CHAPTER 500
STIPULATIONS AND MOTIONS

501 STIPULATIONS 6

501.01 IN GENERAL 6
501.02 FILING STIPULATIONS 6
501.03 FORM OF STIPULATIONS 6

502 MOTIONS--IN GENERAL 7

502.01 AVAILABLE MOTIONS 7
502.02 FORM OF MOTIONS AND BRIEFS ON MOTIONS 8
502.02(a) Form of Motions 9
502.02(b) Briefs on Motions 10
502.03 ORAL HEARINGS ON MOTIONS 12
502.04 DETERMINATION OF MOTIONS 12
502.05 ATTORNEYS' FEES, ETC., ON MOTIONS 14
502.06 TELEPHONE AND PRE-TRIAL CONFERENCES 14
502.06(a) Telephone Conferences 14
502.06(b) Pre-trial Conferences 17
502.07 FED. R. CIV. P. 11 APPLICABLE 17

503 MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM 17

503.01 TIME FOR FILING 17
503.02 NATURE OF MOTION 18
503.03 LEAVE TO AMEND DEFECTIVE PLEADING 19
503.04 MATTERS OUTSIDE THE PLEADING SUBMITTED ON MOTION TO DISMISS 20

504 MOTION FOR JUDGMENT ON THE PLEADINGS 21

504.01 TIME FOR FILING 21
504.02 NATURE OF MOTION 22
504.03 MATTERS OUTSIDE THE PLEADINGS SUBMITTED ON MOTION FOR JUDGMENT ON PLEADINGS 22

505 MOTION FOR A MORE DEFINITE STATEMENT 23

505.01 NATURE OF MOTION 23
505.02 TIME FOR FILING 24
505.03 FAILURE TO OBEY ORDER FOR MORE DEFINITE STATEMENT 24

506 MOTION TO STRIKE MATTER FROM PLEADING 24

506.01 NATURE OF MOTION 24
506.02 TIME FOR FILING 26

506.03 EXHIBITS ATTACHED TO PLEADINGS 26

507 MOTION TO AMEND PLEADING 27

507.01 IN GENERAL 27
507.02 AMENDMENTS--GENERAL RULE—FED. R. CIV. P. 15(A) 27
507.02(a) Timing of Motion to Amend Pleading – In General 29
507.02(b) Timing of Motion to Amend to Add Counterclaim 31
507.03 AMENDMENTS TO CONFORM TO THE EVIDENCE -- FED. R. CIV. P. 15(B) 32
507.03(a) During Trial After Objection to Trial Evidence 32
507.03(b) To Add Issues Tried by Express or Implied Consent 32

508 MOTION FOR DEFAULT JUDGMENT FOR FAILURE TO ANSWER 33

509 MOTION TO EXTEND TIME; MOTION TO REOPEN TIME 34

509.01 NATURE OF MOTIONS 35
509.01(a) Motions to Extend Time 35
509.01(b) Motions to Reopen Time 36
509.02 FORM AND DETERMINATION OF MOTIONS TO EXTEND OR REOPEN 39

510 MOTION TO SUSPEND; MOTION TO RESUME 41

510.01 IN GENERAL 42
510.02 SUSPENSION PENDING OUTCOME OF ANOTHER PROCEEDING; RESUMPTION 43
510.02(a) Suspension 43
510.02(b) Resumption 46
510.03 SUSPENSION FOR OTHER REASONS; RESUMPTION 46
510.03(a) Suspension 46
510.03(b) Resumption 49

511 MOTION TO CONSOLIDATE 51

512 MOTION TO JOIN OR SUBSTITUTE 53

512.01 ASSIGNMENT OF MARK 53
512.02 CHANGE OF NAME 55
512.03 ISSUANCE OF REGISTRATION TO ASSIGNEE, OR IN NEW NAME 55
512.04 MISIDENTIFICATION 56

513 MOTION TO WITHDRAW AS REPRESENTATIVE; PETITION TO DISQUALIFY 57

513.01 MOTION TO WITHDRAW AS REPRESENTATIVE 57
513.02 PETITION TO DISQUALIFY 60

514 MOTION TO AMEND APPLICATION OR REGISTRATION 61

514.01 IN GENERAL 61

514.02 AMENDMENT WITH CONSENT 62
514.03 AMENDMENT WITHOUT CONSENT 63
514.04 AMENDMENT TO ALLEGE USE; STATEMENT OF USE 65

515 MOTION TO REMAND APPLICATION TO EXAMINING ATTORNEY 65

516 MOTION TO DIVIDE APPLICATION 66

517 MOTION TO STRIKE BRIEF ON MOTION 67

518 MOTION FOR RECONSIDERATION OF DECISION ON MOTION 68

519 MOTION FOR LEAVE TO SERVE ADDITIONAL INTERROGATORIES 69

520 MOTION TO TAKE FOREIGN DEPOSITION ORALLY 70

521 MOTION TO QUASH NOTICE OF DEPOSITION 71

522 MOTION FOR ORDER RE MANNER OR PLACE OF DOCUMENT PRODUCTION 73

523 MOTION TO COMPEL DISCOVERY 74

523.01 IN GENERAL 74
523.02 SPECIAL REQUIREMENTS FOR MOTION 76
523.03 TIME FOR FILING MOTION 77
523.04 FAILURE TO FILE MOTION TO COMPEL 77

524 MOTION TO TEST SUFFICIENCY OF RESPONSE TO ADMISSION REQUEST 78

524.01 IN GENERAL 78
524.02 SPECIAL REQUIREMENTS FOR MOTION 79
524.03 TIME FOR FILING MOTION 79
524.04 FAILURE TO FILE MOTION 80

525 MOTION TO WITHDRAW OR AMEND ADMISSION 80

526 MOTION FOR A PROTECTIVE ORDER 81

527 MOTION FOR SANCTIONS 83

527.01 MOTION FOR DISCOVERY SANCTIONS 83
527.01(a) For Failure to Comply With Board Discovery Order 83
527.01(b) If Party Says It Will Not Respond to Discovery Request 85
527.01(c) Untimely Response to Discovery Requests 85
527.01(d) In the Case of Requests for Admission 86
527.01(e) Estoppel Sanction 87
527.02 MOTION FOR FED. R. CIV. P. 11 SANCTIONS 88
527.03 INHERENT AUTHORITY TO SANCTION 91

Chapter 500
STIPULATIONS AND MOTIONS

528 MOTION FOR SUMMARY JUDGMENT ____ 92

528.01 GENERAL NATURE OF MOTION ____ 94
528.02 TIME FOR FILING MOTION ____ 97
528.03 SUSPENSION PENDING DETERMINATION OF MOTION ____ 98
528.04 MISCAPTIONED MOTION ____ 100
528.05 SUMMARY JUDGMENT EVIDENCE ____ 101
528.05(a) In General ____ 101
528.05(b) Affidavits and Accompanying Exhibits ____ 102
528.05(c) Discovery Responses ____ 104
528.05(d) Registrations ____ 104
528.05(e) Printed Publications and Official Records ____ 105
528.05(f) Testimony from Another Proceeding ____ 107
528.06 REQUEST FOR DISCOVERY TO RESPOND TO SUMMARY JUDGMENT ____ 107
528.07 UNPLEADED ISSUE ____ 110
528.07(a) Not Basis for Entering or Avoiding Summary Judgment ____ 110
528.07(b) Not Defense Against Summary Judgment ____ 111
528.08 ENTRY OF SUMMARY JUDGMENT IN FAVOR OF NONMOVING PARTY ____ 111

529 MOTION TO OFFER DISCOVERY DEPOSITION OF SELF OR NONPARTY ____ 112

530 MOTION TO USE TESTIMONY FROM ANOTHER PROCEEDING ____ 113

531 MOTION THAT DEPOSITION UPON WRITTEN QUESTIONS BE TAKEN ORALLY ____ 114

532 MOTION TO STRIKE NOTICE OF RELIANCE ____ 115

533 MOTION TO STRIKE TRIAL TESTIMONY DEPOSITION ____ 117

533.01 ON GROUND OF UNTIMELINESS ____ 117
533.02 ON GROUND OF IMPROPER OR INADEQUATE NOTICE ____ 117
533.03 WHEN MOTION TO STRIKE SHOULD NOT BE FILED ____ 119

534 MOTION FOR JUDGMENT FOR PLAINTIFF'S FAILURE TO PROVE CASE ____ 119

534.01 IN GENERAL ____ 119
534.02 MOTION FOR JUDGMENT UNDER RULE 2.132(A) ____ 120
534.03 MOTION FOR JUDGMENT UNDER RULE 2.132(B) ____ 122
534.04 MOTION UNDER FED. R. CIV. P. 41(B) OR FED. R. CIV. P. 50(A) NOT AVAILABLE ____ 123

535 MOTION FOR ORDER TO SHOW CAUSE UNDER RULE 2.134(B) ____ 124

536 MOTION FOR ORDER TO SHOW CAUSE UNDER RULE 2.128(A)(3) ____ 125

537 MOTION FOR LEAVE TO EXCEED PAGE LIMIT FOR BRIEF ON CASE ____ 126

538 MOTION FOR LEAVE TO FILE AMICUS BRIEF ____ 128

539 MOTION TO STRIKE BRIEF ON CASE ____ 128

540 MOTION FOR AUGMENTED PANEL HEARING ____ 130

541 MOTION TO CHANGE ORAL HEARING DATE; FOR ADDITIONAL TIME ____ 130

541.01 MOTION TO CHANGE ORAL HEARING DATE ____ 130
541.02 MOTION FOR ADDITIONAL TIME FOR ORAL ARGUMENT ____ 132

542 MOTION FOR LEAVE TO AUDIOTAPE ORAL HEARING ____ 132

543 MOTION FOR RECONSIDERATION OF FINAL DECISION ____ 133

544 MOTION FOR RELIEF FROM FINAL JUDGMENT ____ 134

APPENDIX OF CASES ____ 137

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 Fed. R. Civ. P. 34 may be made in a specified place and/or manner;[1] to protective agreements;[2] to the facts in the case of any party;[3] that the testimony of witnesses may be submitted in affidavit form;[4] that a deposition may be taken at a particular place, or in a certain manner;[5] that the proceeding shall be ended in a specified way.[6]

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, 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 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 Stipulations

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

If parties stipulate to extend or reopen a time or times, the stipulation should specify the closing date for each rescheduled time. For example, if parties stipulate to extend or reopen a defendant's time to file an answer to the complaint, the stipulation should specify the new due

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[1] *See* 37 CFR § 2.120(d)(2).

[2] S*ee* TBMP § 412.02 (Protective Orders – Upon Stipulation).

[3] *See* 37 CFR § 2.123(b).

[4] *See* 37 CFR § 2.123(b).

[5] *See* 37 CFR § 2.123(b).

[6] *See* TBMP § 605.03 (Settlement Agreements).

date for the answer. Due dates for answers to complaints may not be extended beyond the close of discovery. Stipulations to extend the time to answer beyond the close of discovery will be denied. 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.[7] 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.[8]

The resetting, whether by stipulation or otherwise, of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods--such dates will be rescheduled only upon stipulation of the parties being approved by the Board, or upon motion granted by the Board, or by order of the Board.[9]

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

However, because the Board is an administrative tribunal, its rules and procedures, and hence the motions available in proceedings before it, necessarily differ in some respects from those prevailing in the Federal district courts.[10]

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.[11] Further, for reasons of administrative economy,

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[7] *See* 37 CFR § 2.121(d), and *Jan Bell Marketing Inc. v. Centennial Jewelers Inc.*, 19 USPQ2d 1636 (TTAB 1990).

[8] *See* 37 CFR §§ 2.102(d) and 2.121(d), and *Jan Bell Marketing Inc. v. Centennial Jewelers Inc., supra*.

[9] *See* 37 CFR §§ 2.120(a) and 2.121(a), and TBMP § 403.04 (Extensions of Discovery Period and/or Time to Respond to Discovery).

[10] *See* TBMP §§ 102.03 (General Description of Board Proceedings) and 702 (Manner of Trial and Introduction of Evidence).

it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision.[12] For this reason, the Board will defer consideration of substantive objections to trial evidence (e.g., on the grounds of hearsay, relevance, or that the evidence constitutes improper rebuttal) until final decision.[13] Therefore, except for the motions for involuntary dismissal under Trademark Rules 2.132(a) and (b) for failure of the plaintiff to take testimony, the Board will not entertain any motion challenging or otherwise relating to the probative value or sufficiency of a party's trial evidence.[14] Motions that require examination of trial evidence prior to final decision, such as those under Fed. R. Civ. P. 41(b) for involuntary dismissal and under Fed. R. Civ. P. 50(a) for judgment as a matter of law (formerly known as a motion for directed verdict), are not available in Board proceedings.[15]

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

502.02 Form of Motions and Briefs on 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. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. ... The Board may, in its discretion,*

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[11] *See* 37 CFR § 2.125(c) and TBMP § 702 (Manner of Trial and Introduction of Evidence).

[12] *See, e.g., M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (Board will not rule on objections pertaining to admissibility prior to final decision).

[13] *See, e.g., Hilson Research Inc. v. Society for Human Resource Management,* 27 USPQ2d 1423, 1426 (TTAB 1993) (contested motions to introduce discovery depositions filed with a notice of reliance deferred); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (objection to notice of reliance that the evidence is improper rebuttal evidence will be deferred) and *M-Tek Inc. v. CVP Systems, Inc., supra* (motion to strike documents submitted under a notice of reliance as hearsay and not properly authenticated deferred). *See also* TBMP § 707 (Objections to Evidence).

[14] *For information concerning these motions see* TBMP § 534.

[15] *See Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993) (directed verdicts not available); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718, 718 (TTAB 1985) (to extent motion for summary judgment was intended as one for directed verdict, it is inappropriate); *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 61 (TTAB 1985), *aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (motion for involuntary dismissal under Rule 41(b) unavailable); and Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods*, 73 Trademark Rep. 76 (1983).

consider a reply brief. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion will be considered by the Board. Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. The brief in support of the motion and the brief in response to the motion shall not exceed 25 pages in length; and a reply brief shall not exceed 10 pages in length. Exhibits submitted in support of or in opposition to the motion shall not be deemed to be part of the brief for purposes of determining the length of the brief....

(e)(1)*... If no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within 30 days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. ... The Board may, in its discretion, consider a reply brief A reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.*

502.02(a) Form of Motions

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.[16] A party who files a motion, which does not bear the correct proceeding number, runs the risk that the paper will not 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.[17]

The certificate of mailing by first-class mail procedure provided under 37 CFR § 1.8, and the "Express Mail" procedure provided under 37 CFR § 1.10, are both available for the filing of motions.[18]

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[16] *See* TBMP § 106.01 (Identification of Paperes).

[17] *See* 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Papers).

[18] *See* 37 CFR §§ 1.8 and 1.10, and TBMP §§ 110 (Certificate of Mailing or Transmission Procedure) and 111 ("Express Mail" Procedure).

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.[19]

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.[20] Further, 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.

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 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.

502.02(b) Briefs on Motions

Every motion must embody or be accompanied by a brief.[21]

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[19] *See* 37 CFR §§ 2.119(a) and 2.119(b), and TBMP § 113 (Service of Papers).

[20] *See* 37 CFR § 2.121(d), and TBMP §§ 501.03 (Form of Stipulations) and 509.02 (Form and Determination of Motions to Extend or Reopen). *Cf.* TBMP § 403.03 (Time for Service of Discovery Responses).

[21] *See* 37 CFR § 2.127(a).

Briefs on motions should not be filed in bound form.[22] Briefs must be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Briefs in support of and in response to a motion may not exceed 25 pages in length and a reply brief may not exceed 10 pages.[23] Exhibits submitted with the brief are not counted in determining the length of the brief.

A brief in response to a motion, except for a motion for summary judgment, 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).[24] A brief in response to a motion for summary judgment (or, if appropriate, a motion under Fed. R. Civ. P. 56(f)), must be filed within 30 days from the date of service of the summary judgment motion (35 days if 37 CFR. § 2.119(c) applies).[25] These time periods for responding to motions shall apply unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause; or the time is reopened by stipulation of the parties approved by the Board or by order of the Board on motion showing excusable neglect.[26]

The Board may, in its discretion, consider a reply brief in support of a motion.[27] A reply brief, if filed, including a reply brief for a summary judgment motion, shall be filed within 15 days from the date of service of the brief in response to the motion (20 days if 37 CFR § 2.119(c) applies). The time for filing a reply brief will not be extended.[28] No further papers (including surreply briefs) will be considered by the Board, and any such papers filed in violation of this rule may be returned to the filing party.[29] The filing of

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[22] *See* TBMP § 106.03 (Form of Papers).

[23] *See* 37 CFR § 2.127(a). *See also Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002) (reply brief was untimely and exceeded page limit) and *Estate of Shakur v. Thug Life Clothing Co*., 57 USPQ2d 1095, 1096 (TTAB 2000) (filing of two briefs in an attempt to circumvent page limitation improper).

[24] *See* 37 CFR § 2.119(c)).

[25] *See* Trademark Rule 2.127(e)**.** *See also* TBMP § 528.02 *for further information regarding the time for filing a motion for summary judgment.*

[26] *See* Fed. R. Civ. P. 6(b) and TBMP § 509 (Motion to Extend Time; Motion to Reopen Time).

[27] *See* 37 CFR § 2.127(a). *See also, e.g., Seculus da Amazonia S/S v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, n.4 (TTAB 2003) (reply brief considered because it clarified the issues under consideration); *Harjo v. Pro-Football, Inc.,* 45 USPQ2d 1789, 1791 (TTAB 1998) (motion to strike reply brief denied); and *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 n.4 (TTAB 1995).

[28] *See* 37 CFR § 2.127(a). *See also Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc., supra* (approval of consented motion to extend time to file reply brief vacated).

[29] *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000).

reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief.[30] Thus, it remains within the Board's discretion whether to consider a reply brief.[31]

502.03 Oral Hearings on Motions

An oral hearing is not held on a motion except by order of the Board.[32] 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 are, and should be, adequately presented in the briefs thereon, and therefore the Board rarely grants a request for an oral hearing on a motion.[33]

502.04 Determination of Motions

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

37 CFR § 2.127(c) *Interlocutory motions, requests, 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.*

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.

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[30] *See No Fear Inc. v. Rule*, *supra* at 1553 and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto").

[31] *See No Fear Inc. v. Rule*, *supra* at 1553 (TTAB 2000) (reply brief reviewed, but given no consideration).

[32] *See* 37 CFR § 2.127(a).

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

If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the Board, in its discretion, may grant the motion as conceded.[34] However, the Board, in its discretion, may also decline to treat an uncontested motion as conceded, and may grant or deny the motion on its merits.[35]

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

Interlocutory motions which are not actually or potentially dispositive of a proceeding may be acted upon by a single Board administrative trademark judge, or by a single interlocutory attorney to whom such authority has been delegated.[36] Contested motions that are actually or potentially dispositive of a proceeding are determined by a panel of at least three Board judges.[37] Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be determined under the authority of the Board.

For information concerning the remedies available to a party that is dissatisfied with a decision on a motion, see TBMP § 518. *See also* TBMP § 905.

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 that 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.

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[34] *See* 37 CFR § 2.127(a). *See also Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (treating motion for summary judgment as conceded was proper); *Central Manufacturing Inc. v. Third Millennium Technology, Inc*., 61 USPQ2d 1210, 1211 (TTAB 2001) (motion to dismiss treated as conceded); and *Boston Chicken Inc. v. Boston Pizza International Inc*., 53 USPQ2d 1053, 1054 (TTAB 1999).

[35] *See, e.g., Boyds Collection Ltd. v. Herrington & Co.,* 65 USPQ2d 2017, 2018 (TTAB 2003) (motion to suspend for civil action not treated as conceded where potentially dispositive motion was pending when motion to suspend was filed); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.,* 55 USPQ2d 1848, 1854 (TTAB 2000) (cross-motion for judgment not treated as conceded in view of its potentially dispositive nature); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990) (uncontested motion to dismiss decided on merits) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990).

[36] *See* 37 CFR § 2.127(c), and TBMP § 102.03 (General Description of Board Proceedings).

[37] *See* TBMP § 102.03.

502.05 Attorneys' Fees, etc., on Motions

The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party.[38]

502.06 Telephone and Pre-Trial Conferences

502.06(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.*

When it appears to the Board that a motion filed in an inter partes proceeding may be resolved by a telephone conference call involving the parties or their attorneys and an interlocutory attorney, or an administrative trademark judge, of the Board, the Board may, upon its own initiative or upon request made by a party, resolve the motion by telephone conference.[39] Immediately after the resolution of a motion by telephone conference, the Board will issue a written order confirming its decision on the motion.

Board attorneys retain discretion to decide whether a particular matter can be heard or disposed of by telephone. There is no formal limit as to the type of matters that can be handled through telephone conferences,[40] but the Board will not decide by telephone

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[38] 37 CFR § 2.127(f). *See, for example, Central Manufacturing Inc. v. Third Millennium Technology Inc.,* 61 USPQ2d 1210, 1213 (TTAB 2001) and *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 n.3 (TTAB 2000). *See also* 37 CFR §§ 2.120(f) and 2.120(g)(1). Note, however, that conduct in violation of the Canons and Disciplinary Rules set forth in 37 CFR part 10 may be referred to the Office of Enrollment and Discipline for appropriate action. *See* 37 CFR §§ 10.18(d) and 10.20, *et.seq.*

[39] *See* 37 CFR § 2.120(i)(1). *See also Duke University v. Haggar Clothing Co.,* 54 USPQ2d 1443, 1446 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.,* 53 USPQ2d 1758, 1761 (TTAB 1999); *Electronic Industries Association v. Potega,* 50 USPQ2d 1775 (TTAB 1999); *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); and the *Official Gazette* notice entitled *Teleconferencing on Cases Before the TTAB* (June 20, 2000). The notice is posted on the USPTO home page, and is accessible via www.uspto.gov. under the *Official Gazette* Notices (item #9 of the June 20, 2000 notice).

