving party, the Board will decide the motion on its merits.

A party has no right to assume that its motion to extend (much less a motion to reopen) made without the consent of the adverse party will always be granted automatically. *See Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (CCPA 1980). 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. *See Chesebrough-Pond's Inc. v. Faberge, Inc., supra.* *Cf.* TBMP §202.01; *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r 1992); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194 (Comm'r 1966). Therefore, it is preferable, at least where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, 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.

The resetting of the closing date for discovery will result in the automatic rescheduling of the testimony periods by the Board. 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. *See* 37 CFR §2.121(a).

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When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

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 Commissioner upon written request, which should be directed to the Office of the Solicitor (not the Board). *See* 37 CFR §2.145(e); *Appeals to the Federal Circuit from PTO*, 1120 TMOG 22 (November 13, 1990); and TBMP §§902.02 and 903.04.

### **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 parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action.*

*(b) Whenever there is pending, at the time when the question of the suspension of proceedings is raised, a motion which is potentially dispositive of the case, the motion may be decided before the question of suspension is considered.*

*(c) Proceedings may also be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board.*

#### **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. *See* 37 CFR §2.117, and *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990),

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*rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990). Some of the most common reasons for suspension are discussed below.

### 510.02 Suspension Pending Outcome of Another Proceeding

#### 510.02(a) Suspension

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action which may be dispositive of the Board case, proceedings before the Board may be suspended until final determination of the civil action. *See, for example*, 37 CFR §2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (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 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); *Squirrel Brand Co. v. Barnard Nut Co.*, 101 USPQ 340 (Comm'r 1954); *Townley Clothes, Inc. v. Goldring, Inc.*, 100 USPQ 57 (Comm'r 1953); and David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

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. To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. *See, for example*, *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (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 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); *Tuvache, Inc. v. Emilio Pucci Perfumes International, Inc.*, 263 F. Supp. 104, 152 USPQ 574 (S.D.N.Y. 1967); Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and*

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*Issue Preclusion in Board Proceedings*, 80 Trademark Rep. 540 (1990); and David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

However, the Board may also, in its discretion, suspend pending the final determination of another Board proceeding in which the parties are involved, or a civil action pending between the parties in a state court (*see Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983), and *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975)), 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 (*see Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (TTAB 1993), and *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986)) or even another proceeding in which only one of the parties is involved (*see Argo & Co. v. Carpetsheen Manufacturing, Inc.*, *supra*).

Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board. *See, for example Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); and *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971). *But see E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 USPQ 807 (TTAB 1978), and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (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).

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, nor do parties or their attorneys. *See Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990), and *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971). 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, the Board will go forward with its proceeding. *See* David B. Allen,

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*TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

When a motion to suspend pending the outcome of a civil action is filed, the Board normally will require that a copy of the pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action will have a bearing on the issues before the Board. *See SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975). This requirement ordinarily is waived if the parties stipulate to the suspension.

The Board does not usually require that 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. 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 will have a bearing on the issues before the Board. *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23129, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 19.

If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. *See* 37 CFR §2.117(b), and Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23129, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 20. *Cf. Allegro High Fidelity, Inc. v. Zenith Radio Corp.*, 197 USPQ 550 (TTAB 1977); *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449 (TTAB 1976); and *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977) (NOTE: each of these cases was decided prior to the adoption, in 1983, of 37 CFR §2.117(b)). The purpose of this practice 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. *See* David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984). However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion. *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23129, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 20.

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### **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 file a paper notifying the Board of the disposition of the other proceeding, and requesting that further appropriate action be taken in the Board proceeding (i.e., 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). The paper should be accompanied by a copy of the decision in the other proceeding.

A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e., a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided.

### **510.03 Suspension for Other Reasons**

#### **510.03(a) Suspension**

The Board suspends proceedings in cases before it for a wide variety of reasons.

Proceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board. *See* 37 CFR §2.117(c). 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. *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

The Board will automatically suspend proceedings in a case before it if it comes to the attention of the Board that the defendant has filed a petition for bankruptcy. *See In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992). 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,

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inter alia, of the commencement or continuation of a judicial, administrative, or other process against the debtor that was or could have been commenced before the commencement of the bankruptcy case. However, if it is the Board proceeding plaintiff, rather than defendant, which 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).

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 desires to represent itself, failing which the Board may issue an order to show cause why default judgment should not be entered against the party. *See*, with respect to withdrawal of counsel, TBMP §§116.02-116.05 and 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 in the party's behalf in the proceeding. *See* TBMP §114.03. *See also* TBMP §§114.04 and 114.05.

When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion. *See* 37 CFR §2.127(d); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477 (TTAB 1985); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979). The filing of a potentially dispositive motion does not, in and of itself, operate to suspend a case; until the Board issues its suspension order, all times continue to run. *See SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994), and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). Once the Board has suspended proceedings in a case pending determination of a potentially dispositive motion, no party should file any paper which is not relevant to the motion. *See* 37 CFR §2.127(d); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, *supra*; and *Nestle Co. v. Joyva Corp.*, *supra*.

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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 proceedings in the case to allow for the orderly completion of the depositions upon written questions. *See* 37 CFR §2.124(d)(2), and TBMP §714.04.

### **510.03(b) Resumption**

When proceedings are suspended for purposes of settlement negotiations, the Board normally sets a specific period of suspension (up to six months). Each party has the right to request resumption at any time during the suspension period. *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979). If no word is heard from either party prior to the expiration of the suspension period, the Board resumes proceedings. Until the Board issues an order resuming proceedings and setting new response and/or trial dates, proceedings remain suspended, despite the fact that the suspension period set by the Board has run.

When proceedings have been suspended by the Board because a Board proceeding defendant (or plaintiff whose registration is the subject of a counterclaim) has filed a petition for bankruptcy, the Board periodically 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.

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 (*see* TBMP §510.03(a)), and new counsel is appointed (and the Board is informed thereof) during the time allowed, the Board will resume proceedings, and go forward with that person representing the party. If, instead, the party files a paper stating that it desires to represent itself, the Board will resume proceedings and go forward with the party representing itself, but the party may employ a new attorney or other authorized representative at any time

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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. 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.

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. *See* 37 CFR §2.127(d).

### 511 Motion to Consolidate

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* FRCP 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262 (TTAB 1985); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464 (TTAB 1983); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973). 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 which may be caused thereby. *See, for example*, *Wright & Miller, Federal Practice and Procedure: Civil* §2383 (1971); *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (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 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same and issue was likelihood of confusion); *World Hockey Ass'n v. Tudor Metal Products Corp.*, *supra* (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); and *Izod, Ltd. v. La Chemise Lacoste*, *supra* (consolidation denied where issues

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differed). Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered (*see Bigfoot 4x4 Inc. v. Bear Foot Inc., supra*), it is not always necessary (*see Wright & Miller, supra*, at §2384, and *Izod, Ltd. v. La Chemise Lacoste, supra*).

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. *See, for example*, *Wright & Miller, Federal Practice and Procedure: Civil* §2383 (1971); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993) (stipulation); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Board's initiative); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) (stipulation); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987) (joint motion); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262 (TTAB 1985) (motion); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464 (TTAB 1983) (motion); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975) (Board's initiative).

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. *Cf.* 37 CFR §§2.104(b) and 2.114(b), and TBMP §306.

When cases have been ordered consolidated, they may (but do not have to) be presented on the same records and briefs. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464 (TTAB 1983); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975). Papers filed therein should bear the number of each of the consolidated cases. The oldest (i.e., first-filed) of the consolidated cases is treated as the "parent" case. With certain exceptions (such as the pleadings and all other papers up to the point of consolidation, the consolidation order, and the Board's final decision), most of the papers filed by the parties, or issued by the Board, in a consolidated proceeding are placed only in the file of the parent case. Thus, parties filing papers in a

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consolidated proceeding usually need not file a copy for each consolidated case; a single copy, bearing the number of each consolidated case, normally is sufficient.

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. *See* TBMP §117.02.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. *See* Wright & Miller, *Federal Practice and Procedure: Civil* §2382 (1971).

### **512 Motion to Join or Substitute**

#### **512.01 Assignment of Mark**

When there has been an assignment of a mark which 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.

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. §1060, any action with respect to the application or registration which 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 or that proof of the assignment has been submitted. *See* 37 CFR §§3.71 and 3.73(b). If the mark in an application or registration which 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 Branch of the PTO, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objection to substitution, or the

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discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. *See, for example*, 37 CFR §§2.113, 3.71 and 3.73(b); FRCP 17 and 25; *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984); *Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc.*, 217 USPQ 810 (TTAB 1982); *Liberty & Co. v. Liberty Trouser Co.*, 216 USPQ 65 (TTAB 1982); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976); and *Aloe Creme Laboratories, Inc. v. Aloe 99, Inc.*, 188 USPQ 316 (TTAB 1975).

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 if the assignment occurred prior to the commencement of the proceeding, or the discovery and testimony periods have closed, or the assignor is no longer in existence, or 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. 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 is advisable because it will aid the assignee in its effort to prove ownership of the application or registration at trial. *See, for example*, FRCP 17 and 25; 37 CFR §2.102(b); TBMP §303.05(b); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1871 (TTAB 1994); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992); *Huffy Corp. v. Geoffrey Inc.*, 18 USPQ2d 1240 (Comm'r 1990); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); *Information Resources Inc. v. X\*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985); *E.E. Dickinson Co. v. T.N. Dickinson Co.*, 221 USPQ 713 (TTAB 1984); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982). *Cf. Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

If the mark of an excepted common law user (which 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. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27

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USPQ2d 1224 (TTAB 1993), and *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133 (TTAB 1982).

Alternatively, if there has been an assignment of a mark which 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. *See* FRCP 25(c), and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982).

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. *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992).

### **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 (such as, a copy of the name change document, or the numbers of the reel and frame where such document is recorded in the Assignment Branch of the PTO) is made of record in the proceeding. *See, for example, WMA Group Inc. v. Western International Media Corp.*, 29 USPQ2d 1478 (TTAB 1993); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992); *NutraSweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964 (TTAB 1987), and *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984). *Cf. In re Brittain's Tullis Russell Inc.*, 23 USPQ2d 1457 (Comm'r 1991). If no such evidence is made of record in the proceeding, the proceeding may be continued in the party's old name. *See, for example, Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736 (TTAB 1983), and *National Blank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 827 (TTAB 1983). *Cf.* FRCP 25(c).

