

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

DUNN

Mailed: May 5, 2009

Opposition No. 91162780

MESSAGE IN A BOTTLE, INC.
F/K/A GOLD SHELLS, INC.

v.

KEITH CANGIARELLA

Elizabeth A. Dunn, Attorney (571-272-4267):¹

This case comes up on applicant's motion to submit testimony by declaration, filed April 26, 2009.² The motion is contested, and at the request of opposer, the Board held a phone hearing on May 4, 2009. The participants were Peter Smith, attorney for opposer, Keith Cangiarella, applicant acting pro se, and Elizabeth Dunn, attorney for the Board.

As background, the Board notes that this proceeding, pending since 2004, involves opposer's claim of nonuse,

¹ Robert Coggins, the Board attorney assigned to address interlocutory matters in this proceeding, is absent temporarily from the office.

² During the hearing applicant clarified that his references to Trademark Rules 2.146 and 2.148, which address matters subject to the USPTO Director's supervisory authority, were made in error and applicant did not intend its motion as a petition to the Director. As discussed, filing such a petition would require a filing fee and the opposition would not be stayed while the petition is pending. Trademark Rules 2.6(a)(15), 2.146(g).

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false association, and likelihood of confusion between its registered mark MESSAGE IN A BOTTLE for communication services and applicant's mark MESSAGE IN A BOTTLE for bottles and bottle kits for sending communications, and applicant's counterclaim to cancel opposer's pleaded registration on the ground of fraud.

On May 27, 2008, during his testimony period, applicant submitted a declaration and exhibits in lieu of testimony. On March 17, 2009, the Board granted opposer's motion to strike the declaration and exhibits, and reset testimony periods in order to allow applicant to conduct a testimonial deposition.

APPLICANT'S MOTION IS DENIED

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence. *L. & J.G. Stickley, Inc. v. Ronald C. Cosser*, 81 USPQ2d 1956 (TTAB 2007) ("The record consists of ... the discovery depositions submitted by stipulation ... and the testimony of Gustav Stickley, III from a U.S. district court case, with exhibits, also submitted by stipulation."); TBMP §705. However, absent stipulation, "[e]vidence not obtained and filed in compliance with [the Board's rules] will not be considered." Trademark Rule 2.123(1).

Here, applicant argues that opposer acts unreasonably in refusing to stipulate to submission of applicant's testimony by declaration, and moves for the Board's permission to do so without a stipulation on the ground that a recent medical emergency within applicant's family precludes participation in a deposition. The supporting details regarding this medical emergency are scant. Moreover, since applicant already submitted testimony by declaration a year ago, the medical emergency plainly is not applicant's sole reason for choosing to present its case in this way. However, the most serious defect in the applicant's motion is its failure to address the impact that the grant of the motion would have upon opposer.³

In his motion applicant makes no effort to show that testimony by declaration is equivalent to testimony by deposition pursuant to Trademark Rule 2.123 in the procedural safeguards offered to opposer. That is, applicant's motion addresses only applicant's convenience, and not the potential prejudice to opposer. If applicant's motion is granted, opposer would not get notice of deposition and the prospective subjects of the testimony in advance, would not have the opportunity to attend the deposition, would not receive a transcript of the testimony

³ We give no weight to applicant's frivolous argument that, if the motion is granted over opposer's objection, opposer would not have to attend a deposition and thus would save time and money.

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prepared by a neutral third party, and most importantly, would not have the opportunity to cross-examine the witness. In these circumstances, opposer plainly is acting reasonably in refusing to stipulate to submission of applicant's testimony by declaration.

Accordingly, applicant's motion to submit testimony by declaration is denied.

Testimony dates remain as reset by the Board's order issued March 17, 2009.

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>