

TIAB



11-12-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #74

UNITED STATES DEPARTMENT OF  
COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: November 4, 2003

Opposition No 91158324  
Serial No. 78144217

JOHN E. MCKIE  
224 S MICHIGAN AVE  
CHICAGO, IL 60604-2505

TALENT PLUS, INC. d/b/a TALENT+

v.

MANPOWER INC.

BRUCE A. MCDONALD  
WILEY REIN & FIELDING LLP  
1776 K STREET, N.W.  
WASHINGTON, DC 20006

**Michelle Greenfield, Legal Assistant:**

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof. (See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as

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well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

**Discovery and testimony periods are set as follows:**

Discovery period to open: **November 24, 2003**

Discovery period to close: **May 22, 2004**

30-day testimony period for party  
in position of plaintiff to close: **August 20, 2004**

30-day testimony period for party  
in position of defendant to close: **October 19, 2004**

15-day rebuttal testimony period  
for plaintiff to close: **December 03, 2004**

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See 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.

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "*Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board*," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

**New Developments at the Trademark Trial and Appeal Board**

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at [www.uspto.gov](http://www.uspto.gov).

TTAB



UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

TALENT PLUS, INC., )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 MANPOWER, INC., )  
 )  
 Applicant. )

Opposition No. \_\_\_\_\_



10-22-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #78

10/31/2003 TSMITH 00000182 501129 78144217  
01 FC:6402 600.00 DA

NOTICE OF OPPOSITION

Talent Plus, Inc., d/b/a Talent+, a Nebraska corporation located at 5220 S. 16<sup>th</sup> St., Lincoln, Nebraska 68512 (hereinafter "Opposer"), hereby opposes the application filed on July 16, 2002, by Manpower, Inc., a Wisconsin corporation located at North Ironwood Road, Milwaukee, WI 53201 (hereinafter "Applicant"), for registration of "TALENTPORT," U.S. Application Serial No. 78/144,217, in connection with employment agency services; temporary employment agency services; job placement services; career development; employment recruitment services; employment counseling and recruiting; employment hiring, recruiting, placement, staffing and career networking services; employment outplacement services; providing and managing contract personnel resourcing programs; analyzing and consulting on personnel needs; providing contract and temporary contract personnel staffing services; arranging for and managing the provision of temporary contract personnel; personnel management and personnel resourcing consultancy services; providing information and consultancy services on the procurement of temporary and contract personnel; computer on-line ordering, and providing computer on-line reports, both via a global information network, in the fields of personnel procurement and personnel resourcing; human resources

consulting on recruiting, training and testing of employees; testing to determine employment skills; employment counseling for others; providing career information via a website on a global information network; providing information on jobs via a website on a global information network; providing information on employee pay and benefits in connection with contract personnel staffing, on-line via a global information network; providing an on-line computer database in the fields of jobs and contract personnel staffing, in Class 35; and providing training in business and job skills and office technology; providing on-line courses of study in the following - information technology, software use, job, office and business skills - via a website on a global information network, in Class 41.

As grounds for this Opposition, Opposer states as follows:

(1) Applicant's mark depicted above is prohibited from registration under Section 2(d) of the Federal Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1052(d), because it is likely to be confused with one or more of the marks depicted in the following United States registrations owned by Opposer and duly registered on the Principal Register of the Patent and Trademark Office (PTO):

**Opposer's Marks**

Reg. No.	Mark	Goods/Services & Date of First Use
U.S. Reg. No. 2,457,968, registered 6/5/2001	<b>TALENT PLUS</b>	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 5/0/2000)
U.S. Reg. No. 1,694,765, registered 6/16/1992	<b>TALENT+</b>	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 7/17/89)