A name change document does not have to be recorded 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 which desires, if it prevails

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in the proceeding, to have its registration issue in its new name (*see* TBMP §512.03).

### **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 which 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. In addition, an appropriate document must be of record in the Assignment Search Room of the PTO, 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. *See Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992).

If an assignment or change of name document is recorded in the Assignment Search Room 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

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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 PTO 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.

### 512.04 Misidentification

When it is shown to the satisfaction of the Board that a party in whose name a Board proceeding complaint was filed was misidentified therein by mistake, the Board may allow amendment of the complaint, pursuant to FRCP 15(a), to correct the misidentification and/or to substitute the proper party in interest. *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985); *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505 (TTAB 1974); *Textron, Inc. v. Gillette Co.*, 177 USPQ 530 (Comm'r 1973); *Lone Star Manufacturing Co. v. Bill Beasley, Inc.*, 176 USPQ 426 (TTAB 1972), *rev'd on other grounds*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Davidson v. Instantype, Inc.*, 165 USPQ 269 (TTAB 1970); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221 (TTAB 1969); and *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407 (TTAB 1964). *Cf.* 37 CFR §2.102(b); TBMP §303.05(c); and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993) (misidentification of potential opposer in request for extension of time to oppose)..

When an application or registration is the subject of an inter partes proceeding before the Board, and it is shown to the satisfaction of the Board that the applicant was misidentified in the application by mistake, the Board may allow amendment of the application or registration (and of the Board proceeding title) to correct the misidentification. *See Argo & Co. v. Springer*, 198 USPQ 626 (TTAB 1978); *Argo & Co. v. Springer*, 189 USPQ 581 (TTAB 1976); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r 1974). *Cf.* TMEP §§802.06 and 802.07; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r 1990); *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982); and *In re Eucryl Ltd.*, 193 USPQ 377 (TTAB 1976).

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### 513 Motion to Withdraw as Representative; Petition to Disqualify

#### 513.01 Motion to Withdraw as Representative

*37 CFR §2.19(b)* An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Commissioner.

#### **37 CFR §10.40 Withdrawal from employment.**

*(a)* A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

*(b) Mandatory withdrawal.* A practitioner representing a client before the Office shall withdraw from employment if:

*(1)* The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

*(2)* The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

*(3)* The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

*(4)* The practitioner is discharged by the client.

*(c) Permissive withdrawal.* If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

*(1)* The petitioner's client:

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*(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;*

*(ii) Personally seeks to pursue an illegal course of conduct;*

*(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;*

*(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;*

*(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or*

*(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.*

*(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;*

*(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;*

*(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;*

*(5) The practitioner's client knowingly and freely assents to termination of the employment; or*

*(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.*

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 §§10.40(b) and 10.40(c). Moreover, the practitioner must comply with the requirements of 37 CFR §10.40(a). *See* 37 CFR §§2.19(b) and 10.40. *Cf. In re Legendary Inc.*, 26 USPQ2d 1478 (Comm'r 1992).

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

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statement that the unearned part has been refunded; and (5) proof of service of the request upon the client and upon every other party to the proceeding. *See* 37 CFR §10.40. *Cf. In re Legendary Inc.*, 26 USPQ2d 1478 (Comm'r 1992).

If 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 desires to represent itself, failing which 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. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

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 and 114.05.

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 §§116.02-116.05. *Cf.* TMEP §602.03(a).

### **513.02 Petition to Disqualify**

*37 CFR §10.130(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner 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 may testify in the proceeding as a witness on behalf of his client), the party may file a petition to disqualify the practitioner.

Petitions to disqualify are not disciplinary proceedings and hence are not governed by 37 CFR §§10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR §10.130(b), and are determined in the manner specified in that rule. For

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

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.

With respect to disqualification due to an asserted conflict of interest, *see* TBMP §114.08, and authorities cited therein. With respect to disqualification due to testimony on behalf of client, *see* 37 CFR §10.63; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); and *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989). *Cf. Computer Associates International Inc. v. Computer Automation Inc.*, 678 F. Supp. 424, 6 USPQ2d 1459 (S.D.N.Y. 1987).

### **514 Motion to Amend Application or Registration**

*37 CFR §2.133(a) An application involved in a proceeding may not be amended in substance nor may a registration 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 except upon motion.*

*(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 involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal 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.*

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### 514.01 In General

The amendment of any application or registration which is the subject of an inter partes proceeding before the Board is governed by 37 CFR §2.133. Thus, an application which 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. Similarly, a registration which is the subject of a Board inter partes proceeding may not be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion. *See* 37 CFR §2.133(a). *Cf.* TBMP §212.

A proposed amendment must also comply with all other applicable rules and statutory provisions. These include 37 CFR §§2.71-2.75, in the case of a proposed amendment to an application; and 37 CFR §2.173 and Section 7(e) of the Act, 15 U.S.C. §1057(e), in the case of a proposed amendment to a registration. Thus, for example, a proposed amendment which involves an addition to the identification of goods or services, or which materially alters the character of the subject mark, will not be approved by the Board. *See* Section 7(e) of the Act; 37 CFR §§2.71(b), 2.72, and 2.173(a) and 2.173(b); and *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993). *See also* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).

A request to amend an application or registration which 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. *See* 37 CFR §2.119(a), and TBMP §113.

When the Board grants a request to amend a registration which is the subject of a Board inter partes proceeding, and forwards the registration to the Post Registration branch of the Office of Trademark Services for amendment of the registration, action by the Post Registration branch is limited to the ministerial duty of ensuring that the authorized change to the registration is made. *See In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r 1980).

### 514.02 Amendment With Consent

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When a request to amend an application or registration which 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.

### 514.03 Amendment Without Consent

The Board, in its discretion, may grant a motion to amend an application or registration which is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto. *See* 37 CFR §2.133(a).

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 which 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 FRCP 15(b). *See, for example, Signal Companies v. Southwestern Petroleum Corp.*, 181 USPQ 599 (TTAB 1973), and *Mack Trucks, Inc. v. Hydra-Mac, Inc.*, 180 USPQ 147 (TTAB 1973), *aff'd*, *Hydra-Mac, Inc. v. Mack Trucks, Inc.*, 507 F.2d 1399, 184 USPQ 351 (CCPA 1975). *See also* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991). *Cf. Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990), and TBMP §§311, 321, and 507.

The Board generally will defer determination of an unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (defendant's motion to amend its identification of goods to include restriction); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987) (defendant's motion to amend dates of use in its subject application); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985) (defendant's motion to amend dates of use in its subject application). *See also* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).

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

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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. *See* 37 CFR §§2.133(a) and 2.133(b); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863 (TTAB 1991); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); TBMP §318.02(b); and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991). The proposed restriction should be described in defendant's pleading, or in its motion to amend, in sufficient detail to give the plaintiff fair notice thereof. *See Space Base Inc. v. Stadis Corp.*, *supra*, and TBMP §318.02(b). *See also Flow Technology Inc. v. Picciano*, *supra*.

If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction which was timely proposed by the defendant, the proposed restriction will be approved and entered. 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. *See* 37 CFR §2.133(b), and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991). *See also* Section 18 of the Act, 15 U.S.C. §1068. 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. *See* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra*.

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding. *See* 37 CFR §2.133(c), and TBMP §1101.02. Moreover, Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §2.173 cannot be used to impose concurrent use restrictions on registrations. *See In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984), and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987). However, an applicant whose geographically unrestricted 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

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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. See TBMP §1112; *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983); Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991); and Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings*, 76 Trademark Rep. 252 (1986).

### **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 which 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 Examiner of Trademarks.***

*If, during the pendency of an inter partes case, facts appear which, in the opinion of the Examiner of Trademarks, render the mark of any applicant involved unregistrable, the attention of the Trademark Trial and Appeal Board shall be called thereto. The Board may suspend the proceeding and refer the application to the Examiner of Trademarks for his determination of the question of registrability, following the final determination of which the application shall be returned to the Board for such further inter partes action as may be appropriate. The consideration of such facts by the Examiner of Trademarks shall be ex parte, but a copy of the action of the examiner will be furnished to the parties to the inter partes proceeding.*

#### ***37 CFR §2.131 Remand after decision in inter partes proceeding.***

*If, during an inter partes proceeding, facts are disclosed which appear to render the mark of an applicant 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 refer the application to the examiner for reexamination in the event the applicant ultimately prevails in the*

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*inter partes* proceeding. Upon receiving the application, the examiner shall withhold registration pending reexamination of the application in the light of the reference by the Board. If, upon reexamination, the examiner 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, the Examining Attorney learns of facts which, in his or her opinion, render the subject mark of an involved applicant 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. See 37 CFR §2.130.

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 which 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. See generally 37 CFR §2.133(a), and TBMP §514.

However, if, during the course of an opposition, concurrent use, or interference proceeding, facts are disclosed which appear to render the subject mark of an involved applicant 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 FRCP 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, include a recommendation that in the event applicant ultimately prevails in the *inter partes* proceeding, the Examining Attorney reexamine the application in light of the disclosed facts. See, for example, 37 CFR §2.131; *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306 (TTAB 1987); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012 (TTAB 1984); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936 (TTAB 1983); and *Antillian Cigar Corp. v. Bedit Cigar Corp.*, 218 USPQ 187 (TTAB 1983). 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 subject mark of an involved applicant unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to FRCP 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR §2.131 remand to the

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Examining Attorney. The request may be made in the party's brief on the case, at oral hearing, or by separate motion.

### **516 Motion to Divide Application**

An application which is the subject of an inter partes proceeding before the Board may be physically divided into two or more separate applications upon motion granted by the Board, and payment of the required fee. *See* 37 CFR §2.87.

For example, if an application which is the subject of an opposition includes multiple classes (*see* 37 CFR §2.86(b)), 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. *See* 37 CFR §§2.87(a) and 2.87(b). If the motion is granted, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Section 1(b) of the Act, 15 U.S.C. §1051(b), for issuance of a notice of allowance.

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 (*see* 37 CFR §2.86(a)), 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. Applicant must also submit both a fee for dividing the application, and an application filing fee, for each new application to be created by the division. *See* 37 CFR §§2.87(a) and 2.87(b). If the motion is granted, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Section 1(b) of the Act, 15 U.S.C. §1051(b), for issuance of a notice of allowance.

Any request to divide an application which 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.

A registration may not be divided. *See* TMEP §1105.06(b).

