

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

EAD

Opposition No. 118,664

Mandarin Music Pty Ltd.

v.

Joseph Alan Kalman Greenbaum

Elizabeth A. Dunn, Attorney

It has come to the Board's attention that the order dated January 2, 2003 was not mailed until January 30, 2003. Insofar as the parties will not receive the order until the dates reset therein have begun to run, the Board's order of January 2, 2003 is hereby vacated. The instant order replaces the January 2, 2003 order.

On September 19, 2002, the Board allowed applicant, who has chosen to continue acting *pro se*, 30 days, or until October 19, 2002, in which to file a designation of domestic representative which was signed, served, and in the proper form. Notwithstanding that the Board had made an exception to this rule and earlier invited applicant by phone to fax to the Board his designation of a new domestic representative, the Board advised applicant that the Board normally does not accept papers for filing by fax.

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On November 5, 2002, applicant faxed the Board his designation of a new domestic representative which does not indicate proof of service of a copy of same on counsel for opposer. With regard to applicant's late, faxed, and unserved designation of his new domestic representative, applicant is advised as follows:

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- 1) When a Board order requires an act or allows an act to be done at or within a specified time, the action should be performed within that time.¹ See Fed. R. Civ. P. 6(b). Failure to act within the specified time may result in the Board's refusal to consider the late action.
- 2) With the exception of the notice of *ex parte* appeal, the Board does not accord a filing date to facsimile transmissions. See U.S. Patent and Trademark Office Rule 1.6(d)(8). An exception was made once in this proceeding but applicant was specifically informed that it was an exception. Future fax filings will be discarded.
- 3) Trademark Rule 2.119(a) requires that "Every paper filed in the Patent and Trademark Office in *inter partes* cases, including notice of appeal, must be served upon the other parties ... [and] [p]roof of such service must be made before the paper will be considered by the Office." Applicant's designation of his new domestic representative does not indicate proof

¹ A party may file a motion for an enlargement of the time in which an act is required or allowed to be done. If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend, and the moving party need only show good cause for the requested extension. If, however, the motion is not filed until after the expiration of the period as originally set or previously extended, the motion is a motion to reopen, and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. See, for example, FRCP 6(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); and TBMP §509.01.

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of service of a copy of same on counsel for opposer.² Applicant is allowed until ten days from the mailing date on this order to so serve opposer's attorney. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

Both parties are advised that, effective December 30, 2002, the trademark rules were amended to make appointment of a domestic representative optional for foreign parties, including in Board *inter partes* cases. The text of amended Trademark Rule 2.119(d) reads, in pertinent part:

If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.

Accordingly, insofar as applicant has failed to submit a proper designation of domestic representative, all correspondence in this proceeding should be served directly to applicant at the following address:

² To show "proof of service" is to mail the document to opposer's attorney and to so state on the copy sent to the Board. Specifically, the requirement for proof of service is satisfied if each filing with the Board includes a written statement, titled "certificate of service" which reads as follows: "The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer's attorney by forwarding said copy, via first class mail, postage prepaid to: [insert name and address]." The certificate of service must be signed and dated.

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Applicant again is advised that securing the services of a trademark attorney is advisable, and that strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

Trial dates are reset as follows:

DISCOVERY

CLOSED

Testimony period for party in
position of plaintiff to close:
(opening thirty days prior thereto)

March 31, 2003

Testimony period for party in
position of defendant to close:
(opening thirty days prior thereto)

May 30, 2003

Rebuttal testimony period for
plaintiff to close:
(opening fifteen days prior thereto)

July 14, 2003

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.