Reg. No.	Mark	Goods/Services & Date of First Use
U.S. Reg. No. 2,643,789, registered 10/29/2002	TALENTBANK	Computer programs used by employers for monitoring and evaluating the performance of employees, in Class 9 (first use September 2001)
U.S. Reg. No. 2,716,938, registered 5/20/2003	TALENT BENCHMARK	Employment consulting services, namely evaluating employees and prospective employees, in Class 35 (first use 1991)
U.S. Reg. No. 2,551,962, registered 3/26/2002	TALENT INTENSITY INDEX	Employment consulting services, namely, evaluating employees and prospective employees, in Class 35 (first use 1/1/1991)
U.S. Reg. No. 2,492,575, registered 9/25/2001	TALENT CARD	Certificates recognizing employee qualities and achievements, in Class 16 (first use 1/1/1990)
U.S. Reg. No. 2,682,377, registered 2/4/2003	TALENTFIT	Employee recruiting services, namely, assisting in evaluating prospective employees, in Class 35 (first use 5/1/2000)
U.S. Reg. No. 2,642,089, registered 10/29/2002	TALENT PREDICTION	Business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989)
U.S. Reg. No. 2,624,108, registered 9/24/2002	TALENT PROFILE	Business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989)
U.S. Reg. No. 2,032,573, registered 1/21/1997	TALENT ONLINE	Employment recruiting services, in Class 35 (first use 9/1/95)
U.S. Reg. No. 2,638,760, registered 10/22/2002	TALENT GRAPH	Business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989)
U.S. Reg. No. 2,726,929, registered 6/17/2003	TALENT+ MASTER TRAINER	Business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1995)

(2) In addition to the United States registrations owned by Opposer pleaded above, Opposer has common law rights in the "TALENT" mark represented by the following application currently pending at the PTO:

Applic. No.	Mark	Goods/Services & Date of First Use
U.S. App. Ser. No. 76/492,177, filed 2/24/2003	TALENT+ VIEWPOINT	Business management, personnel and human resources consulting services, namely, development and application of proprietary structured processes, validated questionnaires and instruments for psychometric testing; development and support of related software; and associated personnel services, in Class 35 (first use 3/5/2001)

#### Description of Opposer

(3) Opposer is a consultant to businesses across the United States in the field of psychometrics – the use of validated testing instruments to identify personal traits that lead to success in specific jobs.

(4) Since its incorporation in 1989, Opposer has invested substantially in the development of a family of marks that link the word "Talent" with another word, e.g., TALENT PLUS, TALENT+, TALENTBANK, TALENT BENCHMARK, TALENT INTENSITY INDEX, TALENT CARD, TALENTFIT, TALENT PREDICTION, TALENT PROFILE, TALENT ONLINE, TALENT GRAPH, TALENT+ MASTER TRAINER, and TALENT+ VIEWPOINT, as depicted in Paragraphs 1 and 2 above.

(5) Since adopting its "TALENT" marks, Opposer has made substantial, continuous and exclusive use of those marks in sales to business corporations, associations, executives, and human resources professionals in the specialized market for the development and application of proprietary structured interview processes, validated questionnaires and testing instruments, supporting software and related personnel services.

(6) Opposer currently has approximately 65 employees engaged in the specialized services described above and annual revenues of around \$8 million.

(7) In its specialized field, Opposer's "TALENT" marks have acquired secondary meaning and are familiar to the purchasing public in that they identify Opposer as the source of products and services offered under Opposer's family of "TALENT" marks.

**Acquired Secondary Meaning of Opposer's "TALENT" Marks**

(8) Opposer's "TALENT" marks may be described as "suggestive" of Opposer's goods and services within the meaning of the trademark law, as they connote a quality, ingredient, or characteristic of Opposer's goods and services. However, they are not descriptive, because imagination is required to reach a conclusion as to the actual goods and services or to connect the marks with the goods and services. A person without knowledge of Opposer's products and services would not likely know that Opposer is exclusively engaged in the specialized market for the development and application of proprietary structured interview processes, validated questionnaires and testing instruments, supporting software and related personnel services. Opposer's "TALENT" marks are "suggestive" because they conjure up images of Opposer's products and services without actually describing them.

(9) While Opposer's "TALENT" marks may be suggestive on their face, as a family of marks they have acquired secondary meaning as the result of many years of use, advertising and promotion. As a result of such use, advertising and promotion, Opposer and its "TALENT" marks are well known in the market for the services offered by Opposer.

