

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

gcp/jk

Mailed: August 15, 2008

Opposition No. 91156321

THE CHAMBER OF COMMERCE OF
THE UNITED STATES OF AMERICA

v.

UNITED STATES HISPANIC
CHAMBER OF COMMERCE
FOUNDATION

George C. Pologeorgis, Interlocutory Attorney:

This proceeding is before the Board for consideration of (1) applicant's amended motion (filed February 28, 2008) to extend its testimony period 60 days, or to suspend proceedings, and (2) opposer's motion (filed April 28, 2008) to extend its rebuttal testimony period for 10 days. The motions are fully briefed.

The Board takes note that, on August 12, 2008, opposer filed a motion to modify the briefing schedule.

Applicant's amended motion to extend its testimony period

As reset by the Board's October 2, 2007 order, applicant's testimony period opened January 30, 2008, and was to close February 28, 2008. On February 28, 2008, applicant filed its motion seeking a 60-day extension of its testimony

period, asserting that (1) it needs to complete depositions of and obtain documents requested from [four] third-party chambers of commerce as witnesses to whom it issued subpoenas on February 8, 2008, (2) it is precluded from obtaining documents from its non-deposed witnesses because they "have become uncomfortable complying with the subpoenas" as a result of opposer's filing, on February 14, 2008, of ten motions to quash in the U.S. District Courts for the District of Columbia, the Southern District of New York, and the Eastern District of Virginia, (3) opposer lacks standing to move the U.S. District Courts to quash the subpoenas, 4) its need for additional time is not caused by its own inaction, tardiness or lack of diligence in noticing the depositions of said third-party witnesses. Applicant requested, in the alternative, a suspension of proceedings pending the resolution of opposer's motions to quash pending before the Federal District Court for the District of Columbia.

Opposer argues that (1) applicant seeks to extend a testimony period which opened seven months prior, (2) applicant had a seven month period to put on its case, but waited until the "last minute" thereof to notice ten third party depositions over the last four days of its testimony period, (3) applicant seeks discovery of third parties, during applicant's trial period, "under the guise of having issued 'trial' subpoenas" inasmuch as applicant's subpoenas are

designed to solicit discovery, (4) the three third party trial depositions applicant did take indicate that applicant was seeking discovery therein, and (5) applicant should have petitioned the Board to reopen the discovery period rather than seeking an extension of its testimony period.

To prevail on its motion, applicant must demonstrate good cause for its requested extension, must set forth with particularity the facts in support therefor, and must establish that such request is not necessitated by its own lack of diligence or unreasonable delay in taking the required action during the previously allowed time. See TBMP § 509.01(a) (2d ed. rev. 2004).

Initially, and primarily for opposer's benefit, we note that, pursuant to Trademark Rule 2.121(c), applicant's assigned testimony period was for a period of thirty (30) days. Applicant did not, as opposer repeatedly contends, have a seven month period to put on its case. See TBMP § 701 (2d ed. rev. 2004).

Turning to applicant's motion, with respect to the facts underlying applicant's request, we find that applicant has set forth with sufficient particularity the facts upon which its motion rests.

With respect to applicant's own degree of diligence in pursuing its case before and during its assigned testimony period, we note that applicant noticed testimony depositions

of three of its witnesses on January 30, 2008, the day its testimony period opened, and issued subpoenas to ten third-party witnesses only 9 days later, on February 8, 2008.

With respect to the resultant delay in this proceeding, we find such delay to have been largely caused by opposer's behavior during the time in question. First, irrespective of the individual merits of the eight civil actions and ten motions to quash which opposer filed on February 14, 2008 in three U.S. district courts, it is clear that opposer's filings thereof contributed to the delay of which opposer now complains. Second, while applicant's February 15, 2008 attempt to secure opposer's consent to a 20-day extension of applicant's testimony period to allow resolution of the subpoena issue constituted diligence on applicant's part midway through its testimony period, opposer's February 19, 2008 refusal of applicant's request, based on opposer's unilateral determination that the pendency of the subpoena issue did not "constitute valid grounds for rescheduling" the depositions, contributed to the delay of which opposer now complains. Third, in its ten separate February 19, 2008 letters to counsel for applicant, opposer continued to contribute to such delay with its erroneous insistence that applicant's testimony period opened in August of 2007, and its resulting but erroneous conclusion that applicant did not pursue its testimony witnesses "until the end of" applicant's

testimony period. Fourth, opposer's transmittal of letters to each of the ten third-party witnesses whom applicant sought to depose contributed to the delay by creating an intentional impediment to applicant's ability to complete its testimony. Finally, opposer contributed to delay with its February 26, 2008 refusal to consent to applicant's February 25, 2008 request, via email, to take a deposition of an unavailable witness by telephone. In summary, having placed or caused to be placed various procedural obstacles to applicant's securing of trial testimony, opposer cannot now make a persuasive case that applicant did not act diligently during its assigned trial period.