[40] *See, for example, Duke University v. Haggar Clothing Co., supra* at 1446 (consented request to stay opposer's rebuttal testimony period pending ruling on opposer's motion to quash); *Electronic Industries Association v. Potega,* 50 USPQ2d 1775 (TTAB 1999) (motion to quash and motion for discovery sanctions); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991) (motion to attend testimony deposition by telephone); and *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990) (uncontested motion to extend testimony period and motion for a protective order).

conference any motion which is potentially dispositive, that is, a motion which, if granted, would dispose of a Board proceeding. The telephone conference procedure is particularly useful for resolving motions where time is of the essence, such as a motion to quash a notice of deposition.[41]

Telephone conferences are not a substitute for stipulated written motions. Parties are encouraged to file stipulated motions rather than call the Board for an order that can be agreed upon without the Board's involvement.[42] Moreover, telephone conferences may not be used as a means to supplement a motion or a related brief, and are not an opportunity to present oral arguments in support of fully briefed written motions.[43]

Requesting a telephone conference:[44] A party may request a telephone conference from the responsible Board attorney before it files the underlying motion. The initial contact will be limited to a simple statement of the nature of the issues proposed to be decided by telephone conference, with no discussion of the merits. A party served with a written motion may request a telephone conference by contacting the responsible Board attorney soon after it receives the service copy of the motion. A party may not request a telephone conference at or near the end of its time to respond to the motion, so as to avoid or delay its response to the motion.

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

When the Board grants a party's request for a telephone conference, the requesting party is responsible for scheduling the conference at a time agreeable to all parties and the Board attorney. The party must arrange the conference call. When a telephone conference is initiated by the Board, the Board attorney will schedule the conference. If a response to a pending motion has not yet been filed, the non-moving party should be prepared to make an oral response to the motion during the telephone conference. Any other instructions regarding filing of briefs or serving copies will be provided. To expedite matters, the moving party may hand deliver its motion, at the offices of the

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[41] *See, for example, Electronic Industries Association v. Potega, supra; Luemme Inc. v. D.B. Plus Inc.,* 53 USPQ2d 1758, 1761 (TTAB 1999) (to the extent time was of the essence, party could have contacted the Board and requested that the motion to extend discovery be resolved on an expedited basis or by telephone conference);.and cases cited in previous note. *See also* TBMP § 521 *regarding motions to quash a notice of deposition..*

[42] *See, generally, Official Gazette notice entitled Teleconferencing on Cases Before the TTAB, supra.*

[43] *Id.*

[44] *Id.*

Board, to the Board attorney to whom the case is assigned. Alternatively, the moving party may call the Board attorney and request permission to fax a copy of the motion to the Board.[45]

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

Conduct of conference.[46] The telephone conference will be limited to the issues defined by the Board prior to, or at the commencement of, the conference. The Board will not record the conference nor may the parties record the contents of the telephone conference. The Board attorney may make rulings at the conclusion of the conference or may take the parties' arguments under advisement. If the Board attorney determines during the telephone conference that the motion or matter should be decided on the written record, the Board attorney may halt the telephone conference and direct the filing of a motion or response to a motion, or both.

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

Participation.[47] Failure to participate in a scheduled telephone conference may result in the motion being denied with prejudice or the motion being treated as conceded.

Issuance of Rulings.[48] The Board attorney may make rulings at the conclusion of a telephone conference or may take the parties' arguments under advisement. In every instance, after the resolution of a motion or matter by telephone conference, the Board attorney will issue a written order containing all rulings. In most instances, the Board's written order will consist of only a brief summary of the issues and the resulting decision; generally, the order will not include a recitation of the parties' arguments. The decision will be forwarded to the parties by fax or mail.

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[45] *See* TBMP § 107 (How and Where to File Papers).

[46] *See, generally, Official Gazette Notice entitled Teleconferencing on Cases Before the TTAB, supra*.

[47] *Id.*

[48] *Id.*

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

502.06(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 or where attorneys or parties are unable to work out a resolution of any of their differences.[49]

502.07 Fed. R. Civ. P. 11 Applicable

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

503 Motion to Dismiss for Failure to State a Claim

503.01 Time for Filing

When the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer.[50] 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.[51]

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[49] *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).

[50] *See* Fed. R. Civ. P. 12(b) and *Hollowform Inc. v. Delma Aeh*, 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). *Compare Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478 n.1 (TTAB

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.[52] 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.[53]

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.[54] 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).[55]

1998) (untimeliness waived where 12(b)(6) motion filed three weeks after answer, but plaintiff responded to motion on the merits).

[51] *See William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1871 (TTAB 1994).

[52] *See Hollowform, Inc. v. Delma Aeh, supra* (motion for default judgment for failure to answer denied).

[53] *See* Fed. R. Civ. P. 12(h)(2), and Wright & Miller, *Federal Practice and Procedure*: Civil 2d §1357 (1990). *See also DAK Industries Inc. v. Daiichi Kosho Co.,* 35 USPQ2d 1434 (TTAB 1995) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (construed as motion for judgment on the pleadings). *Compare, Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995) (Rule 12(b)(6) permits defendant to assert in answer "defense" of failure to state a claim thereby allowing plaintiff to test sufficiency of defense by moving under 12(f) to strike the defense).

[54] *See, for example, Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) (Rule 12(b)(6) challenges the legal theory of the complaint not the sufficiency of the evidence that might be adduced); *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).

[55] *See Young v. AGB Corp.,* 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)*; Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538 (TTAB 2000); *Kelly Services Inc. v. 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.[56]

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.[57] Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.[58]

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 Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought.[59]

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.[60] 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

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[56] *Cf. Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (leave to amend pleading granted over objection that there was no evidence to prove the ground to be added). *See also 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).

[57] *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); *Young v. AGB Corp., supra; Intellimedia Sports Inc. v. Intellimedia Corp.* 43 USPQ2d 1203 (TTAB 1997). *See also Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra*; and *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

[58] *See Young v. AGB Corp., supra; Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra*; and *Kelly Services Inc. v. Greene's Temporaries Inc., supra.*

[59] *See Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters, supra; Intellimedia Sports Inc. v. Intellimedia Corp., supra*; *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993); and *Kelly Services Inc. v. Greene's Temporaries Inc., supra. See also 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).

[60] *See* TBMP § 507.02 (Amendments – General Rule – Fed. R. Civ. P. 15(a)).

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.[61]

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.[62]

503.04 Matters Outside the Pleading Submitted on Motion to Dismiss

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 Fed. R. Civ. P. 56.[63] Ordinarily, the parties to the proceeding will be notified that the motion to dismiss is being treated as a motion for summary judgment, and the responding party will be given reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56.[64]

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[61] *See, for example, Intellimedia Sports Inc. v. Intellimedia Corp.,* 43 USPQ2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993) (particularly where challenged pleading is the initial pleading); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985). *See also 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).

[62] *See, for example,* Fed. R. Civ. P. 15(a); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (amendment would be futile because opposers cannot prevail on claim as a matter of law); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985) (plaintiff had already been allowed two opportunities to perfect its pleading). 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) (amendment would serve no useful purpose).

Cf. Trek Bicycle Corp. v. StyleTrek Ltd., 64 USPQ2d 1540 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987) (motion to amend to add claim or defense which is legally insufficient will be denied); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855 (TTAB 1986) (would serve no useful purpose); and TBMP § 507.02 (regarding motions to amend pleading).

[63] *See Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ 1478, 1479 n.2 (TTAB 1998) (matters excluded) and *Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, 1436 (TTAB 1996) (matters excluded).

[64] *See, for example,* Fed. R. Civ. P. 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, 646 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as a motion for summary judgment

Such notice may be dispensed with as unnecessary, however, where the parties themselves clearly have treated a motion to dismiss as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis.[65]

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.[66] 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.[67] 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.[68]

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.[69]

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without notifying adverse party); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992); and *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156 (TTAB 1991) (not an appropriate case to treat as summary judgment; extrinsic matters excluded). *See also 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) (motion for judgment on the pleadings properly treated as motion for summary judgment).

[65] *See Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (both parties submitted evidentiary materials outside the pleadings). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc., supra* (nonmoving party expected only that sufficiency, not merits of case would be decided).

[66] *See* Fed. R. Civ. P. 12(c).

[67] *See* 37 CFR § 2.116(e); *Von Schorlemer 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).

[68] *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).

[69] *See Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, 1438 (TTAB 1996); *DAK Industries Inc. v. Daiichi Kosho Co.,* 35 USPQ2d 1434 (TTAB 1995); and *Western Worldwide Enterprises Group*

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.[70]

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 Fed. R. Civ. P. 8(d), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted.[71] All reasonable inferences from the pleadings are drawn in favor of the nonmoving party.[72]

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.[73]

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.[74]

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

Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990) (since motion based on defense that petition fails to state claim, standard for adjudicating motion for judgment on pleading is same as Rule 12(b)(6)). *Cf.* TBMP § 503.01 (Time for Filing Motion to Dismiss).

[70] *See The Scotch Whisky Association v. United States Distilled Products Co*., 13 USPQ2d 1711, 1714 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991)), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

[71] *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, 1026 (TTAB 1983); and Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 1367 *et seq*. (1990).

[72] *See Baroid Drilling Fluids Inc. v. Sun Drilling Products, supra*; *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992); and Wright & Miller, *supra* § 1367 *et seq*.

[73] *See Baroid Drilling fluids Inc. v. Sun Drilling Products*, *supra*; *CBS Inc. v. Mercandante, supra; International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); and Wright & Miller, *supra* § 1367 et seq.

[74] *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, *supra* and Wright & Miller, *supra* § 1368 (1990).

R. Civ. P. 56.[75] Ordinarily, the parties to the proceeding will be notified that the motion for judgment on the pleadings is being treated as a motion for summary judgment, and they will be given a reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56.[76]

Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion for judgment on the pleadings as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis.[77]

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.[78] 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.[79]

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

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[75] *See Wellcome Foundation Ltd. v. Merck & Co*., 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (matters outside the pleading excluded); and *DAK Industries Inc. v. Daiichi Kiosho Co*., 35 USPQ2d 1434, 1436 (TTAB 1995) (exhibits excluded).

[76] *See* Fed. R. Civ. P. 12(c). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as motion for summary judgment without notifying nonmoving party); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, supra; Pegasus Petroleum Corp. v. Mobil Oil Corp*., 227 USPQ 1040 (TTAB 1985); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp., supra;* and *Exxon Corp. v. National Foodline Corp*., 196 USPQ 444 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978);

[77] *Compare Selva & Sons, Inc. v. Nina Footwear, Inc.*, *supra* at 646 (nonmoving party did not expect Rule 12(b)(6) motion to be treated as one for summary judgment).

[78] *See* Fed. R. Civ. P. 12(e), and Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 1376 (1990). *Cf. CBS Inc. v. Mercandante*, 23 USPQ2d 1784, n.8 (TTAB 1992) (answer to a counterclaim is not a pleading to which a responsive pleading is permitted).

[79] *See* Fed. R. Civ. P. 12(e) and Wright & Miller, *supra* § 1378.

cannot make a responsive pleading in good faith or without prejudice to itself.[80] If the movant believes that the pleading does not state a claim upon which relief can be granted, its proper remedy is a motion under Fed. R. Civ. P. 12(b)(6) to dismiss for failure to state a claim upon which relief can be granted, not a motion for a more definite statement.[81]

A motion for a more definite statement may not be used to obtain discovery. The only information that a movant may obtain by this motion is that which it needs to make its responsive pleading.[82]

505.02 Time for Filing

A motion for a more definite statement, if filed, must be filed within the time for, and before, the moving party's responsive pleading.[83] 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.

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.[84]

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.[85] The

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[80] *See* Wright & Miller, *supra* § 1376-1377.

[81] *See* Wright & Miller, *supra* § 1376.

[82] *See* Wright & Miller, *supra* § 1376-1377.

[83] *See* Fed. R. Civ. P. 12(e).

[84] *See* Fed. R. Civ. P. 12(e).

[85] *See* Fed. R. Civ. P. 12(f).

Board also has the authority to strike an impermissible or insufficient claim (or portion of a claim) from a pleading.[86]

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case.[87] The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted.[88] 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.[89] 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.[90]

Nevertheless, the Board grants motions to strike in appropriate cases.[91]

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[86] *See Ohio State University v. Ohio Universi*ty, 51 USPQ2d 1289, 1293 (TTAB 1999) (motion to strike certain allegations in the counterclaim) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery,* 17 USPQ2d 1137 (TTAB 1990) (motion to strike allegations of geographic descriptiveness asserted against registration over five years old granted).

[87] *See Ohio State University v. Ohio University, supra; 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); and Wright & Miller, *supra* § 1380 (1990).

[88] *See* TBMP §§ 309.03 (Substance of Complaint) and 311.02 (Substance of Answer); *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).

[89] *See Ohio State University v. Ohio University, supra* at 1294-95; *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims);. *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (applicant's affirmative defense amplifies denial of likelihood of confusion); and *Harsco Corp. v. Electrical Sciences Inc., supra* at 1571 (reasonable latitude permitted in statement of claims).

[90] *See* Wright & Miller, *supra* § 1381.

[91] *See, for example, Ohio State University v. Ohio University, supra at* 1292 and 1295 n.16 (estoppel may not be asserted as a defense against claims of mere descriptiveness or geographic descriptiveness; laches may not be maintained against fraud); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial)*; American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (insufficient affirmative defenses stricken); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (ground for cancellation not available for registration over five years old); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988) (immaterial allegation stricken); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822 (TTAB 1984) (affirmative defense stricken because identical to counterclaim); *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); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794 (TTAB 1974) (complaint stricken for failure to comply with requirement of Rule 10(b) that each numbered paragraph be limited to a single set of circumstances); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973) (allegations in answer which merely reiterated denial of likelihood

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.[92] 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)).[93]

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.[94] Thus, the Board, in its discretion, may entertain an untimely motion to strike matter from a pleading.[95]

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 on behalf of

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of confusion without adding anything of substance thereto stricken as redundant); *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973) (affirmative defense attacking validity of plaintiff's pleaded registration stricken); *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 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).

[92] *See* Fed. R. Civ. P. 12(f) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, supra*.

[93] *See* Fed. R. Civ. P. 12(f). *See also American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1316 (TTAB 1992).

[94] *See* Fed. R. Civ. P. 12(f).

[95] *See* Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 1380 (1990); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995); *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1316 (TTAB 1992); and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, supra.*

the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period.[96]

507 Motion to Amend Pleading

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.[97] 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.[98]

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15.[99] Amendments in general are governed by Fed. R. Civ. P. 15(a). Amendments to conform the pleadings to trial evidence are governed by Fed. R. Civ. P. 15(b).

A motion for leave to amend a pleading should be accompanied by a signed copy of the proposed amended pleading.[100]

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

A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course 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.[101] An amendment filed as a matter of course need not be accompanied by a motion for leave to amend.[102]

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[96] *See* 37 CFR § 2.122(c), and TBMP § 317 (Exhibits to Pleadings).

[97] *See* TBMP §§ 309.03(a) (General Substance of Complaint), 311.02 (Substance of Answer), 506.01 (Nature of Motion to Strike Matter from Pleading), 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).

[98] *See* TBMP § 314 (Unpleaded Matters) and cases cited therein.

[99] *See* 37 CFR §§ 2.107, 2.115, and 2.116(a).

[100] *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[101] *See* Fed. R. Civ. P. 15(a).

[102] *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.[103] 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.[104]

This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint,[105] including a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint.[106]

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.[107] 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

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[103] *See* Fed. R. Civ. P. 15(a).

[104] *See, for example, Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ 1701 (TTAB 2000); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843 (TTAB 1989); *See's Candy Shops Inc. v. Campbell Soup Co*., 12 USPQ2d 1395 (TTAB 1989); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302 (1991). *For additional case cites see the Appendix of Cases.*

[105] *See, for example, Boral Ltd. v. FMC Corp., supra* at 1702. S*ee also Marmark Ltd. v. Nutrexpa 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).

[106] *See, for example, Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1867 (Fed. Cir. 1991) (amendment to add later-acquired registration to tack on prior owner's use); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (notice of opposition amended during testimony period to add claim of ownership of newly issued registration); *Marmark Ltd. v. Nutrexpa S.A.*, *supra*; and *Cudahy Co. v. August Packing Co*., 206 USPQ 759 (TTAB 1979); and *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240 (Comm'r 1990) (opposer's motion to amend to join party and claim ownership of registration granted)).

[107] *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973) (allegations amplified). *See also*, *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1734 (TTAB 1990) (petitioner permitted to add allegation concerning respondent's assertion of infringement to support standing). [NOTE: This case was overruled by *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG* , 34 USPQ2d 1266 (TTAB 1995), to the extent it held that Section 18 of the trademark Act may be invoked only when tied to a properly pleaded ground for opposition or cancellation.]

will deny the motion for leave to amend.[108] On the other hand, whether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment.[109]

Generally, an amended pleading, if allowed, will supercede any prior pleadings, particularly an amended pleading which is complete in itself and does not adopt or make any reference to the earlier pleadings.[110]

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

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by

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[108] *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (motion to amend to restrict goods would serve no purpose); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.,* 62 USPQ2d 1857, 1858 (TTAB 2002) (amendment denied because Board has no jurisdiction to decide issues arising under state dilution laws), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003); *Leatherwood Scopes International Inc. v. Leatherwood,* 63 USPQ2d 1699 (TTAB 2002) (proposed amended pleading of abandonment insufficient and leave to amend denied as futile where opposer asserted applicant's lack of exclusive rights in the mark but failed to include allegation that mark had lost all capacity to act as a source indicator for applicant's goods); *Polaris Industries v. DC Comics, supra at* 1799 (where proposed pleading of dilution was legally insufficient, leave to re-plead allowed); *Trek Bicycle Corp. v. StyleTrek Ltd*., 64 USPQ2d 1540 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2D 1057 (TTAB 2000) (motion to add counterclaim denied where mere allegation that opposer did not submit copy of foreign registration at time of examination is insufficient to state claim); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (opposers could not prevail on res judicata claim as a matter of law); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993) (claim of lack of bona fide intent to use found legally sufficient); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784 (TTAB 1992) (opposer's attempt to amend answer to add counterclaim denied as inconsistent with notice of opposition); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (defense of unclean hands insufficient because allegations were either unclear, non-specific, irrelevant to the defense or merely conclusory; defense of laches not available where ground is failure to control use of a certification mark); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (proposed amendment to add 2(d) claim denied as legally insufficient); and *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977). *Cf.* TBMP § 503.03 (Leave to Amend Defective Pleading).

[109] *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha***,** 22 USPQ2d 1316, 1318 (TTAB 1992), and *Flatley v. Trump, supra* at 1286

[110] *See Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1858 (Fed. Cir. 2000) (citing, *inter alia, Kelley v. Crosfield Catalysts*, 135 F.3d 1202 (7th Cir. 1998)) and, *e.g.*, *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136, n.10 (TTAB 2000). *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81, *supra.*

allowance of the proposed amendment.[111] A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely.[112]

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[111] *See International Finance Corporation v. Bravo Company*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (motion to amend opposition denied where it was filed eight months after filing of notice of opposition, with no explanation for the delay, and appeared to be based on facts within opposer's knowledge at the time opposition was filed); *Boral Ltd. v. FMC Corp.*, *supra* at 1703-04 (no undue delay because motion to add claim of dilution was promptly filed after such claim became available, albeit over two years after commencement of proceeding); *Penguin Books Ltd. v. Eberhard,* 48 USPQ2d 1280, 1286-87 (TTAB 1998) (request raised for the first time in reply brief on counterclaim to further restrict pleaded registration denied since opposer had no notice of this issue)**;** *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.***,** 41 USPQ2d 1030, 1033 (TTAB 1996) (motion to add claim of fraud denied where petitioner was fully aware of all the facts it needed to add such claim over three years before filing motion to amend)*; Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205 (TTAB 1993) (motion filed after close of discovery to assert claim of res judicata based on a judgment entered in another case after the filing of opposition permitted since applicant was afforded adequate notice and no further discovery would be necessary); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (no undue delay in view of pending motion for summary judgment and discovery was still open when motion was filed); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993) (proceeding still in pre-trial stage and discovery had been extended); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (opposer's motion to amend its pleading during its testimony period granted in the interests of justice and judicial economy and since any prejudice could be mitigated by reopening discovery solely for applicant); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990) ("concept of 'undue delay' is inextricably linked with the concept of prejudice to the non-moving party"); *.Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990) (proceeding still in the discovery stage and no undue prejudice shown); *Flatley v. Trump*, *supra* (proceedings still in the discovery stage); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (no substantial prejudice to applicant by allowance of amendment where 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) (proceeding was still in the pre-trial stage); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) (trial period had not yet commenced and no prejudice to applicant); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974) (no testimony had as yet been taken); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971) (applicant's motion to amend its pleading after the close of opposer's testimony period, but before the opening of applicant's testimony period, permitted); 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 moved to amend after close of its testimony period, motion denied as untimely to extent it sought amendment under Rule 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 eight 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).

[112] *See M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984) (plaintiff should plead any registrations it wishes to introduce as soon as possible after the omission, or newly issued registration, comes to plaintiff's attention). *See also International Finance Corporation v. Bravo Company*, *supra* at 1604 (motion denied

In order to avoid any prejudice to the adverse party when a motion for leave to amend under Fed. R. Civ. P. 15(a) is granted, the Board may, in its discretion, reopen the discovery period to allow the adverse party to take discovery on the matters raised in the amended pleading.[113]

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

The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations. Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i).[114] As provided therein, if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned.[115]

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where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim).