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For further information concerning division of an application, see TMEP §§1105.06 and 1105.06(a).

### **517 Motion to Strike Brief on Motion**

#### **517.01 Brief in Support of, or in Opposition to, Motion**

Specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion and a brief in opposition to a motion. *See* 37 CFR §2.127(a). *See also* TBMP §502.03.

Subject to the provisions of FRCP 11, a party is entitled to offer in its brief any argument it feels will be to its advantage. Accordingly, when a brief in support of, or in opposition to, a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party which simply objects to the contents thereof. Rather, any objections which 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 which are found by the Board to be improper will be disregarded.

However, if a brief in opposition to a motion is not timely filed, it may be stricken, or given no consideration, by the Board.

#### **517.02 Reply Brief on Motion**

The Trademark Rules of Practice neither specifically provide for, nor prohibit, a reply brief on a motion. Thus, when a party moves to strike a reply brief on a motion, the Board, in its discretion, may elect either to entertain the brief, or to strike it as being unwarranted under the circumstances. *See* TBMP §502.03, and cases cited therein.

The Board may also strike a reply brief as untimely if it is not filed within the time allowed for filing other responsive briefs on motions, i.e., within 15 days from the date of service of the paper to which the brief responds (20 days if service of the paper to which the brief responds was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §§2.119(c)), unless another time is specified by the

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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. *See* TBMP §502.03, and authorities cited therein.

### **518 Motion for Reconsideration of Decision on Motion**

A request for reconsideration or modification of an order or decision issued on a motion must be filed within 30 days from the date of the order or decision. *See* 37 CFR §2.127(b). Unless the Commissioner, 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 30 days from the date of the order or decision complained of. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736 (Comm'r 1974). Nor does the rule contemplate a second request for reconsideration of the same basic issue. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986), and *Avedis Zildjian Co. v. D. H. Baldwin Co.*, *supra*. 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. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, *supra*.

Any brief in response to a request for reconsideration or modification of an order or decision issued on a motion must be filed within 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.120(c)). *See* 37 CFR §2.127(b).

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 nonresponding party cannot use a request for reconsideration as a second opportunity to file a brief in opposition to the motion. *See Joy Manufacturing Co. v. Robbins Co.*, 181 USPQ 408 (TTAB 1974). *Cf. General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc.*, 189 USPQ 425 (TTAB 1975).

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 properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on

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the original motion. Rather, the motion normally 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. *Cf.* TBMP §544.

An interlocutory motion, request, or other matter which is not actually or potentially dispositive of a proceeding may be acted upon by a single Board administrative trademark judge, or by a Board interlocutory attorney to whom authority so to act has been delegated. *See* 37 CFR §2.127(c). *See also* TBMP §502.05. When a single Board administrative trademark judge, or a single duly authorized interlocutory attorney, has acted upon an interlocutory motion, request, or other matter not actually or potentially dispositive of the proceeding, and one or more of the parties is dissatisfied with the action, the dissatisfied party or parties may seek review thereof by requesting, under 37 CFR §2.127(b), the same single Board judge, or the same single interlocutory attorney, to reconsider the action, and/or by filing a petition to the Commissioner for review of the decision under 37 CFR §2.146(e)(2) (*see* TBMP §905). A request that the action of the single Board judge, or single interlocutory attorney, be reviewed by one or more (other) administrative trademark 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. *See, for example, Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 (TTAB 1986).

### **519 Motion for Leave to Serve Additional Interrogatories**

*37 CFR §2.120(d)(1) 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. 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. ...*

A motion under 37 CFR §2.120(d)(1) for leave to serve additional interrogatories must be filed and granted *prior* to service of the proposed additional

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interrogatories; and must be accompanied both by a copy of any interrogatories which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. *See* 37 CFR §2.120(d)(1); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479 (TTAB 1990); *Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990); Notice of Final Rulemaking, published in the *Federal Register* on September 12, 1991 at 56 FR 46376 and in the *Official Gazette* of October 22, 1991 at 1131 TMOG 54, as corrected in the *Federal Register* of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992).

Good cause for the service of additional interrogatories will generally be found only where it is shown that there is a legitimate need for further discovery by interrogatories. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466 (TTAB 1990). The mere fact that the additional interrogatories 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 additional interrogatories. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990).

For further information concerning good cause for a motion to serve additional interrogatories, *see* TBMP §406.03(C).

For information concerning the interrogatory limit specified in 37 CFR §2.120(d)(1), *see* TBMP §406.03.

### **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*

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*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 or the parties stipulate, that the deposition be taken by oral examination.*

**37 CFR §2.120(a)(2)** *A testimonial deposition 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.*

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 FRCP 30(b)(6) or 31(a)(3) 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. *See* 37 CFR §2.120(c)(1). *See also* TBMP §404.03(c)(1), and authorities cited therein. 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. *See* TBMP §404.03(c)(1), and authorities cited therein.

However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the deposition, when taken in a foreign country, be taken by oral examination. *See* 37 CFR §2.120(c)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989); *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983); and TBMP §404.03(c)(1).

Similarly, a testimony deposition taken in a foreign country must be taken by deposition 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. *See* 37 CFR §2.123(a)(2).

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. *See Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989). *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980); and TBMP §532.

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### 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 testimony deposition, to quash the notice of deposition. In the case of a notice of discovery deposition, the motion may alternatively be titled a motion for a protective order. *See* TBMP §414.

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 (*see Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978)); or (2) constitutes harassment (*see Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); *cf. Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976)); or (3) in the case of a discovery deposition to be taken in the United States, is not scheduled to be taken in the Federal judicial district where the proposed deponent resides or is regularly employed (*see* 37 CFR §2.120(b)); or (4) in the case of a deposition to be taken in a foreign country, is scheduled to be taken orally in violation of 37 CFR §2.120(c) or 2.123(a)(2) (*see Rhone-Poulenc Industries v. Gulf Oil Corp., supra*); or (5) that 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 (*see* 37 CFR §2.123(c)); or (6) that there was not due (i.e., reasonable) notice of the proposed deposition (*see* 37 CFR §§2.123(c) and 2.124(b)(2); FRCP 30(b) and 31(a); and TBMP §§404.04 and 713.05); or (7) that the taking of the deposition should be deferred until after determination of a certain motion pending before the Board (*see Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141 (TTAB 1975)); or (8) that 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 (*see* TBMP §404.03(c)(1), and authorities cited therein); or (9) that a testimony 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) (*see* 37 CFR §2.123(a)(1); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980)).

However, the Board has no jurisdiction over nonparty depositions, or adverse witness depositions, taken by subpoena, and thus has no authority to quash such

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depositions. *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987), and TBMP §§404.03(b)(2) and 713.06(b).

A motion to quash a notice of deposition should be filed promptly after the grounds therefor become known to the moving party. When time is of the essence, the moving party may telephone the Board interlocutory attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call. *See* 37 CFR §2.120(i)(1), and TBMP §502.07(a). However, the Board will not resolve a motion by telephone conference until a copy of the motion has been received by the Board. A copy of the motion should also have been received by every other party to the proceeding.

To expedite matters, the moving party may hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned. Alternatively, if the motion has been filed with the Board by some (acceptable) method other than hand delivery to the interlocutory attorney, but has not yet actually been received by the Board and/or entered in the proceeding file for which it is intended, the moving party may call the interlocutory attorney and request permission to fax a copy of the motion to the Board. *See* TBMP §107.

### **522 Motion for Order re Manner or Place of Document Production**

*37 CFR §2.120(d)(2) The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, 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 of production of documents and things is governed by 37 CFR §2.120(d)(2). *See also Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976); and TBMP §408.03.

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. For example, the Board may order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party, all at the requesting party's expense. *See Unicut Corp. v. Unicut, Inc.*, 220

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USPQ 1013 (TTAB 1983); Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449, 451 (1984).

### 523 Motion to Compel Discovery

#### 523.01 In General

**37 CFR §2.120(e) Motion for an order to compel discovery.** *If a party 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 or thing, the party seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. ...*

In inter partes proceedings before the Board, the motion to compel discovery procedure is available, for a failure to provide requested discovery, with respect to discovery depositions, interrogatories, and requests for production of documents and things. *See* 37 CFR §2.120(e). *See also, for example, MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976); *Spa International, Inc. v. European Health Spa, Inc.*, 184 USPQ 747 (TTAB 1975); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); and *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974). *Cf.* FRCP 37(a)(2)(B).

Alternatively, if a witness objects to, and refuses to answer (or answer adequately), a question propounded during a discovery deposition, the propounding party may obtain an immediate ruling on the propriety of the objection by 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 answer. *See* TBMP §§404.02 and 415.03, and authorities cited therein.

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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(h) and FRCP 36(a). *See* TBMP §§415.02 and 524.

### 523.02 Special Requirements for Motion

**37 CFR §2.120(e) Motion for an order to compel discovery.** ... *The motion shall include a copy of the request for designation 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 or things that were not produced for inspection and copying. The motion must be supported by a written statement 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 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 compel must include a copy of the request for discovery and the response thereto, as specified in 37 CFR §2.120(e). *See also, with respect to this requirement, Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Helene Curtis Industries, Inc. v. John H. Breck, Inc.*, 183 USPQ 126 (TTAB 1974).

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. *See, for example, 37 CFR §2.120(e); Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); *Ford Motor Co. v. Shelby International, Inc.*, 193 USPQ 236 (TTAB 1976); *Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc.*, 189 USPQ 479 (TTAB 1976); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB

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1975); *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Penthouse International Ltd. v. Dyn Electronics, Inc.*, 184 USPQ 117 (TTAB 1974); and *Angelica Corp. v. Collins & Aikman Corp.*, 183 USPQ 378 (TTAB 1974).

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require determination. *See* 37 CFR §2.120(e).

For information concerning the special requirements for a motion to compel answer to interrogatories which are the subject of a general objection on the ground of excessive number, *see* TBMP §406.03(e).

### **523.03 Time for Filing Motion**

A motion to compel does not necessarily have to be filed during the discovery period. *See Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974). 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.

### **523.04 Failure to File Motion**

If a party which served a request for discovery receives a response thereto which 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. *See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976); and *Comserv Corp. v. Comserv*, 179 USPQ 124 (TTAB 1973). *Cf.* TBMP §524.04. *Cf. also* TBMP §527.05.