### **PTO Recognition of Secondary Meaning in Opposer's Marks**

(10) The PTO has recognized the acquired secondary meaning associated with the word "TALENT" as used in Opposer's marks. Specifically, the PTO has registered the following marks of Opposer pursuant to Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f), based on a finding that the word "TALENT" has acquired distinction as used in connection with Opposer's goods and services:

- **TALENT GRAPH**, U.S. Reg. No. 2,638,760, Oct. 22, 2002, for business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989);
- **TALENT PREDICTION**, U.S. Reg. No. 2,642,089, Oct. 29, 2002, for business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989);
- **TALENT PROFILE**, U.S. Reg. No. 2,624,108, Sept. 24, 2002, for business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989); and
- **TALENT BENCHMARK**, U.S. Reg. No. 2,716,938, registered May 20, 2003, for employment consulting services, namely evaluating employees and prospective employees, in Class 35 (first use 1991).

### **Incontestability**

(11) Opposer's registrations for **TALENT ONLINE**, U.S. Reg. No. 2,032,573, registered Jan. 21, 1997, and **TALENT+**, U.S. Reg. No. 1,694,765, registered June 16, 1992, are "incontestable" under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and constitute conclusive evidence of the validity of the registered marks pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

### **Enforcement History**

(12) Opposer has consistently and vigorously enforced its rights in the "TALENT" marks alleged in this Notice of Opposition by protesting against confusingly

similar uses by third parties. In 2000, Opposer filed a suit that led to a third party's agreement to terminate its use of the name "TalentPoint." In addition, Opposer is presently prosecuting a federal trademark infringement action involving Opposer's family of "TALENT" marks.

#### **Overlapping Recitations**

(13) The recitation in the opposed application is drawn in a manner that could be interpreted to encompass the development and application of proprietary structured interview processes, validated questionnaires and testing instruments, supporting software and related personnel services, in which Opposer's family of "TALENT" marks is especially well known. As the recitation in the opposed application is not limited to exclude that possibility, registration of Applicant's mark would allow Applicant to compete directly with Opposer in the specialized market where Opposer's family of "TALENT" marks is especially well known.

#### **Conclusion**

(14) Applicant's proposed mark so resembles Opposer's family of "TALENT" marks in appearance, sound, connotation and commercial impression as to be likely, when applied to Applicant's goods and services, to cause confusion, mistake and/or deception. Registration of Applicant's mark is therefore prohibited under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and would be damaging to Opposer's exclusive rights in its registered and unregistered marks pleaded above.

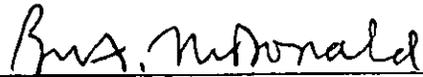
WHEREFORE, Talent Plus, Inc., opposes the application cited in the preamble above, and moves the Board to sustain this opposition and to refuse registration of the mark depicted in that application.

Opposer hereby authorizes the filing fee of SIX HUNDRED DOLLARS (\$600.00) and any additional charges necessary to institute this proceeding in two classes to be debited from the deposit account of Wiley Rein & Fielding LLP, Account No. 501129.

This Notice of Opposition is being filed by the undersigned attorneys at law, duly authorized to represent Opposer in this proceeding, pursuant to Trademark Rule 2.101(b).

Respectfully submitted,

**TALENT PLUS, INC., d/b/a Talent+**

By: 

Bruce A. McDonald  
**WILEY REIN & FIELDING LLP**  
1776 K Street, N.W.  
Washington, D.C. 20006  
(202) 719-7000

Attorneys for Opposer

Dated: October 22, 2003

WRFMAIN 12133995.1

## THE TRADEMARK TRIAL AND APPEAL BOARD WOULD LIKE YOU TO KNOW:

The TTAB Customer Service Center is available to

- \*answer telephone inquiries
- \*explain pertinent legal provisions and related administrative practices as they apply to specific cases
- \*provide status information on pending cases
- \*provide access to the files of pending cases
- \*resolve problems

The telephone number for the TTAB Customer Service Center is (703) 308-9300, extension 0 [zero].

The Patent and Trademark Office has two special boxes for expedited processing and distribution of documents filed with the TTAB. Envelopes and transmittal letters for TTAB should be addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202, followed by one of the following designations

“Box TTAB Fee”: for papers filed with the TTAB that include filing fees, such as notices of opposition, petitions to cancel, and notices of ex parte appeal

and

“Box TTAB”: for all non-fee papers filed with the TTAB, such as requests for extensions of time to file notices of opposition and motions.

The TTAB Customer Service Center makes every effort to provide public access to application files, opposition files, cancellation files and concurrent use files immediately upon request for access. Files located will be made available in a central storage area accessible to the public. You can also access information about TTAB proceeding files online. Go to <http://www.uspto.gov/web/offices/dcom/ttab/> and click the “BISX LINK”.