[113] *See Boral Ltd. v. FMC Corp.*, *supra* (reopened for limited purpose of conducting discovery on new claim); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (reopened solely for applicant's benefit); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (applicant to advise whether it would need additional discovery); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[114] *See* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by 2.106(b)(2)(i)). *But see See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989) (applied 13(f) "when justice requires" standard where grounds for counterclaim were known at time of answer).

[115] *See* 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i); TBMP § 313.04 (Compulsory Counterclaims) and cases cited therein; and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). *See also Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (asserting claim as separate petition to cancel rather than counterclaim does not obviate timeliness requirements of 2.114(b)(2)(i)); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1033 (TTAB 1996); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992) (filing of an answer is not a condition precedent to operation of Trademark Rule 2.106(b)(2)(i) where grounds are learned during course of proceeding) and *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990) (counterclaim was pleaded promptly after defendant obtained information through discovery concerning possible fraud).

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

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.[116]

The motion for leave to amend should be filed promptly after the objection is made.[117] 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.[118]

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.[119]

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[116] *See* Fed. R. Civ. P. 15(b), and *Ercona Corp. v. JENAer Glaswerk Schott & Gen.*, 182 USPQ 573 (TTAB 1974).

[117] *See* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

[118] *See* Fed. R. Civ. P. 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).

[119] *See, for example,* Fed. R. Civ. P. 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984) (motion to amend to add abandonment submitted after filing of trial briefs denied because the issue had not been tried);*Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (opposition deemed amended to include opposer's claim of ownership of previously unpleaded registrations where opposer filed notice of reliance on those registrations at trial and applicant did not object thereto); *Linville v. Rivard,* 41 USPQ2d 1731, 1735 n.9 (TTAB 1996) (certain abandonment issues while not pleaded were clearly tried by the parties and argued in their trial briefs), *aff'd,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 (TTAB 1993) (functionality was tried by implied consent, such consent having been given by defendant prior to trial); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (no express or implied consent to try certain issues); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990) (permitted to amend answer after trial to add an affirmative defense that was in fact tried); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600 (TTAB 1987) (motion to amend at time of final briefing granted); and Beth A. Chapman, *TIPS*

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.[120]

Inasmuch as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a Fed. R. Civ. P. 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing.[121]

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.[122]

FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). *For additional cases relating to this issue see the Appendix of Cases.*

[120] *See, for example, Time Warner Entertainment Co. v. Jones*, *supra* at 1653 n.2 (where opposer, during trial, filed notice of reliance on seven unpleaded registrations and where applicant did not object thereto, Board found parties had tried by implied consent, any issues arising from those registrations); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony but was not fairly apprised that evidence, which also related to existing claim, was being offered in support of unpleaded claim); *Levi Strauss & Co. v. R. Josephs Sportswear, Inc*., 36 USPQ2d 1328 (TTAB 1994) (party was not fairly apprised that evidence used for a pleaded claim of descriptiveness was also being offered in support of unpleaded 2(d) claim); *Kasco Corp. v. Southern Saw Service Inc.*, *supra* at 1504 (defendant raised no objection to evidence on unpleaded issue but was fairly apprised of its purpose); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.., supra* (applicant sufficiently apprised that issue was being litigated where applicant's answers to discovery requests on unpleaded issue were made of record by opposer, and where applicant did not object to the cross-examination on this issue and moreover attempted to clarify a matter related to the issue); *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985) (stipulation of evidence relating to chain of title of mark and registration was insufficient to put respondent on notice of additional claims of lack of ownership); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991). *For additional case cites, see Appendix of Cases.*

[121] *See Micro Motion Inc. v. Danfoss A/S, supra; Devries v. NCC Corp*., 227 USPQ 705 (TTAB 1985). *See also 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 (Available Motions).

[122] *See* 37 CFR §§ 2.106(a) and 2.114(a); Fed. R. Civ. P. 55(a) and 55(b) and TBMP § 312 (Default). *See also, for example, DeLorme Publishing Co., Inc. v. Eartha's, Inc.* 60 USPQ2d 1222, 1223-24 (TTAB 2000) (good cause not shown where failure to answer was based on belief that notice of opposition was "incomplete").

The issue of whether default judgment should be entered against a defendant when it fails to file a timely answer to the complaint may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its 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 Fed. R. Civ. P. 55(c) standard, which requires that the defendant show good cause why default judgment should not be entered against it. [123]

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.[124]

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.[125]

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

509 Motion to Extend Time; Motion to Reopen Time

Fed. R. Civ. P. 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.*

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[123] *See* TBMP § 312 (Default) and authorities cited therein.

[124] *See* Fed. R. Civ. P. 55(b) and 55(c), and 37 CFR § 2.127(a).

[125] *See* 37 CFR § 2.127(a), and TBMP § 502.02(b) (Briefs on Motions).

509.01 Nature of Motions

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 CFR § 2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done.[126] 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 moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect.[127]

509.01(a) Motions to Extend Time

A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient.[128]

Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor.[129] The Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown.[130]

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[126] *Compare, however*, 37 CFR § 2.127(e)(1) ("The time for filing a motion under [Fed. R. Civ. P.] 56(f) will not be extended").

[127] *See* Fed. R. Civ. P. 6(b).

[128] *See, e.g., Fairline Boats plc v. New Howmar Boats Corp.,* 59 USPQ2d 1479, 1480 (TTAB 2000) (motion denied where party failed to provide detailed information regarding apparent difficulty in identifying and scheduling its witnesses for testimony and where sparse motion, containing vague reference to possibility of settlement, demonstrated no expectation that proceedings would not move forward during any such negotiations); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause); *Luemme, Inc. v. D. B. Plus Inc.,* 53 USPQ2d 1758 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.").

[129] *See Luemme, Inc. v. D. B. Plus Inc.***,** *supra* 1760-61 (diligence not shown; discovery requests not served until last day of the discovery period); and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant's motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time).

[130] *See Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 63 Fed. Reg. at 48086 (1998), 1214 TMOG at 149 (September 29, 1998). *See also Luemme, Inc. v. D. B. Plus Inc.***,** *supra.*

For further information concerning good cause for a motion to extend, see the cases cited in the note below.[131]

If a motion to extend the time for taking action is denied, the time for taking such action may remain as previously set.[132]

509.01(b) Motions to Reopen Time

In general. Where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action. The movant must show that its failure to act during the

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[131] *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383-84 (TTAB 2001) (the press of other litigation may constitute good cause to extend but alleged deficiencies in discovery responses not good cause to extend discovery where timely motion to compel was not filed); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.,* 61 USPQ2d 1542, 1543-44 (TTAB 2001) (insufficiently explained rearrangement of petitioner's laboratory facilities; no detailed information regarding petitioner's apparent difficulty in preparing and submitting its evidence or why petitioner waited until the last day of its testimony period to request the extension); *SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited,* 60 USPQ2d 1372 (TTAB 2001) (attorney's unwarranted and untimely request for permission to withdraw from representation of party viewed as bad faith attempt to obtain an extension of time); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra* (while maternity leave may constitute good cause, in this case defendant's counsel knew that defendant would not be able to comply with deadline, yet waited until penultimate day of response period to file unconsented motion to extend time); *Fairline Boats plc v. New Howmar Boats Corp., supra* (mere existence of settlement negotiations or proposals, without more, would not justify delay in proceeding with testimony); *Instruments SA Inc. V. ASI Instruments, Inc.*, *supra* (plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown); *Luemme, Inc. v. D.B. Plus Inc., supra* (plaintiff failed to set forth detailed facts concerning the circumstances -- plaintiff's allegedly busy travel schedule -- which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously-set discovery period)*; Luehrmann v. Kwik Kopy Corp*., 2 USPQ2d 1303 (TTAB 1987) (desire to conduct follow-up discovery is not good cause for extension of discovery period where party seeking extension did not serve initial discovery requests until late in discovery period) and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985) (opposer's motion to compel having been granted, it was reasonable to allow additional time, albeit less than requested, for opposer to complete discovery before proceeding with testimony). *For additional cases relating to this issue, see Appendix of Cases.*

[132] *See, e.g.,* Trademark Rules 2.120(a) (discovery period); 2.121(a)(1) (testimony period); 2.127(a) (time for responding to a motion); and 2.127(e)(1) (time for responding to a summary judgment motion). S*ee also Fairline Boats plc v. New Howmar Boats Corp., supra* at 1479**;** *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra*; *Luemme Inc. v. D.B. Plus Inc., supra;* and *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (petitioner's testimony period consequently expired where motion to extend testimony period was denied and dates were left as originally set).

Compare C.H. Stuart Inc. v. Carolina Closet, Inc., 213 USPQ 506, 507(TTAB 1980) (three-day testimony period for opposer reset "putting opposer in the same position it would have been in had no motion to compel been filed."). *In addition, see Notice of Final Rulemaking*, published in the Federal Register on September 9, 1998 at 63 FR 48081, specifically, comments and responses published in the notice at 48091.

time previously allotted therefor was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b).

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps,* 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith.[133]

The "prejudice to the nonmovant" contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant.[134].

It has been held that the third *Pioneer* factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case.[135]

Additionally, although many excusable neglect decisions which were issued prior to the Board's 1997 *Pumpkin* decision may no longer be controlling under the somewhat more

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[133] *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, supra* at 395 and *Pumpkin Ltd. v. The Seed Corps, supra* at 1586. *See also* cases cited throughout this section and in TBMP §§ 534.02 regarding motions to dismiss under 37 CFR § 2.132, and 544 regarding motions for relief from final judgment.

[134] *See Pumpkin Ltd. v. The Seed Corps, supra* at 1587, citing *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997) and *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

[135] *See Pumpkin Ltd. v. The Seed Corps, supra* at n.7 and cases cited therein. *See also Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.,* 59 USPQ2d 1369 (TTAB 2000) (failed to provide specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (failed to provide evidence linking the reason for the delay with the expiration of movant's testimony period); and *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay).

flexible excusable neglect standard set out in *Pioneer* and *Pumpkin* (e.g., decisions holding that a failure to act due to counsel's docketing errors is, *per se,* not the result of excusable neglect), they nonetheless may be directly relevant to the Board's analysis under the third *Pioneer* excusable neglect factor.[136]

A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient.[137]

In addition, for purposes of making the excusable neglect determination, it is irrelevant that the failure to timely take the required action was the result of the party's counsel's neglect and not the neglect of the party itself. Under our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel.[138]

To introduce newly discovered evidence. If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not

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[136] *See Pumpkin Ltd. v. The Seed Corps., supra* at 1586-87 and at n.8. Such pre-*Pioneer* cases include, e.g., *Hewlett-Packard Co. v. Olympus Corp.,* 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (no excusable neglect where plaintiff's counsel unreasonably relied on defendant's counsel to sign and file plaintiff's proposed stipulated motion to extend trial dates); *American Vitamin Products Inc. v. DowBrands Inc.,* 22 USPQ2d 1313 (TTAB 1992) (defendant's desire to take follow-up discovery and its uncertainty regarding status of plaintiff's pending motion to strike affirmative defenses did not excuse respondent's neglect in failing to file timely motion to extend discovery); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2065 (TTAB 1990) (no excusable neglect where defendant's failure to timely respond to certain discovery requests was due to defendant's oversight or lack of care in reading discovery requests); *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.,* 229 USPQ 619 (TTAB 1986) (no excusable neglect where defendant's failure to timely respond to summary judgment motion was due to counsel's press of other litigation); and *Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc*., 223 USPQ 176 (TTAB 1984) (same). *For additional cases involving the excusable neglect standard, see Appendix of Cases and TBMP §§ 534 (Motion for Judgment for Plaintiff's Failure to Prove Case) and 544 (Motion for Relief from Final Judgment).*

[137] *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., supra* (no specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, *supra* (no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case).

[138] *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, supra*, at 396 (citing *Link v. Wabash R. Co.,* 370 U.S. 626 (1962) and *United States v. Boyle*, 469 U.S. 241 (1985)); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., supra*; *CTRL Systems Inc. v. Ultraphonics of North America Inc*., 52 USPQ2d 1300 (TTAB 1999); and *Pumpkin Ltd. v. The Seed Corps., supra* at 1586.

Cf. Netcore Technologies, Inc. v. Firstwave Technologies, Inc., ___ USPQ2d ___ (TTAB 2001) (attorney's unwarranted and untimely request to withdraw from representation of party may not be used as subterfuge to obtain a reopening of time to which the party is not otherwise entitled).

have been discovered earlier through the exercise of reasonable diligence.[139] However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of the new evidence. The Board must also consider such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party.[140]

509.02 Form and Determination of Motions to Extend or Reopen

If a motion to extend or a motion to reopen is made with the consent of the nonmoving party, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its 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.[141]

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.[142] If a consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, specifies only the closing date for the first period to be reset, and the motion is approved, the Board will

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[139] *See, for example, Rowell Laboratories, Inc. v. Canada Packers Inc.*, 215 USPQ 523, 529 n.2 (TTAB 1982) (improper to attempt to introduce newly discovered evidence by way of rebuttal testimony rather than moving to reopen testimony period*). See also Oxford Pendaflex Corp. v. Roladex Corp.*, 204 USPQ 249 (TTAB 1979); *Wilson Sporting Goods Co. v. Northwestern Golf Co*., 169 USPQ 510 (TTAB 1971); *United States Plywood Corp. v. Modiglass Fibers, Inc*., 125 USPQ 144 (TTAB 1960); *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).

[140] *See Harjo v. Pro-Football, Inc*., 45 USPQ2d 1789, 1790 (TTAB 1998) (newly discovered evidence was cumulative and redundant and did not have significant probative value to justify further delay of case) *citing Canadian Tire Corp. Ltd. v. Cooper Tire & Rubber Co*., 40 USPQ2d 1537, 1539 (Comm'r 1996) (newly discovered evidence was hearsay in nature and pertained to unpleaded defense).

[141] *See* 37 CFR §§ 2.102(d) and 2.121(d), and TBMP §§ 501.03 (Form of Stipulations) and 502.02(a) (Form of Motions). *Cf.* TBMP § 403.03 (Time for Service of Discovery Responses).

[142] *See* 37 CFR § 2.121(d).

automatically reschedule the subsequent periods as well.[143] 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.

A stipulation to extend time to file an answer, but not the other trial dates, will be approved only if the proposed new due date for the answer is prior to the close of the discovery period. The time to answer will not be extended beyond the close of the discovery period. Thus, any extension request which would reset the time to answer beyond the date presently set for the close of discovery must also include a request for an extension of the discovery period.

When the Board notes that a consented or stipulated motion to extend time is based on the asserted existence of the parties' settlement negotiations, the Board may suspend proceedings, sua sponte, for six months, to enable the parties to concentrate on settlement and to obviate the filing of numerous extension requests. Such suspension shall be made subject to either party's right to request resumption of proceedings at any time.[144]

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.[145] If the nonmoving party fails to file a brief in opposition thereto, the motion normally will be granted by the Board as conceded. [146] If the motion is contested by the nonmoving party, the Board will decide the motion on its merits.[147]

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.[148] 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

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[143] *See* 37 CFR § 2.121(a).

[144] *See* TBMP § 510.03(a) (Suspension).

[145] *Cf.* 37 CFR § 2.127(a).

[146] *See* 37 CFR § 2.127(a), and TBMP § 502.02(b) (Briefs on Motions).

[147] *See* TBMP § 509.01 regarding the standards to be applied in deciding contested motions to extend or reopen time.

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

is under no obligation to do so, and in many cases cannot.[149] 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. However, in the event that the motion to extend or reopen time is denied, the time for taking required action may remain as previously set.[150]

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.[151]

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 Director upon written request, which should be directed to the Office of the Solicitor, not the Board.[152]

510 Motion to Suspend; Motion to Resume

37 CFR § 2.117 Suspension of proceedings.
(a) *Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding*

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[149] *See Chesebrough-Pond's Inc. v. Faberge, Inc., supra* and *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999) (waiting for Board approval of previous extension request insufficient to justify resetting of dates). *Cf.* TBMP § 202.01 (Time for Filing Request – In General); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); and *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r 1992).

[150] *See* 37 CFR §§ 2.120(a), 2.121(a)(1), 2.121(c), 2.12(a) and 2.127(e)(1). *See also Luemme, Inc. v. D. B. Plus Inc., supra.*

[151] *See* 37 CFR § 2.121(a).

[152] *See* 37 CFR § 2.145(e); *Appeals to the Federal Circuit from PTO*, 1120 TMOG 22 (November 13, 1990); and TBMP §§ 902.02 (Time for Filing Notice of Appeal) and 903.04 (Time for Filing Civil Action).

which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

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

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

37 CFR § 2.120(e)(2) *When a party files a motion for an order to compel discovery, the case will be suspended by the [Board] with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.*

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 [Board] with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

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

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

510.01 In General

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon

motion, or upon stipulation of the parties approved by the Board.[153] Some of the most common reasons for suspension are discussed below.

510.02 Suspension Pending Outcome of Another Proceeding; Resumption

510.02(a) Suspension

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action.[154]

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 often binding upon the Board, while the decision of the Board is not binding upon the court .[155]

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[153] *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), *rev'd on other grounds,* 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

[154] *See* 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); and David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

[155] *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the PTO); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986) (primary jurisdiction should not be invoked where, inter alia, a stay of the district court action is more likely to prolong the dispute than lead to its economical disposition and where the district court action includes claims which cannot be raised before the Board); and *Toro Co. v. Hardigg Industries, Inc.,* 187 USPQ 689, 692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977);

Cf. Larami Corp. v. Talk To Me Programs Inc., 36 USPQ2d 1840, 1844-1845 (TTAB 1995) (district court finding concerning priority of use not binding in view of differences in interpretation of Section 7(c) by Board and court, and finding regarding priority of secondary meaning not binding because said issue was not involved in the Board proceeding); Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and 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).

Further, pursuant to 37 CFR § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved,[156] or a civil action pending between the parties in a state court,[157] 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,[158] or even another proceeding in which only one of the parties is involved.[159]

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.[160]

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,[161] nor do parties or their

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

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

[158] *See Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (TTAB 1993) (opposition suspended pending decision of German court on validity of foreign registration which is the basis of the U.S. application involved in the opposition).

[159] *See Argo & Co. v. Carpetsheen Manufacturing, Inc., supra* (state court action between applicant and third party to determine ownership of applicant's mark).

[160] *See* 37 CFR § 2.117(a) and, *for example, General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ 1933 (TTAB 1992) (relief sought in Federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Section 2(d) claim before Board), *petition denied,* 181 USPQ 779 (Comm'r 1974). *See also 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 Boyds Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017 (TTAB 2003) (petitioner's motion to suspend filed after trial denied as untimely, and in any event, petition was dismissed since petitioner's only proffered evidence had been stricken); *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 USPQ 807, 808 n.3 (TTAB 1978) 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).

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

attorneys.[162] However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding.[163]

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.[164] This requirement ordinarily is waived if the parties stipulate to the suspension.

The Board does not usually require that an issue be joined (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.[165] 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.

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.[166] The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion.[167] However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.

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[162] *See Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971)).

[163] *See* David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act,* 74 Trademark Rep. 180 (1984).

[164] *See Forest Laboratories Inc. v. G.D. Searle & Co.* 52 USPQ2d 1058 (TTAB 1999) and *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975).

[165] *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied,* 181 USPQ 779 (Comm'r 1974).

[166] *See* 37 CFR § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co., supra* (motion to strike petitioner's notice of reliance, its only evidence in the case, decided before motion to suspend, and granted).

[167] *See* David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse Gaston Act*, *supra*.

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. 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. Absent any such notification as to the final determination of the civil action, cases which have been suspended pending civil action will remain in a suspended status for two years before the Board will issue an order requiring the parties to provide the status of the civil action.

A proceeding is considered to have been finally determined when 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; Resumption

510.03(a) Suspension

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

Upon motion or upon stipulation. Proceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board.[168] 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.[169] In addition, if a motion to extend time indicates that the parties are negotiating for settlement, the Board may, in lieu of granting the requested extension, suspend proceedings for a specified time, usually six months, subject to resumption by either party at any time.[170] The parties may also agree to suspend

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[168] *See* 37 CFR § 2.117(c).

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

[170] *See* TBMP § 509.02 (Form and Determination of Motions to Extend or Reopen).

proceedings for consideration of a matter by the Examining Attorney, including the disposition of a party's application before the Examining Attorney.[171]

Bankruptcy. The Board will issue an order suspending proceedings if it comes to the attention of the Board that the defendant has filed a petition for bankruptcy.[172] Under the automatic stay provisions of Section 362 of the United States Bankruptcy Code, 11 U.S.C. § 362, a petition for bankruptcy (filed under Section 301, 302, or 303 of the Code, 11 U.S.C. § 301, 302, or 303) operates as a stay, inter alia, of the commencement or continuation of a judicial, administrative, or other process against the debtor that was or could have been commenced before the commencement of the bankruptcy case. However, if it is the plaintiff in the Board proceeding, rather than the defendant, 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).

Withdrawal of counsel. If, in a Board proceeding, a party's attorney or other authorized representative files a request to withdraw as counsel for the party, and the request is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it 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.[173] A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance on the party's behalf in the proceeding.[174]

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[171] *See, for example, The Tamarkin Co. v. Seaway Food Town Inc*., 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending consideration of consent agreement by Examining Attorney).

[172] *See, for example, In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992) (suspended where petitioner's pleaded registration was the subject of a counterclaim) *aff'd sub nom., Checkers Drive-In Restaurants, Inc. v. Commissioners or Patents and Trademarks,* 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995), *cert. denied,* 516 US 866 (1995).

[173] *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) (Resumption).

[174] *See* TBMP § 114.03 (Representation by Attorney). *See also* TBMP §§ 114.04 (Representation by Non-Lawyer) and 114.05 (Representation by Foreign Attorney).

