

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

DUNN

Mailed: April 17, 2009

Opposition No. 91186473

Apex, LLC

v.

Apex Pavers, Inc

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

This case comes up on several pending contested matters, including applicant's motion to compel, filed March 20, 2009. The Board held a phone hearing on April 15, 2009. The participants were Brent Canning, attorney for opposer¹, Leslie Burgk, attorney for applicant, and Elizabeth Dunn, attorney for the Board.

This order will not set forth all matters discussed at the hearing but will summarize relevant points. As background the Board notes that this case involves opposer's claim that applicant's mark APEX PAVERS for various construction and installation services is likely to be

¹ Gailyc Sonia also attended the hearing on behalf of opposer but did not participate.

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confused with opposer's marks including or comprising the term APEX for a variety of services, the subject of common law use and eight pleaded registrations. Applicant's answer denied the salient allegations of the notice of opposition.

APPLICANT'S CONTESTED MOTION TO STRIKE OPPOSER'S REPLY BRIEF ON ITS MOTION TO EXTEND IS DENIED

Applicant refused to consent to newly-hired counsel for opposer's request for additional time to respond to applicant's motion to amend its application, and then opposed opposer's motion to extend time on the grounds that it was insufficiently supported. Opposer's reply brief provides the requested detail on its reasons for seeking extension and was considered herein.

OPPOSER'S CONTESTED MOTION TO EXTEND IS GRANTED

Opposer's motion for a thirty day extension of time to respond to applicant's motion to amend the opposed application asserts that opposer retained counsel the day before the response was due and that counsel needed additional time to become familiar with the case. For good cause shown therein, opposer's motion is granted.

APPLICANT'S CONTESTED MOTION TO STRIKE OPPOSER'S OPPOSITION TO THE MOTION TO AMEND IS DENIED

Having contested opposer's motion to extend its time to respond to applicant's motion to amend, applicant's

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opposition to any extension was before the Board and there was no basis for moving to strike applicant's response on the same ground.

APPLICANT IS ORDERED TO SEEK THE BOARD'S PERMISSION BEFORE FILING ANY FUTURE MOTION TO STRIKE

Permission may be sought by phone by calling Board attorney Elizabeth Dunn at the number listed above and absent permission being granted, no consideration will be given to any motion to strike filed by applicant.

THE PARTIES ARE ORDERED TO SEEK A PHONE HEARING ON ANY DISPUTED SCHEDULING MATTERS

Any contested motion to extend or to reopen a party's time for taking action will be heard by the Board by telephone. After making a good faith but unsuccessful attempt to seek consent to a scheduling change, the movant should determine when the parties are available for a phone hearing and then contact Board attorney Elizabeth Dunn at the number listed above to request a hearing. The Board will determine whether written briefing is necessary or whether the motion and opposition may be presented by phone.

No call is necessary if the parties agree to a scheduling change and file a stipulation with the Board.

APPLICANT'S MOTION TO AMEND ITS APPLICATION IS DEFERRED

On January 3, 2009, applicant moved to amend the dates of use listed in its opposed application. The application

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filed July 31, 2007 listed June 1, 2006 as its date of first use anywhere and in commerce and by its motion applicant seeks to amend the dates to July 17, 2006 for its date of first use anywhere and September 12, 2006 as its date of first use in commerce. Opposer filed an opposition to the amendment.²

The Board will defer determination of the unconsented motion to amend in substance until final decision, or until a case is decided upon summary judgment. See *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990).

APPLICANT'S MOTION TO COMPEL IS DENIED

As discussed, opposer's responses to applicant's discovery requests served January 5, 2009 were due February 9, 2009, and on January 22, 2009, opposer retained counsel who requested an extension of time to respond to the discovery requests. When the requested extension was denied, opposer filed timely discovery responses but stated that lack of time precluded obtaining all requested information and that the responses would need to be

² As discussed, the amendment to the dates in these circumstances will not constitute a fraud claim. See *Western Worldwide Enterprises Group Inc. v. Qingdao Brewery*, 17 USPQ2d 1137, 1141 (TTAB 1990) ("the fact that a party has set forth an erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing date of the application").

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supplemented.³ On February 20, 2009, applicant mailed opposer a letter outlining perceived deficiencies in the discovery responses. On February 26, 2009, opposer contacted applicant to request time to supplement the discovery responses and applicant refused the extension. On March 6, 2009, applicant filed the instant motion to compel supplemental responses.

A party seeking discovery has a duty to make a good faith effort to determine why no response has been made before coming to the Board with a motion to compel. See, e.g., *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979). In these circumstances, it is clear that applicant was aware why only partial responses were made - opposer twice retained new counsel who requested time to become familiar with case. Applicant's February 20, 2009 letter was in no way an offer to meet or confer, but merely an announcement of its intention to seek Board intervention if opposer failed to meet applicant's terms. Accordingly, applicant failed to comply with the requirements of Fed. R. Civ. P. 26(g) and Trademark Rule 2.120(e)(1) to make a good faith effort to resolve the parties' discovery dispute

³ Due to a technical problem explained to applicant at the time, the responses were filed one day late. In these circumstances the Board exercises its discretion and accepts the responses as timely.

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without the Board's intervention. Applicant's motion to compel is denied without prejudice.

As noted at the hearing, the Board's standard protective order is in effect, and no discovery responses should be withheld on the basis of confidentiality. The Board has collected and made available many cases outlining information deemed discoverable in Board proceedings in the Trademark Trial and Appeal Board Manual of Procedure (TBMP) §414 Discovery Guidelines (2nd ed. rev. 2004). The parties are urged to review these materials before refusing to produce any information, and are also urged to make a good faith effort to cooperate in discovery.

PURSUANT TO THE PARTIES' STIPULATION, DISCOVERY IS EXTENDED TO JUNE 25, 2009

Expert Disclosures Due	5/26/09
Discovery Closes	6/25/09
Plaintiff's Pretrial Disclosures	8/9/09
Plaintiff's 30-day Trial Period Ends	9/23/09
Defendant's Pretrial Disclosures	10/8/09
Defendant's 30-day Trial Period Ends	11/22/09
Plaintiff's Rebuttal Disclosures	12/7/09
Plaintiff's 15-day Rebuttal Period Ends	1/6/10

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>