The Board finds that applicant, under these circumstances, has demonstrated good cause for an extension of its testimony period. However, inasmuch as applicant waited until the last day of its assigned 30-day testimony period, namely, February 28, 2008, to file its motion, after having become aware of its difficulties in securing its trial depositions in mid February, the Board finds that applicant is not entitled to an extension of its entire testimony period. Accordingly, applicant's amended motion to extend is granted to the extent that applicant is allowed a limited twenty (20) day testimony period.

Opposer's motion to extend its rebuttal testimony period

In the interest of judicial economy, the Board considers this motion in conjunction with opposers motion to extend the briefing schedule filed on August 12, 2008.

As last reset, by the Board's October 2, 2007 order, opposer's rebuttal testimony period was to close on April 28, 2008. In a motion filed April 28, 2008, opposer seeks a ten-day extension of said rebuttal testimony period in order to allow opposer to take testimony "to authenticate a specific document that was only recently identified during the testimony of Mr. Ramos, a third party." Opposer noticed Mr. Ramos' deposition on April 7, 2008, and took it on April 21, 2008.

Applicant, in opposition to the motion, states that opposer's own lack of diligence during its assigned rebuttal period caused opposer to need an extension, and that opposer failed to seek applicant's consent to an extension before filing its motion. Applicant also urges the Board to note a distinction between opposer's "unyielding" opposition to applicant's February 28, 2008 motion for an extension wherein opposer strenuously argued the impropriety of taking trial testimony outside of one's assigned testimony period, and opposer's subsequent motion to extend its own rebuttal period.

Notwithstanding the disingenuous nature of opposer's motion, which has not escaped the Board's attention, we find

that opposer has shown good cause for the extension it seeks, namely, an extension for the sole and limited purpose of offering the testimony of the Hispanic Association on Corporate Responsibility (HACR) to authenticate one document identified during the testimony of Mr. Daniel Ramos, said document being one that shows a particular prior page from the HACR website.

Accordingly, opposer's motion is granted to the extent that opposer is allowed a limited ten (10) day rebuttal testimony period for the sole and limited purpose of offering the testimony of the Hispanic Association on Corporate Responsibility (HACR) to authenticate one document identified during the testimony of Mr. Daniel Ramos, said document being one that shows a particular prior page from the HACR website.¹

In view of our rulings on applicant's motion to extend its testimony period, and opposer's motion to extend its rebuttal testimony period, and the resultant resetting herein below of the affected testimony and briefing periods, opposer's August 12, 2008 motion to modify the briefing schedule is deemed moot and will be given no further consideration.

¹ The Board notes that opposer filed testimony in April 2008, during its testimony period as previously reset by the Board on October 2, 2007. Said testimony is deemed to have been timely filed and need not be resubmitted.

Proceedings herein are resumed. Remaining testimony periods, and briefing periods, are reset as follows:

LIMITED 20 DAY testimony period
(limited as stated hereinabove) for
defendant in the opposition
and as plaintiff in the counterclaim
to close: 9/26/2008

LIMITED 10 DAY testimony period
(limited as stated hereinabove) for
defendant in the counterclaim
and its rebuttal testimony as
plaintiff in the
opposition to close: 11/25/2008

Rebuttal testimony period for
plaintiff in the
counterclaim to close: 1/9/2009
(opening 15 days prior thereto)

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition
shall be due: 3/10/2009

Brief for defendant in the opposition
and as
plaintiff in the counterclaim shall
be due: 4/9/2009

Brief for defendant in the
counterclaim and its reply
brief (if any) as plaintiff in the
opposition
shall be due: 5/9/2009

Reply brief (if any) for plaintiff in
the counterclaim shall be due: 5/24/2009

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>