Potentially dispositive motion. When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss,[175] 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.[176]

The filing of such 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.[177] However, when issuing its suspension order, the Board ordinarily treats the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion.[178] On a case-by-case basis, the Board may find that the filing of a potentially dispositive motion provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests.[179]

Once the Board has suspended proceedings in a case, pending determination of a potentially dispositive motion, no party should file any paper that is not germane to the motion.[180]

Motion to compel. Pursuant to 37 CFR § 2.127(d) (effective October 9, 1998) when a party files a motion to compel discovery, the Board will issue an order suspending the

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

[176] *See* 37 CFR § 2.127(d); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (suspended pending disposition of motion for discovery sanctions which included request for entry of judgment); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434 (TTAB 1995) (suspended pending disposition of motion for judgment on the pleadings); *Pegasus Petroleum Corp. v. Mobil Oil Corp.,* 227 USPQ 1040, 1044 n.7 (TTAB 1985) (suspended pending motion for summary judgment, and subsequent motion to suspend for civil action deferred until after decision on summary judgment); and *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross motion for summary judgment is germane to a pending motion for summary judgment).
Cf. SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994) (motion for leave to amend a notice of opposition is not a potentially dispositive motion which would warrant suspension under 2.127(d)).

[177] *See Electronic Industries Association. V. Potega, supra; SDT Inc. v. Patterson Dental Co., supra;* and *Giant Good, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986).

[178] *See Leeds Technologies Limited v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002) and *Electronic Industries Association. v. Potega, supra.*

[179] *See Leeds Technologies Limited v. Topaz Communications Ltd., supra* (time for opposer to serve discovery responses reset following decision on opposer's motion for judgment on pleadings).

[180] *See* 37 CFR § 2.127(d); *Pegasus Petroleum Corp. v. Mobil Oil Corp., supra* (motion to suspend for civil action not considered); and *Nestle Co. v. Joyva Corp., supra* (cross-motion for summary judgment germane to pending summary judgment motion).

proceeding with respect to all matters not germane to the motion,[181] and no party should file any paper which is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel.[182]

Petition to the Director. The mere filing of a petition to the Director seeking review of an interlocutory decision or order of the Board[183] will not act as a stay of the Board proceeding pending disposition of the petition. Such a stay must be specifically requested of the Board and granted by the Board.[184] The decision as to whether to grant such a stay is within the Board's discretion. Until and unless the Board issues a suspension order, all times continue to run as previously set or reset by the Board.

Testimony Depositions on Written Questions. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions pursuant to 37 CFR § 2.124, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions upon written questions.[185]

510.03(b) Resumption

Settlement negotiations. When proceedings are suspended for purposes of settlement negotiations, the Board normally sets a specific period of suspension (up to six months). Each party has the right to request resumption at any time during the suspension period.[186] If no word is heard from either party prior to the expiration of the suspension period, the Board resumes proceedings. When resuming proceedings, if the consented motion or stipulation to suspend does not specify otherwise, the Board will generally issue a new trial order beginning with whatever period was running when the consented

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

[182] *See* 37 CFR § 2.120(e)(2). *See also* TBMP § 523 regarding motions to compel.

[183] *See generally* TBMP § 905 (Petition to the Director).

[184] *See* 37 CFR § 2.146(g).

[185] *See* 37 CFR § 2.124(d)(2), and TBMP § 703.02(c) (Depositions on Written Questions – When Taken).

[186] *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

motion or stipulation to suspend was filed.[187] In addition to, or instead of, resetting trial dates, the Board may reset the time for the parties to take other appropriate action in the case. 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.

Matter Before the Examining Attorney. If proceedings have been suspended for consideration of a matter by the Examining Attorney, including the disposition of a party's application before the Examining Attorney, and the matter does not resolve the case, the Board will issue an order resuming proceedings, and taking further appropriate action.[188]

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

Withdrawal of counsel. If proceedings have been suspended in order to allow a party, whose attorney or other authorized representative has withdrawn, a period of time in which to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself[189] 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 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

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[187] *See Instruments SA Inc. v. ASI Instruments Inc.,* 53 USPQ2d 1925, 1927 n.3 (TTAB 1999).

[188] *See, for example, The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings to be resumed if consent agreement did not overcome Examining Attorney's 2(d) refusal).

[189] *See* TBMP § 510.03(a) (Suspension).

judgment should not be entered against it.[190] If the party, in turn, files a response indicating that it has not lost interest in the case, default judgment will not be entered against it. If the party fails to file a response to the show cause order, default judgment may be entered against it.

Potentially dispositive motion. When proceedings have been suspended pending determination of a potentially dispositive motion, and the determination of the motion does not dispose of the case, the Board, in its decision on the motion, will issue an order resuming proceedings, and taking further appropriate action.[191]

511 Motion to Consolidate

Fed. R. Civ. P. 42 (a) Consolidation. *When actions involving a common question of law or fact are pending before the court, it may order a joint hearing or trial of any or all the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.*

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases.[192] 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.[193] Although identity of the parties is another factor considered by the Board in determining whether

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[190] *See, for example, Pro-Cuts v. Schilz-Price Enterprises Inc*., 27 USPQ2d 1224 (TTAB 1993).

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

[192] *See* Fed. R. Civ. P. 42(a). *See also S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); *Ritchie v. Simpson,* 41 USPQ2d 1859 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993) (opposition and cancellation consolidated); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). *For additional cases relating to this issue, see Appendix of Cases*.

[193] *See, for example*, Wright & Miller, *Federal Practice and Procedure*: Civil 2d § 2383 (1999); *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); *World Hockey Ass'n v. Tudor Metal Products Corp.,* 185 USPQ 246 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); and *Izod, Ltd. v. La Chemise Lacoste,* 178 USPQ 440 (TTAB 1973) (consolidation denied where issues differed).

consolidation should be ordered,[194] it is not always necessary.[195] 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.[196]

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.[197]

When cases have been ordered consolidated, they may be presented on the same record and briefs.[198] Papers should only be filed in the "parent" case of the consolidated proceedings unless otherwise advised by the Board, but the caption of each paper filed with the Board should reference the individual proceeding numbers with the parent case listed first.[199] The oldest (i.e., first-filed) of the consolidated cases is treated as the "parent" case.

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.[200]

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment.[201] Upon consolidation,

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[194] *See Bigfoot 4x4 Inc. v. Bear Foot Inc.,* 5 USPQ2d 1444 (TTAB 1987)

[195] *See* Wright & Miller, *supra* at § 2384.

[196] *See, for example*, Wright & Miller, *supra* at § 2383; *8440 LLC v. Midnight Oil Co.* , 59 USPQ2d 1541 (TTAB 2001) (opposition and cancellation proceedings consolidated on Board's own initiative*); S. Industries Inc. v. Lamb-Weston Inc., supra* at 1297 (motion); *Hilson Research Inc. v. Society for Human Resource Management*, *supra* (stipulation); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (Board's initiative); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) (stipulation); *Bigfoot 4x4 Inc. v. Bear Foot Inc., supra* (joint motion); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, *supra* (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).

[197] *Cf.* 37 CFR §§ 2.104(b) and 2.114(b), and TBMP § 305 (Consolidated and Combined Complaints).

[198] *See Internet Inc. v. Corporation for National Research Initiatives,* 38 USPQ2d 1435, n.2 (TTAB 1996) and *Hilson Research Inc. v. Society for Human Resource Management*, *supra.*

[199] *See, e.g., S. Industries Inc. v. Lamb-Weston Inc., supra* at n.4 and *Nabisco Brands Inc. v. Keebler Co.,* 28 USPQ2d 1237, 1238 n.2 (TTAB 1993).

[200] *See* TBMP § 117.02 (More than One Attorney).

[201] *See* Wright & Miller, *supra* at § 2382 (1999).

the Board will reset trial dates for the consolidated proceeding, usually by adopting the trial dates as set in the most recently instituted of the cases being consolidated.

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.[202]

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.[203] 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 Division of the Patent and Trademark Office, 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 discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery.[204]

If a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted for the originally named party if the assignment

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[202] *See, e.g., Interstate Brands Corp. v. McKee Foods Corp*., 53 USPQ2d 1910, 1910 n.1 (TTAB 2000) (assignee joined at final decision).

[203] *See* 37 CFR §§ 3.71 and 3.73(b).

[204] *See, for example*, 37 CFR §§ 2.113, 3.71 and 3.73(b); Fed. R. Civ. P. 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, 1138 n.4 (TTAB 1990) (assignee joined after filing copy of an assignment which occurred subsequent to commencement of proceeding); and *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 857 n.1 (TTAB 1986) (assignee joined where papers filed by parties indicated registration had been assigned). *For additional cases relating to this issue, see Appendix of Cases.*

occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or if the defendant raises no objection to substitution. Otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence.[205] The assignment does not have to be recorded with respect to a plaintiff's pleaded application or registration before substitution or joinder (whichever is appropriate) is made. However, recordation in the Assignment Division of the Patent and Trademark Office is advisable because it will aid the assignee in its effort to prove ownership of the application or registration at trial.

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.[206]

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.[207]

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.[208]

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[205] *See, for example*, 37 CFR §§ 2.113, 3.71 and 3.73(b); Fed. R. Civ. P. 17 and 25; 37 CFR § 2.102(b); TBMP § 303.05(b) (Opposition Filed by Privy); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870 (TTAB 1994) (substitution of opposer appropriate where assignment occurred prior to commencement); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993) (motion to substitute filed during testimony period granted to the extent that successor was joined); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992) (opposer's motion to substitute granted where copy of assignment was filed and applicant did not object); and *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988) (survivor of merger substituted at final decision). *For additional cases relating to this issue, see Appendix of Cases.*

Compare SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994) (motion to join licensee as "co-opposer" denied since right to oppose may be transferred but not shared unless timely opposition is filed) and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993) (substitution of proper party in interest not permitted in view of misidentification of original party).

[206] *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993) and *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133 (TTAB 1982).

[207] *See* Fed. R. Civ. P. 25(c), and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, n.1 (TTAB 1982) (decision will be binding upon the assignee).

[208] *See Avia Group International Inc. v. Faraut,* 25 USPQ2d 1625 (TTAB 1992) (respondent's motion to join petitioner's licensor as party plaintiff denied).

512.02 Change of Name

If the name of a party to an inter partes proceeding before the Board is changed, the title of the Board proceeding may be changed, upon motion or upon the Board's own initiative, to reflect the change of name, provided that appropriate evidence thereof is made of record in the proceeding. Such evidence may consist, for example, of a copy of the name change document, or the reel and frame numbers at which such document is recorded in the Assignment Services Division of the USPTO.[209] If no such evidence is made of record in the proceeding, the proceeding may be continued in the party's old name.[210]

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 in the proceeding, to have its registration issue in its new name.[211]

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.

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[209] *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, 1135 n.1 (TTAB 1992) (caption to be changed if document evidencing of change of name is submitted); *NutraSweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964 n.2 (TTAB 1987) (although no request to substitute was filed, where the change of name was recorded and there was no dispute as to facts and circumstances surrounding name change, opposer under new name was substituted as plaintiff); and *Binney & Smith Inc. v. Magic Market Industries, Inc*., 222 USPQ 1003 (TTAB 1984). *Cf. In re Brittains Tullis Russell Inc.*, 23 USPQ2d 1457 n.1 (Comm'r 1991) (in petition to Commissioner to accept § 8 & 15 affidavit, registration file evidenced change of registrant's name and claim of ownership accepted).

[210] *See, for example, Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736 (TTAB 1983) (caption was not changed to reflect name change where no supporting documents submitted) and *National Blank Book Co. v. Leather Crafted Products*, 218 USPQ 827 (TTAB 1983). *Cf.* Fed. R. Civ. P. 25(c).

[211] *See* TBMP § 512.03 (Issuance of Registration to Assignee, or in New Name) and, *for example*, *Maine Savings Bank v. First Banc Group of Ohio, Inc., supra*.

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,[212] 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 Division of the USPTO, or the written request must state that the document has been filed for recordation. Finally, the address of the assignee must be made of record in the application file.

Similarly, even though the title of an inter partes proceeding before the Board may have been changed to reflect a name change of an applicant whose application is the subject of the proceeding, any registration issued from the application may issue in the applicant's original name unless the applicant complies with the requirements of 37 CFR § 3.85.[213]

If an assignment or change of name document is recorded in the Assignment Division well prior to the time the subject application is prepared for issuance of a registration, the registration may issue in the name of the assignee, or in the new name, even if no 37 CFR § 3.85 request is filed. However, the registration may issue in the name of the assignor, or in the old name. The purpose of the written request is to call the attention of the 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 Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest.[214]

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[212] *See* TBMP § 512.01 (Assignment of Mark).

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

[214] *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.3 (TTAB 1985); *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505 (TTAB 1974); *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); *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407 (TTAB 1964); and *Textron, Inc. v. Gillette Co.*, 177 USPQ 530 (Comm'r 1973). *Cf.* 37 CFR § 2.102(b); TBMP § 303.05(c)

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.[215]

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 Director.*

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;*

(Misidentification of Opposer); and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993) (amendment to correct misidentification and substitute proper party in interest not permitted).

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

Cf. TMEP §§ 802.06 and 802.07; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r 1990)*; In re Techsonic Industries, Inc.,* 216 USPQ 619 (TTAB 1982); and *In re Eucryl Ltd.,* 193 USPQ 377 (TTAB 1976).

(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:

(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).[216] In accordance with that rule, a request for permission to withdraw should include (1) a specification of the basis for the request; (2) a statement that the practitioner has notified the client of his or her desire to withdraw from employment, and has allowed time for employment of another practitioner; (3) a statement that all papers and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (4) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded; and (5) proof of service of the request upon the client and upon every other party to the proceeding.[217] The facts establishing these elements should be set out in detail.[218] Moreover, a request to withdraw from representation may not be used as a subterfuge to obtain an extension or reopening of time that a party would not otherwise be entitled to.[219]

If the request to withdraw is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it desires to represent itself. If the party fails to take such action, the Board may issue an order to show cause why default judgment should not be entered against the party based on the party's apparent loss of interest in the case.[220]

A request for permission to withdraw as counsel in an application that is the subject of a potential opposition (*i.e.*, an application as to which a request for extension of time to file an opposition is pending) is determined by the Board, not the examining operation, and it should be filed with the Board to insure prompt processing.[221] .

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[216] *See* 37 CFR §§ 2.19(b) and 10.40; *SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372 (TTAB 2001) (request to withdraw denied as prejudicial to client where it was filed on last day of client's testimony period, although grounds for withdrawal were known months earlier); *Netcore Technologies, Inc. v. Firstwave Technologies, Inc.*, ___ USPQ2d ___ (TTAB 2001) (attorney's withdrawal request filed in response to Board's show cause order under Rule § 2.128(a)(3) denied as untimely where attorney assertedly had ceased to represent client months earlier).

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

[217] *See* 37 CFR § 10.40.

[218] *See SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited,, supra* and *Netcore Technologies Inc, v. Firstwave Technologies, Inc.*, *supra*.

[219] *See SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited,, supra* and *Netcore Technologies Inc, v. Firstwave Technologies, Inc.*, *supra*.

[220] *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

[221] *See* TBMP § 212.01 (Jurisdiction to Consider Amendment).

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.[222]

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 [Director of the United States Patent and Trademark Office] 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.

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition. After the petition has been determined or dismissed, the Board issues an action resuming proceedings in the case, and taking further appropriate action therein. Petitions to disqualify in matters before the Board are currently determined by the Chief Administrative Trademark Judge under authority delegated by the Director.[223]

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[222] *See* TBMP § 114.03 (Representation by Attorney). *See also* TBMP §§ 114.04 (Representation by Non-Lawyer) and 114.05 (Representation by Foreign Attorney).

[223] *With respect to disqualification due to an asserted conflict of interest, see* TBMP § 114.08, and authorities cited therein. *With respect to disqualification where the attorney is a witness in the case, such as giving testimony on behalf of the client, see* 37 CFR § 10.63; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ 2d 1663 (TTAB 1988); and *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989). *Cf. In re Gray*, 3 USPQ2d 1558 (TTAB 1987).

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

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.*

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 granted by the Board.[224] 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.[225]

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

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

[225] *See* 15 U.S.C. § 1057(e) and 37 CFR § 2.173.

A proposed amendment to any application or registration which is the subject of an inter partes proceeding 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.[226] However, an otherwise appropriate amendment to an application will ordinarily not be rejected by the Board solely on the basis that the amendment would require republication of the mark.

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.[227] A request to amend an application involved in a Board proceeding must be filed with the Board, not with the Trademark Examining Operation. Similarly, a request to amend a registration involved in a Board proceeding must be filed with the Board, not with the Post Registration Branch. Failure to file such a request with the Board will result in unnecessary delay and may result in the loss or misplacement of the amendment request.

When the Board grants a request to amend a registration which is the subject of a Board inter partes proceeding, the file is forwarded to the Post Registration branch of the Office of Trademark Services for entry of the amendment of the registration. The action by the Post Registration branch is limited to the ministerial duty of ensuring that the authorized change to the registration is made.[228]

514.02 Amendment With Consent

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

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[226] *See* Section 7(e) of the Act, 15 U.S.C. § 1057; 37 CFR §§ 2.71(b), 2.72, 2.173(a) and 2.173(b); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (material alteration); *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993) (expansion of scope of goods); *Mason Engineering and Designing Corporation v. Mateson Chemical Corporation*, 225 USPQ 956 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration); and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).

[227] *See* 37 CFR § 2.119(a) and TBMP § 113 (Service of Papers).

[228] *See In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r 1980) (examining operation acted beyond its authority in denying amendment to registration which Board had already approved).

ordinarily will be approved by the Board. However, if the application or registration is the subject of other inter partes proceedings, the consent of the other parties in each of those other proceedings must be of record before the amendment may be approved.[229]

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.[230]

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 Fed. R. Civ. P. 15(b).[231]

The Board generally will defer determination of a timely filed (i.e., pre-trial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment.[232]

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[229] *See Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (no consent from opposers in two other oppositions against the application).

[230] *See* 37 CFR § 2.133(a). *See also, for example, International Harvester Company v. International Telephone and Telegraph Corporation,* 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods) and *Pro-Cuts v. Schilz-Price Enterprises Inc.,* 27 USPQ2d 1224 (TTAB 1993) (where applicant consented to entry of judgment against itself with respect to a geographically unrestricted registration).

[231] *See, for example, Personnel Data Systems, Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863 (TTAB 1991) (defendant's motion to restrict identification of goods in involved registration, filed with brief on case, denied) *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (same); and *International Harvester Company v. International Telephone and Telegraph Corporation,* 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods). *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 (Form and Content of Oppositions and Petitions to Cancel), 314 (Unpleaded Matters), and 507 (Motion to Amend Pleading).

[232] *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same). *See also* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra*.

If a defendant, whose application or registration is the subject of a Board inter partes proceeding, wishes to defend by asserting that it is at least entitled to a registration with a particular restriction, the defense should be raised either in the defendant's answer to the complaint, or by way of a timely motion to amend the application or registration to include the restriction.[233] 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.[234]

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.[235] 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.[236]

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding.[237] 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.[238] 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

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[233] *See* 37 CFR §§ 2.133(a) and 2.133(b); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, *supra*; *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); *Space Base Inc. v. Stadis Corp.*, *supra*; TBMP § 311.02(b) (Affirmative Defenses); and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra.*

[234] *See Space Base inc. v. Stadis Corp., supra* and TBMP § 311.02(b) (Affirmative Defenses). *See also Flow Technology Inc. v. Picciano, supra*.

[235] *See* 37 CFR § 2.133(b), and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra*. *See also* Section 18 of the Act, 15 U.S.C. § 1068.

[236] *See* Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today, supra.*

[237] *See* 37 CFR § 2.133(c); *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990) (allegations of abandonment in a particular geographic location is an insufficient pleading); and TBMP § 1101.02 (Context for USPTO Determination of Concurrent Rights).

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

opposer does not consent to the amendment, the amendment may nevertheless be approved and entered, and a concurrent use proceeding instituted, provided that applicant agrees to accept entry of judgment against itself in the opposition with respect to its request for a geographically unrestricted registration.[239]

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 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

[239] *See* TBMP § 1113 ("Conversion" of Opposition or Cancellation Proceeding to Concurrent Use Proceeding); *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).

suspend the inter partes proceeding, and remand the application to the Examining Attorney for further ex parte examination.[240]

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.[241]

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 Fed. R. Civ. P. 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.[242] 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 application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR § 2.131 remand to the Examining Attorney. The request may be made in the party's brief on the case, at oral hearing, or by separate motion.

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.[243]

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[240] *See* 37 CFR § 2.130.

[241] *See generally* 37 CFR § 2.133(a), and TBMP § 514 (Motion to Amendment Application or Registration).

[242] *See, for example*, 37 CFR § 2.131; *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1636 n.6 (TTAB 1988) (remand for consideration of evidence regarding applicant's date of first use); *West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.,* 2 USPQ2d 1306, 1309 n.5 (TTAB 1987) (remand for determination of status of underlying foreign registration); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984) (remand for consideration of evidence regarding applicant's use of mark prior to application filing date); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.,* 222 USPQ 1012 (TTAB 1984); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936 (TTAB 1983); and *Antillian Cigar Corp. v. Benedit Cigar Corp*., 218 USPQ 187 (TTAB 1983).

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

For example, if an application which is the subject of an opposition includes multiple classes, not all of which have been opposed, the applicant may file a motion to divide out the unopposed classes. If applicant seeks to divide out an entire class or classes, a fee for dividing the application must be submitted for each new application to be created by the division.[244]

Similarly, if an application which is the subject of an opposition includes more than one item of goods, or more than one service, in a single class, and the opposition is not directed to all of the goods or services, the applicant may file a motion to divide out the unopposed goods or services. Applicant must submit both a fee for dividing the application, and an application filing fee, for each new application to be created by the division.[245]

In both cases, if the motion to divide is granted, the application file is forwarded to the ITU/Divisional Unit for processing of the division. After the applications have been divided, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Section 1(b) of the Act, 15 U.S.C. § 1051(b), for issuance of a notice of allowance. The original application will be returned to the Board.

