

GCP

Mailed: September 3, 2013

Opposition No. 91211312

GrubHub, Inc

v.

So Within Reach, LLC

By the Trademark Trial and Appeal Board:

This case now comes before the Board for consideration of applicant's motion (filed July 29, 2013) to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6).¹ Opposer filed a timely response to the motion on August 15, 2013.

A review of applicant's motion, however, demonstrates that the motion is not based on the ground that opposer has failed to plead properly its standing and/or its asserted claim of priority and likelihood of confusion; rather, the motion argues the merits of opposer's claim. Additionally, applicant relies on matters/facts outside of the pleadings. As such, the Board construes applicant's motion as one for summary judgment. *See* TBMP § 503.04 (3d ed. rev. 2 2013).

¹ Applicant's change of correspondence address filed on August 9, 2013 is noted. Board records have been updated accordingly.

A motion for summary judgment, however, may not be filed until the moving party has provided its initial disclosures to the opposing party, except if the motion is based upon claim or issue preclusion or that the Board lacks jurisdiction to entertain the case. *See* Trademark Rule 2.127(e)(1). Inasmuch as applicant's motion is not based upon claim or issue preclusion or that the Board lacks jurisdiction to entertain opposer's claim and because the record does not demonstrate that applicant served its initial disclosures upon opposer prior to filing its July 29, 2013 motion, applicant's motion is **denied** without prejudice as premature.²

Trial Schedule

Proceedings remain ongoing.³ Trial dates, beginning with the deadline for the parties' required discovery conference, are reset as follows:

Deadline for Discovery Conference	9/23/2013
Discovery Opens	9/23/2013
Initial Disclosures Due	10/23/2013
Expert Disclosures Due	2/20/2014
Discovery Closes	3/22/2014
Plaintiff's Pretrial Disclosures Due	5/6/2014
Plaintiff's 30-day Trial Period Ends	6/20/2014
Defendant's Pretrial Disclosures Due	7/5/2014
Defendant's 30-day Trial Period Ends	8/19/2014
Plaintiff's Rebuttal Disclosures Due	9/3/2014
Plaintiff's 15-day Rebuttal Period Ends	10/3/2014

² Even if we were to consider applicant's motion as a proper motion to dismiss under Fed. R. Civ. P. 12(b)(6), we would nonetheless have denied the motion inasmuch as, after a careful review of opposer's notice of opposition, we find that opposer has set forth sufficient allegations regarding its standing and has sufficiently pleaded its claim of priority and likelihood of confusion.

³ Applicant's answer to the notice of opposition filed on August 5, 2013 is noted and accepted.

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 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.

As a final matter, the Board notes that applicant, on August 12, 2013, filed a request, via ESTTA, for Board participation in the parties' required discovery conference, setting the date and time for the conference for Wednesday, September 4, 2013 at 11:30 a.m. EDT. We first note that applicant's request for Board participation was premature inasmuch as applicant's motion to dismiss was still pending before the Board. Second, a party may not unilaterally designate the date and time for the discovery conference with Board participation. The requesting party must first get Board approval for the Board's participation and then consult with the adverse party to ascertain when both parties would be available for the discovery conference. Notwithstanding the foregoing and since the Board has now made a determination regarding applicant's construed motion for summary judgment, applicant's request for Board participation in the parties' discovery conference is GRANTED. The Board, however, is not available to participate in the discovery conference on the date and time indicated in applicant's request. Accordingly, the Board requests that the parties contact each other promptly and ascertain a mutually agreeable date and time when

both parties would be available for the discovery conference and advise the Board by emailing the interlocutory attorney assigned to this proceeding, i.e., George C. Pologeorgis, at the following email address:

george.pologeorgis@uspto.gov

Pro Se Information

It appears that applicant is representing itself in this proceeding. Applicant may do so. However, it should be noted that while Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in a Board proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure. If applicant does not retain counsel, then applicant will have to familiarize itself with the rules governing this proceeding. Strict compliance with the Trademark Rules of Practice and all other applicable rules is expected of all parties, even those representing themselves.

Electronic Resources

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 system⁴ (<http://estta.uspto.gov>) for Board filings, and TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) for case status and prosecution history.

Service of Papers

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers⁵ which applicant may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its

⁴ Use of electronic filing with ESTTA is strongly encouraged. This electronic file system operates in real time. *See* TBMP § 110.09 (3d ed. rev. 2 2013).

⁵ The form of submissions is governed by Trademark Rule 2.126. *See* TBMP § 106.03 (3d ed. rev. 2 2013).

attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "Certificate of Service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon [insert name of party served] by forwarding said copy, via [insert manner of service (e.g., first class mail)], to: [insert name and address].

The certificate of service must be signed and dated. *See* TBMP § 113 (3d ed. 2011).

Nature of Board Proceedings

Applicant is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

Representation

As referenced above, applicant is strongly encouraged to obtain trademark counsel who is acquainted with the technicalities of the procedural and substantive law involved in Board proceedings.