

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

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Mailed: May 29, 2013

Opposition No. 91202126

Zynga Inc.

v.

Next Thing Productions,  
Incorporated

**Benjamin U. Okeke, Interlocutory Attorney:**

Now before the Board is opposer's notification, filed March 20, 2013, advising the Board that opposer has retained expert witnesses whom it may rely upon at trial to present evidence, and has served the required expert disclosures upon applicant pursuant to Fed. R. Civ. P. 26(a)(2), is noted. Additionally, on April 19, 2013, applicant filed a proposed amendment to its application Serial No. 85196735, with opposer's consent.

By the proposed amendment applicant seeks to change the identification of goods to delete the following struck language and add the following underlined language:

~~Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones;~~ Computer software featuring musical sound recordings and musical video recordings; Computer software for conveying lessons and drills that teach enunciation, vocabulary, reading, mathematics, social skills and personal care by employing music, animation

**Opposition No. 91202126**

and games in imaginary environments; Computer software for conveying lessons and drills that teach enunciation, vocabulary, reading, mathematics, social skills and personal care by employing music, animation and games intended for educational or therapeutic purposes, in imaginary environments that may be downloaded from a global computer network; all the aforementioned goods intended for educational or therapeutic purposes.

The amendment is unacceptable because it impermissibly broadens the scope of the identification as it appeared at publication. In particular, the addition of the clause "[c]omputer software featuring musical sound recordings and musical video recordings" is outside the scope of the prior identification. This clause does not contain any limiting language that would bring this new clause within the scope of any of the goods previously listed, which were either computer gaming software or software featuring an educational or instructional function.

Accordingly, the parties' consent motion to amend the subject application is **DENIED** without prejudice. The proposed amendment will not be entered; the identification of goods as it appeared at the time of publication will remain operative.

The parties are encouraged to continue settlement efforts.

In light of opposer's notice of expert disclosures, proceedings are suspended pending the parties' compliance with Fed. R. Civ. P. 26(a)(2) and the exchange of discovery

**Opposition No. 91202126**

limited to planned expert testimony, including that of any rebuttal expert. Trademark Rule 2.120(a)(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 will introduce the expert report(s), whether the expert testimony may be provided by affidavit or declaration, or whether the witnesses will present testimony and discuss exhibits in testimony depositions.

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 DAYS** from the mailing date of this order to disclose any

**Opposition No. 91202126**

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.

Upon the resumption of proceedings, the remaining time for discovery, and the trial dates will be reset.