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.[246]

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

517 Motion to Strike Brief on Motion

Specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion, a brief in opposition to a motion, and a reply brief in further support of the motion. No further papers will be considered regarding the motion and any such papers may be returned to the filing party as being filed in violation of the rules.[247]

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief any argument it feels will be to its advantage. Accordingly, when a moving brief, an opposition

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[244] *See* 37 CFR §§ 2.87(a) and 2.87(b).

[245] *See* 37 CFR §§ 2.87(a) and 2.87(b).

[246] *See* TMEP § 1105.06(b).

[247] *See* 37 CFR § 2.127(a). *See also* TBMP § 502.02(b) (Briefs on Motions).

brief, or a reply brief on a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party 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, or a reply brief in support of the motion, is not timely filed, it may be stricken, or given no consideration, by the Board.

518 Motion for Reconsideration of Decision on Motion

37 CFR § 2.127(b) *Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within 15 days from the date of the service of the request.*

A request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date of the order or decision.[248] Unless the Director, upon petition, waives the time requirement of 37 CFR § 2.127(b), the Board need not consider a request for reconsideration or modification filed more than one month from the date of the order or decision complained of.[249] Nor does the rule contemplate a second request for reconsideration of the same basic issue.[250] 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.[251]

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)).[252]

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

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[248] *See* 37 CFR § 2.127(b) and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

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

[250] *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) and *Avedis Zildjian Co. v. D.G. Baldwin Co., supra.*

[251] *See Avedis Zildjian Co. v. D. H. Baldwin Co., supra.*

[252] *See* 37 CFR § 2.127(b).

use a request for reconsideration as a second opportunity to file a brief in opposition to the motion.[253]

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 the original motion. Rather, the motion should be limited to a demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change.[254]

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.[255] 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 Director 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.[256]

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*

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[253] *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).

[254] *Cf.* TBMP § 543 (Motion for Reconsideration of Final Decision).

[255] *See* 37 CFR § 2.127(c). *See also* TBMP § 502.04 (Determination of Motions).

[256] *See, for example, Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986).

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 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.[257]

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.[258] 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.[259]

For further information concerning good cause for a motion to serve additional interrogatories, see TBMP § 405.03(C). *For information concerning the interrogatory limit specified in 37 CFR § 2.120(d)(1), see* TBMP § 405.03.

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 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.*

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[257] *See* 37 CFR § 2.120(d)(1); *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); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479 (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).

[258] *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., supra*.

[259] *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., supra; Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc., supra; and Brawn of California Inc. v. Bonnie Sportswear Ltd., supra*.

37 CFR § 2.123(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 Fed. R. Civ. P. 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.[260] 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.[261]

However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the discovery deposition, when taken in a foreign country, be taken by oral examination.[262]

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.[263] 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.[264]

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. Alternatively, in

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[260] *See* 37 CFR § 2.120(c)(1). *See also* TBMP § 404.03(b) (Person Residing in a Foreign Country – Party), and authorities cited therein.

[261] *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998); and TBMP § 404.03(b) and authorities cited therein.

[262] *See* 37 CFR § 2.120(c)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989) (good cause to take oral deposition of witness in England); *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983) (stipulation to take oral deposition in Canada); and TBMP § 404.03(b).

[263] *See* 37 CFR § 2.123(a)(2). *See Jain v. Ramparts, supra* at 1431.

[264] *See Orion Group Inc. v. Orion Insurance Co. P.L.C.*, *supra* at 1925-26 (good cause found in view of circumstances and since fares to England were not that much greater than fares within the U.S. and no translation was required). *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990) (applicant would be prejudiced by rebuttal testimony deposition on written questions of opposer's survey expert who was present in U.S.), *corrected,* 19 USPQ2d 1479 (TTAB 1990); and TBMP §§ 521 (Motion to Quash) and 531 (Motion that Deposition upon Written Questions be taken Orally).

the case of a notice of discovery deposition and under appropriate circumstances, the party may file a motion for a protective order.[265]

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;[266] or **(2)** constitutes harassment or is without proper basis;[267] or **(3)** in the case of a discovery deposition to be taken in the United States, the deposition is not scheduled to be taken in the Federal judicial district where the proposed deponent resides or is regularly employed;[268] or **(4)** in the case of a deposition to be taken in a foreign country, the deposition is scheduled to be taken orally in violation of 37 CFR § 2.120(c) or 2.123(a)(2);[269] 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;[270] or **(6)** that there was not due (i.e., reasonable) notice of the proposed deposition;[271] or **(7)** that the

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[265] *See* TBMP § 410 (Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery).

[266] *See S. Industries Inc. v. Lamb-Weston Inc.,* 45 USPQ2d 1293, 1298 (TTAB 1997) (notice was reasonable and timely; no scheduling conflict with depositions in civil action)**;** *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990) (notices of 13 depositions on written questions served eight months after original opening of testimony period, but within 10 days of latest extension, were timely); and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978) (deposition noticed during discovery but scheduled for date after discovery closed was untimely).

[267] *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988) (notice to take deposition of CEO merely to discuss settlement was baseless as a party is not required to discuss settlement). *Compare Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976) (written discovery requests directed to assignor need not be answered where assignment occurred prior to institution of proceeding).

[268] *See* 37 CFR § 2.120(b).

[269] *See Rhone-Poulenc Industries v. Gulf Oil Corp., supra.*

[270] *See* 37 CFR § 2.123(c).

[271] *See* 37 CFR §§ 2.123(c); Fed. R. Civ. P. 30(b) and 31(a); and *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (whether notice is reasonable depends upon the circumstances of each case; one and two-day notices were not reasonable without compelling need for such haste, but three-day notice was reasonable).

See also, where objection to notice was raised by other means, Electronic Industries Association v. Potega , 50 USPQ2d 1775 (TTAB 1999) (two-day notice unreasonable and failure of opposing counsel to attend was excused); *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown); and TBMP §§ 404.05 (Notice of [Discovery] Deposition) and 703.01(e) (Notice of [Testimony] Deposition) .

taking of the deposition should be deferred until after determination of a certain motion pending before the Board, such as a motion for summary judgment; 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;[272] 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).[273]

However, the Board has no jurisdiction over nonparty depositions, or adverse witness depositions, taken by subpoena, and thus has no authority to quash such subpoenas.[274]

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 attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call.[275] Telephone conference procedures are fully discussed in TBMP § 502.06(a).

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 where documents and things are to be produced is governed by 37 CFR § 2.120(d)(2).[276]

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[272] *See* TBMP § 404.03(b) (Person Residing in a Foreign Country – Party) and authorities cited therein. *Cf. Jain v. Ramparts Inc.*, 49 USPQ 1429 (TTAB 1998) (issue raised by motion to compel).

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

[274] *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (Board has no jurisdiction over third-party subpoenas), and TBMP §§ 404.03(a)(2) (Person Residing in United States – Nonparty) and 703.01(f) (Securing Attendance of Unwilling Adverse Party or Nonparty).

[275] *See* 37 CFR § 2.120(i)(1) and TBMP § 502.06(a) (Telephone Conferences).

[276] *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) (documents to be produced as part of a discovery deposition would be produced where they are located); and TBMP § 406.03 (Elements of Request for Production; Place of Production).

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.[277]

523 Motion to Compel Discovery

523.01 In General

37 CFR § 2.120(e) Motion for an order to compel discovery. *(1) 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. ...*

(2) When a party files a motion for an order to compel discovery, 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, except as otherwise specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

In inter partes proceedings before the Board, a motion to compel discovery procedure is available in the event of a failure to provide discovery requested by means of discovery depositions, interrogatories, and requests for production of documents and things.[278]

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[277] *See Unicut Corp. v. Unicut, Inc., supra;* 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). *See also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (applicant ordered to copy responsive documents and forward them to opposer at applicant's expense as discovery sanction) and *Jain v. Ramparts Inc*., 49 USPQ2d 1429, 1432 (TTAB 1998).

[278] *See* 37 CFR § 2.120(e). *See also* TBMP § 411 (Remedy for Failure to Provide Discovery) and, *for example*, *Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998) (interrogatories and document requests); *S. Industries Inc. v. Lamb-Weston Inc.,* 45 USPQ2d 1293, 1298 (TTAB 1997) (discovery deposition)*; MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979) (interrogatories); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976) (motion for sanctions treated as motion to compel); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976) (party may file motion to compel if it believes objections to discovery requests to be improper). *In addition, see 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*

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.[279]

In accordance with 37 CFR § 2.120(e)(2), when a party files a motion to compel discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel.[280]

This rule, in conjunction with 37 CFR §§ 2.120(e)(1) and 2.120(h)(1) which provide, respectively, that a motion to compel must be filed prior to the commencement of the first testimony period as originally set or as reset and that the period between the end of the discovery period and the opening of the first testimony period is increased from thirty to sixty days, is designed to ensure that all discovery disputes are resolved prior to the commencement of trial.[281] 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 Fed. R. Civ. P. 36(a).[282]

For information concerning the effect of a party's failure to timely respond to interrogatories and document requests, see TBMP §§ 403.03 (regarding time for service of discovery responses), 405.04(a) (regarding time for service of interrogatory responses), and 406.04(a) (regarding time for service of responses to document requests), 523 (regarding motion to compel discovery) and 524 (regarding motion to test sufficiency of responses to admission requests).

Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); and *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974). *Cf.* Fed. R. Civ. P. 37(a)(2)(B).

[279] *See* TBMP §§ 404.09 (Discovery Depositions Compared to Testimony Depositions) and 411.03 (Discovery Depositions), and authorities cited therein.

[280] *See* 37 CFR § 2.120(e)(2).

[281] *See Luemme Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758 (TTAB 1999) (motions to compel and motions to test the sufficiency of responses to requests for admission must be filed prior to the opening of the first testimony period).

[282] *See* TBMP §§ 411.02 (Requests for Admissions) and 524 (Motion to Test Sufficiency of Response to Admission Request).

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).[283]

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.[284]

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[283] *See also Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (TTAB 1976) (Board must be able to render a meaningful decision on a motion to compel); *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).

[284] *See* 37 CFR § 2.120(e); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (failed to submit documentary evidence of good faith effort); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties must narrow disputed requests for discovery to a reasonable number); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80, 83 (TTAB 1984) (it was clear from the nature and the number of discovery requests that no good faith effort had been made); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979) (good faith effort is required where there has been a complete failure to respond to discovery; telephone call to counsel sufficient); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (same; a statement that discovery has not been responded to is insufficient). *See also 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 Nobel Corp.*, 188 USPQ 581 (TTAB 1975); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 581 (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.[285]

For information concerning the special requirements for a motion to compel answers to interrogatories that are the subject of a general objection on the ground of excessive number, see TBMP § 405.03(e).

523.03 Time for Filing Motion

37 CFR§ 2.120(e) Motion for an order to compel discovery. *...The motion must be filed prior to the commencement of the first testimony period as originally set or as reset. ...*

A motion to compel does not necessarily have to be filed during the discovery period.[286] However, the motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate and must, in any event, be filed before the first testimony period opens.[287] Trial schedules include a 60-day period between the close of discovery and the opening of the first testimony period to allow time for the filing of any necessary discovery motions.

523.04 Failure to File Motion to Compel

If a party that 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.[288]

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

[286] *See Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974).

[287] *See* 37 CFR § 2.120(e); and, *for example*, *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL,* 59 USPQ2d 1383 (TTAB 2001).

[288] *See Time Warner Entertainment Co. v. Jones,* 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (objections that discovery requests are, for example, ambiguous or burdensome, are not of a nature which would lead propounding party to believe that the requested information does not exist and party should have filed motion to compel), *aff'd,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery

524 Motion to Test Sufficiency of Response to Admission Request

524.01 In General

Fed. R. Civ. P. 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. ...*

37 CFR § 2.120(h) Request for admissions. *... (2) When a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, 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, except as otherwise specified in the Board's suspension order. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.*

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.[289]

If the Board, upon motion to test the sufficiency of a response to a request for admission, determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served.[290]

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deposition without motion to compel complete responses and violation of an order compelling answers). *See also Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL,* 59 USPQ2d 1383 (TTAB 2001) (any motion to compel to test alleged deficiencies in responses would be time-barred). *In addition, see 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). *Accord* TBMP § 524.04 (regarding failure to file motion regarding sufficiency of admission responses). *Cf.* TBMP § 527.01(e) (Estoppel Sanction).

[289] *See* 37 CFR § 2.120(h); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697 n.7 (TTAB 1971). *Cf.* 37 CFR § 2.120(e), and TBMP § 523.01 (Motion to Compel Discovery – In General).

[290] *See* Fed. R. Civ. P. 36(a).

524.02 Special Requirements for Motion

37 CFR § 2.120(h) Request for admissions. *(1) ... The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.*

A motion to determine the sufficiency of a response to a request for admission must include a copy of the request for admission (and any exhibits thereto) and of the answer or objection.[291]

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.[292]

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.[293]

524.03 Time for Filing Motion

37 CFR § 2.120(h) Request for admissions.
(1) Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed prior to the commencement of the first testimony period, as originally set or as reset.

(2) When a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, 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, except as otherwise specified in the Board's suspension order. The filing of a motion to determine the sufficiency of an answer or objection to

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

[292] *See* 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e) and TBMP § 523.02 (Special Requirements for Motion), and cases cited therein.

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

a request for admission shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

A motion to test the sufficiency of a response to a request for admission does not necessarily have to be filed during the discovery period, but it should be filed within a reasonable time after service of the response believed to be inadequate and, in any event, must be filed prior to the commencement of the first testimony period, as originally set or as reset.[294]

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.[295]

525 Motion to Withdraw or Amend Admission

Fed. R. Civ. P. 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 Fed. R. Civ. P. 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission.[296] 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.[297]

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[294] 37 CFR § 2.120(h)(1). *Cf. Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974) (motion to compel timely even if filed after close of discovery) and TBMP § 523.03 (Time for Filing Motion).

[295] *See Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971). *Cf.* TBMP § 523.04 (failure to file motion to compel), and cases cited therein. *Cf. also* TBMP § 527.04 (regarding effect of failure to timely respond to requests for admission).

[296] *See* Fed. R. Civ. P. 36(b), and TBMP § 407.04 (Effect of Admission).

[297] *See* Fed. R. Civ. P. 6(b) and 36, and TBMP §§ 407.03(a) (Time for Service of Responses) and 407.04 (Effect of Admission).

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.[298] 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.[299]

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.[300]

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[298] *See* Fed. R. Civ. P. 36(b); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (amendment permitted where the requested admissions were ambiguous and conclusory and possible prejudice avoided by extending discovery period); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by relieving opposer of admission on relevant issue and prejudice avoided by allowing applicant limited discovery as to the amended answer); and *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979) (motion to withdraw admissions by default denied, but to extent admissions are contradicted by evidence, they will not be relied on for purposes of deciding whether entry of summary judgment is appropriate). *See also American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend).

[299] *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc., supra* (propounding party's testimony period had not yet opened) and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp., supra* (case was still in pre-trial stage). *Cf.* TBMP § 507.02 (Amendments under Fed. R. Civ. P. 15(a)).

[300] *See* TBMP § 410 (Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery) and cases cited therein. *See also Luemme Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999).

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.[301]

Nevertheless, there are certain situations (such as, for example, when a request for discovery 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.[302]

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.[303]

When the Board grants a request for a protective order with respect to confidential or trade secret information, it may direct either the disclosing party, or the parties together, to prepare an order with terms which are mutually agreeable to them.[304] Other alternatives involve accepting a protective agreement proffered by a party or ordering parties to adhere to Board's standard agreement.[305] Parties are encouraged, however, to stipulate to a protective agreement governing

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[301] *See* 37 CFR § 2.120(d)(1), and TBMP § 405.03(e) (Remedy for Excessive Interrogatories).

[302] *See, for example,* 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c); *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high level executive granted); and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where obligation to respond to discovery requests rested with assignee). *See also* TBMP § 412 (Protective Orders).

[303] *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).

[304] *See, for example, Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra*; and *Neville Chemical Co. v. Lubrizol Corp.*, *supra*.

[305] *For other 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); and *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.,* 188 USPQ 141 (TTAB 1975) (motion for protective order that discovery not be taken pending Board's determination of motion to dismiss).

the handling of confidential or trade secret information rather than filing a motion for a protective order.

For further information concerning protective orders, see TBMP § 412.

527 Motion for Sanctions

527.01 Motion for Discovery Sanctions

527.01(a) For Failure to Comply With Board Discovery Order

37 CFR § 2.120(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 will not hold any person in contempt or 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).[306] 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.[307]

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.[308] Default judgment is a harsh remedy, but may be justified where no

[306] *See* 37 CFR § 2.120(g)(1) and *Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 11 Fed. R. Serv.3d 1342 (Fed. Cir. 1988) (question of proper sanction committed to sound discretion of the court).

[307] *See* 37 CFR § 2.120(g)(1).

[308] *See Ingalls Shipbuilding, Inc. v. United States*, *supra* (Fed. Cir. 1988); *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment); *Baron Philippe de Rothchild S.A. v. Styl-Rite Optical Mfg. Co.,* 55 USPQ2d 1848, 1854 (TTAB 2000) (pattern of dilatory conduct indicated willful disregard of

less drastic remedy would be effective and there is a strong showing of willful evasion.[309] However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party.[310]

The motion for sanctions for failure to comply with an order of the Board lies only when the Board has entered an order relating to discovery (i.e., an order compelling discovery or a protective order) and the order has been violated.[311]

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 Fed. R. Civ. P. 36, except that the Board will not award any expenses to any party.[312]

For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, see TBMP § 527.01(d).

Board order and resulted in entry of judgment); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (applicant ordered to copy and forward documents to opposer at applicant's expense); and *Electronic Industries Assn. v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (where applicant, in violation of order, served objections to discovery requests, judgment was denied as too harsh but applicant was ordered to provide new and complete responses without objection, to copy documents and forward to opposer, and to study sections of TBMP and certify completion to the Board). *See also Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984) and *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983) (in 1983 decision respondent sanctioned by order to produce documents by mailing them to petitioner's attorney at petitioner's expense; in 1984 decision respondent's continued refusal to obey Board orders sanctioned by entry of judgment); and *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976) (judgment entered where applicant provided no reason for not complying with Board order compelling discovery).

Cf. Ingalls Shipbuilding, Inc. v. United States, supra at 1348 (failure to comply based on confusion or sincere misunderstanding of court's order does not warrant dismissal) and *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984) (sanction of drawing adverse inference best left to situations where witness fails or refuses to answer during testimony as opposed to discovery deposition).

[309] *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra* at 1854, *and other cases cited in previous note.*

[310] *See* 37 CFR §§ 2.120(g)(1) and 2.127(f), and TBMP § 502.05 (Attorneys' Fees, etc., on Motions).

[311] *See, for example, MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979) (Board did not issue order compelling discovery but had only resumed proceedings after apparent failure of settlement negotiations and reset time to respond to discovery); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976) (motion for summary judgment on basis of petitioner's failure to answer interrogatories denied); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974) (motion for judgment denied).

[312] *See* 37 CFR § 2.120(h), and TBMP § 502.05.

[312] *See* 37 CFR §§ 2.120(g)(1), (2), 2.127(f), and TBMP § 502.05.

527.01(b) 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 judgment against the disobedient party. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party.[313]

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 § 527.01(d).

527.01(c) 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.[314] Objections going to the merits of a discovery request include claims that the

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[314] *See No Fear Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found)*; Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (circumstances do not justify waiver of right to object in view of confusion regarding time to respond); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (even where there is complete failure to respond to discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel); *and Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975)

information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.[315] Objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.[316]

527.01(d) In the Case of Requests for Admission

The entry of sanctions for failure to respond, or respond properly, to requests for admission is governed by 37 CFR § 2.120(h) and Fed. R. Civ. P. 36, except that the Board will not award expenses to any party.[317]

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 Fed. R. Civ. P. 36(b), and granted by the Board. *See* Fed. R. Civ. P. 6(b) and 36(a), and TBMP § 407.03(a). *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.[318] If the Board determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served.[319] *For information concerning*

(waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also* TBMP § 403.03 (Time for Service of Discovery Responses)

[315] *See No Fear Inc. v. Rule*, *supra* at 1554.

[316] *See No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

[317] *See* 37 CFR § 2.120(h), and TBMP § 502.05 (Attorneys' Fees etc., on Motions)

[318] *See* 37 CFR § 2.120(h); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971).

[319] *See* Fed. R. Civ. P. 36(a).

motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.

527.01(e) 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).[320]

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[320] *See, for example, Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 11 Fed. R. Serv. 3d 1342, 1351 (Fed. Cir. 1988); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 828-29 (CCPA 1980) (applicant's representations in objecting to interrogatories that facts other than those already litigated in prior proceedings were irrelevant and not discoverable gave rise to equitable estoppel preventing applicant from introducing testimony about those other facts); *Super Valu Stores Inc. v. Exxon Corp.*, 11 USPQ2d 1539, 1543 (TTAB 1989) (party may not refuse to answer interrogatories by claiming confidentiality and then introduce responsive information during its trial period); *Presto Products Inc. v. Nice-Pak Products Inc.,* 9 USPQ2d 1895, 1896 n.5 (TTAB 1988) (trademark search report not produced under attorney-client privilege, albeit rightfully withheld, still cannot be relied upon to support motion for summary judgment); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987) (exhibits demonstrating pronunciation not produced during discovery, though encompassed by discovery requests, excluded from consideration); and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration). *See also* TBMP § 523.04 (Failure to File Motion to Compel).

