

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

Lykos

Mailed: April 16, 2010

Opposition No. 91188993

Rolex Watch U.S.A., Inc.

v.

AFP Imaging Corporation

Angela Lykos, Interlocutory Attorney

Opposer's motion (filed March 10, 2010) for leave to amend its notice of opposition to add an additional claim is granted as conceded. See Fed. R. Civ. P. 15(a) and Trademark Rule 2.127(a). The amended notice of opposition filed concurrently therewith is accepted and is now the operative pleading in this proceeding. Applicant is allowed until **twenty (20) days** from the mailing date of this order to file an answer to the amended notice of opposition.

It is further noted that on March 23, 2010, opposer notified the Board of its timely disclosure to applicant of plans to use expert testimony.¹ Accordingly, **upon the filing and service of applicant's answer**, proceedings herein

¹Opposer's consented motion (filed February 12, 2010) to extend the deadline for making expert disclosures is granted. See Trademark Rule 2.127(a).

are automatically suspended for **SIXTY (60) days** pending the parties' compliance with Fed. R. Civ. P. 26(a)(2) and the exchange of discovery limited to planned expert testimony, including that of any rebuttal expert. Trademark Rule 2.120(a)(2).²

To the extent that the use of experts did not form part of the parties' discovery conference discussions, the parties shall promptly confer on the arrangements for the completion of disclosures relating to planned expert testimony, including any testimony by a rebuttal expert, and for exchanging and responding to discovery requests, if any, related to the identified experts. Such discussions should also encompass stipulations regarding the introduction into evidence of the testimony of expert witnesses, for example, whether in lieu of testimony, the parties introduce the expert report(s), whether the expert testimony may be provided by affidavit or declaration³, or whether the witnesses will present testimony and discuss exhibits in testimony depositions.

² Trademark Rule 2.120(a)(2) states, in part:
Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.

³ Parties that stipulate that the testimony of a witness may be introduced by affidavit or declaration may also reserve the right to conduct in-person cross-examination, if necessary.

Federal Rule 26(a)(2) provides that a party planning to use an expert solely to contradict or rebut an adverse party's expert must disclose such plans within thirty days of the adverse party's prior disclosure. However, Trademark Rule 2.120(a)(2) also provides that the Board may set a deadline for disclosing plans to use a rebuttal expert. Accordingly, if applicant has not already complied with the requirements of the federal rule, it is allowed until **THIRTY (30) days from the date of this order** to disclose any planned rebuttal expert testimony. Federal Rule 26(a)(2) also details what information and materials must be provided for a party to satisfy its disclosure obligation with respect to experts. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42246 (Aug. 1, 2007).

Upon the completion of expert discovery and the service of information required by Federal Rule 26(a)(2), the parties must inform the Board so that proceedings may be resumed.