

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: August 7, 2015

Opposition No. 91209617

Xikar, Inc.

v.

Debra Wiseberg

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of unconsented filings, including Applicant's July 10, 2015 motion to suspend proceedings for twenty days, and Opposer's July 16, 2015 motion to suspend proceedings for an additional twenty days. The motions are fully briefed.

Fee

In the July 1, 2015 order, the Board noted that no counterclaim fee had been applied to Registration No. 2200215, and thus required Applicant to submit the fee. The parties thereafter expended much effort in briefing this issue.¹ However, the following discussion disposes of this issue.

Subsequent to the July 1, 2015 order, the Board ascertained that on April 17, 2013, the USPTO finance office erroneously applied the \$300.00 fee,

¹ The Board finds no merit in or authority for Opposer's argument that Applicant "has not yet paid for the most recently filed counterclaim" because the original fee was paid for the counterclaim that was stricken.

which Applicant submitted with the April 15, 2013 filing, to application Serial No. 85652496. Also, the finance office did not code the payment as a counterclaim fee. These erroneous applications of the fee are shown in the finance office stamp on page 1 of the April 15, 2013 filing.

The Board has had the finance office rectify this by applying that fee to Registration No. 2200215, and coding it as a counterclaim fee. Consequently, the record has been corrected and the requirement that Applicant submit a counterclaim fee is withdrawn.²

Applicant's motion to extend; Opposer's motion to extend

On July 10, 2015, Applicant filed an unconsented motion to suspend proceedings for twenty days, and to “postpone all trial dates and deadlines ... for 30 days.” Applicant did not state or attest that she had made any effort to obtain Opposer's consent. On July 16, 2015, Opposer filed a response stating that it consents to the suspension, and that it would have given consent if Applicant had contacted Opposer prior to filing the motion. In reply, Applicant states that she had a time constraint issue.

The better practice would have been for Applicant to make at least one good faith effort to secure Opposer's consent prior to filing the motion, and to submit a sworn declaration with her motion attesting to the effort(s) that had

² The Board notes Applicant's July 31, 2015 “Request to Remove Filing No. 43 in this Matter from the Public Record.” The Board has designated Applicant's July 14, 2015 filing as confidential. Nonetheless, Applicant's piecemeal filings of July 10, 2015 and July 14, 2015 were contrary to established Board procedure for the submission of filings that include confidential matter. *See* Trademark Rule 2.126(c); TBMP § 120.02 and 412.04 (2015). In short, the filing party should file two complete filings, one being marked confidential, and one being redacted.

been made. This was particularly imperative because the extension that Applicant requested is nearly equal to the amount of time Opposer was allowed pursuant to Trademark Rule 2.127(a) to file its response to said motion. This illustrates one of several reasons why the Board expects parties to communicate with each other to resolve issues prior to filing a motion seeking the Board's intervention, and this is particularly expected with respect to scheduling issues. Applicant states that her motion is now moot, and the parties have treated the motion as moot.

Turning to Opposer's July 16, 2015 unconsented motion in which it requests "an additional thirty (30) day extension of" trial dates, Opposer states that it "telephoned and left a message for Applicant" but does not set forth the date and time of said attempted communication. On July 31, 2015, Applicant filed a response stating that she consents to Opposer's motion.

Opposer's July 16, 2015 motion is granted. Trial dates are reset as set forth on page 2 of Opposer's motion.

Filing requirement effective as of mailing date of this order

Based on the circumstances of record that are apparent in the parties' filings of sequential unconsented motions to suspend, it is apparent that the parties are not communicating with each other often and early enough with respect to scheduling needs that arise. On a larger scale and more to the point, the parties are not making sufficient efforts to communicate in an effort to resolve matters that give rise to alleged last-minute needs to file

unconsented motions, and thus are litigating on paper in lieu of making timely and sincere efforts to cooperate with each other in the manner in which the Board expects. *Cf.* TBMP §§ 408.01 and 408.01(c) (2015). *See also Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 n.1 (TTAB 2014) (parties may not act inconsistent with the Board's expectation that they cooperate and communicate throughout proceeding); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving scheduling conflicts); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (parties failed to cooperate, thus saddling the Board with needless motions)

On rare instances, the Board finds it necessary to restrict the filing of unconsented motions so as to control the filing of motions and the course of litigation. To that end, the Board finds the following requirement to be appropriate and necessary: effective as of the mailing date of this order, neither party may file any unconsented motion in this proceeding without first contacting the assigned interlocutory attorney by telephone (571-272-9183, Monday through Friday; emails to the Board are inappropriate) to request the Board's permission to submit the filing. Any party who does contact the Board should be prepared to state what specific efforts the party has made (that is, the date(s), time(s) and manner(s)) to secure the consent or involvement of the adverse party. In the absence of a sufficient fulfillment of this requirement, the Board may deny permission to file the unconsented

motion. Furthermore, the Board may deny consideration of any unconsented motion that is filed without prior Board permission.

In addition, the Board may require the parties to teleconference with the Board attorney to address or resolve any motion or issue either prior to or subsequent to the filing of a motion. That is, the Board may require the teleconference either in lieu of or subsequent to the filing of a motion. *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2015).

Service requirement effective as of mailing date of this order

Opposer's certificates of service on its July 16, 2015 filings are incomplete, and thus ambiguous, in that they include Applicant's street address but do not specify the manner in which service was made to said address (*e.g.* by First Class mail). *See* Trademark Rule 2.119(a); TBMP § 113.03 (2015). Also, the certificates indicate service "via e-mail" to Applicant to her email address of record, although Applicant states in two filings that Opposer did not serve via email and that the parties have not agreed to service via email.

Again, to the extent that there are service-related problems, such problems appear to have been generated and unresolved due to a lack of coordination and communication between the parties. The Board finds it necessary to address the issue. Accordingly, effective as of the mailing date of this order, the parties are required to serve both by First Class mail, postage prepaid (*see* TBMP § 113.03) and by email, and shall include proof of service which sets forth the particulars of both manners of service, as required by applicable authorities. For the purpose of

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determining response times, the date and manner of service by First Class mail shall control.