

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

Mailed: January 21, 2011

Opposition No. 91178758
(parent case)
Opposition No. 91192099

McDonald's Corporation

v.

McSweet LLC

Jennifer Krisp, Interlocutory Attorney:

Request for Admission

Pending in Opposition No. 91192099 is opposer's motion (filed December 1, 2010) to withdraw its response to applicant's Request for Admission No. 105. The motion is 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 19, 2011, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's counsel John A. Cullis, applicant's counsel Katherine Hendricks, and the assigned Interlocutory Attorney.

The Board has review the parties' arguments and submissions. For efficiency, this order does not repeat

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them, but rather summarizes applicable authorities and the Board's findings.

Opposer submitted, with its motion, a proposed supplemental response to Request for Admission No. 105.

The prevailing authority, Fed. R. Civ. P. 36(b) states, in pertinent part:

A matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended. Subject to Rule 16(e), the court may permit withdrawal or amendment if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits.

Emphasized throughout the Federal Rules of Civil Procedure is the importance of resolving actions on the merits whenever possible. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 (TTAB 1989). "[T]he decision to allow a party to withdraw its admission is quintessentially an equitable one, balancing the rights to a full trial on the merits, including the presentation of all relevant evidence, with the necessity of justified reliance by parties on pre-trial procedures and finality as to issues deemed no longer in dispute." *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1308 (TTAB 2007) (citation omitted).

Applying Fed. R. Civ. P. 36(b) to the circumstances presented here, allowing opposer to enter its proposed supplemental response would promote the presentation of the merits of Opposition No. 91192099. Specifically, factual

issues underlying the claims in this proceeding are whether, where and in what manner opposer's goods are offered for sale, and the request at issue is relevant to these issues. Allowing the admission to stand would have a preclusive effect on the presentation of facts which are, or may be, in actual dispute regarding these issues. Accordingly, allowing opposer's supplemental response may aid the Board in ascertaining the merits of the grounds for opposition.

The element of prejudice relates to the specific difficulties a party may face caused by a sudden need to obtain evidence upon the withdrawal or amendment of an admission, and the Board takes into consideration whether any potential prejudice can be mitigated by extending the discovery period. See *Giersch*, 85 USPQ2d at 1308-09. Inasmuch as timing is a factor that is often relevant to prejudice, it is noted that opposer sought to amend its admission 19 days prior to the close of discovery (as previously reset on April 21, 2010),¹ and two months after the admission was made. Accordingly, while opposer filed its motion in the latter part of the proceeding, trial had not yet commenced. See *Hadley v. U.S.*, 45 F.3d 1345 (9th Cir. 1995).

While applicant asserts that it "would likely have to take one or more depositions of Opposer's personnel" (applicant's brief, p. 5), this does not appear to pose an unrealistic burden. The record does not indicate that applicant's

¹ It is noted that the parties subsequently stipulated to extend discovery until January 18, 2011, by way of their December 17, 2010 motion.

reliance, thus far, on opposer's initial response to Request for Admission No. 105 has created actual prejudice to it that cannot be remedied through an extension of discovery, and applicant's need to move forward on ascertaining evidence regarding the matter that was originally admitted, although potentially burdensome, does not rise to the level of prejudice that would justify a denial of a motion to withdraw or amend an admission regarding a factual issue in dispute. *Hadley v. U.S.*, 45 F.3d at 1349. Applicant has not identified, for example, any witness or evidence which has become unavailable since the time that opposer served its original response.

In view of these circumstances, and on balance, opposer's motion to withdraw its response to Request for Admission No. 105 is hereby granted, and its proposed supplemental response to Request for Admission No. 105 is accepted as its amended response.

Consolidation

Also before the Board is opposer's motion (filed December 15, 2010, in each opposition proceeding) to consolidate. Inasmuch as the two proceedings involve the same parties and claims, and the same marks, and inasmuch as consolidation would be in the interest of judicial economy, the Board finds that consolidation is appropriate.²

² Furthermore, it is noted that applicant, in its January 4, 2011 brief, indicates agreement with respect to the appropriateness of consolidation, given the procedural postures of the cases at this time.

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Accordingly, opposer's motion is granted. See Fed. R. Civ. P. 42(a); TBMP § 511 (2d ed. rev. 2004).

Opposition Nos. 91178758 and 91192099 are hereby consolidated and may be presented on the same record and briefs. **Opposition No. 91178758** is hereby designated as **the "parent case."** From this point forward, all motions and papers filed with the Board are to be filed in the parent case only, and must caption both opposition proceedings, listing and identifying the parent case first (see caption hereinabove).

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The final decision will be filed in each proceeding.

Schedule

As noted during the conference, Opposition No. 91178758 was filed *prior to* the effective date of the Rules of Procedure as amended and effective November 1, 2007 ("amended rules"), whereas Opposition No. 91192099 is governed by said amended rules. See generally, *Notice of Final Rulemaking*, 72 Fed. Reg. 42242 (Aug. 1, 2007). In this situation, it is necessary to place the consolidated proceedings on a schedule that accounts for the requirements (e.g. pre-trial disclosure requirements) that are unique to the amended rules, and said requirements pertain only to the proceeding to which they apply (Opposition No. 91192099).

It is further noted that opposer filed a timely expert disclosure in Opposition No. 91192099, and opposer's counsel confirmed that opposer has complied with the disclosure and service requirements of Fed. R. Civ. P. 26(a)(2). Applicant's counsel confirmed that applicant did not file a rebuttal expert witness disclosure, and that applicant did not presently plan to do so.

The parties' stipulation, filed January 18, 2011 in Opposition No. 91192099, sets forth a proposed discovery and trial schedule that accounts for 1) pretrial disclosures, and 2) the counterclaim filed therein.³

Accordingly, the close of discovery, and trial and briefing periods, are hereby reset as set forth in the parties' January 18, 2011 stipulation.

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.

³ On January 14, 2011 in Opposition No 91178758, petitioner's reply in support of its motion to consolidate requested the adoption of the schedule set forth therein in the Board's December 7, 2010 order. Shortly thereafter, the January 18, 2011 stipulation in Opposition No. 91192099 was filed. The Board appreciates that the parties conferred in order to ascertain a mutually agreeable modified schedule. See Trademark Rules 2.120(a)(2) and 2.120(a)(3); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767 (TTAB 2008).

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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.