

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

Mailed: January 12, 2011

Opposition No. 91184529

Georgia-Pacific Consumer  
Products LP

v.

Global Tissue Group, Inc.

Jennifer Krisp, Interlocutory Attorney:

Pending before the Board is opposer's motion (filed November 19, 2010) to reopen time for expert disclosures and for leave to present expert testimony on applicant's counterclaims. The motion has been fully briefed.

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2d ed. rev. 2004). On January 11, 2011, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's counsel R. Charles Henn, Jr., applicant's counsel R. Glenn Schroeder, and the assigned Interlocutory Attorney.

The Board has thoroughly reviewed the parties' arguments and submissions, and for the sake of efficiency, does not summarize all of them herein. The Board provided the parties an opportunity to elaborate on their respective positions during the conference.

The deadline for expert disclosure in this case expired on November 2, 2009. Upon the Board's determination of subsequent motions, the close of discovery, but not the expert disclosure deadline, was reset. Such action was not inconsistent with Board practice. By way of the motion presently before the Board, filed five days prior to the close of discovery, as reset, opposer moved to reopen the expert disclosure deadline, and notified the Board of its intention to use an expert in this proceeding. Opposer concurrently submitted the declaration of its intended expert witness, Dr. Gerald L. Ford, as well as the report upon which Dr. Ford would base his testimony. Fed. R. Civ. P. 26(a)(2).

A party that retains an expert after the deadline for disclosure of expert testimony must promptly file a motion for leave to use expert testimony. See Trademark Rule 2.120(a)(2); See also *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42254 (Aug. 1, 2007). The Board has been clear that it will decide how to handle a party's late identification of an expert on a case-by-case basis. *Id.*, at 42246.

Having considered the particular circumstances of this case, including the timing of the filing of the counterclaims to which opposer asserts that its expert testimony will be relevant, the lack of indication that opposer is abusing the discovery and trial process, and the fact that opposer filed its motion (and notified applicant of its intent to use expert testimony) very shortly after having ascertained the results of

its expert's survey and accompanying report, the Board finds that opposer moved promptly for the Board's leave to use expert testimony.

In view thereof, opposer's motion to reopen expert disclosures is hereby granted. Opposer's written disclosure and report, filed November 19, 2010, are noted. Fed. R. Civ. P. 26(a)(2).

Upon a party's disclosure of plans to use expert testimony, the Board may issue an order regarding expert discovery and set a deadline for the other party to disclose plans to use a rebuttal expert. In this regard, the Board has discretion and flexibility to make any orders necessary to manage disclosure and discovery regarding experts.<sup>1</sup>

*Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. at 42254.

In the event that the Board resumes proceedings subsequent to its determination of opposer's motion for summary judgment (filed January 6, 2011, and further discussed below), the Board will, as appropriate, re-suspend proceedings, set applicant's time in which to notify the Board of its intention to employ a rebuttal expert witness, set time for limited discovery of the expert witness(es), and require the parties to notify the Board upon the completion of expert discovery and the service of information required by Fed. R. Civ. P. 26(a).

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<sup>1</sup> The parties may enter into, and are encouraged to consider, stipulations regarding the introduction of expert testimony. For example, they may agree that expert reports may be introduced in lieu of testimony. Also, they may agree to provide expert

Suspension under Trademark Rule 2.127(d)

Subsequent to the briefing of the motion to reopen, opposer moved for summary judgment under Fed. R. Civ. P. 56 with respect to its claim of a lack of bona fide intent to use the applied-for mark. Accordingly, proceedings are suspended pending disposition of the motion for summary judgment. Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. See Trademark Rule 2.127(d).

As the Board noted during the conference, further briefing on the motion for summary judgment is due in accordance with Trademark Rule 2.127(e)(1).

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testimony by affidavit or declaration, and reserve the right to conduct in-person cross-examination, if necessary.