

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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BUO

Mailed: March 29, 2016

Opposition No. 91207895

Hokie Objective Onomastics Society LLC

v.

*Virginia Polytechnic Institute and State
University*

Benjamin U. Okeke, Interlocutory Attorney:

This case now comes up for consideration of Applicant's motion, filed December 23, 2015, to strike "*Opposer's First, Third and Fourth Notices of Reliance or in the Alternative Motion Under Fed. R. Civ. P. 36(B) to Withdraw the Admissions.*" The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision. The motion is fully briefed.

Trademark Rule 2.120(j) provides for the introduction, by notice of reliance, of responses to written discovery, including admissions. Rule 2.120(j) states in relevant part:

- (3) (i) an answer to an interrogatory, an admission to a request for admission, or a written disclosure (but not a disclosed document), which may be offered in evidence under the provisions of paragraph (j) of this section, may be made of record in the case by filing ... a copy of the request for

admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto) ... together with a notice of reliance.

37 C.F.R. § 2.120(j)(3)(i). *See also* TBMP § 704.09 (2014).

As pertinent here, Opposer submitted, as exhibits in connection with its first, third and fourth notices of reliance, copies of its first, third and fourth sets of discovery requests, including Opposer's requests for admission. 42, 60 and 63 TTABVUE. Specifically, Opposer asserts that these requests have been deemed admitted inasmuch as Applicant "appears to have made a practice of waiting until shortly before a discovery response deadline and then filing a motion in order to suspend its obligation to serve a response," and "[s]ometimes ... has cut things very close, leaving itself just a couple of days' leeway (or, arguably, no leeway at all)," and consequently served certain responses after they were due. 71 TTABVUE 2. Opposer alleges that despite the Board's suspension orders, issued in light of Applicant's motions for summary judgment, Applicant miscalculated the time to serve, and in any event neglected to timely serve its responses to Opposer's requests for admission, thereby rendering those requests admitted by operation of Fed. R. Civ. P. 36(a)(3).

Evidence timely and properly introduced by notice of reliance under the applicable Trademark Rules of Practice generally will not be stricken, but the Board will consider any objections thereto in its evaluation of the probative value of the evidence at final hearing. *See M-Tek Inc. v. CVP Sys. Inc.*, 17 USPQ2d 1070, 1073 & n.2 (TTAB 1990).

Accordingly, inasmuch as Applicant has not alleged any deficiency in Opposer's notice of reliance or the nature of the evidence submitted therewith, Applicant's motion to strike Opposer's First, Third and Fourth Notices of Reliance is **DENIED**.

However, upon motion under Fed. R. Civ. P. 36(b), the Board may permit withdrawal or amendment of admissions when: (1) the presentation of the merits of the proceeding will be subserved by their withdrawal, and (2) the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice that party in maintaining its action on the merits. Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1308-09 (TTAB 2007) (motion to withdraw effective admissions granted). The type of prejudice envisioned by this rule is the loss of witnesses or evidence, not merely that Opposer would now have to prove its case, which Opposer was presumably prepared to do prior to this impasse. *See Giersch*, 85 USPQ2d at 1309. Opposer has shown no such prejudice.

In any event, Trademark Rule 2.127(d) reads in full:

When any party files a motion to dismiss, or a motion for judgment on the pleadings, *or a motion for summary judgment*, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

37 C.F.R. § 2.127(d) (emphasis added).

The language of Rule 2.127(d) belies Opposer's argument that the retroactive suspension of proceedings in light of the filing of a potentially dispositive motion "does not apply to motions for summary judgment." 71 TTABVUE 3. In fact, Opposer bases much of its argument on language contained in the TBMP, however, the TBMP is not statutory as Opposer suggests, but is merely a guide to the Board's practice and procedures. *See* TBMP § 101.05. Therefore, any "surplusage" perceived by Opposer is of no moment. 71 TTABVUE 4.

In both suspension orders mentioned by Opposer, the Board cites to Rule 2.127(d). Indeed, the Board's October 23, 2014 order concludes:

In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures.

32 TTABVUE 1 (citing TBMP § 528.03).

Opposer, however, aptly argues that notwithstanding the applicability of Trademark Rule 2.127(d), there is no bright-line rule that the Board must automatically suspend the proceeding in light of a potentially dispositive motion, and that suspension is within the discretion of the Board. Further, as Opposer intimates, its interpretation of the Board's suspension orders is not inherently inconsistent with the language of the suspension orders or the strictures of Trademark Rule 2.127(d), which provides the Board discretion to decide whether or not to stay all activity in a proceeding in light of a potentially dispositive motion.

However, the Board's practice is to treat a proceeding that is being suspended under Trademark Rule 2.127(d) as if it had been suspended as of the filing date of the

potentially dispositive motion. *See Leeds Techs. Ltd. v. Topaz Commc'ns Ltd.*, 65 USPQ2d 1303, 1305-06 (TTAB 2002); *Elec. Indus. Ass'n v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999). Additionally, where such a suspension creates discovery issues, the Board may exercise its discretion to find that the filing of a potentially dispositive motion provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests. *See Leeds Techs. Ltd.*, 65 USPQ2d at 1306, 1307-08.

Therefore, according to the Trademark Rules of Practice and established law, suspension pending disposition of a potentially dispositive motion is within the Board's discretion, and where the Board finds good cause to do so, the Board may relieve a party of its outstanding discovery obligations in light of such a suspension. Opposer itself attests to this discretion. 71 TTABVUE 6.

Finally, Applicant's motion to strike and alternative motion to withdraw these admissions makes clear that the issues identified in the requests for admission are disputed. Therefore, presentation of the merits of the case would not be served by allowing these admissions to stand. *See Johnston Pump/General Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989).

Accordingly, in light of the foregoing and the Board's preference to decide cases on the merits, Applicant's motion to withdraw its admissions and have its responses served January 15, 2014, and August 31, 2015, including the supplemental responses served September 18, 2015, deemed timely, is **GRANTED**.

Schedule

The proceeding is **RESUMED**. The remaining disclosure and trial dates are reset as follows:

Defendant's Pretrial Disclosures	4/10/2016
Defendant's 30-day Trial Period Ends	5/25/2016
Plaintiff's Rebuttal Disclosures	6/9/2016
Plaintiff's 15-day Rebuttal Period Ends	7/9/2016

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 Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.