Cf. Linville v. Rivard, 41 USPQ2d 1731, 1733 (TTAB 1996) (no estoppel; where objections that discovery requests are, for example, ambiguous or burdensome, or are otherwise not of a nature which would lead propounding party to believe that the requested information does not exist, party should have filed motion to compel), *aff'd,* 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (no estoppel; where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery deposition without motion to compel complete responses and violation of an order compelling answers); and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989) (in that party need not specify evidence it intends to present, failure to identify witness in response to interrogatory seeking identification of all witnesses who would testify at trial, did not preclude testimony of such witness).

For additional cases relating to this issue, see Appendix of Cases.

527.02 Motion for Fed. R. Civ. P. 11 Sanctions

Fed. R. Civ. P. 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 attorneys, law firms, or 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, 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 an attorney, law firm, or 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 for correspondence filed in the Patent and Trademark Office.
(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.*

(b) *By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

> *(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and*
> *(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-*
>
> > *(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;*
> > *(ii) The claims 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;*
> > *(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*
> > *(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

(c) *Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of*

paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner [Director of the United States Patent and Trademark Office], or the Commissioner's [Director's] designee, which may include, but are not limited to, any combination of-

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action. See §10.23(c)(15).*

The quoted provisions of Fed. R. Civ. P. 11 are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board.[321] Thus, if a paper filed in an inter partes proceeding before the Board violates the provisions of Fed. R. Civ. P. 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction. The Board may find a Fed. R. Civ. P. 11 violation, and impose an appropriate sanction, not only upon motion, but also upon its own initiative, following issuance of an order to show cause and an opportunity for the party to be heard.[322]

Moreover, Rule 11 certification standards apply to parties as well as attorneys.[323]

While Fed. R. Civ. P. 11 provides, inter alia, for the imposition of monetary sanctions, the Board will not impose monetary sanctions, or award attorneys' fees or other expenses to any party.[324]

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[321] *See* 37 CFR § 2.116(a); *The Clorox co. v. Chemical Bank,* 40 USPQ2d 1098, n.9 (TTAB 1996) (accuracy in factual representations is expected); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (filing of notice of reliance on third-party discovery deposition constitutes certificate that circumstances exist which justify acceptance of the evidence). *See also*, Alan S. Cooper, *The Application of Rule 11 Sanctions in Trademark Cases*, 78 Trademark Rep. 427 (1988).

[322] *See* Fed. R. Civ. P. 11(c)(1)(B); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.,* 45 USPQ2d 2021 (TTAB 1998) (order to show cause issued where, although 56(f) motion was granted, party responded to summary judgment without taking the requested discovery); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 633 n.19 (TTAB 1986) (Rule 11 permits court to enter sanctions sua sponte).

[323] *See Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.,* 498 U.S. 533, 547, 111 S.Ct. 922, 112 L.Ed.2d 1140 (1991) and *Central Manufacturing Inc. v. Third Millennium Technology Inc*., 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). *See also* Patent and Trademark Rule 10.18(b).

[324] *See* 37 CFR § 2.127(f) and TBMP § 502.05 (Attorneys' Fees etc., on Motion). *Compare* 37 CFR § 2.120(f) and 2.120(g)(1).

However, the Board may enter other appropriate sanctions, up to and including the entry of judgment, against a party which violates Fed. R. Civ. P. 11.[325]

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

The provisions of 37 CFR § 10.18 largely pattern Federal Rule 11 and 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.[326]

527.03 Inherent Authority to Sanction

Flowing from the Board's inherent authority to manage the cases on its docket is the inherent authority to enter sanctions against a party.[327] The Board's exercise of this authority is clearly permitted in a variety of situations where the conduct in question does not fall within the reach of other sanctioning provisions of the rules.[328]

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[325] *See* 37 CFR § 2.116(a); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, *supra* at 2023 (sanctions included requirement that law firm include express provision in all subsequent filings acknowledging Rule 11(b) and Trademark Rule 10.18(a) and stating that motion was read, has a sound legal basis and is not interposed for delay, harassment or other improper purpose); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1221 (TTAB 1990) (Rule 11 not designed to punish semantic errors; applicant had reasonable basis for allegations in its pleading); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (filing of discovery motions without reasonable basis in law or in fact resulted in Rule 11 sanctions precluding applicant from filing further discovery motions and from filing any motion without prior leave of Board); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (applicant's frivolous request for reconsideration of order imposing Rule 11 sanctions resulted in entry of judgment); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986) (applicant warned that any other filing deemed frivolous would result in judgment). *See also*, Alan S. Cooper, *The Application of Rule 11 Sanctions in Trademark Cases*, 78 Trademark Rep. 427 (1988).

[326] *See* 37 CFR § 10.18 and, for example, *ITC Entertainment Group Ltd. v. Nintendo of America Inc., supra. For information concerning disciplinary proceedings, see* 37 CFR §§ 10.130-10.170, and TBMP § 115.02 (Disciplinary Proceedings). In addition, conduct in violation of the Canons and Disciplinary Rules set forth in 37 CFR part 10 may be referred to the Office of Enrollment and Discipline for appropriate action. *See* 37 CFR §§ 10.18(d) and 10.20, *et.seq.*

[327] *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27*, rehearing denied*, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991) (stating that this inherent power "stems from the very nature of courts and their need to be able to manage their own affairs so as to achieve the orderly and expeditious disposition of the cases").

[328] *See Chambers v. NASCO, Inc.*, *supra* (stating that "[i]f in the informed discretion of the court, neither the statute nor the Rules are up to the task, the court may safely rely on its inherent power.") and *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's conduct did not "fall within reach" of Rule 11 but resulted in judgment under Board's inherent power to sanction).

For example, when a party to an inter partes proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and request entry of judgment in its favor. If, as is usually the case, the motion is uncontested, the Board normally will grant it.[329]

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. Alternatively, under these or similar circumstances indicating that a party is no longer interested in the case, the Board may, either upon motion by the adverse party or upon its own initiative, issue an order that the party show cause why the Board should not enter judgment in view of the party's apparent loss of interest in the case. If the party files no response to the order, judgment will normally be entered.

Other circumstances involving the Board's inherent power to sanction are set forth in the cases cited in the note below. [330]

528 Motion for Summary Judgment

Fed. R. Civ. P. 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.*

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[329] *See* 37 CFR § 2.127(a).

[330] *International Finance Corp. v. Bravo Co.,* 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (following opposer's third motion to compel, Board prohibited opposer from filing any further motions to compel without prior Board permission); *Central Manufacturing Inc. v. Third Millennium Technology, Inc*., 61 USPQ2d 1210 (TTAB 2001) (extensions of time based on false allegations of continuing settlement negotiations resulted in imposition of continuing sanctions in future cases); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's "callous disregard for Board orders and ignorance of warnings" including violation of order prohibiting filing of any further papers without prior leave, resulted in order dismissing opposition without prejudice, and holding opposed application abandoned without prejudice); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp*., 13 USPQ2d 1719, n.4 (TTAB 1989) (opposer's counsel warned that Board would not tolerate any further "game playing" or evasiveness in discovery).

Cf. Thrifty Corporation v. Bomax Enterprises, 228 USPQ 62, 63 n.2 (TTAB 1985) (Board, while noting that it did not condone applicant's repeated failure to comply with the requirements of Trademark Rules 2.119(a) and (b) found that, in absence of any prejudice to opposer, such conduct did not justify the harsh result of entry of default judgment).

(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 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."[331]

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.[332]

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.[333]
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.[334] This is a burden that is higher than the preponderance of the evidence burden needed to prevail at final

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[331] Fed. R. Civ. P. 56(c). *See, for example, Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); *Dana Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); and *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). *For additional cases relating to this issue, see Appendix of Cases.*

[332] *See, for example*, *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) (evidence which might be adduced at trial would not change result given the differences in the goods of the parties); *Larami Corp. v. Talk To Me Programs Inc*., 36 USPQ 1840, 1843 (TTAB 1995) (where issue involved collateral estoppel); and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1390-91 (TTAB 1994).

[333] *See, for example*, *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (no relevant evidence to raise genuine issue of material fact); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984) (response contained only unsupported arguments and conclusions): and *The Clorox Co. v. Chemical Bank,* 40 USPQ2d 1098, 1102 (TTAB 1996) (question of legal effect of assigning ITU application is one of law). *See also*, 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, 1298-99 (Fed. Cir. 1991) (factual question of intent [regarding misuse of registration symbol] is particularly unsuited to disposition on summary judgment) and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (question of intent [regarding filing of ITU application] generally unsuitable for disposal by summary judgment).

[334] *See, for example*, *Copelands' Enterprises Inc. v. CNV Inc., supra* (moving party's conclusory statement as to intent insufficient) and *Corporate Document Services Inc. v. I.C.E.D. Management Inc*., 48 USPQ 1477 (TTAB 1998).

hearing. 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."[335]

If the moving party meets its burden, that is, if the moving party has supported its motion with affidavits or other evidence which if unopposed would establish its right to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial.[336] A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party.[337]

In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine issues of material fact to be tried.[338] The non-moving 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 non-moving party.[339]

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[335] *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) (no requirement that moving party support its motion with affidavits or other similar materials negating the opponent's claim but may be based on nonmovant's failure to make sufficient showing as to its own case on which it has burden of proof) and *Anderson v. Liberty Lobby, Inc*., 477 U.S. 242 (1986). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991); *Kellogg Co. v. Pack'Em Enterprises Inc.,* 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991); *Avia Group International Inc. v. L.A. Gear California Inc.,* 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); and *Sweats Fashions Inc. v. Pannill Knitting Co.,* 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

[336] Fed. R. Civ. P. 56(e); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (non-moving party's response was not supported by contradictory facts, but merely expressed disagreement with facts); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, *supra* at 1797 ("mere conclusory statements and denials do not take on dignity by placing them in affidavit form.").

[337] *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (not required to present entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute); *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.,* 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987) (dispute is genuine "only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant"); and *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc*., 60 USPQ2d 1733, 1735 (TTAB 2001).

[338] *See Dyneer Corp. v. Automotive Products plc,* 37 USPQ 1251, 1254 (TTAB 1995) and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

[339] *See Lloyd's Food Products Inc. v. Eli's Inc.,* 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (impermissible inferences against nonmovant); *Opryland USA Inc. v. The Great American Music Show Inc.*, *supra* at 1472; *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992) (impermissible inferences in favor of movant); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) (reasonable inferences as to intent could have been drawn in nonmovant's favor); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc*., 41 USPQ2d 1030, 1034 (TTAB 1996) (Board accepted nonmovant's

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings."[340] However, a dispute over a fact that would not alter the Board's decision on the legal issue will not prevent entry of summary judgment.[341] Further, even a genuine dispute over a fact relating only to an issue which is not the subject of the summary judgment motion will not preclude determination of the motion.[342]

Where both parties have moved for summary judgment, the mere fact that they have done so does not necessarily mean that there are no genuine issues of material fact, or authorize the resolution of such issues, or dictate that judgment should be entered in favor of one of them.[343] Summary judgment cannot be granted on an unpleaded issue or defended on an unpleaded claim or defense.[344]

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 that are in dispute.[345]

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version of the facts for purposes of deciding motion); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (on opposer's motion for summary judgment applicant's evidence of statement of use filed in connection with another of its applications covering many of same goods as in opposed application created inference of bona fide intent to use present mark despite absence of any documents regarding its intent to use present mark).

[340] *Opryland USA Inc. v. The Great American Music Show Inc., supra* at 1472. *See also Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1879 (TTAB 1998) (fact is material when its resolution would affect the outcome of the case).

[341] *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result). *See also Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1879 (TTAB 1998) and *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

[342] *See United States Olympic Committee v. O-M Bread Inc.*, 29 USPQ2d 1555 (TTAB 1993) (genuine issues of fact as to grounds which were asserted in opposition but were not grounds for summary judgment were irrelevant).

[343] *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

[344] *See* TBMP § 528.07 (Unpleaded Issue).

[345] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

If the Board concludes that there is no genuine issue of material fact, but that the nonmoving party is the one entitled to judgment as a matter of law, the Board may enter summary judgment sua sponte in favor of the nonmoving party.[346]

Briefs in support of a motion for summary judgment and briefs in response are limited to 25 pages, and a reply brief shall not exceed 10 pages in length. Exhibits submitted in support of or in opposition to the motion are not deemed to be part of the brief for purposes of determining the length of the brief.[347] 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 may not be filed until notification of the proceeding has been sent to the parties by the Trademark Trial and Appeal Board. A motion for summary judgment, if filed, should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the 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 may not be filed until after the Board notifies the parties of the institution of the proceeding.[348]

Moreover, the motion for summary judgment should be filed before the opening of the first testimony period, as originally set or as reset. The motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law.[349] In inter partes proceedings before the Board, trial commences with the opening of the first testimony period.[350] Therefore, a motion for summary judgment 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.[351] If testimony

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[346] *See Clorox Co. v. Chemical Bank,* 40 USPQ2d 1098, 1104 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor).

[347] 37 CFR § 2.127(a).

[348] *See* 37 CFR 2.127(e)(1). *See also* TBMP § 310.01 (Notification of Proceeding).

[349] *See* TBMP § 528.01 (General Nature of Motion [for Summary Judgment]) and authorities cited therein.

[350] *See* TBMP §§ 504.01 (Time for Filing [Judgment on the Pleadings]) and 701 (Time of Trial).

[351] *See* 37 CFR § 2.127(e)(1); *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) (motion filed three days before testimony period opened was not untimely despite respondent's claim that it would have conducted additional discovery if it had known petitioner was planning to file motion rather than go to trial); *Stephanus Freiherr Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB

periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion for summary judgment filed before such testimony period commences is timely. Once the first testimony period commences, however, any summary judgment motion filed thereafter is untimely, even if technically filed prior to 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.[352] The Board will generally not consider a motion for summary judgment filed after the first testimony period commences unless **(1)** it involves a matter of res judicata (claim preclusion) or collateral estoppel (issue preclusion), **(2)** was submitted by agreement of the parties (prior to the taking of any testimony), or **(3)** was not opposed by the nonmoving party (at least on the basis of its untimeliness).[353]

When a motion for summary judgment is filed a brief in response or a motion under 56(f) of the Federal Rules of Civil Procedure shall be filed within 30 days from the date of service of the motion. A reply brief, if any, shall be filed within 15 days from the service date of the brief in response.[354] The time for filing a responsive brief may be extend, but the time for filing, in lieu thereof, a motion under Rule 56(f) will not be extended.[355]

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 except as otherwise specified in the Board's suspension*

1986) (motion filed after trial period opens does not serve purpose of eliminating need for trial); and *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985) (motion filed after close of applicant's testimony period untimely).

[352] *See La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976) (motion filed before reset testimony period opened, but after previous testimony period opened was untimely; petition to Commissioner to reverse Board action denied); 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).

[353] *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1498 n.2 (TTAB 1986) (untimely cross-motions decided where parties acknowledged that both were untimely but wanted a ruling thereon); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), *aff'd, Vesper Corp. v. Lukens Inc.,* 831 F.2d 306 (Fed. Cir. 1987) (untimely motion decided where non-moving party did not object to timeliness and responded on merits and moreover, motion was based on collateral estoppel); and *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (untimely motion decided where no objection to timeliness was raised and delay was relatively insignificant).

[354] 37 CFR § 2.127(e)(1).

[355] *See* TBMP § 528.06 (Request for Discovery to Respond to Summary Judgment).

order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

When a party files a timely motion for summary judgment, the Board will suspend proceedings in the case with respect to all matters not germane to the motion[356] (if the motion was untimely filed, the Board, in its discretion, may issue an immediate action denying the motion for that reason). 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.[357] However, on a case-by-case basis, the Board may find that the filing of a motion for summary judgment provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests.[358]

Once the Board has suspended proceedings in a case pending the determination of a motion for summary judgment, no party should file any paper that is not germane to the motion.[359] 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 Fed. R. Civ. P. 56(f) for discovery needed 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.[360]

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[356] *See* 37 CFR §§ 2.127(d) and (e)(1) and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986) (motion to compel deferred pending ruling on summary judgment motion).

[357] *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, *supra* at 965 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, 637 n.8 (TTAB 1984) (filing of motion for entry of default judgment for failure to answer does not automatically suspend proceedings).

[358] *Cf. Leeds Technologies Limited v. Topaz Communications Ltd.,* 65 USPQ2d 1303 (TTAB 2002) (regarding suspension in the case of a motion for judgment on the pleadings); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (regarding suspension in the case of a motion for sanctions in the nature of judgment); and *Giant Food, Inc. v. Standard Terry Mills, Inc., supra* at 965-66 (pendency of applicant's summary judgment motion did not under the circumstances constitute good cause for not responding to outstanding discovery requests).

[359] *See* 37 CFR § 2.127(d) and*, for example, Corporate Document Services Inc. v. I.C.E.D. Management Inc*., 48 USPQ2d 1477, 1479 (TTAB 1998) (motion for discovery sanctions not considered) and *Pegasus Petroleum Corp. v. Mobil Oil Corp., supra* (motion to suspend for civil action not considered).

[360] *See* TBMP § 528.07 (Unpleaded Issue), and cases cited therein (regarding amendment of pleadings*). See also International Finance Corp. v. Bravo Co.,* 64 USPQ2d 1597, 1603-04 (TTAB 2002) (motion to amend opposition germane inasmuch as it related to the issue of whether applicant's motion is one for complete or partial summary judgment); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.,* 41 USPQ 1030, 1032 (TTAB 1996) (motion to amend pleading to add new claim); *United States Olympic Committee v. O-M Bread Inc*., 26 USPQ2d 1221, 1222 (TTAB 1993) (motion to amend to amplify pleading); and *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment is a proper filing even after proceeding is suspended).

Extensions of time will not be granted for a motion under 56(f) for discovery or for the moving party to file a reply brief. The Board will consider no further papers beyond a reply brief in support of or in opposition to a motion for summary judgment.[361]

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.[362]

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 Fed. R. Civ. P. 56.[363] 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 a reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56.[364] 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.[365]

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[361] 37 CFR § 2.127(e)(1).

[362] *See* 37 CFR § 2.127(d).

[363] *See, for example, Wellcome Foundation Ltd. v. Merck & Co.,* 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (third-party registrations submitted, but excluded). *See also* TBMP §§ 503.04 (regarding motions to dismiss for failure to state a claim) and 504.03 (regarding motions for judgment on the pleadings).

[364] *See, for example, Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc., supra at* 1031 (12(b)(6) motion treated in its entirety as one for summary judgment). *See also* TBMP §§ 503.04 (Matters Outside the Pleading for Motion to Dismiss) and 504.03 (Matters Outside the Pleadings for Judgment on Pleadings) and authorities cited therein.

[365] *See* TBMP §§ 503.04 and 504.03; *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (motion under 12(b)(6) and/or for summary judgment treated as a motion for summary judgment where both parties submitted evidentiary materials outside pleadings); and *Parker Brothers v. Tuxedo Monopoly, Inc.*, 225 USPQ 1222 (TTAB 1984) (motion to dismiss treated as one for summary judgment where matters outside the pleadings submitted and cross-motion for summary judgment filed in response).

Cf. Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) (Board improperly treated motion to dismiss as a motion for summary judgment by rendering a decision on the merits without giving plaintiff notice it would treat the motion as such).

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.[366]

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."[367]

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 as provided in 37 CFR § 2.122(b) and a copy of any registration pleaded and made of record by the plaintiff with its complaint, in the manner prescribed in 37 CFR § 2.122(d)(1). In addition, a party may make of record, for purposes of summary judgment, copies of other registrations; 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.[368] A party need not submit these materials under a notice of reliance in order to make them of record for purposes of a summary judgment motion. Rather, the materials may be submitted as attachments or exhibits to a party's brief on the motion.[369]

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

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[366] *See S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987) (motion for summary judgment was unsupported and whether movant was entitled to judgment as a matter of law could not be determined on pleadings alone); and Wright, Miller & Kane, *Federal Practice and Procedure*: Civil 3d § 2722 (1998). *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.

[367] *See* Fed. R. Civ. P. 56(c). *See also* Fed. R. Civ. P. 56(e).

[368] *See* 37 CFR §§ 2.122(b), 2.122(d)(2), 2.122(e), 2.122(f), and 2.127(e)(2). *See also Raccioppi v. Apogee Inc.*, 47 USPQ 1368, 1369-70 (TTAB 1998) (may rely on documents admissible under 2.122(e)).

[369] *Cf.* TBMP § 700 (Trial Procedure and Introduction of Evidence).

registration which is the subject matter of the proceeding; and any registration pleaded and made of record by the plaintiff with its complaint. Any other evidence, which a party wishes to have considered upon summary judgment, must be submitted in connection with the summary judgment motion.[370]

Evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion**.** If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period.[371] However, the parties may stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision.[372] Moreover, the parties may, if they so desire, stipulate that the summary judgment motion and evidence be treated as the final record and briefs in the case.[373]

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

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 **(l)** are made on personal knowledge; **(2)** set forth such facts as would be admissible in evidence; and **(3)** show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits are

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[370] *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

[371] *See Hard Rock Café Licensing Corp. v. Elsea,* 48 USPQ2d 1400, 1404 (TTAB 1998)*; Levi Strauss & Co. v. R. Josephs Sportswear Inc*., 28 USPQ2d 1464 (TTAB 1993) (declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during applicant's testimony period); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983) (affidavit offered with response to motion for summary judgment became part of trial record when witness identified it during testimony deposition and adverse counsel cross-examined witness about statements in the affidavit); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981) (material in support of untimely summary judgment motion not trial evidence absent agreement of parties). *See also 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).

[372] *See, for example, Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1662 n.2 (TTAB 1998) (where parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial).