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### 524 Motion to Test Sufficiency of Response to Admission Request

#### 524.01 In General

**37 CFR §2.120(h) Request for admissions.** *Requests for admissions shall be governed by Rule 36 of the Federal Rules of Civil Procedure except that the Trademark Trial and Appeal Board does not have authority to award any expenses to any party. ...*

**FRCP 36(a) Request for Admission.** *... The party who has requested the admissions may move to determine the sufficiency of the answers or objections. Unless the court determines that an objection is justified, it shall order that an answer be served. If the court determines that an answer does not comply with the requirements of this rule, it may order either that the matter is admitted or that an amended answer be served. ...*

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. *See* 37 CFR §2.120(h); FRCP 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971). *Cf.* 37 CFR §2.120(e), and TBMP §523.01.

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 FRCP 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. *See* FRCP 36(a).

#### 524.02 Special Requirements for Motion

**37 CFR §2.120(h) Request for admissions.** *... A motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission 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 that such party or the attorney therefor has made*

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*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. *See* 37 CFR §2.120(h). *Cf.* 37 CFR §2.120(e).

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. *See* 37 CFR §2.120(h). *Cf.* 37 CFR §2.120(e), and TBMP §523.02 and cases cited therein.

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require determination. *See* 37 CFR §2.120(h). *Cf.* 37 CFR §2.120(e).

### **524.03 Time for Filing Motion**

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. *Cf. Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974), and TBMP §523.03. However, the motion should be filed within a reasonable time after service of the response believed to be inadequate.

### **524.04 Failure to File Motion**

If a party which served a request for admission receives a response thereto which 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. *See Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971). *Cf.* TBMP §523.04, and cases cited therein.

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### 525 Motion to Withdraw or Amend Admission

***FRCP 36(b) Effect of Admission.*** Any matter admitted under this rule is conclusively established unless the court on motion permits withdrawal or amendment of the admission. ...the court may permit withdrawal or amendment when the presentation of the merits of the action will be subserved thereby and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits. Any admission made by a party under this rule is for the purpose of the pending action only and is not an admission for any other purpose nor may it be used against the party in any other proceeding.

Any matter admitted under FRCP 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. See FRCP 36(b), and TBMP §411.04. 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. See FRCP 6(b) and 36, and TBMP §§411.01 and 411.04.

The Board, upon motion, 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. See FRCP 36(b); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); and *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233 (TTAB 1979). See also *American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991).

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. See *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990) (opposer's testimony period had not yet opened and any possible prejudice to opposer, the propounding party, could be overcome by extending the discovery period), and *Johnston Pump/General Valve*

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*Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989) (case was still in pre-trial stage and prejudice to the propounding party could be avoided or mitigated by reopening discovery for that party). *See also American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991). *Cf.* TBMP §507.02.

### **526 Motion for a Protective Order**

**37 CFR §2.120(f) Motion for a protective order.** *Upon motion by a party 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 (1) through (8), inclusive, of Rule 26(c) 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 provide or permit discovery.*

In inter partes proceedings before the Board, motions for a protective order are governed by 37 CFR §2.120(f).

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 which it believes to be proper, and stating its objections to those which it believes to be improper. *See* TBMP §414, and cases cited therein.

Moreover, if a party upon which interrogatories have been served believes that the number of interrogatories served exceeds the limitation specified in 37 CFR §2.120(d)(1), 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, 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. *See* 37 CFR §2.120(d)(1), and TBMP §406.03(e).

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Nevertheless, there are certain situations (such as, for example, when a request for discovery otherwise constitutes clear harassment, 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. *See, for example, Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976).

Except in those situations, 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. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 387-388 (1985).

When the Board grants a request for a protective order with respect to confidential or trade secret information, it normally will direct either the disclosing party, or the parties together, to prepare an order with terms which are mutually agreeable to them. *See, for example, Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975).

For examples of cases involving a motion for a protective order relating to discovery, *see Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) (request for protective order that discovery be governed by the Hague Evidence Convention); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988) (motion for protective order relating to discovery of confidential information); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976) (motion for protective order that assignor need not respond to discovery requests); *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141 (TTAB 1975) (motion for protective order forbidding that discovery not be taken until Board's determination of pending motion to dismiss); and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975) (request for protective order relating to discovery of confidential information).

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For further information concerning protective orders, *see* TBMP §416.

### **527 Motion for Discovery Sanctions**

#### **527.01 For Failure to Comply With Board Discovery Order**

##### ***37 CFR §2.120(g) Sanctions.***

*(1) If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board does not have authority to hold any person in contempt or to award any expenses to any party. The Board may impose against a party any of the sanctions provided by this subsection 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.*

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(g)(1). *See* 37 CFR §2.120(g)(1). *See also, for example,* TBMP §502.06; *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); and *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976). *Cf. Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 11 Fed. R. Serv.3d 1342 (Fed. Cir. 1988). In the case of a protective order, these sanctions may be entered by the Board against a party if the party or any attorney, agent, or designated witness of the party fails to comply with the protective order. *See* 37 CFR §2.120(g)(1).

The sanctions which 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 does not have authority to hold any person in contempt, or to award any expenses, including attorneys' fees, to any party. *See* 37 CFR §§2.120(g)(1) and 2.127(f), and TBMP §502.06.

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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 assertedly been violated. *See, for example, MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976); *Spa International, Inc. v. European Health Spa, Inc.*, 184 USPQ 747 (TTAB 1975); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974).

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 admissions. Sanctions in those situations are governed by FRCP 36, except that the Board does not have authority to award any expenses to any party. *See* 37 CFR §2.120(h), and TBMP §502.06. For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, *see* TBMP §527.04.

### **527.02 If Party Says It Will Not Respond to Discovery Request**

*37 CFR §2.120(g)(2) 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 (g)(1) of this section.*

The motion for sanctions under 37 CFR §2.120(g)(2) is available only for discovery depositions, interrogatories, and requests for production of documents and things, and lies only where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made.

The sanctions which 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

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judgment against the disobedient party. However, the Board does not have authority to hold any person in contempt, or to award any expenses, including attorneys' fees, to any party. *See* 37 CFR §§2.120(g)(1) and (2), and 2.127(f), and TBMP §502.06.

The motion for sanctions under 37 CFR §2.120(g)(2) does not apply in situations involving requests for admissions. For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, *see* TBMP §527.04.

### **527.03 Untimely Response to Discovery Requests**

A party which fails to respond to a request for discovery (except for a request for admission) during the time allowed therefor, and which 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. *See* *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

### **527.04 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(h) and FRCP 36, except that the Board does not have authority to award expenses to any party. *See* 37 CFR §2.120(h), and TBMP §502.06.

If a party upon which requests for admission have been served fails to file 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(j)(3)(i), 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 FRCP 36(b), and granted by the

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Board. *See* FRCP 6(a) and 36(a), and TBMP §411.01. 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. *See* 37 CFR §2.120(h); FRCP 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971). If the Board determines that an answer does not comply with the requirements of FRCP 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. *See* FRCP 36(a). For information concerning motions to determine the sufficiency of answers or objections to requests for admission, *see* TBMP §524.

### 527.05 Estoppel Sanction

A party which 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, providing 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). *See, for example* *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820 (CCPA 1980); *Super Valu Stores Inc. v. Exxon Corp.*, 11 USPQ2d 1539 (TTAB 1989); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987); *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671 (TTAB 1987); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985); *Era Corp. v. Electronic Realty Associates, Inc.*, 211 USPQ 734 (TTAB 1981); *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980); *Shoe Factory Supplies Co. v. Thermal Engineering Co.*, 207 USPQ 517 (TTAB 1980); *Refreshment Machinery Inc. v. Reed Industries, Inc.*, 196 USPQ 840 (TTAB 1977); *Autac Inc. v. Walco Systems, Inc.*, 195 USPQ 11 (TTAB 1977); and

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*Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976). Cf. *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989); *Nestle Foods Corp. v. Kellogg Co.*, 6 USPQ2d 1145 (TTAB 1988); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co.*, 204 USPQ 76 (TTAB 1979); *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976); and TBMP §523.04.

### 528 Motion for Summary Judgment

#### ***FRCP 56. Summary Judgment***

***(a) For Claimant.*** A party seeking to recover upon a claim [or] counterclaim ... may ... move with or without supporting affidavits for a summary judgment in the party's favor upon all or any part thereof.

***(b) For Defending Party.*** A party against whom a claim [or] counterclaim ... is asserted ... may ... move with or without supporting affidavits for a summary judgment in the party's favor as to all or any part thereof.

***(c) Motion and Proceedings Thereon.*** ... The adverse party ... may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. ...

***(d) Case Not Fully Adjudicated on Motion.*** If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court ..., by examining the pleadings and the evidence before it ..., shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, ... and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

***(e) Form of Affidavits; Further Testimony; Defense Required.*** Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts

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*as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party.*

***(f) When Affidavits are Unavailable.*** *Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.*

\* \* \*

### **528.01 General Nature of Motion**

The motion for summary judgment is a pretrial device to dispose of cases in which "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *See, for example, FRCP 56(c); Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *Dana Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986); *Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 (TTAB 1986); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986).

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The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue 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. See, for example, *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Exxon Corp. v. National Foodline Corp.*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994); *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241 (TTAB 1989).

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. See, for example, *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992); *Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 (TTAB 1986); T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413, at 413-414 (1990); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, 77-78 (1986). But see *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) ("As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment."), and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See, for example, *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, *clarified, on recon.*, 18 USPQ2d 1896 (Fed. Cir. 1991); *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990); *C.R. Bard Inc. v. Advanced*

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*Cardiovascular Systems Inc.*, 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989). The burden of the moving party may be met by showing (that is, pointing out) "that there is an absence of evidence to support the nonmoving party's case." See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986). See also *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled 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 FRCP 56, showing that there is a genuine factual dispute for trial. See FRCP 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc.*, 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and *Coup v. Vornado Inc.*, 9 USPQ2d 1824 (TTAB 1988). A factual dispute is genuine only if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d

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937, 16 USPQ2d 1783 (Fed. Cir. 1990); *C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc.*, 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. *See Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990); *Litton Industries, Inc. v. Litronix Inc.*, 577 F.2d 709, 198 USPQ 280 (CCPA 1978); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994); *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues 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. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*, 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991); *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, *clarified, on recon.*, 18 USPQ2d 1896 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc.*, 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); *Litton Industries, Inc. v. Litronix Inc.*, 577 F.2d 709, 198 USPQ 280 (CCPA 1978); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994); *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986).

