

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

Mailed: January 16, 2009

Opposition No. 91187033

David C McGowan

v.

Key Curriculum Press, Inc.

Frances S. Wolfson, Interlocutory Attorney:

On January 5, 2009, at approximately 3:00PM EST, the Board held a telephone conference among Mr. Dave McGowan, opposer, Mr. Eugene Pak, counsel for applicant, and the above signed Board attorney, to discuss applicant's uncontested motion to dismiss the proceeding and opposer's cross-motion to amend the notice of opposition.

During the phone conference, the Board explained generally the nature of notice pleading and the discovery and trial process, and granted the parties' cross motions. The parties also asked the Board to assist them in conducting their discovery conference and the Board agreed.

Consequently, pursuant to Fed. R. Civ. P. 26(f), the parties further discussed the claims and defenses in this case, the possibility of settlement and the actions each would take in

the event settlement was not reached. Initially, the parties confirmed that they are not involved in other litigation or Board proceedings involving opposer's pleaded marks or applicant's mark.

Nature of and Basis for Claims and Defenses

Opposition has been filed against registration of the mark SKETCHPAD for "Computer software for use in all levels of education on the subject of mathematics, geometry, and mathematical visualization and instruction manuals therefor sold as a unit; prints and publications, namely, books and manuals on the subject of mathematics, geometry, and mathematical visualization." Opposer claims that the mark is generic for the specified goods. Inasmuch as the notice of opposition, as filed, fails to state a claim upon which relief may be granted, the Board grants opposer time to replead. The Board reviewed the requirements with opposer for a proper pleading under Rule 8(a) of the Federal Rule of Civil Procedure, made applicable this proceeding by Trademark Rule 2.116(a).¹ Pursuant to the schedule set

¹ Federal Rule 8, in pertinent part, reads as follows:

Rule 8. General Rules of Pleading

(a) Claims for Relief.

A pleading that states a claim for relief must contain:

(1) a short and plain statement of the grounds for the court's jurisdiction, unless the court already has

forth below, opposer is allowed time to file an amended notice of opposition and applicant is allowed time to file its answer.

Possibility of Settlement

The parties had not yet discussed settlement before the conference. However, the parties agreed to stay on the line to discuss settlement after the Board disconnected from the call. In a follow-up telephone conference held January 15, 2009, the parties indicated that possible scenarios for settlement had been discussed.

The Board also recommended that the parties file papers via the Board's electronic filing system ("ESTTA") and the parties agreed to the use of e-mail for service of papers.² Papers served by e-mail that require a response are not entitled to receive the additional "5 day response time" provided under Trademark Rule 2.119(c).³

jurisdiction and the claim needs no new jurisdictional support;

(2) a short and plain statement of the claim showing that the pleader is entitled to relief; and

(3) a demand for the relief sought, which may include relief in the alternative or different types of relief.

² Opposer's counsel indicated that the firm requests that the following address be included on all e-mail sent to counsel regarding this matter: "ttabdocket@dlapiper.com."

³ That rule reads, in pertinent part: "Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper

Arrangements Relating to Disclosures, Discovery and Introduction of Evidence at Trial

If the parties are unable to reach a settlement, the case will proceed to the disclosure, discovery and trial phases. The mutual exchange of initial disclosures is required within 30 days from the opening of the discovery period, and initial disclosures must be made before traditional discovery requests may be propounded or a motion for summary judgment filed (except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Board). Trademark Rules 2.120(a)(3) and 2.127(e)(1). The Board assured the parties that any confidential material may be designated as such and provided in accordance with the Board's standard protective order, which has been automatically made applicable to this proceeding.⁴ Both parties indicated their familiarity with the Board's standard protective order.

The parties agreed to consider limiting the scope of discovery and the Board suggested ways the parties could streamline the proceeding, such as by entering into a stipulation of facts not in dispute; accepting affidavit authentication of documents produced during discovery or as a result of initial disclosures, including internet

is served by first-class mail, 'Express Mail,' or overnight courier, 5 days shall be added to the prescribed period.

⁴ The terms of the standard order may be modified by agreement of the parties and approval thereof by the Board.

evidence; and stipulating not to use expert witnesses. Given that the claim in this case is that applicant's mark is generic, the case is not considered a typical candidate for accelerated case resolution ("ACR").

In view of the grant of the parties' cross motions, opposer is allowed until THIRTY DAYS from the mailing date of this order to file and serve an amended notice of opposition, and applicant is allowed until THIRTY DAYS from the date of service of opposer's amended notice to file an answer.

Trial dates, including disclosure dates and the close of discovery, are reset as indicated below.

Discovery Opens	4/5/09
Initial Disclosures Due	5/5/09
Expert Disclosures Due	9/2/09
Discovery Closes	10/2/09
Plaintiff's Pretrial Disclosures Due	11/16/09
Plaintiff's 30-day Trial Period Ends	12/31/09
Defendant's Pretrial Disclosures Due	1/15/10
Defendant's 30-day Trial Period Ends	3/1/10
Plaintiff's Rebuttal Disclosures Due	3/16/10
Plaintiff's 15-day Rebuttal Period Ends	4/15/10

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.

ELECTRONIC RESOURCES:

Below, the Board provides general information regarding its electronic resources.

The Trademark Trial and Appeal Board Manual of Procedure (TBMP) and Title 37 of the Code of Federal Regulations (the Trademark Rules of Practice) are both available on the USPTO website, www.uspto.gov. The first revision of the second edition (March 2004) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.

Title 37 of the Code of Federal Regulations has been posted on the USPTO web site at <http://www.uspto.gov/web/offices/tac/tmlaw2.html>.

Other useful databases include the ESTTA filing system for Board filings, available on the USPTO website, and TTABVUE for status and prosecution history. The files of this Board proceeding can be examined using TTABVUE, accessible at <http://ttabvue.uspto.gov>. (after entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.)

GENERAL INFORMATION FOR PRO SE PARTIES:

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, disclosure obligations, discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. *See, generally* TBMP § 700 "Trial Procedure and Introduction of Evidence."

While Patent and Trademark Rule 10.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel. While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991).

Some rules to pay particular attention to are discussed below.

1. Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. The Board will accept as *prima facie* proof of service, a statement signed by the filing party, or by its attorney, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon [insert party, either opposer or applicant] by forwarding said copy, via [state method, ex. first class mail postage prepaid, or e-mail] to: [insert name and address].

The certificate of service must be signed and dated. See also TBMP §113 (2d ed. rev.)

2. Any paper that is required to file with the Board must be received by the Board by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 and 2.198 is utilized.

3. Papers filed with the Board should not take the form of a letter; proper format should be utilized. The form of submissions is governed by Trademark Rule 2.126. See also TBMP § 106.03 (2d ed. rev. 2004).

4. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party. See TBMP § 117.07 (2d ed. rev. 2004).

These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations.

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>