[373] *See*, *for example*, *Arleen Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002) and *Miller Brewing Company v. Coy International Corporation*, 230 USPQ 675, 676 (TTAB 1986).

self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. However, an adverse party may have an opportunity for direct examination of the affiant, if a Fed. R. Civ. P. 56(f) motion to take the discovery deposition of the affiant is made and granted - *see* TBMP § 528.06.[374]

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.[375]

Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit.[376] An affidavit that is not supported by documentary evidence may nevertheless be given consideration if the statements contained in the affidavit are clear and convincing in character, and uncontradicted.[377]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20.[378]

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[374] *See* Fed. R. Civ. P. 56(e). *See also* Fed. R. Civ. P. 56(c); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (moving party's affidavit and other evidence were uncontradicted by nonmoving party); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477 (TTAB 1998) (use of standard language in declaration did not raise genuine issue as to personal knowledge); *C & G Corp. v. Baron Homes, Inc.*, 183 USPQ 60 (TTAB 1974) (affidavit is competent evidence); *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93, 94 (TTAB 1972) (affidavit was not made on personal knowledge and there was no foundation for statements made therein); and *4U Company of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251 (TTAB 1972) (issue of credibility raised as to one affiant but statements by another affiant were competent and uncontradicted and suspicion alone is insufficient to invalidate).

[375] *See* Fed. R. Civ. P. 56(e), and *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993) (additional affidavit submitted with reply brief considered).

[376] *See Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1030 n.9 (TTAB 1988) (documents were related to information given in affidavit, but were not specifically identified therein).

[377] *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001) (opposer's declaration, while not accompanied by any documentary evidence, was internally consistent, not characterized by uncertainty and unchallenged by applicant); *4U Company of America, Inc. v. Naas Foods, Inc., supra* at 253 (fact that allegations in affidavit not supported by invoice does not undermine the testimony when uncontradicted).

Cf., for example, with respect to testimony depositions, Liqwacon Corp. v. Browning-Ferris Industries, Inc., 203 USPQ 305, 307 n.1 (TTAB 1979); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976); *Clubman's Club Corp. v. Martin*, 188 USPQ 455, 458 (TTAB 1975); and *Rite Aid Corp. v. Rite-Way Discount Corp.*, 182 USPQ 698, 702 n.5 (TTAB 1974), *aff'd*, 508 F.2d 828, 184 USPQ 351 (CCPA 1975).

[378] *See* 37 CFR § 2.20, and *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (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 §§ 704.09-704.11.

528.05(d) Registrations

37 CFR § 2.122(d)(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) 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.[379] 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.[380]

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[379] *See Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 n.3 (TTAB 1986). *Cf.* 37 CFR § 2.122(d)(2).

[380] *See Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977) (third-party registrations may be plain copies). *See also* 37 CFR § 2.122(e) and *Raccioppi v. Apogee Inc., supra* at 1370 (incomplete TRAM records of third-party registrations not sufficient).

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.[381]

528.05(e) Printed Publications and Official Records

Printed publications, as described in 37 CFR § 2.122(e), include such materials as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding.[382] The term "official records," as used in 37 CFR § 2.122(e), refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer.[383]

Materials which qualify as printed publications or official records under 37 CFR § 2.122(e) are considered essentially self-authenticating, that is, the nonoffering party is readily able to verify the authenticity of the proffered materials.[384] As such, these materials may be relied on for purposes of summary judgment without further evidence of authenticity.[385] A party may introduce evidence of this nature in connection with a summary judgment motion, if the evidence is competent and relevant, by: specifying the official record or printed publication (including, with respect to the printed publication, information sufficient to identify the source and date of the publication) and the pages to be read; indicating generally the relevance of the material being offered; and including a copy of the proffered material with the party's brief.[386]

The material need not be submitted under a notice of reliance or in connection with the affidavit or declaration of a witness, and may simply be submitted as an attachment or exhibit to a party's supporting brief.

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[381] *See, e.g., Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

[382] *See* 37 CFR § 2.122(e) and TBMP § 704.08 (Printed Publications).

[383] *See* TBMP § 704.07 (Official Records).

[384] *See Racciopppi v. Apogee Inc*., 47 USPQ2d 1368, 1370 (TTAB 1998) and *Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

[385] *See* 37 CFR § 2.122(e) *and Racciopppi v. Apogee Inc., supra* at 1369.

[386] *Cf. Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source).

Internet evidence and other materials that are not self-authenticating. The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet.[387] Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not "subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered."[388] For this reason, Internet printouts cannot be considered the equivalent of printouts from, for example, a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified.[389]

Materials which do not fall within 37 CFR § 2.122(e), that is, materials which are not self-authenticating in nature, may nonetheless be admissible as evidence in connection with a summary judgment motion, if competent and relevant, provided they are properly authenticated by an affidavit or declaration pursuant to Fed. R. Civ. P. 56(e).[390] Such materials, including printouts of articles or information obtained from the Internet may, on summary judgment, be introduced by the affidavit or declaration of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials.[391]

For further information concerning official records and printed publications, including the probative value of such evidence, see TBMP § 704.08.[392]

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[387] *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

[388] *Weyerhaeuser v. Katz*, *supra* at 1232 (TTAB 1992) *citing Glamorene Products Corporation v. Earl Grissmer Company, Inc.*, 203 USPQ 1091, 1092 n.5 (TTAB 1979). *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *Cf. Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1134 (TTAB 2000) (introduction of telephone listings retrieved from Internet was improper); and *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (printout of page of website is not proper subject matter for a notice of reliance).

[389] *See Raccioppi v. Apogee Inc.*, *supra* at 1370. *See also In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (examining attorney's request for judicial notice of on-line dictionary definitions denied because the definitions were not available in printed format).

[390] *See* TBMP § 528.05(b) (Affidavits and Accompanying Exhibits).

[391] *See, e.g., Raccioppi v. Apogee Inc.*, *supra* at 1369.

[392] *See also Raccioppi v. Apogee Inc., supra at* 1371 for a discussion of the probative weight given evidence obtained from the Internet.

528.05(f) Testimony from Another Proceeding

37 CFR § 2.122(f) Testimony from other proceedings. *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

Upon motion granted by the Board, testimony taken in another proceeding, or in a suit or action in a court, between the same parties or their privies, may be used in connection with a summary judgment motion in a pending Board proceeding, to the extent that the testimony is relevant and material. The use of such testimony, however, is subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony."[393] Any motion made to enter testimony from another proceeding should be accompanied by a copy of the testimony sought to be entered in the record together with clear arguments as to its relevance and materiality. Relevance and materiality frequently hinge upon the marks and goods or services involved in the two proceedings.[394]

When the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken upon recall of the same witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion for summary judgment; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, upon motion granted by the Board, during the appropriate trial period.[395]

528.06 Request for Discovery to Respond to Summary Judgment

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present by affidavit facts essential to justify its opposition to the motion.[396]

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[393] 37 CFR § 2.122(f).

[394] *See* TBMP § 530 (Motion to Use Testimony from Another Proceeding).

[395] *See* TBMP § 528.05(a) (Summary Judgment Evidence – In General).

[396] *See* Fed. R. Civ. P. 56(f); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992) (finding sufficient need for additional discovery); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (unfocused requests for discovery; 56(f) makes no

It is not sufficient that a nonmoving party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(f) 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.[397] If a party has demonstrated a need for discovery which is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment.[398] The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable party to respond to the motion for summary judgment.[399]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20.[400]

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distinction between whether no discovery has been taken or whether additional discovery is needed); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988) (complaint that summary judgment was granted before it could take discovery unavailing where party failed to seek 56(f) protection); *Spectra Corp. v. Lutz*, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988) (discovery properly denied where plaintiff had conducted 11 months of discovery and was allowed to continue taking discovery pending decision on defendant's motion for summary judgment and failed to file 56(f) affidavit); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion in brief of need for discovery insufficient). *See also Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 n.13 (TTAB 1998) (assertion in response to summary judgment motion that opposers intend to conduct further discovery was not proper request for 56(f) discovery); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (56(f) denied where applicant also filed a response to the summary judgment motion on the merits); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989) (56(f) declaration sufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989) (mere unsupported assertion of desire to take deposition inadequate); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990). *See also Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) (failure to file 56(f) motion creates presumption party did not consider such discovery essential).

[397] *See Dyneer Corp. v. Automotive Products PLC, supra at* 1253 (56(f) denied where applicant failed to show need for discovery as to specific issues, not merely a showing that it deferred taking discovery it otherwise would have taken had it known a motion for summary judgment would be filed*). See also cases cited in previous note.*

[398] *See Orion Group Inc. v. Orion Insurance Co. P.L.C.,* 12 USPQ2d 1923 (TTAB 1989).

[399] *See Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (unfocused requests for discovery are insufficient); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (mere assertion that discovery is necessary is insufficient); *Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990) (affidavit stating that, during discovery party will seek to elicit information on likelihood of confusion insufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989) (56(f) motion, to the extent it could be construed as such, was not supported by required affidavit); and *J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697 (TTAB 1986) (statement by applicant of need to take discovery on validity of assignment was unsupported speculation).

[400] *See* 37 CFR § 2.20. *Cf. Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

When a request for discovery under Fed. R. Civ. P. 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.[401]

A request for Fed. R. Civ. P. 56(f) discovery, if filed, must be filed within 30 days of the date of service of the summary judgment motion.[402] No extensions of time will be granted to file a motion under Rule 56(f). The affidavit in support of the request may be signed either by the requesting party or by its counsel, as appropriate.[403]

A request for 56(f) discovery should be clearly made, and certainly not buried somewhere in a responsive brief or other paper, and should not be filed as a "throw away" alternative accompanying a response to the motion for summary judgment on the merits.[404] Moreover, if a party's request for discovery under Fed. R. Civ. P. 56(f) is granted by the Board, and the party thereafter files a response to the summary judgment without taking the requested discovery, the filing of the Rule 56(f) motion may be viewed as sanctionable conduct under Fed. R.. Civ. P. 11.[405]

For further information concerning requests for discovery under Fed. R. Civ. P. 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).

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[401] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

[402] 37 CFR § 2.127(e)(1).

[403] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, *supra*.

[404] *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, supra* at 416. *See also Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002) (56(f) motion denied where opposer filed a response to the motion for summary judgment on the merits).

[405] *See ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021 (TTAB 1998) (order to show cause issued where, although 56(f) motion was granted, party responded to summary judgment without taking the requested discovery).

528.07 Unpleaded Issue

528.07(a) Not Basis for Entering or Avoiding Summary Judgment

A party may not obtain summary judgment on an issue that has not been pleaded.[406] Moreover, at the summary judgment stage of a proceeding before the Board, there has not yet been a trial of any issue, whether pleaded or unpleaded, and therefore the requirements of Fed. R. Civ. P. 15(b) for an amendment to conform the pleadings to the evidence cannot have been met.[407]

However, a party that seeks summary judgment on an unpleaded issue may move to amend its pleading to assert the matter.[408] Alternatively, if the parties, in briefing 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.[409]

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[406] *See* Fed. R. Civ. P. 56(a) and 56(b); *S. Industries Inc. v. Lamb-Weston Inc*., 45 USPQ2d 1293, 1297 (TTAB 1997); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 n.8 (TTAB 1991); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 628 (TTAB 1986); and *Consolidated Foods Corp. v. Berkshire Handkerchief Co. Inc.*, 229 USPQ 619, 621 (TTAB 1986).

[407] *See, e.g., Vaughn Russell Candy Co. v. Cookies in Bloom Inc.,* 47 USPQ2d 1635, 1635 (TTAB 1998) (attempt to amend pleadings under 15(b) denied since there had not yet been a trial, but allowed time to move to amend under 15(a))**.**

[408] *See Vaughn Russell Candy Co. v. Cookies in Bloom Inc., supra* at 1635 (allowed time to file motion to amend pleading to add new grounds and to renew summary judgment motion); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, *supra* (motion to amend, filed after summary judgment on unpleaded issue had been denied, was granted); and *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 n.4 (TTAB 1989) (motion to amend to add new ground, filed simultaneously with motion for summary judgment, granted and allegations in new ground deemed denied).

[409] *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 81 n.3 (TTAB 1984) (pleading deemed amended where nonmoving party did not object to motion on unpleaded claim and treated it on its merits). *Compare Greenhouse Systems Inc. v. Carson,* 37 USPQ2d 1748, 1750 n.5 (TTAB 1995) (not permitted where nonmoving party objected to inclusion of unpleaded grounds even though party responded to motion on unpleaded grounds on merits).
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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.[410]

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.[411] 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.[412]

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).[413]

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[410] *Cf. Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) (may not assert unpleaded Morehouse defense), and *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.2 (TTAB 1992) (no consideration given to three unpleaded grounds asserted by opposer in response to applicant's motion for summary judgment).

[411] *See United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993).

[412] *Cf.* TBMP § 528.07(a) (Unpleaded Issue – Not Basis for Entering or Avoiding Summary Judgment) and authorities cited therein.

[413] *See, for example, Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1446 (TTAB 1996) (nonmovant entitled to summary judgment where question was one of law); *The Clorox Company v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986) (granted to nonmovant as to its standing); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (granted to nonmovant applicant because application elements allegedly missing from application were not required by Paris Convention); and *Visa International Service Assn v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983) (nonmovant entitled to judgment as a matter of law on issues of abandonment, non-use and fraud).

529 Motion to Offer Discovery Deposition of Self or Nonparty

37 CFR § 2.120(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.

(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 Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 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.[414]

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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[414] *See* 37 CFR § 2.120(j)(2), and TBMP § 704.09 (Discovery Depositions) and authorities cited therein. *Cf.* 37 CFR § 2.120(j)(4) (fairness exception provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce any other part of the deposition which should be considered so as to make not misleading what was offered by the submitting party).

(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.[415]

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.[416]

530 Motion to Use Testimony From Another Proceeding

37 CFR § 2.122(f) Testimony from other proceedings. *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

The use, in an inter partes proceeding before the Board, of testimony taken in another Board proceeding, or testimony taken in a suit or action in a court, is governed by 37 CFR § 2.122(f).[417]

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.[418] The Board prefers that a

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[415] *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (opposer established that one third-party witness was out of the country during its testimony period but failed to establish that another witness was either a "party" as contemplated by Trademark Rule 2.120(j)(1), at the time of deposition or the existence of exceptional circumstances).

Cf. Maytag Co. v. Luskin's, Inc., 228 USPQ 747 n.4 (TTAB 1986) (deposition of opposer's nonparty witness taken by opposer during discovery treated as testimony deposition taken by stipulation of the parties prior to trial); and *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (discovery deposition of nonparty treated as stipulated in the record where applicant had not objected to opposer's notice of reliance upon the deposition).

[416] *See* 37 CFR § 2.120(j)(2).

[417] *Cf.* TBMP § 704.11 (Produced Documents) and authorities cited therein.

[418] *See* TBMP §§ 528.05(f) (Testimony from Another Proceeding) and 704.11 (Produced Documents) and authorities cited therein.

motion for leave to use testimony from another proceeding as evidence on the case be filed during the testimony period of the moving party.[419] 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.[420]

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.[421]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony,[422] or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

531 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, 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*

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[419] *Cf.* 37 CFR § 2.120(j)(2).

[420] *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to admit testimony from prior opposition filed during discovery period).

[421] *See* 37 CFR § 2.119(a), and *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, supra.*

[422] *See Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172 (*cf.,* Allen, *dissenting,* 177, 182 n.15) (TTAB 1986) (wherein dissent contended that discovery deposition should have been admitted as admission against interest).

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.[423]

The determination of whether good cause exists for a motion that a testimonial deposition upon written questions instead is taken by oral examination, is made by the Board on a case-by-case basis, depending upon the particular facts and circumstances in each case.[424]

532 Motion to Strike Notice of Reliance

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. *For a discussion of the introduction of evidence see* TBMP § 700. Trademark 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 Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR § 2.122(e). Trademark 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. Trademark Rule 2.122(e), 37 CFR § 2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records.[425]

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[423] *See* 37 CFR § 2.123(a)(1).

[424] *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990) (unjust to deprive applicant of oral cross-examination opposer's expert rebuttal witness present in U.S.), *corrected*, 19 USPQ2d 1479 (TTAB 1990) and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980) (proposed deposition on written questions of petitioner's employees during rebuttal period would deprive applicant of cross-examination and confronting witness). *See also* Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253, at 254 (1980). *Cf. Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989) (good cause to take oral discovery deposition of witness in England) and TBMP § 520 (Motion to Take Foreign Deposition Orally).

[425] *See also* TBMP §§ 704.03(b) (Not Subject of Proceeding – In General), and 704.07-704.11.

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted thereunder), in its entirety, as untimely.[426]

An adverse party may also move to strike a notice of reliance, in whole or in part, on the ground that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted. For example, a party may move to strike a Rule 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,[427]or that the proffered materials are not appropriate for introduction by notice of reliance.[428] If, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party which filed the notice of reliance time within which to cure the defect, failing which the notice will stand stricken.[429]

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.[430]

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 authorities cited therein. Thus, if a motion to strike cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), but instead would require a review of testimony or other evidence, determination of the motion will be deferred by the Board until final hearing.[431]

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[426] *See* TBMP § 707.02(c), and cases cited therein.

[427] *See* TBMP § 707.02(b)(2), and cases cited therein.

[428] *See* TBMP § 707.02(b)(2) (regarding objections to notices of reliance on procedural grounds) *and, for example, Boyds Collection Ltd. v. Herrington & Co*., 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance).

[429] *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990) (allowed 20 days to correct deficiencies) and *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (where registrant was given leave to amend notice of reliance to correct deficiencies but failed to do so, documents remained stricken).

[430] *See* TBMP § 707.02(c) and authorities cited therein.

[431] *See M-Tek Inc. v. CVP Systems Inc.*, *supra* (questions of admissibility of documents based on hearsay and lack of authentication deferred).

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 objections thereto in its evaluation of the probative value of the evidence at final hearing.[432]

533 Motion to Strike Trial Testimony Deposition

533.01 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.[433]

When there is no such approved stipulation, granted motion, or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety, as untimely.[434] Alternatively, the adverse party may raise this ground for objection in its brief on the case.[435]

533.02 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*

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[432] *See* TBMP § 707.02(c) (Objections to Notice of Reliance on Substantive Grounds) and cases cited therein.

[433] *See* 37 CFR § 2.121(a) and TBMP § 701 (Time of Trial).

[434] *See* 37 CFR §§ 2.121(a) and 2.123(l); *Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998); and *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990) (motion to strike testimony for insufficient notice construed as motion to strike testimony taken out of time).

[435] *See* TBMP § 707.03(b)(1) (Objections to Trial Testimony Depositions On Ground of Untimeliness) and authorities cited therein. *But see Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991) (where applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of testimony deposition two days prior to opening of testimony period could have been corrected upon seasonable objection).

witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. ...

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.[436]

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances.[437]

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[436] *See* 37 CFR § 2.123(e)(3); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1704 (TTAB 1990) (one day notice not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986) (substitute witness not identified but adverse party failed, after deposition, to move to strike); *Home Juice Co. v. Runglin Companies Inc.*, 231 USPQ 897, 898 n.4 (TTAB 1986) (motion to strike filed four months after testimony taken was untimely); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (where applicant attended deposition and objected to its consideration on ground that it was taken on two-days notice, Board found that notice, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

See also, for example, Duke University v. Haggar Clothing Co., 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Assn v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable and opposing counsel's failure to appear was excused); and *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date).

[437] *See* 37 CFR § 2.123(e)(3).

533.03 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.[438]

534 Motion for Judgment for Plaintiff's Failure to Prove Case

534.01 In General

37 CFR § 2.132 Involuntary dismissal for failure to take testimony.
(a) *If the time for taking testimony by any party in the position of plaintiff has expired and 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 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.*

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[438] *See* TBMP § 707.03(c) (Objections to Trial Testimony Depositions on Other Grounds).

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 the Board entertain such a motion.[439]

534.02 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.[440] 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.[441]

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 respond and show cause why judgment should not be rendered against it. In the absence of a showing of good and sufficient cause, judgment may be rendered against the plaintiff.[442]

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[439] *See* TBMP § 534.04 (Motion Under Fed. R. Civ. P. 41(b) or 50(a) Not Available).

[440] *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); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.,* 61 USPQ2d 1542, 1544 (TTAB 2001) (motion to extend testimony period denied; motion to dismiss granted); *SFW Licensing Corp. v. Di Pardo Packing Ltd*., 60 USPQ2d 1372, 1374 (TTAB 2001) (same); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) (motion to extend testimony period granted, motion to dismiss denied); *Atlanta Fulton County Zoo Inc. v. De Palma,* 45 USPQ2d 1858 (TTAB 1998) (motion to reopen discovery and testimony periods denied, motion to dismiss granted); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 n.4 (TTAB 1990) (respondent advised that if petitioner continued to show no interest and failed to take testimony, applicant may avail itself of § 2.132(a)); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1845-46 (TTAB 1987) (where opposer failed to offer evidence during its testimony period, applicant could have filed motion to dismiss instead of offering its own evidence); *Loren Cook Co. v. Acme Engineering and Manufacturing Corp.*, 216 USPQ 517 (TTAB 1982) (where evidence was presented by plaintiff, motion for judgment under rule 2.132 was not entertained); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275-276 (1984).

[441] *See* 37 CFR § 2.132(c), and *Hewlett-Packard Co. v. Olympus Corp., supra* and *Atlanta-Fulton County Zoo, supra*.

[442] *See* 37 CFR § 2.132(a). *See also Hewlett-Packard Co. v. Olympus Corp.*, *supra* at 1713 ("While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines") and *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.,* 61 USPQ2d 1860, 1862 (TTAB 2002) (Board is justified in enforcing procedural deadlines).

Cf. Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509, 512 (TTAB 1976) (although no testimony or other evidence was introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing).

The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard that would have to be met by any motion under Fed. R. Civ. P. 6(b) to reopen the plaintiff's testimony period.[443]

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 note below.[444] *For a complete discussion of excusable neglect and the standard to be applied, see* TBMP § 509.01(b) regarding motions to reopen, and cases cited therein.