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings." *See Opryland USA Inc. v. Great American Music Show Inc.*, *supra*, at 1472, and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See, for example, Kellogg*

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*Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); and *Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 (TTAB 1986). *See also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992) (whether a genuine factual issue is material so as to preclude summary judgment depends upon applicable substantive law). Further, a dispute over a fact relating only to an issue which is not the subject of the summary judgment motion is not a genuine issue of fact material to the determination of the motion. *See United States Olympic Committee v. O-M Bread Inc.*, 29 USPQ2d 1555 (TTAB 1993).

Where both parties have moved for summary judgment, the mere fact that they have done so does not establish that there is no genuine issue of material fact, and that judgment should be entered in favor of one of them. *See Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, *clarified, on recon.*, 18 USPQ2d 1896 (Fed. Cir. 1991), and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994).

A party moving for summary judgment should specify, in its brief in support of the motion, the material facts which are undisputed. The nonmoving party, in turn, should specify, in its brief in opposition to the motion, the material facts which are in dispute. *See T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

A motion for summary judgment should be filed in single (not multiple) form.

### **528.02 Time for Filing Motion**

**37 CFR §2.127(e)(1)** *A motion for summary judgment should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Trademark Trial and Appeal Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter.*

A motion for summary judgment filed in an inter partes proceeding before the Board ordinarily should be filed after the time when the Board notifies the parties of the institution of the proceeding, but before the opening of the first testimony period, as originally set or as reset.

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When the Board determines that an opposition or a petition to cancel has been timely filed in proper form, and that the required fee has been submitted, the Board sets up the opposition or cancellation proceeding file, and prepares a letter wherein it, inter alia, notifies defendant of the filing of the complaint, and notifies both parties of the formal institution of the proceeding. A copy of the notification letter is mailed to each of the parties. The Board sends a copy of the complaint to the defendant along with its copy of the notification letter. *See* TBMP §315.01. The defendant does not know, until it receives these papers from the Board, that an opposition or cancellation has been timely filed in proper form, with the required fee, and that the proceeding has been instituted by the Board. Accordingly, a motion for summary judgment filed prior to the mailing of the Board's notification letter is premature, and the defendant need not respond thereto. *See Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993).

Further, 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 issue of material fact, and that it is entitled to judgment as a matter of law. *See* TBMP §528.01, and authorities cited therein. In inter partes proceedings before the Board, the trial period commences with the opening of the first testimony period (*see* TBMP §§504.01 and 701), testimony 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 final decision (*see* TBMP §502.01, and cases cited therein). For these reasons, a motion for summary judgment ordinarily should be filed prior to the opening of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any summary judgment motion filed thereafter. *See, for example*, 37 CFR §2.127(e)(1); *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981); *Allegro High Fidelity, Inc. v. Zenith Radio Corp.*, 197 USPQ 550 (TTAB 1977); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976); *Peterson's Ltd. v. Consolidated Cigar Corp.*, 183 USPQ 559 (TTAB 1974); and *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 182 USPQ 572 (Comm'r 1974). *Cf.* TBMP §504.01. If testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion for summary judgment filed before a first trial period commences is timely. Once the first trial period commences, however, any summary judgment motion filed thereafter is untimely, even if it is filed prior to

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the opening of a rescheduled testimony period-in-chief for plaintiff, and/or even if no trial evidence has actually been adduced by the plaintiff. *See La Maur, Inc. v. Bagwells Enterprises, Inc.*, *supra*; David J. Kera, *TIPS FROM THE TTAB: Summary Judgment*, 71 Trademark Rep. 59, 62 (1981); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, at 73-74 (1986).

The Board generally will not consider a motion for summary judgment filed after the first trial period commences unless it involves a matter of res judicata (claim preclusion) or collateral estoppel (issue preclusion); was submitted by agreement of the parties (prior to the taking of any testimony); or was not opposed by the nonmoving party (at least on the basis of its untimeliness). *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497 (TTAB 1986); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299 (TTAB 1986), *aff'd*, *Vesper Corp. v. Lukens Inc.*, 831 F.2d 306 (Fed. Cir. 1987); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); and *Foodland, Inc. v. Foodtown Super Markets, Inc.*, 138 USPQ 591 (TTAB 1963).

### 528.03 Suspension Pending Determination of Motion

*37 CFR §2.127(d) When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be 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. 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 Board will suspend proceedings in the case with respect to all matters not germane to the motion (if the motion was untimely filed, the Board, in its discretion, may issue an immediate action denying the motion for that reason). *See 37 CFR §§2.127(d) and (e)(1)*. The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case; rather, proceedings are suspended when the Board issues an order to that effect. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, at 74 (1986). *Cf. Consultants & Designers, Inc. v. Control Data Corp.*, 221 USPQ 635 (TTAB

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1984). 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. *See* 37 CFR §2.127(d).

Once the Board has suspended proceedings in a case pending the determination of a motion for summary judgment, no party should file any paper which is not germane to the motion. *See* 37 CFR §2.127(d). Examples of papers which 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 FRCP 56(f) for discovery to enable the nonmoving party to respond to the summary judgment motion, a cross-motion for summary judgment, and a motion for leave to amend a party's pleading. *See* TBMP §528.07, and cases cited therein (motion for leave to amend pleading); and *Nestle Co. v. Joyva Corp.*, 227 USPQ 477 (TTAB 1985) (cross-motion for summary judgment).

### **528.04 Miscaptioned Motion**

If, on a motion captioned as a motion to dismiss (for failure to state a claim upon which relief can be granted), or a motion for judgment on the pleadings, matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under FRCP 56. Ordinarily, the parties to the proceeding will be notified that the motion to dismiss, or for judgment on the pleadings, is being treated as a motion for summary judgment, and they will be given reasonable opportunity to present all material made pertinent to such a motion by FRCP 56. *See* TBMP §§503.04 and 504.03, and authorities cited therein. Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion to dismiss, or 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. *See* TBMP §§503.04 and 504.03, and *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983). *Cf. Parker Brothers v. Tuxedo Monopoly, Inc.*, 225 USPQ 1222 (TTAB 1984).

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, or of a motion for judgment on the pleadings. *See S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); and Wright,

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Miller & Kane, *Federal Practice and Procedure*: Civil 2d §2722 (1983). For information concerning the motion to dismiss for failure to state a claim, *see* TBMP §503. For information concerning the motion for judgment on the pleadings, *see* TBMP §504.

### **528.05 Summary Judgment Evidence**

#### **528.05(a) In General**

The types of evidence which may be submitted in support of, or in opposition to, a motion for summary judgment include "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any." *See* FRCP 56(c). *See also* FRCP 56(e).

The evidentiary record upon summary judgment in an inter partes proceeding before the Board also includes, without action by any party, the file of any application or registration which is the subject of the proceeding. *See* 37 CFR §2.122(b). It also includes 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; 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 which 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. *See* 37 CFR §§2.122(b), 2.122(d)(2), 2.122(e), 2.122(f), and 2.127(e)(2).

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 which is the subject matter of the proceeding; and any registration pleaded and made of record by the plaintiff with its complaint. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Any other evidence which a party wishes to have considered upon summary judgment must be submitted in connection with the summary judgment motion.

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Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981); *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57 (TTAB 1975), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); and *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214 (TTAB 1970).

What follows, in TBMP §§528.05(b) through 528.05(e), is a more detailed discussion of some of the types of evidence which may be submitted in connection with a summary judgment motion.

### **528.05(b) Affidavits and Accompanying Exhibits**

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) 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. *See* FRCP 56(e). *See also* FRCP 56(c); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *C & G Corp. v. Baron Homes, Inc.*, 183 USPQ 60 (TTAB 1974); *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93 (TTAB 1972); *4U Company of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251 (TTAB 1972); and *Jos. Schlitz Brewing Co. v. United Vintners, Inc.*, 166 USPQ 493 (TTAB 1970). This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant (of course, an adverse party may have an opportunity for direct examination of the affiant, if a FRCP 56(f) motion to take the discovery deposition of the affiant is made and granted--*see* TBMP §528.06). *See* FRCP 56(e); *C & G Corp. v. Baron Homes, Inc.*, *supra*; and *Jos. Schlitz Brewing Co. v. United Vintners, Inc.*, *supra*.

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. *See* FRCP 56(e), and *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993).

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Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit. *See Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028 (TTAB 1988). An affidavit which 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. *See 4U Company of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251 (TTAB 1972). *Cf.*, for example, *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (TTAB 1979); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576 (TTAB 1976); *Clubman's Club Corp. v. Martin*, 188 USPQ 455 (TTAB 1975); and *Rite Aid Corp. v. Rite-Way Discount Corp.*, 182 USPQ 698 (TTAB 1974), *aff'd*, 508 F.2d 828, 184 USPQ 351 (CCPA 1975).

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR §2.20. *See* 37 CFR §2.20, and *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412 (TTAB 1986).

### **528.05(c) Discovery Responses**

*37 CFR §2.127(e)(2) For purposes of summary judgment only, a discovery deposition, or an answer to an interrogatory, or a document or thing produced in response to a request for production, or an admission to a request for admission, will be considered by the Trademark Trial and Appeal Board if any party files, with the party's brief on the summary judgment motion, the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for production and the documents or things produced in response thereto, or a copy of the 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).*

*Cf.* 37 CFR §2.120(j), governing the use of discovery responses as trial evidence, and TBMP §§709-711.

### **528.05(d) Registrations**

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**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 two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...*

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 such a status and title copy with its brief on the summary judgment motion. *See Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 (TTAB 1986). *Cf.* 37 CFR §2.122(d)(2). A registration owned by a defendant may be made of record, for purposes of summary judgment only, in the same manner.

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. *See Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984), and *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977). *See also* 37 CFR §2.122(e).

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 issue of material fact as to the nature and extent of third-party use of a particular designation. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

### **528.05(e) 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,*

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*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." *See* 37 CFR §2.122(f), and *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57 (TTAB 1975), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976). *See also* TBMP §531.

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; 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. *See Oxy Metal Industries Corp. v. Technic, Inc., supra*, and TBMP §528.05(a).

### **528.06 Request for Discovery to Respond to Summary Judgment**

A party which 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, present by affidavit facts essential to justify its opposition to the motion. *See* FRCP 56(f); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); *Spectra Corp. v. Lutz*, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions*

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*for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990). See also *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992).