Any questions, comments, or suggestions concerning TTAB service should be directed to Jean Brown, TTAB Technical Program Manager, at (703) 308-9300, extension 123 or Afendi Ziad, Supervisory Legal Assistant at (703) 308-9300, extension 205 or Angela Pope, Supervisory Legal Assistant at (703) 308-9300, extension 144.

**NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION (ADR)**

**TTAB NOTICE CONCERNING CORRESPONDENCE ADDRESS  
(TRADEMARK RULE 2.18)**

The Trademark Trial and Appeal Board will mail correspondence to only one address for each party.

If a party is located in the U.S., correspondence will be sent to the party's own address, unless (1) papers filed with the Board are filed by a party's attorney, (2) a written power of attorney is filed, (3) a written authorization of some other person entitled to be recognized is filed, or (4) the party requests in writing that correspondence be sent to another address. In these situations, correspondence will be sent, respectively, to (1) the attorney filing papers, (2) the attorney named in the power of attorney, (3) the other person designated in the written authorization, or (4) the other address specified by the party.

When one attorney or other authorized representative makes an appearance on behalf of a party, his address is noted on the proceeding file as the correspondence address. If a second attorney or other authorized representative makes an appearance on behalf of the party, and requests that correspondence be directed to him, the correspondence address on the proceeding file will be changed, and future correspondence will be sent to the second attorney or other authorized representative, rather than to the first one. If the second attorney or other authorized representative does not request that correspondence be sent to him, the Board will continue to send correspondence to the first attorney or authorized representative.

If a power of attorney from a party to one attorney has been filed, and thereafter another attorney or authorized representative makes an appearance on behalf of the party and asks that correspondence be sent to him, the second attorney or authorized representative will be required to submit authorization, from the party or from the first attorney, for the requested change in correspondence address.

If a power of attorney from a party to one attorney has been filed, and thereafter a power of attorney from the party to another attorney is filed, the second power of attorney will be construed as a written request to change the correspondence address from the first attorney to the second one, even if there is no revocation of the first power, unless the party or the first attorney directs otherwise. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney has been filed, and thereafter that attorney files an "associated power of attorney" to another attorney, the correspondence address will remain unchanged, and the Board will continue to send correspondence to the first attorney, unless the first attorney or the party directs otherwise.

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address. Thereafter, the correspondence address may be changed as described in Trademark Rule 2.18.

In the case of a party whose registration is the subject of a Board proceeding, any representative which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself unless and until another correspondence address is established in the manner described in Trademark Rule 2.18.

**PROCEEDING SYNOPSIS**

United States Patent and Trademark Office - Trademark Trial and Appeal Board  
Trademark Opposition and Cancellation Proceedings Under 15 USC 1063, 1064; 37 CFR 2.101 et. seq.

**FILING OPPOSITION/CANCELLATION**

- ❖ Any person (Opposer) may file a Notice of Opposition within 30 days against any mark published under 15 USC 1062(a) in Official Gazette; may oppose in whole or part.<sup>1</sup>
- ❖ Time for filing Notice may be extended by written request to TTAB. A first extension for not more than 30 days will be granted upon request. Further extensions may be granted for good cause. Extensions aggregating more than 120 days from pub. date not granted unless consented to by applicant or extraordinary circumstances. 37 CFR 2.102(c). Request should be in triplicate. 37 CFR 2.102(d).
- ❖ Any person (Petitioner) may file a Petition to cancel a registration in whole or in part, but only under conditions set forth in 15 USC 1064.<sup>2</sup> Geographic limitation will be considered by TTAB only in concurrent use proceeding. 37 CFR 2.99(h), 2.133(c).
- ❖ Opposer/Petitioner is in position of Plaintiff and Applicant/Respondent is Defendant. 37 CFR 2.116(b).
- ❖ Notice/Petition corresponds to complaint in civil action. 37 CFR 2.116(c).
- ❖ Amendment to pleadings in accord with Rule 15, Fed. Rules of Civil Procedure (FRCP). 37 CFR 2.107, 2.115.

**MAILING PROCEDURES**

- ❖ Certificate of Mailing or Transmission and Express Mail procedures effective for all papers. 37 CFR 1.8, 1.10.

