

ESTTA Tracking number: **ESTTA249152**

Filing date: **11/17/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91156321
Party	Plaintiff The Chamber of Commerce of the United States of America
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Date	11/17/2008
Attachments	Motion to Modify Order and Permit Rebuttal Testimony.pdf ( 6 pages )(34062 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE CHAMBER OF COMMERCE OF  
THE UNITED STATES OF AMERICA

*Opposer,*

v.

UNITED STATES HISPANIC CHAMBER  
OF COMMERCE FOUNDATION,

*Applicant.*

Opposition No.: 91/156,321

Serial No.: 78/081,731

**MOTION TO MODIFY BOARD'S SCHEDULING ORDER  
TO PERMIT OPPOSER TO OFFER REBUTTAL TESTIMONY**

Opposer, The Chamber of Commerce of the United States of America, respectfully moves for an order clarifying and modifying the Board's *Order* of August 15, 2008. Under the literal terms of the *Order*, as it presently stands, the Board appears not to have provided Opposer with an opportunity to present testimony in rebuttal to the new evidence Applicant is permitted (under the terms of the same *Order*) to adduce during its extended case-in-chief. Given that an unbalanced trial schedule would be inconsistent with Trademark Rule 2.121(b)(1), along with traditional notions of fairness and due process, this result was likely unintended, and the Board's *Order* thus should be clarified so as to reflect the proper posture of this case and to remove any uncertainty regarding the propriety of Opposer submitting such evidence.

## BACKGROUND

Opposer's opening testimony period in this matter closed on June 29, 2007, *see* D.I. 35, 36, and Applicant's opening period was originally scheduled to close on February 28, 2008. *See* D.I. 49, 46. Just before the close of its testimony period, however, Applicant moved to extend its time so that it could offer the testimony of a series of third-party witnesses, which testimony Applicant had sought by way of subpoena ("the new Third-Party Testimony"). *See* D.I. 50, 51. Opposer resisted that motion, arguing that "good cause" had not been shown. *See* D.I. 54.

Under the terms of the then-operative scheduling order (D.I. 49), Opposer's rebuttal period opened on March 30, 2008. *See* D.I. 46. When that date came, however, the Board had not yet ruled on the propriety of Opposer's contested motion to extend its opening testimony period. As a consequence, Opposer went forward during its rebuttal period with the presentation of evidence in rebuttal to the evidence Applicant had actually offered during its opening period. *Cf. TBMP*, Section 509.01(a) (noting that the parties can be held to the original case schedule if a motion to extend is denied) (citing cases at n.145). Opposer naturally did not offer a "rebuttal" to the new Third-Party Testimony, as such testimony had not yet been offered by Applicant.

During the presentation of Opposer's rebuttal case (that is, Opposer's rebuttal to the evidence Applicant had submitted up through February 28<sup>th</sup>), Opposer became aware of the need for the testimony of an additional rebuttal witness to authenticate a document that Opposer first learned of during the testimony of its first rebuttal witness. Unfortunately, however, that witness was unavailable until after the close of Opposer's rebuttal period on April 28, 2008. Therefore, Opposer moved the Board for its own short extension, limited to the purpose of scheduling this additional witness. *See* D.I. 72. Notably, though, Opposer's request for an extension was solely for the purpose of completing Opposer's case in rebuttal to the evidence Applicant *actually*

*presented* during its opening testimony period, as the Board had not ruled by that point on whether Applicant would be permitted to offer the new Third-Party Testimony.

On August 15, 2008, the Board granted Applicant's extension request and afforded Applicant a twenty-day period in September to take the new Third-Party Testimony, *see* D.I. 83, and as permitted under the terms of the *Order*, Applicant took that testimony. *See, e.g.*, D.I. 84. Despite allowing Applicant to present this new testimony, however, the Board unfortunately did not also provide Opposer with an opportunity to offer evidence in *rebuttal* to that new Third-Party Testimony. The reason for this apparent oversight seems to be because the Board, in the August 15<sup>th</sup> *Order*, also took up Opposer's request to extend its original rebuttal period, a motion that, as noted above, was filed when Applicant's contested motion was still pending and the new Third-Party Testimony had not yet been taken. Thus, under the new schedule, the Board only granted Opposer an opportunity to present the limited evidence (namely, the testimony of the authentication witness) that Opposer had identified in its original motion. *See* D.I. 83, p. 8.

