

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

Mailed: July 25, 2012

Opposition No. 91201001

Victoria's Secret Stores
Brand Management, Inc.

v.

Yael Mamroud/ Cummins

**Robert H. Coggins,
Interlocutory Attorney:**

This case comes up on opposer's motion to extend the close of discovery by 60 days, and applicant's cross-motion to extend its time to provide discovery responses by 180 days.

Telephone Conference

On July 24, 2012, at approximately 2:00 p.m. EDT, the Board exercised its discretion and conducted a telephone conference to resolve the motion. Participating in the conference were Yael Mamroud, president of applicant, and Mark Cummins, an officer and general manager of applicant, appearing *pro se*; Kevin C. Parks, counsel for opposer; and the above-referenced Board attorney responsible for resolving interlocutory matters in this case.

The Board considered the arguments raised by both parties in the motion and cross-motion, and the statements made by the

parties during the conference. The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize all of the parties' statements and arguments raised in the motions, briefs, or during the telephone conference. Instead, this order lists the decisions made by the Board.

Change of Address

Opposer's change of correspondence address (filed May 17, 2012) was noted.

Motion to Amend Application

Applicant made an oral motion to amend the application to correct a mistake in the manner in which the name of the applicant is set out in the application. See TMEP § 1201.02(c) (Correcting Errors in How the Applicant Is Identified); and TBMP § 514 (3d ed. rev. 2012) (Motion to Amend Application or Registration). Specifically, applicant moved to amend applicant's name to 9226-8754 Quebec Inc. DBA Vitamine & Sea. When the application was filed, Yael Mamroud/Cummins was identified as the owner of the mark, and the legal entity of the owner was listed as a Canadian corporation.

"If the original application reflects an inconsistency between the owner name and the entity type, for example, an individual and a corporation are each identified as the owner in different places in the application, the application may be amended to clarify the inconsistency." TMEP § 1201.02(c). In

particular, “[i]f the information in the ‘owner section’ of a TEAS application form is inconsistent with the information in the ‘entity section’ of the form, the inconsistency can be corrected, for example, if an individual is identified as the owner and a corporation is listed as the entity, the application may be amended to indicate the proper applicant name/entity.” *Id.* Such appeared to be the case at issue and this was the basis for applicant’s oral motion.

However, inasmuch as (1) an application which is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party and the approval of the Board, or except upon motion granted by the Board; (2) opposer did not give its consent to the proposed amendment during the conference, but instead asked for time to investigate the issue; and (3) an unconsented motion to amend in substance is generally deferred by the Board until the case is decided upon summary judgment or final decision; the Board deferred consideration of the oral motion to amend. Opposer was allowed until August 31, 2012, in which to file its consent or otherwise object in writing to the motion.

Cross-Motions to Extend

The Board noted that applicant’s brief in opposition was due June 1, 2012, but was not received by the Board until June 4, 2012. The Board stated that a foreign party generally

cannot receive the benefit of a certificate of mailing. See TBMP § 110.09 (3d ed. rev. 2012). The Board also stated that the format of filings is governed by Trademark Rule 2.196, which provides that paper submissions must be double-spaced and paginated. Notwithstanding the technical deficiencies with applicant's brief and cross-motion, the Board exercised its discretion to consider applicant's filing.

Opposer's discovery requests, served May 15, 2012, were deemed timely. Applicant was advised that, because interrogatories, requests for production, and requests for admissions may be served until the closing date of discovery, a responding party may not object to such discovery requests on the ground that responses would be due after the close of discovery. TBMP § 403.03 (3d ed. rev. 2012). Inasmuch as opposer served a paper copy of the discovery requests on May 15, 2012, applicant's responses would normally be due on or before June 19, 2012.

After a discussion with the parties, applicant's motion was granted to the extent that applicant's responses to opposer's discovery requests are due on or before November 19, 2012, and opposer's motion was granted to the extent that discovery will close January 19, 2013.¹

¹ The Board is aware of the Canadian action between the parties, which is mentioned in opposer's motion; however, inasmuch as the subject application was filed under Section 1(b) of the Trademark Act, the Canadian action does not appear to have a bearing on this Board proceeding.

Pro Se Information

Although Patent and Trademark Rule 11.14(e) permits a company to represent itself in a Board proceeding, it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters. If applicant does not retain counsel, then applicant will have to familiarize itself with the rules governing this proceeding. Compliance with the Trademark Rules of Practice and all other applicable rules is expected of all parties, even those representing themselves.

Applicant may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the Board's homepage at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. The Board's homepage provides electronic access to these and other materials including the Board's standard protective order, answers to frequently asked questions, the ESTTA filing system² (<http://estta.uspto.gov>) for Board filings, and TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) where a party may view the case status and prosecution history of any Board proceeding.

Schedule

Dates were reset on the following schedule.

² Use of electronic filing with ESTTA is strongly encouraged. ESTTA operates in real time. See TBMP § 110.09 (3d ed. rev. 2012).

Opposer's Response to Applicant's Motion to Amend Due	8/31/2012
Applicant's Responses to Opposer's May 15th Discovery Requests Due	11/19/2012
Expert Disclosures Due	12/19/2012
Discovery Closes	1/18/2013
Plaintiff's Pretrial Disclosures	3/4/2013
Plaintiff's 30-day Trial Period Ends	4/18/2013
Defendant's Pretrial Disclosures	5/3/2013
Defendant's 30-day Trial Period Ends	6/17/2013
Plaintiff's Rebuttal Disclosures	7/2/2013
Plaintiff's 15-day Rebuttal Period Ends	8/1/2013

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.