If a timely motion under 37 CFR § 2.132(a) is denied, testimony periods will be reset for the defendant and for rebuttal.[445]

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[443] *See PolyJohn Enterprises Corp. v. 1-800-Toilets Inc., supra* at 1860-61*; HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998); and *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989) (showing of good and sufficient cause is equivalent of excusable neglect because it requires the reopening of the testimony period to introduce the evidence).

[444] *Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc.*, 65 USPQ2d 1701 (TTAB 2002) (excusable neglect not found where opposer waited four months after close of testimony period to file motion to reopen and where reason for delay was based on, *inter alia*, opposer's asserted failure to receive answer to opposition); *HKG Industries Inc. v. Perma-Pipe Inc., supra* (plaintiff provided no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc., supra* (excusable neglect not found where motion to reopen was filed nearly one month after close of testimony period and was based on mistaken belief that extension of time to respond to discovery extended testimony period and on fact that petitioner was gathering information to respond to discovery); *Jain v. Ramparts*, 49 USPQ2d, 1429, 1431 (TTAB 1998) (pendency of plaintiff's motion to compel and to extend trial dates after ruling on such motion sufficient cause for failure to try case); and *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations insufficient).

See also the following cases [NOTE: These cases were decided prior to *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership,* 507 U.S. 380 (1993) which changed the excusable neglect standard. For a discussion of the effect of this change on the Board's analysis, see TBMP § 509.01(b) regarding motions to reopen.] *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (mere request from adversary for extension of time is not sufficient and plaintiff cannot rely on inaction of defendant to establish that its own neglect was excusable); *Grobet File Co. of America Inc. v. Associated Distributors Inc.,* 12 USPQ2d 1649 (TTAB 1989) (no excusable neglect where plaintiff mistakenly assumed extension of time to respond to discovery would result in extension of discovery period); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982) (opposer's good faith interpretation of parties' long-standing agreement to cooperate in extending or resetting dates constituted excusable neglect).

Cf. 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); and *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).

For additional cases, with summaries, see Appendix of Cases.

[445] *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.[446] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory.[447] 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, plaintiff cannot prevail and, thus, defendant need not offer evidence either.[448]

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).[449]

534.03 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.[450] A motion for judgment under 37 CFR § 2.132(b) must be filed before the opening of the moving party's testimony period. [451]

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.[452]

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[446] *See Litton Business Systems, Inc. v. J. G. Furniture Co. Inc.*, 190 USPQ 431 (TTAB 1976).

[447] *See Pfaltzgraf v. William Davies Co. Inc.*, 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).

[448] *See, for example*, *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1645-46 (TTAB 1987) (opposition dismissed where applicant filed evidence instead of a motion to dismiss and opposer filed improper rebuttal) and *Pfaltzgraf v. William Davies Co.*, *supra*.

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

[450] *See* 37 CFR § 2.132(b).

[451] *See* 37 CFR § 2.132(c).

[452] *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.[453]

If a timely motion under 37 CFR § 2.132(b) is denied, testimony periods will be reset for the defendant and for rebuttal.[454]

The purpose of the motion under 37 CFR § 2.132(b) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff, during its testimony period, has offered no evidence other than copies of USPTO records, and those records do not make out a prima facie case.[455] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory.[456]

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).[457]

534.04 Motion Under Fed. R. Civ. P. 41(b) or Fed. R. Civ. P. 50(a) Not Available

Trial testimony, in Board inter partes proceedings, is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence, prior to its final deliberations in the proceeding.[458]

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[453] *See* 37 CFR § 2.132(b). *See also Merker Counter Co., Inc. v. Central Counter Co.*, 310 F.2d 746, 135 USPQ 433 (CCPA 1962) (declined to render judgment); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (judgment entered where marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); and *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313 (TTAB 1976) (motion granted as conceded but even if denied, petition to cancel would have been dismissed on the merits).

Cf. Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509, 512 (TTAB 1976) (where 2.132(a) motion was filed, although no testimony or other evidence had been introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing).

[454] *See* 37 CFR § 2.132(b).

[455] *See, for example*, *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., supra* (2.132(b) requires decision on merits of the case); and *Litton Business Systems, Inc. v. J. G. Furniture Co., Inc.*, 190 USPQ 431, 434 (TTAB 1976) (Board will not use judicial notice to remedy plaintiff's failure to present adequate evidence).

[456] *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).

[457] *See Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., supra.*

[458] *See* TBMP § 502.01 (Available Motions) 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).[459] The motion under Fed. R. Civ. P. 41(b) for involuntary dismissal, and the motion under Fed. R. Civ. P. 50(a) for a directed verdict, are not available in Board proceedings.[460]

535 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 § 8 of the Act of 1946 or has failed to renew his involved registration under § 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.*

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, 15 U.S.C. § 1058 or 1059, 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.

The purpose of 37 CFR § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding and avoid judgment by deliberately failing to file a required affidavit of use under § 8 or renewal application under § 9.[461]

In those cases where the Board finds that respondent has not acted deliberately to avoid judgment and thereby has shown good and sufficient cause why judgment should not be entered against it under 37 CFR § 2.134(b), petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. In those cases where the Board enters judgment against the

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[459] *See* TBMP §§ 534.02 (Motion for Judgment Under Rule 2.132(a)) and 534.03 (Motion for Judgment under Rule 2.132(b)).

[460] *See* TBMP § 502.01 (Available Motions) and authorities cited therein.

[461] *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (failure to file Section 8 occurred prior to commencement of proceeding and therefore not to avoid judgment).

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. [462]

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

536 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.[463] 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. If the plaintiff files no response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff.[464]

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

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[462] *See* TBMP § 602.02(b) (Cancellation Under Section 8; Expiration Under Section 9) and cases cited therein.

[463] *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).

[464] *See, for example, CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2D 1300, 1302 (TTAB 1999) (no response filed).

When it finds that a 37 CFR § 2.128(a)(3) order to show cause has been discharged, the Board may 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 Fed. R. Civ. P. 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.[465]

537 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. ...*

Motions for leave to file a brief on the case in excess of the page limit are disfavored by the Board and rarely granted. Because the Board is an administrative tribunal of limited jurisdiction, empowered to determine only the right to register, very few of the cases before it are of such a nature as to require a brief on the case which exceeds the 37 CFR § 2.128(b) page limit. Further, one of the primary purposes of the rule is to assist the Board in managing its workload, and to encourage litigants to focus their arguments and eliminate needless verbiage.[466] Thus, a party seeking leave to file a brief on the case with more than the allowed number of pages must obtain "prior leave" from the Board to do so.[467] The motion must be submitted on or before the date that the brief is due.[468] This is so even in those cases where the motion is filed with the consent of the adverse party or parties. Trademark Rule 2.128(b) is for the benefit of the Board, and it is only with the Board's permission, timely sought, that a brief exceeding the page limit be entertained.

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[465] *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (show cause order discharged but plaintiff failed to show excusable neglect to reopen case).

[466] *Cf. Fleming v. County of Kane*, 855 F.2d 496 (7th Cir. 1988).

[467] *See* 37 CFR § 2.128(b) and, *for example, Boswell v. Mavety Media Group Ltd.,* 52 USPQ2d 1600**,** 1604 n.4 (TTAB 1999)**.**

[468] *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994).

The 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 motion. If the moving party refrains from filing its brief with the motion, and the motion is granted, the Board in its decision on the motion will allow time for the filing of the brief and specify the number of additional pages granted. Alternatively, if the motion is denied, the Board, in its decision, will allow time for the filing of a brief that does not exceed the page limit specified in 37 CFR § 2.128(b). On the other hand, if the proposed overlength brief is filed with 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. denied, the overlength brief will be given no consideration as not in compliance with the rules, but the Board will allow time for the filing of a brief which conforms to the relevant page limit of 37 CFR § 2.128(b).[469]

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.[470]

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.[471]

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

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[469] *See United Foods Inc. v. United AirLines Inc.*, *supra* (filing brief with motion is potentially disadvantageous as movant may end up having to redo brief if motion is denied).

[470] *See United Foods Inc. v. United AirLines Inc., supra.*

[471] *See United Foods Inc. v. United Air Lines Inc.*, *supra*, (30-page reply brief unnecessary where main brief was 18 pages and responsive brief was 37 pages); and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987) (due to size of record, parties allowed to file overlength briefs). *Cf.* 37 CFR § 2.129(a), and TBMP § 541.02 regarding motions for additional time for oral argument.

538 Motion for Leave to File Amicus Brief

Amicus briefs are neither provided for nor prohibited in the rules governing practice in Board proceedings. Thus, the Board may, in its discretion, entertain an amicus brief if the Board finds that such a brief is warranted under the circumstances of a particular case.[472]

An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. The motion may be accompanied by the proposed brief. An amicus brief should be filed within the time allowed the party whose position the brief serves to support, unless all parties consent otherwise, or the Board, upon motion for good cause shown, permits a later filing.[473]

A motion for leave to file an amicus brief may not be used as a substitute for a timely notice of opposition or petition for cancellation.

Motions for leave to file an amicus brief are rarely filed in Board proceedings, and the granting thereof by the Board is even rarer. The Board will determine whether the proposed brief will aid the Board in resolving issues of law, whether the moving party is effectively seeking a role in the proceeding beyond arguing questions of law, and is effectively arguing factual matters, and whether any partisan arguments would prejudice defendant.[474]

539 Motion to Strike Brief on Case

The Trademark Rules of Practice specifically provide for the filing of briefs on the case, namely, the main brief of the party in the position of plaintiff, the answering brief of the party in the position of defendant, and the reply brief of the party in the position of plaintiff.[475]

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it believes will be to its advantage. 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

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[472] *See, for example*, *Harjo v. Pro-Football Inc*., 45 USPQ2d 1789, 1791 (TTAB 1998) (leave to file amicus brief denied as unnecessary to resolve issues which have been adequately addressed by parties), and Federal Circuit Rule 29 (governing the filing of amicus briefs in appeals to the Court of Appeals for the Federal Circuit).

[473] *Cf.* Federal Circuit Rule 29.

[474] *See Harjo v. Pro-Football Inc., supra* at 1791 (motion denied where Board, noting "intimate" relationship between movants and petitioners, found that movants were seeking to introduce new evidence and advance partisan arguments).

[475] *See* 37 CFR § 2.128(a). *See also* TBMP § 801.02 (Time for Filing Brief on the Case).

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),[476] it may be stricken, or given no consideration, by the Board.[477] 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).[478]

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.[479] 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.[480]

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[476] *See* TBMP §§ 537 (motions regarding page limitations for final briefs) and 801.03 (regarding form and contents of brief).

[477] *See*, *Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250 (TTAB 1972) (brief filed three weeks late stricken); and *American Optical Corp. v. Atwood Oceanics, Inc.*, 177 USPQ 585 (Comm'r 1973) (brief which was too long and not in proper form was not considered).

[478] *But see* TBMP § 537 (if a party files a brief which exceeds the page limit without also filing a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute brief that meets the limit).

[479] *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.3 (TTAB 1993) (motion to strike portions of opposer's reply brief on the case given no consideration since motion was essentially attempt by applicant to file a reply brief); and *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 863 n.3 (TTAB 1985). *See also Hydrotechnic 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).

[480] *See, for example, Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to brief given no consideration); and *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978) (applicant's exhibits attached to its brief cannot be considered). *See also Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387 (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 F.2d 915, 189 USPQ 693 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973).

540 Motion for Augmented Panel Hearing

Each case before the Board is heard by a panel of at least three members of the Board (i.e., its statutory members, including administrative trademark judges).[481] However, the Board may use an augmented panel to hear a case.[482] 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, 1547 (Fed. Cir. 1994) (Director has authority to constitute a new panel for purposes of reconsideration).

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.[483]

541 Motion to Change Oral Hearing Date; For Additional Time

541.01 Motion to Change Oral Hearing Date

If a party to a proceeding before the Board desires to present oral argument (i.e., oral hearing), at final hearing, 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.[484] When a request for an oral

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[481] *See, for example,* 37 CFR §§ 2.129(a) and 2.142(e)(1). *See also* 15 U.S.C. § 1067.

[482] *See, for example, In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992) (augmented panel used to overrule previous decision barring examining attorneys from requesting reconsideration), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (in view of issues presented, oral hearing held before augmented panel of eight Board members); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986) (augmented five-member panel); and *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services).

[483] *See, for example, In re Johanna Farms Inc., supra; In re McDonald's Corp., supra;* and *In re WSM, Inc., supra*. *See also Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (augmented panel of eight-member because of the importance of the issues). *Cf.* Federal Circuit Rule 35 and *In re Alappat*, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Section 7 grants Director authority to designate the members of a panel and expanded panel). *Cf. also Fioravanti v. Fioravanti Corrado S.R.L,* 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

[484] *See* TBMP § 802 regarding oral hearings.

hearing is filed, the Board sets the date and time for the hearing, and sends each party written notice thereof.[485] Ordinarily, oral hearings are scheduled on Tuesdays, Wednesdays and Thursdays. 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.[486] 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 Chief Administrative Trademark Judge's secretary 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 that wishes to have the hearing reset must file a motion therefor, showing good cause.[487] 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.[488] An unconsented motion to reset an oral hearing should not be filed merely because another date would be more convenient. The process of scheduling an oral hearing is a time-consuming task for the Board. Because of the inherent difficulties in arranging a date for an oral hearing, an unconsented motion to reset the hearing should be filed only for the most compelling reasons. Examples thereof include the onset of serious illness, nonelective surgery, death of a family member and similar unanticipated or unavoidable events.[489]

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[485] *See* 37 CFR § 2.129(a).

[486] *See* 37 CFR § 2.129(b).

[487] *See* Fed. R. Civ. P. 6(b) and TBMP § 509 (Motion to Extend Time; Motion to Reopen Time).

[488] *See* TBMP § 502.06(a) (Telephone Conferences).

[489] *See, e.g., In re Taylor & Francis [Publishers] Inc.,* 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule oral hearing three hours before hearing due to "a sudden conflict of time" denied).

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

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

541.02 Motion for Additional Time for Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. [490] 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.[491] 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.[492]

542 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).

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.

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[490] *See* 37 CFR § 2.129(a), and TBMP § 802.05 (Length of Oral Argument).

[491] *See* 37 CFR § 2.129(a), and *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987) (additional time for arguments allowed in view of voluminous record). *Cf.* 37 CFR § 2.128(b) and TBMP § 537 (Motion for Leave to Exceed Page Limit for Brief on Case).

[492] *Cf.* TBMP § 541.01 (Motion to Change Oral Hearing Date).

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.

543 Motion for Reconsideration of Final Decision

37 CFR § 2.129(c) *Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within 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).[493]

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.[494] 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)).

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.[495]

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,[496] nor should it be devoted simply to a reargument of the points presented in

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[493] *Cf.* 37 CFR § 2.127(b), and TBMP § 518 (Motion for Reconsideration of Decision on Motion).

[494] *See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 410 (TTAB 1979) (serious questions raised by applicant's request for reconsideration ought to have generated response by opposer).

[495] *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 176, 177 n.2 (TTAB 1975) (reply brief considered only to the extent it addressed arguments in responsive brief). *See also* 37 CFR § 2.127(a) and TBMP § 502.02(b) (Briefs on Motions).

[496] *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978) (survey did not qualify as newly discovered evidence).

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.[497]

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.[498]

544 Motion for Relief From Final Judgment

Fed. R. Civ. P. 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 (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 Fed. R. Civ. P. 60(b).[499] Thus, upon such terms as are just, the Board, on motion, may relieve a party from a final judgment for one of the reasons specified in Fed. R. Civ. P. 60(b).

Fed. R. Civ. P. 60(b), as made applicable by 37 CFR § 2.116(a), applies to all final judgments issued by the Board, including default and consent judgments, summary judgments, and judgments entered after trial on the merits. As a practical matter, motions to vacate or set aside a final Board judgment are usually based upon the reasons set forth in subsections (1), (2) and/or (6) of Fed. R. Civ. P. 60(b).

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[497] *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). *Cf. In re Kroger Co.*, 177 USPQ 715, 717 (TTAB 1973).

[498] *See* 37 CFR § 2.145(d)(1), and TBMP §§ 902.02 (Time for Filing Notice of Appeal) and 903.04 (Time for Filing Civil Action).

[499] *See* 37 CFR § 2.116(a).

For examples of cases involving a motion for a relief from a final judgment of the Board, see cases cited in the note below.[500]

A motion for relief from judgment must be made within a reasonable time; and if the motion is based on reasons (1), (2), and/or (3), it must be filed not more than one year after the judgment was entered.[501] The filing of the motion will not affect the finality of the judgment or suspend its operation.[502]

Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances.[503] The determination of whether a motion under Fed. R. Civ. P. 60(b) should be granted is a matter which lies within the sound discretion of the Board.[504]

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[500] S*ee CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300 (TTAB 1999) (reason (1) denied; counsel and client share duty [suggesting *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992), where relief was granted due to negligent conduct of counsel who concealed critical facts from petitioner, is no longer good law]); *S. Industries Inc. v. Lamb-Weston Inc*., 45 USPQ2d 1293 (TTAB 1997) (reason (1) granted; petitioner contributed to respondent's delay and confusion); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.,* 44 USPQ2d 1950 (TTAB 1997) (reasons (4) and (6), based on alleged failure to receive correspondence from Board, denied, given presumption of receipt of correspondence, passage of 12 years, and resulting hardship to third parties); *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 (TTAB 1992) (reason (6) granted; petition withdrawn based on apparent acceptance by Examining Attorney of settlement agreement obviating basis for refusal of petitioner's applications); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991) (reason (1) granted; respondent's failure to answer resulted from mistake due to involvement in numerous Board proceedings); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (reason (1) granted; respondent's employees had limited knowledge of English and were unaware cancellation and opposition were separate proceedings).

See also Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976) (reasons (1) and (6) denied; opposer's failure to maintain communication between its staff counsel due to inattention and carelessness is not excusable neglect and does not constitute "inadvertence") and *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (reason (1) denied; petitioner's arguments that its neglect resulted from docketing errors and the absence of petitioner's counsel from its office do not constitute excusable neglect). *In addition see 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)); 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).

[501] *See* Fed. R. Civ. P. 60(b); *Djeredjian v. Kashi Co.*, *supra* (filed 15 days after entry of default judgment); and *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819 (TTAB 1978) (motion denied where judgment was entered under § 2.135 and applicant was mistaken as to consent to abandonment by opposer but delayed over a year to file motion).

[502] *See* Fed. R. Civ. P. 60(b).

[503] *See Djeredjian v. Kashi Co., supra* at 1615.

[504] *See Djeredjian v. Kashi Co., supra* at 1615.

Where a motion for relief from judgment is made without the consent of the adverse party or parties, it must persuasively show (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in Fed. R. Civ. P. 60(b).

Because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments.[505] 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.[506]

If, in a cancellation proceeding, a petition to the Director is filed concurrently with a Fed. R. Civ. P. 60(b) motion to the Board for relief from judgment, and the petition and motion seek the same relief and require review of the same set of facts, the Board will rule first upon the motion for relief from judgment.[507] If the Board grants the motion, the Director, as a ministerial act, will reinstate the subject registration.[508]

Where the parties are agreed that the circumstances warrant the vacating or setting aside of a final judgment, a stipulation or consented motion for relief from the judgment should be filed. The Board ordinarily will grant a consented request for relief from judgment.

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[505] *See* TBMP § 312.03 (Setting Aside Default Judgment) and authorities cited therein.

[506] *See* TBMP § 312.03; *Djeredjian v. Kashi Co.*, *supra* at 1615 (granted pending showing of meritorious where other two elements were established) and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra* (respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings). *Compare Jack Lenor Larsen Inc. v. Chas. O. Larson Co., supra* (motion denied).

[507] *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61 (Comm'r 1985).

[508] *See National Telefilm Associates, Inc. v. Craig Denney Productions*, *supra.*

APPENDIX OF CASES

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

n.104 *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); *Microsoft Corp. v. Qantel Business Systems Inc*., 16 USPQ2d 1732 (TTAB 1990); *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); and *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

Section 507.03(b) [Amendments]To Add Issues Tried by Express or Implied Consent

n.119 *Plastic Fabricators Inc. v. Underwriters Laboratories Inc.,* 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini,* 570 F.2d 328, 1966 USPQ 801 (CCPA 1978); *Jockey International Inc. v. Mallory & Church Corp*., 25 USPQ2d 1233 (TTAB 1992); *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 1 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); and *Conwood Corp. v. Loew's Theatres, Inc*., 173 USPQ 829 (TTAB 1972).

n.120 *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); *Color Key Corp. v. Color 1 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); *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); and *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).

APPENDIX OF CASES

Section 509.01(a) Motion to Extend Time

n.131 *Chesebrough-Pond's Inc. v. Faberge, Inc*., 618 F.2d 776, 205 USPQ 888 (CCPA 1980); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 10 USPQ2d 1671, 1676 (TTAB 1988); *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).

Section 511 Motion to Consolidate

n.192 *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); *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).

Section 512.01 Assignment of Mark

n.204 *Huffy Corp. v. Geoffrey Inc.,* 18 USPQ2d 1240 (Comm'r 1990*). See also S & L Acquisition Co. v. Helene Arpels Inc.,* 9 USPQ2d 1221 (TTAB 1987); *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).

n.205 *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).

Section 527.01(e) Estoppel Sanction

n.320 *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 *Georgia-Pacific Corp. v. Great Plains Bag Co*., 190 USPQ 193 (TTAB 1976). *Cf. 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); and *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.,* 191 USPQ 468 (TTAB 1976).

Section 528.01 [Summary Judgment] General Nature of Motion

n.331 *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).

Section 534.02 Motion for Judgment Under Rule 2.132(a)

n.444 *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 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).