Opposer recently became aware of this oversight in the Board's *Order* while it was preparing its rebuttal case, which case is to include not only the previously-noted authentication witness, but also certain additional evidence for the purpose of rebutting certain aspects of the new Third-Party Testimony. (That is to say, Opposer will not be offering any further evidence to rebut the material Applicant put on prior to February 28, 2008, other than the already-permitted authentication evidence, but it does intend to offer evidence in rebuttal to the new Third-Party testimony). Thus, Opposer is moving here to modify the Board's August 15<sup>th</sup> *Order* to make it clear that Opposer has the right to offer evidence in rebuttal to the new Third-Party Testimony that Applicant recently submitted—a right Opposer submits is fundamental to our adversarial system, *see, e.g.*, 37 CFR §2.121(B)(1), and one Opposer believes the Board would not deny *sua*

*sponte* without a detailed discussion. Unfortunately, though, Applicant has as of present refused to stipulate that Opposer should have an opportunity to offer such evidence in rebuttal, thus necessitating that Opposer file the present motion so as to clarify this matter.<sup>1</sup>

## ARGUMENT

Trademark Rule 2.121(B)(1) provides that the Board will “schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.” 37 CFR §2.121(B)(1); *see also TBMP*, §701. As detailed above, though, the overlapping requests for extensions filed in this proceeding resulted in the Board seeming to grant Applicant the right to put on evidence (namely, the new Third-Party Testimony) without also providing Opposer with a corresponding right to present any rebuttal thereto. *See* D.I. 83; *see also supra*. Such a result was likely unintended, and out of an abundance of caution Opposer is moving the Board for an order clarifying the permissible scope of its rebuttal case.

Opposer has not delayed in any way in bringing this matter to the attention of the Board, having first attempted to resolve this matter through discussions with Applicant. With the recent failure of those party discussions and the opening of Opposer’s rebuttal testimony period (per the August 15<sup>th</sup> *Order*), however, Opposer saw the need to file the present motion.<sup>2</sup> So as to avoid delaying these proceedings, Opposer intends to offer all of its evidence in rebuttal to Applicant’s

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<sup>1</sup> The only testimony Opposer intends to offer in rebuttal to the new Third-Party testimony is the testimony of a current employee of Opposer, who is being offered for the sole purpose of authenticating a particular document. So as not to delay this case, Opposer intends to call that witness during the ten-day rebuttal period currently provided by the Board’s *Order* and will offer Applicant the right to cross-exam the witness about that testimony. Beyond that testimony, Opposer may offer a further *Notice of Reliance*, which it will also submit during the ten-day period.

<sup>2</sup> Although Opposer felt the need to file this motion now, it is continuing to discuss this matter with Applicant. Should the parties reach an agreement this week as to this issue, Opposer would agree to withdraw this motion.

new Third-Party Testimony during its currently-scheduled ten-day rebuttal period, *see* n.1, *supra* (discussing the limited nature of the evidence), and will afford Applicant the right to cross-examine any witness. Opposer would thus request that the Board, in addition to clarifying the scheduling order to permit the taking of such rebuttal testimony, also—to the extent deemed necessary—regard Opposer’s rebuttal evidence as being submitted during an appropriate rebuttal period, even if the original *Order* is interpreted as having not permitted such an offering. *See TBMP*, §701 (“A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board.”).

### CONCLUSION

For the reasons set forth above, Opposer submits that the Board should clarify its *Order* of August 15, 2008, to make it clear that Opposer may present testimony in rebuttal to the new evidence Applicant was permitted to offer under the terms of the same *Order*, and should accept any such evidence submitted by Opposer during the currently-scheduled rebuttal period as having been submitted during a proper “rebuttal” testimony period.

Respectfully submitted,

Date: November 17, 2008

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**CERTIFICATE OF SERVICE**

I hereby certify that the required number of copies of the foregoing *Motion to Modify Board's Scheduling Order to Permit Opposer to Offer Rebuttal Testimony* was served on the parties or counsel on the date and as indicated below:

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