**INSTITUTION OF PROCEEDING; WITHDRAWAL**

- ❖ TTAB examines Notice/Petition for formal requirements and sends notification to Defendant, generally within few weeks of filing date. Duplicate copy of Notice/Petition and Exhibits sent to Defendant. 37 CFR 2.105, 2.113.
- ❖ Notice/Petition may be withdrawn without prejudice before Defendant files Answer. 37 CFR 2.106(c), 2.114(c). With written consent of Defendant, later withdrawal may be without prejudice.
- ❖ Defendant may not abandon application or surrender registration without prejudice except with written consent of Plaintiff. 37 CFR 2.135, 2.134.

**ANSWER; MOTIONS**

- ❖ Time for Answer set by TTAB for 40 days from Notification mailing date.<sup>3</sup> Counterclaim should be filed with answer or promptly upon discovery of information supporting Counterclaim. 37 CFR 2.106(b), 2.114(b).

- ❖ Time for reply to Counterclaim set by TTAB for not less than 30 days from TTAB action mailing date. 37 CFR 2.106(b), 2.114(b).
- ❖ Motions may be brought before TTAB in writing and with Brief in support. Brief in opposition thereto, 15 days (30 days for summary judgment motion). Briefs limited to 25 pages. Reply Brief, if filed, 15 days, limited to 10 pages. Reconsideration 30 days after decision; Opposition Brief, 15 days. 37 CFR 2.127. Most motions used in Federal practice are applicable.
- ❖ Motions for Summary Judgment, to Compel, and to Test Sufficiency of Responses to Requests for Admissions, if filed, due before Plaintiff testimony period opens. 37 CFR 2.127(e), 2.120(e), 2.120(h).

**TRIAL DATES**

- ❖ TTAB issues Order setting opening and close of Discovery and Trial dates. Discovery set for period of 180 days; 30-day Pl. Testimony period closes 90 days after close of Discovery period; 30-day Def. Test. period closes 60 days after Pl. Test. period; 15-day Pl. Rebuttal Test. period closes 45 days after Def. Test. period. 37 CFR 2.120(a), 2.121.
- ❖ In cases where Counterclaim filed, TTAB sets additional time periods for testimony and briefing.

**DISCOVERY PERIOD**

- ❖ Interrogatories, Reqs. for Prod. of Docs. & Things, and Reqs. for Adm., if served, must be served by last day of Discovery period. Written Responses within 30 days from date of service of Disc. Reqs. FRCP apply except as otherwise provided. 37 CFR 2.116, 2.120(a). Extension of Time to respond to discovery granted upon cause or by stipulation.<sup>4</sup>
- ❖ Interrogatories limited to proceeding total of 75, counting subparts; additional interrogatories allowed upon motion for good cause or by stipulation. 37 CFR 2.120(d)(1).
- ❖ Discovery Depositions (noticed and taken within Disc. Period) in District where deponent resides or is employed. 37 CFR 2.120(a), 2.120(b). Either party may request designation of witnesses under FRCP 30(b)(6), 31(a).

**PLAINTIFF'S TRIAL PERIOD**

- ❖ Plaintiff's Testimony-In-Chief. Opens 60 days after Discovery Period closes, and runs for 30 days (refer to Order).

- ❖ Testimony taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.
- ❖ Plaintiff serves Transcript of testimony and copies of documentary exhibits on adverse party within 30 days after completion of taking testimony. Certified transcript and exhibits filed with TTAB. 37 CFR 2.125.
- ❖ Notice of Reliance as appropriate on Discovery Deps., Adms. and Int. Answers, with copies of same, due before close of Test. 37 CFR 2.120.<sup>5</sup>
- ❖ Involved app. or reg. files are in evidence for relevant and competent purposes. Publications in gen. Circ. or in libraries, and official records, may be received if appropriate Notice of Reliance is filed and copies submitted within Test. period. 37 CFR 2.122.
- ❖ Motion under 37 CFR 2.132, if filed, due after close of Pl.'s Test. period & before opening of Def.'s.