A request for FRCP 56(f) discovery, if filed, should be filed on or before the due date for the nonmoving party's response to the summary judgment motion. The affidavit in support of the request may be signed either by the requesting party or by its counsel, as appropriate. See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

It is not sufficient that a nonmoving party simply state in its FRCP 56(f) affidavit 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 by affidavit facts sufficient to show the existence of a genuine issue of material fact for trial. See *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989). Moreover, summary judgment need not be denied based on a nonmoving party's unsupported speculative hope that it will find, through discovery, some evidence to help its case. See *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); *Spectra Corp. v. Lutz*, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989); and *J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697 (TTAB 1986).

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR §2.20. See 37 CFR §2.20. Cf. *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412 (TTAB 1986).

When a request for discovery under FRCP 56(f) 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, requests for discovery outstanding, and those requests remain unanswered. See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990). Cf. *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D. Ohio 1992).

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For further information concerning requests for discovery under FRCP 56(f), see T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

### 528.07 Unpleaded Issue

#### 528.07(a) Not Basis for Summary Judgment

A party may not obtain summary judgment on an issue which has not been pleaded. See FRCP 56(a) and 56(b); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984); *Genesco, Inc. v. Levi Strauss & Co.*, 219 USPQ 1205 (TTAB 1983), *aff'd*, *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); and *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977). 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 FRCP 15(b) for an amendment to conform the pleadings to the evidence cannot have been met. See *Genesco, Inc. v. Levi Strauss & Co.*, *supra*, and *Intermed Communications, Inc. v. Chaney*, *supra*.

However, a party which seeks summary judgment on an unpleaded issue may move to amend its pleading to assert the matter. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241 (TTAB 1989); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); and *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984).

Alternatively, if the parties, upon 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. See: *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB

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1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984); and *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977).

### **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 issues of material fact as to an unpleaded claim or defense. *See Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992), and *Perma Ceram Enterprises, Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992). *Cf.* TBMP §528.07(a), and authorities cited therein.

However, a party which seeks to defend against a motion for summary judgment by asserting the existence of genuine issues of material fact regarding an unpleaded claim or defense, may move to amend its pleading to allege the matter. *See United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993). Alternatively, if a party seeks to defend against a motion for summary judgment by asserting the existence of genuine issues 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), and authorities cited therein.

### **528.08 Entry of Summary Judgment in Favor of Nonmoving Party**

If the Board concludes, upon motion for summary judgment, that there is no genuine issue 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, in appropriate cases, enter summary judgment sua sponte 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). *See, for example*, *Sprinklets Water Center Inc. v. McKesson Corp.*, 25 USPQ2d 1441 (E.D. Mich. 1992); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984); and *Visa International Service Ass'n v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983). *See also, for example* (particularly with respect to when it may

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be appropriate for a court to enter summary judgment sua sponte in favor of the nonmoving party), *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Coach Leatherware Co. v. AnnTaylor Inc.*, 933 F.2d 162, 18 USPQ2d 1907 (2d Cir. 1991); *Arkwright-Boston Manufacturers Mutual Insurance Co. v. Aries Marine Corp.*, 932 F.2d 442, 19 Fed. R Serv.3d 1290 (5th Cir. 1991); and Wright, Miller & Kane, *Federal Practice and Procedure: Civil 2d* §2720 (1986).

### **529 Motion for FRCP 11, or Other Non-Discovery, Sanctions**

#### **529.01 FRCP 11 Sanctions**

***FRCP 11(b) Representations to Court.*** *By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying 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 or to cause unnecessary delay or needless increase in the cost of litigation;*

*(2) the claims, defenses, and 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;*

*(3) 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*

*(4) 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) Sanctions.*** *If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the ... parties that have violated subdivision (b) or are responsible for the violation.*

#### ***(1) How Initiated.***

***(A) By Motion.*** *A motion for sanctions under this rule shall be made separately from other motions or requests and shall describe the specific conduct alleged to violate subdivision (b). It shall be served ..., but shall not be filed with or presented to the court unless, within 21 days after service of the motion (or such other period as the court may prescribe), the challenged paper,*

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*claim, defense, contention, allegation, or denial is not withdrawn or appropriately corrected. ...*

**(B) On Court's Initiative.** *On its own initiative, the court may enter an order describing the specific conduct that appears to violate subdivision (b) and directing [a] ... party to show cause why it has not violated subdivision (b) with respect thereto.*

**(2) Nature of Sanction; Limitations.** *A sanction imposed for violation of this rule shall be limited to what is sufficient to deter repetition of such conduct or comparable conduct by others similarly situated. Subject to the limitations in subparagraphs (A) and (B), the sanction may consist of, or include, directives of a nonmonetary nature, ...*

**(3) Order.** *When imposing sanctions, the court shall describe the conduct determined to constitute a violation of this rule and explain the basis for the sanction imposed.*

**(d) Inapplicability to Discovery.** *Subdivisions (a) through (c) of this rule do not apply to ... discovery requests, responses, objections, and motions that are subject to the provisions of Rules 26 through 37.*

### **37 CFR §10.18 Signature and certificate of practitioner.**

*(a) Except where a copy, including a photocopy or facsimile transmission, of a personally signed piece of correspondence is permitted to be filed pursuant to §1.4 of this chapter, every piece of correspondence filed by a practitioner on behalf of himself or herself or representing an applicant or a party to a proceeding in the Patent and Trademark Office must bear an original signature personally signed in permanent ink by such practitioner except for correspondence which is required to be signed by the applicant or party. The signature of a practitioner on correspondence filed by the practitioner, regardless of whether the correspondence has an original signature or is a copy, including a photocopy or facsimile transmission, of correspondence bearing an original signature, constitutes a certificate that:*

- (1) The correspondence has been read by the practitioner;*
- (2) The filing of the correspondence is authorized;*
- (3) To the best of practitioner's knowledge, information, and belief, there is good ground to support the correspondence, including any allegations of improper conduct contained or alleged therein; and*
- (4) The correspondence is not interposed for delay.*

*(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See §10.23(c)(15).*

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The quoted provisions of FRCP 11 are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. *See* 37 CFR §2.116(a); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). *See also*, Alan S. Cooper, *The Application of Rule 11 Sanctions in Trademark Cases*, 78 Trademark Rep. 427 (1988). Thus, if a paper filed in an inter partes proceeding before the Board violates the provisions of FRCP 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction.

While FRCP 11 provides, inter alia, for the imposition of monetary sanctions, the Board does not have authority to impose monetary sanctions, or to award attorneys' fees or other expenses to any party. *See* 37 CFR §§2.120(f), 2.120(g)(1), 2.120(h), and 2.127(f), and TBMP §502.06.

However, the Board does have authority to enter other appropriate sanctions, up to and including the entry of judgment, against a party which violates FRCP 11. *See* 37 CFR §2.116(a); *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). *See also*, Alan S. Cooper, *The Application of Rule 11 Sanctions in Trademark Cases*, 78 Trademark Rep. 427 (1988). The Board may find a FRCP 11 violation, and impose an appropriate sanction, not only upon motion, but also upon its own initiative. *See* FRCP 11, and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986).

A motion for sanctions under FRCP 11(c) is governed by, and should not be filed in violation of, FRCP 11(b). If the Board finds that a motion for FRCP 11(c) sanctions itself violates the provisions of FRCP 11(b), an appropriate FRCP 11(c) sanction may be entered against the party which filed the motion.

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The provisions of 37 CFR §10.18 are also applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. Any practitioner who knowingly violates the provisions of that rule is subject to disciplinary action. *See* 37 CFR §10.18. For information concerning disciplinary proceedings, *see* 37 CFR §§10.130-10.170, and TBMP §115.02.

### **529.02 Other Non-Discovery Sanctions**

There are certain situations, in addition to those involving a failure to provide discovery (*see* TBMP §527) or a violation of FRCP 11 (*see* TBMP §529.01), in which the Board, in its discretion, may enter sanctions against a party.

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 requesting entry of judgment in its favor. If, as is usually the case, the motion is uncontested, it normally will be granted by the Board. *See* 37 CFR §2.127(a), and TBMP §502.03.

Similarly, if a registrant (having been served by the Board with a copy of a petition to cancel its registration) 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, it normally will be granted by the Board.

### **530 Motion to Offer Discovery Deposition of Self or Nonparty**

#### ***37 CFR §2.120(j) Use of discovery deposition, ...***

*(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.*

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*(2) Except as provided in paragraph (j)(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 at the time of the purported offer of the deposition in evidence, 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, 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 FRCP 30(b)(6) or FRCP 31(a)(3)) 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. *See* 37 CFR §2.120(j)(2), and TBMP §709 and authorities cited therein. *Cf.* 37 CFR §2.120(j)(4) (fairness exception, which provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce under notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party).

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:

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(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); 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. *See Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747 (TTAB 1986); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354 (TTAB 1984); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); and *Insta-Foam Products, Inc. v. Instapak Corp.*, 189 USPQ 793 (TTAB 1976) (the latter two cases were decided prior to the adoption of Rule 2.120(j)(2)).

A motion based on one of the first grounds listed above must be filed at the time of the purported offer of the deposition in evidence. A motion based on the second ground must be filed promptly after the circumstances claimed to justify use of the deposition become known. *See* 37 CFR §2.120(j)(2).

### **531 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 §715 and authorities cited therein.

A party may seek, by motion, to use testimony from another proceeding either as evidence in its behalf upon summary judgment, or as part of its evidence on the case. *See* TBMP §§528.05(e) and 715, and authorities cited therein.

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The Board prefers that a motion for leave to use testimony from another proceeding as evidence on the case be filed during the testimony period of the moving party. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992). *Cf.* 37 CFR §2.120(j)(2). The better practice is to file the motion early in the testimony period, in order to minimize the resulting delay in the proceeding. If the motion is made without the consent of every adverse party, and the moving party believes that it will need additional time to present evidence if the motion is denied, the moving party should file with its motion under 37 CFR §2.122(f) a motion to extend its testimony period.

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. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992).

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. *See* 37 CFR §2.119(a), and *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992).

The Board has construed the term "testimony," as used in 37 CFR §2.122(f), as meaning only trial testimony (*see Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 182 (TTAB 1986)), or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

### **532 Motion That Deposition Upon Written Questions Be Taken Orally**

*37 CFR §2.123(a)(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is,*

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*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 fifteen 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.*

A party served with notice of the taking, by an adverse party, 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, may, within 15 days from the date of service of the notice (20 days if service of the notice was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)), file a motion with the Board, showing good cause, for an order that the deposition be taken by oral examination. *See* 37 CFR §2.123(a)(1).

The determination of whether good cause exists for a motion that a testimonial deposition upon written questions instead be taken by oral examination, is made by the Board on a case-by-case basis, depending upon the particular facts and circumstances in each one. *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990), and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980). *See also* Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253, at 254 (1980), and *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979). *Cf. Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989), and TBMP §520.

### **533 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. Rule 2.120(j), 37 CFR §2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under FRCP 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). Rule 2.122(d)(2), 37 CFR §2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Rule 2.122(e), 37

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CFR §2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. *See also* TBMP §§703.02(a), 703.02(b), 703.03, and 707-711.

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 §718.02(a), and cases cited therein.

An adverse party may also move to strike a notice of reliance, in whole or in part, on the ground that the notice 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 37 CFR §2.122(e) notice of reliance on a printed publication, on the ground that it does not include a copy of the printed publication, or does not indicate the general relevance thereof. *See* TBMP §718.02(b), and cases cited therein. When, 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 which filed the notice of reliance time in which to cure the defect, failing which the notice will stand stricken. *See Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842 (TTAB 1988).

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 which could have been cured if raised promptly by motion to strike. *See* TBMP §718.02(c), and authorities cited therein.

If a motion to strike a notice of reliance raises objections which cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing. *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990).

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing. *See* TBMP §718.02(c), and cases cited therein.

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### 534 Motion to Strike Trial Testimony Deposition

#### 534.01 On Ground of Untimeliness

*37 CFR §2.121(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, 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. *See* 37 CFR §2.121(a), and TBMP §701.

When there is no such approved stipulation, or 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 deposition, in its entirety, as untimely. *See* 37 CFR §§2.121(a) and 2.123(l), and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990). Alternatively, the adverse party may raise this ground for objection in its brief on the case. *See* TBMP §718.03(a), and authorities cited therein. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

#### 534.02 On Ground of Improper or Inadequate Notice

*37 CFR §2.123(c) Notice of examination of witnesses. Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing 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; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. ...*

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**37 CFR §2.123(e)(3)** *Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is 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, if he wishes 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. 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 the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose 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 deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. *See* 37 CFR §2.123(e)(3); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990) (short notice); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (witness not identified); *Home Juice Co. v. Runmlin Cos.*, 231 USPQ 897 (TTAB 1986) (motion to strike untimely); and *Alpha Industries, Inc. v. Alpha Microsystems*, 220 USPQ 67 (TTAB 1983) (no objection based on inadequate notice raised). *Cf. Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984) (witness not identified); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, at fn. 6 (TTAB 1982) (short notice); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352 (TTAB 1976) (witness not identified); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973) (witnesses not identified) [NOTE: this group of cases was decided under 37 CFR §2.123(e)(3) as it existed prior to a rule change effective June 22, 1983, which added thereto, inter alia, the requirement that an adverse party which wishes to preserve an objection based on improper or inadequate notice must move to strike the testimony promptly after its completion].

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

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will be decided on the basis of all the relevant circumstances. *See* 37 CFR §2.123(e)(3).

### **534.03 When Motion to Strike Should Not Be Filed**

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, or orally "on the record" at the taking of the deposition, as appropriate. *See* TBMP §718.03(c).

### **535 Motion for Judgment for Plaintiff's Failure to Prove Case**

#### **535.01 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 that party has not taken testimony or offered any other evidence, 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 fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, 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 a copy or copies of Patent and Trademark Office records 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 fifteen 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 of the evidence is in the record. If*

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*judgment is not rendered, 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.*

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 2.132(b). Only in these two situations will such a motion be entertained by the Board. *See* TBMP §535.04.

### **535.02 Motion for Judgment Under Rule 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. 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. *See* 37 CFR §2.132(a). *See also, for example, Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, at fn.4 (TTAB 1990); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); *Loren Cook Co. v. Acme Engineering and Manufacturing Corp.*, 216 USPQ 517 (TTAB 1982); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275-276 (1984). 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 was filed thereafter. *See* 37 CFR §2.132(c), and *Hewlett-Packard Co. v. Olympus Corp.*, *supra*.

When a motion for judgment under 37 CFR §2.132(a) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)) in which to show cause why judgment should not be rendered against it. In the absence of a showing of good and

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sufficient cause, judgment may be rendered against the plaintiff. *See* 37 CFR §2.132(a).

The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard which would have to be met by any motion under FRCP 6(b) to reopen the plaintiff's testimony period. *See Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989), and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982). For examples of cases involving the question of whether good and sufficient cause has been shown for a plaintiff's failure to offer any evidence, *see Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (plaintiff, without first obtaining defendant's consent thereto, sent defendant a proposed "stipulated" extension of plaintiff's testimony period and asked that defendant sign it and forward it to the PTO; defendant did not do so); *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989) (defendant had filed several motions to extend its time to respond to discovery requests); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987) (plaintiff entitled to know disposition of defendant's pending motion to amend its answer before proceeding to trial); *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982) (misunderstanding between counsel for plaintiff and defendant); *Proctor & Gamble Co. v. Johnson & Johnson Inc.*, 485 F.Supp. 1185, 205 USPQ 697 (S.D.N.Y. 1979), *aff'd without opinion*, 636 F.2d 1203 (2d Cir. 1980) (civil action filed by defendant prior to commencement of plaintiff's testimony period); *Allegro High Fidelity, Inc. v. Zenith Radio Corp.*, 197 USPQ 550 (TTAB 1977) (civil action filed by plaintiff after close of its testimony period); *Tel-E-Gift Corp. v. Teleflora Inc.*, 193 USPQ 254 (TTAB 1976) (communication problem between plaintiff and its counsel); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 428 (TTAB 1976), *recon. denied*, 190 USPQ 431 (TTAB 1976) (inadequate docket system and heavy work load of plaintiff's counsel; request filed by plaintiff, after close of its testimony period, that Board take judicial notice of certain matters); *Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509 (TTAB 1976) (answer to complaint contains certain admissions); *A.R.A. Manufacturing Co. v. Equipment Co.*, 183 USPQ 558 (TTAB 1974) (unfamiliarity with current rule governing introduction of plaintiff's registration); *Pierce Foods Corp. v. Mountain Mamma, Inc.*, 183 USPQ 380 (TTAB 1974) (applicant assertedly guilty of unclean hands); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974) (during its testimony period, plaintiff had moved to suspend pending outcome of recently filed civil action); *W. R. Grace & Co. v. Red Owl*

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*Stores, Inc.*, 181 USPQ 118 (TTAB 1973) (unfamiliarity with current rule governing introduction of plaintiff's registration); and *Perfect Film & Chemical Corp. v. Society Ordinastral*, 172 USPQ 696 (TTAB 1972) (allegations in pleading, and exhibits attached thereto, not evidence in plaintiff's behalf).

If a timely motion under 37 CFR §2.132(a) is denied, testimony periods will be reset for the defendant and for rebuttal. See 37 CFR §2.132(a).

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. See *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976). However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. See *Pfaltzgraf v. William Davies Co.*, 175 USPQ 620 (TTAB 1972), and Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983). If no motion under 37 CFR §2.132(a) is filed, trial dates will continue to run, and the case will be determined at final hearing; in those cases where plaintiff did, in fact, fail to offer any evidence during its testimony period, defendant need not offer evidence either. See, for example, *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987), and *Pfaltzgraf v. William Davies Co.*, 175 USPQ 620 (TTAB 1972).

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). See *W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118 (TTAB 1973).

### **535.03 Motion for Judgment Under Rule 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 PTO records. 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. See 37 CFR §2.132(b). A motion for judgment under 37

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CFR §2.132(b) must be filed before the opening of the moving party's testimony period. *See* 37 CFR §2.132(c).

When a motion for judgment under 37 CFR §2.132(b) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)) to file a brief in response thereto. *See* 37 CFR §2.132(b).

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. *See* 37 CFR §2.132(b). *See also Merker Counter Co. v. Central Counter Co.*, 310 F.2d 746, 135 USPQ 433 (CCPA 1962); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879 (TTAB 1990); and *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313 (TTAB 1976).

If a timely motion under 37 CFR §2.132(b) is denied, testimony periods will be reset for the defendant and for rebuttal. *See* 37 CFR §2.132(b).

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 PTO records, and those records do not make out a prima facie case. *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431 (TTAB 1976). However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. *See* Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983). *Cf. Pfaltzgraf v. William Davies Co.*, 175 USPQ 620 (TTAB 1972).

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). *Cf. W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118 (TTAB 1973).

### **535.04 Motion Under FRCP 41(b) or FRCP 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

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other trial evidence, prior to final decision. *See* TBMP §502.01, and authorities cited therein.

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 2.132(b). *See* TBMP §§535.02 and 535.03. The motion under FRCP 41(b) for involuntary dismissal, and the motion under FRCP 50(a) for a directed verdict, are not available in Board proceedings. *See* TBMP §502.01, and authorities cited therein.

### **536 Motion for Order to Show Cause Under Rule 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 his involved registration to be cancelled under section 8 of the Act of 1946 or has failed to renew his involved registration under section 9 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 or failure to renew 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.*

*See*, in this regard, TBMP §602.02(b) and authorities cited therein.

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 Section 8 or 9 of the Act after the commencement of the proceeding. However, if the cancellation of the registration under Section 8 or 9 of the Act comes to the attention of the Board in another manner, the Board may issue an order to show cause upon its own initiative.

In those cases where the Board finds that respondent 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

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dismissed without prejudice as moot. 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. *See* TBMP §602.02(b), and cases cited therein.

For further information concerning orders to show cause under 37 CFR §2.134(b), *see* TBMP §602.02(b).

### **537 Motion for Order to Show Cause Under Rule 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 he has lost interest in the case, judgment may be entered against plaintiff.*

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 settled, 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. *See* Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23132, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 22; and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984). 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 considered discharged, and judgment will not be entered against plaintiff for failure to file a main brief.

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 fears that the Board may

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inadvertently overlook a plaintiff's failure to file a main brief, the adverse party may file a motion for an order to show cause.

When it finds that a 37 CFR §2.128(a)(3) order to show cause has been discharged, the Board will reset the times for filing remaining briefs on the case. If the plaintiff includes with its response to the show cause order a motion under FRCP 6(b) to reopen its time to file a main brief (*see* TBMP §509), and the motion is granted, all times for filing briefs on the case will be reset.