**DEFENDANT'S TRIAL PERIOD**

- ❖ Opens 30 days after close of Pl.'s Test. period. Runs for 30 days.
- ❖ Test. taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.
- ❖ Notice of Reliance on Discovery responses also due within Test. period, if filed. 37 CFR 2.120.
- ❖ Notice of Reliance on gen. circ. publ. and official records due within Test. period, if filed. 37 CFR 2.122.

- ❖ Def. serves Test. transcript on Pl. within 30 days and files certified transcript and exhibits with TTAB. 37 CFR 2.125.

**PLAINTIFF'S REBUTTAL PERIOD**

- ❖ Rebuttal Test. period for Pl. opens 30 days after close of Def.'s Test. period and runs for 15 days.
- ❖ Pl. may file Notice of Reliance under 37 CFR 2.120, 2.122, with matter relied on, and take Test. to rebut Def. Test. and other evidence.
- ❖ Pl. serves and files Transcript of Rebuttal Test. and exhibits in accordance with 37 CFR 2.125.

**BRIEFS; ORAL HEARING**

- ❖ Pl. Brief due 60 days after Rebuttal period closing.<sup>6</sup>
- ❖ Def. Brief, if filed, due 30 days after Pl. Brief due.
- ❖ Pl. Reply Brief, if filed, due 15 days after Def. Brief due. 37 CFR 2.128.

- ❖ Separate Request for Oral Hearing, if filed, due not later than 10 days after Reply Brief due. 37 CFR 2.129.
  - ❖ Oral Hearing before panel of at least three TTAB judges. 30 minutes for each party. 37 CFR 2.129.
  - ❖ TTAB Notice of Oral Hearing sent to all parties.
- DECISION; RECONSIDERATION; APPEAL
- ❖ TTAB Deliberation. Writing of Opinion and Decision in due course.
  - ❖ Request for rehearing, reconsideration or modification, if filed, due within one month. Brief in opposition due within 15 days. 37 CFR 2.129(c).
  - ❖ Any Appeal from TTAB Decision due within two months of Decision or two months after denial of req. for recon. See especially 37 CFR 2.129(d).

**NOTE: Footnotes and TTAB addresses and telephone number appear on the back of this sheet.**

**FOOTNOTES**

- (1) **Opposer may be any legal entity including a corporation. Opposer must believe that opposer would be damaged by registration of the mark and state the reasons. 15 USC 1063 and 37 CFR 2.101. Notice of Opposition need not be verified. \$300 required fee for each class for each person opposing. 37 CFR 2.6, 2.101(b). May be signed by attorney. 37 CFR 2.101(b). Duplicate copy including exhibits required. Order status and title copies of pleaded registrations in advance and attach to Notice/Petition or introduce as evidence during Testimony-In-Chief period. 37 CFR 2.122.**
- (2) **Action, grounds and requirements (Footnote 1) for initiation of Cancellation proceeding are similar to those for an Opposition proceeding and are covered in 15 USC 1064, 1092 and 37 CFR 2.111, 2.112. \$300 required fee per class, per person. Duplicate copy required.**
- (3) **Except Notice/Petition, each paper must be served on opponent. Statement of service (date and manner) is required. Period to respond to Motions and Discovery Requests is extended 5 days when service is by first-class mail, "Express Mail," or overnight courier. 37 CFR 2.119. Action due on weekend or D.C. holiday can be taken on next business day. 37 CFR 1.7.**
- (4) **Resetting of time to respond to Discovery Request does not result in extension of Discovery period and subsequent testimony periods unless requested. 37 CFR 2.120(a). All consented extensions of time should be filed in triplicate and list specific dates for all subsequent periods affected.**
- (5) **Except for 37 CFR 2.122(e) documents, documents produced in response to Requests for Production cannot be made of record by Notice of Reliance alone. 37 CFR 2.120(j)(ii).**
- (6) **Briefs should be typewritten or printed, double-spaced, in at least pica or eleven-point type, on letter paper (8½ x 11). Three copies of briefs required. Alphabetical index of cases required. Length limit of 55 pages, including table of contents, index of cases, description of record, statement of issues, recitation of facts, argument, and summary. Reply brief 25 pages total. 37 CFR 2.128(b).**

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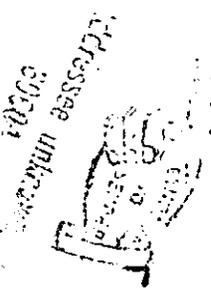
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