If a 37 CFR §2.128(a)(3) order to show cause has been discharged, but the record shows that plaintiff failed, during its testimony period, to take any testimony or offer any other evidence in its behalf, the Board, in lieu of resetting the times for filing remaining briefs on the case, may enter judgment against plaintiff for failure to prove its case.

### **538 Motion for Leave to Exceed Page Limit for Brief on Case**

*37 CFR 2.128(b) ... Each brief shall contain an alphabetical index of cases cited therein. 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 facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. ...*

For further information concerning the parts of a brief which fall within the page limit, *see* TBMP §801.03, and authorities cited therein.

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. *See* 37 CFR §2.128(b). Thus, the motion must be submitted on or before the date that the brief is due. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994). This is so even in those cases where the motion is filed with the consent of the adverse party or parties. Rule 2.128(b) is for the benefit of the Board, and only with the Board's permission, timely sought, will a brief exceeding the page limit be entertained.

The better, and preferred, practice, when a timely motion for leave to exceed the page limit is filed, is that the proposed overlength brief not be filed with the

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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 which 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 the motion, and the motion is granted, the Board will accept the brief. If the motion is denied, the overlength brief will be given no consideration, and the Board will allow time for the filing of a brief which meets the limit. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994).

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 which exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute brief which meets the limit. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994).

Motions for leave to file a brief on the case which exceeds the page limit are relatively rare and are disfavored by the Board. Because the Board is an administrative tribunal of limited jurisdiction, empowered to determine only the right to register (*see* TBMP §102.01), very few of the cases before it are of such nature as to require a brief on the case which exceeds the 37 CFR §2.128(b) page limit. Moreover, page limitations serve several important functions. They assist the Board in the management of its workload, and encourage litigants to focus their arguments and eliminate needless verbiage. *Cf. Fleming v. County of Kane*, 855 F.2d 496 (7th Cir. 1988).

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 which may serve to demonstrate why additional pages are necessary. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994), and *U.S. Navy v.*

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*United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987). *Cf.* 37 CFR §2.129(a), and TBMP §542.02.

### **539 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. *See, for example, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987). *Cf.* TBMP §502.03 (reply briefs on motions neither provided for nor prohibited by rules and may be entertained by Board in its discretion), and Federal Circuit Rule 29 (governing the filing of amicus briefs in appeals to the Court of Appeals for the Federal Circuit).

An entity which 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. *Cf.* Federal Circuit Rule 29.

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.

### **540 Motion to Strike Brief on Case**

Specific provision is made in the Trademark Rules of Practice for the filing of briefs on the case, namely, the main brief of the party in the position of plaintiff, followed by the answering brief of the party in the position of defendant, followed by the reply brief of the party in the position of plaintiff. *See* 37 CFR §2.128(a). *See also* TBMP §801.02.

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Subject to the provisions of FRCP 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. 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 which simply objects to the contents thereof. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the case, and any portions of the brief which 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) (*see* TBMP §§538 and 801.03), it may be stricken, or given no consideration, by the Board. *See American Optical Corp. v. Atwood Oceanics, Inc.*, 177 USPQ 585 (Comm'r 1973) (brief too long and not in proper form), and *Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250 (TTAB 1972) (brief untimely). 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 §538 (if a party files a brief which exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute which meets the limit).

Because the rules do not provide for the filing of a reply or rejoinder brief by a party in the position of defendant, any such brief may be stricken, or given no consideration, by the Board. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863 (TTAB 1985); *Hydrotech Corp. v. Hydrotech International, Inc.*, 196 USPQ 387 (TTAB 1977); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); and *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469 (TTAB 1973).

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. *See, for example, Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (TTAB 1976); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534

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F.2d 915, 189 USPQ 693 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

### 541 Motion for Augmented Panel Hearing

Each case before the Board must be judicially "heard" (i.e., determined) by at least three members (administrative trademark judges) of the Board. See Section 17 of the Act, 15 U.S.C. §1067. See also 37 CFR §§2.129(a) and 2.142(e)(1); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); *Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464 (TTAB 1983); *Jockey International, Inc. v. Bette Appel Unltd.*, 216 USPQ 359 (TTAB 1982); *Ronson Corp. v. Ronco Teleproducts, Inc.*, 197 USPQ 492 (Comm'r 1978); and *Ethicon, Inc. v. American Cyanamid Co.*, 193 USPQ 374 (Comm'r 1977). However, the Board may use an augmented panel to hear a case. See, for example, *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986); *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985); and *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). An augmented panel may include any number of Board members exceeding three, that is, from four to the entire body of members. For information concerning the constitution of Patent and Trademark Office Board panels, see *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

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. See, for example, *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986); *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985); and *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984). Cf. Federal Circuit Rule 35.

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### **542 Motion to Change Oral Hearing Date; For Additional Time**

#### **542.01 Motion to Change Oral Hearing Date**

If a party to a proceeding before the Board desires to have an oral argument (i.e., oral hearing) at final hearing, the party must file a request therefor, by separate paper, not later than 10 days after the due date for the filing of the last reply brief in the proceeding. When a request for an oral hearing is filed, the Board sets the date and time for the hearing, and sends each party written notice thereof. *See* 37 CFR §2.129(a). It is the normal practice of the Board, in setting an oral hearing, to phone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing, following which the written notice formally scheduling the hearing is mailed.

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. *See* 37 CFR §2.129(b). 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 Administrator, 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.

When one or more of the parties does not consent to the resetting of an oral hearing, the party which wishes to have the hearing reset must file a motion therefor, showing good cause. *See* FRCP 6(b), and 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 either hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned, or, if the motion has been filed with the Board by some other method, telephone the interlocutory attorney handling the case and notify the attorney of the filing of the motion. *See* TBMP §502.07(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

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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.

Repeated stipulations or requests to reset an oral hearing should not be filed.

For further information concerning oral hearings, *see* TBMP §802.

### **542.02 Motion for Additional Time for Oral Argument**

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. *See* 37 CFR §2.129(a), and 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. *See* 37 CFR §2.129(a), and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987). *Cf.* 37 CFR §2.128(b), and TBMP §538. If the request is granted, each party will be allowed the same amount of time for oral argument.

When a party decides to request 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. Alternatively (and ideally), the request for additional time may be included in the request for oral hearing. 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 §542.01.

### **543 Motion for Leave to Audiotape Oral Hearing**

Upon prior arrangement, the Board will usually permit a party to make an audiotape recording of an oral hearing. However, 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).

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Leave to audiotape an oral hearing is secured by filing a motion therefor showing good cause (such as, that the audiotape 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 audiotaping equipment in an unobtrusive manner.

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*. Any motion for leave to videotape an oral hearing will be denied.

### **544 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 fifteen 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). *Cf.* 37 CFR §2.127(b), and 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. *See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 410 (TTAB 1979). If a responsive brief is filed, it must be filed within 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR §2.119(c)).

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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. *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 176 (TTAB 1975). *Cf.* TBMP §502.03, and cases cited therein.

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 (*see Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978), and *In re Cosmetically Yours, Inc.*, 171 USPQ 563 (TTAB 1971)), 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. 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.*, 3 USPQ2d 1708 (TTAB 1984), and *In re Kroger Co.*, 177 USPQ 715 (TTAB 1973).

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 two months after action on the request. *See* 37 CFR §2.145(d)(1), and TBMP §§902.02 and 903.04.

### **545 Motion for Relief From Final Judgment**

***FRCP 60(b) Mistakes; Inadvertence; Excusable Neglect; Newly Discovered Evidence; Fraud, etc.*** *On motion and upon such terms as are just, the court may relieve a party or a party's legal representative from a final judgment, order, or proceeding for the following reasons: (1) mistake, inadvertence, surprise, or excusable neglect; (2) newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b); (3) fraud (whether heretofore denominated intrinsic or extrinsic), misrepresentation, or other misconduct of an adverse party; (4) the judgment is void; (5) ... a prior judgment upon which [the judgment] is based has been reversed or otherwise vacated ...; or (6) any other reason justifying relief from the operation of the judgment. The motion shall be made within a reasonable time, and for reasons*

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*(1), (2), and (3) not more than one year after the judgment, order, or proceeding was entered or taken. A motion under this subdivision (b) does not affect the finality of a judgment or suspend its operation. This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or proceeding ... or to set aside a judgment for fraud upon the court. ...*

Motions to set aside or vacate a final judgment rendered by the Board are governed by FRCP 60(b). *See* 37 CFR §2.116(a). 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 FRCP 60(b).

FRCP 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, 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 FRCP 60(b).

For examples of cases involving a motion for relief from a final judgment of the Board, *see* *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992) (reason 6); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992) (reasons 1 and 6); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991) (reason (1)); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (reason (1)); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330 (TTAB 1982) (reasons (1), (3), and (6)); *Lee Byron Corp. v. H.D. Lee Co.* 203 USPQ 1097 (TTAB 1979) (reason (2)); *Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978) (reason (2)); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819 (TTAB 1978) (reason (1)); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976) (reasons (1) and (6)); *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (reason (1)); and *Columbia Broadcasting System, Inc. v. De Costa*, 165 USPQ 95 (TTAB 1970) (reason (6)). *Cf. In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r 1989).

A motion for relief from judgment must be made within a reasonable time; 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. *See* FRCP 60(b); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819 (TTAB 1978); and *Columbia Broadcasting System, Inc. v. De Costa*, 165 USPQ 95 (TTAB 1970). The filing of the motion

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will not affect the finality of the judgment or suspend its operation. *See* FRCP 60(b).

Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances. The determination of whether a motion under FRCP 60(b) should be granted is a matter which lies within the sound discretion of the Board. *See: General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992), and *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991). *Cf. Case v. BASF Wyandotte*, 737 F.2d 1034, 222 USPQ 737 (Fed. Cir. 1984).

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 FRCP 60(b).

Because default judgments for failure to timely answer the complaint are not favored by the law, a motion under FRCP 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under FRCP 60(b) for relief from other types of judgments. *See* TBMP §317.03, and authorities cited therein. 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. *See* TBMP §317.03; *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991), and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991). *See also* *Waifersong Ltd. Inc. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992). *Cf. General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992).

If, in a cancellation proceeding, a petition to the Commissioner is filed concurrently with a FRCP 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. If the Board grants the motion, the Commissioner, as a ministerial act, will reinstate the subject registration. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61 (Comm'r 1985).

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

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judgment should be filed. A consented request for relief from judgment ordinarily will be granted by the Board.