

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: June 4, 2014

Opposition No. 91214312

Diageo Brands B.V.

v.

Midway Trading Corp.

**M. Catherine Faint,
Interlocutory Attorney:**

On March 7, 2014, applicant/counterclaim petitioner filed a motion to amend the answer to add a counterclaim. The counterclaim seeks partial cancellation in the alternative under Section 18, 15 U.S.C. § 1068, of opposer/counterclaim respondent's involved Registration No. 3369110. On April 11, 2014, the Board granted the parties' consented motion to suspend proceedings for 60 days for settlement negotiations.

A party seeking to restrict an opponent's identification of goods or services pursuant to Section 18, in a case involving likelihood of confusion, must plead and prove that (i) the entry of a proposed restriction to the goods or services in its opponent's application or registration will avoid a finding of likelihood of confusion and (ii) the opponent is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered. *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH &*

Co. KG, 34 USPQ2d 1266, 1271 (TTAB 1994). The Board finds that the proposed pleading provides respondent with sufficient notice of the claim.

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15, made applicable to Board proceedings by operation of Trademark Rule 2.116(a). *See* Trademark Rule 2.107. Inasmuch as applicant's amended answer was filed within twenty-one days of service of the original answer, and the pleading is sufficient, the amended answer and counterclaim is **approved and entered**.

Because of the parties' subsequent motion for suspension, a date for answer to the counterclaim was not set. Further, it is unclear from the motion to suspend whether the parties have served initial disclosures. Accordingly, upon resumption, dates are reset as set out below.

Proceedings Resume	June 10, 2014
Answer to Counterclaim Due	July 10, 2014
Initial Disclosures Due	August 9, 2014
Expert Disclosures Due	December 7, 2014
Discovery Closes	January 6, 2015
Plaintiff's Pretrial Disclosures Due	February 20, 2015
30-day testimony period for plaintiff's testimony in the opposition to close	April 6, 2015
Defendant/Counterclaim plaintiff's pretrial disclosures due	April 21, 2015

30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close	June 5, 2015
Counterclaim defendant's disclosures and its rebuttal disclosures as plaintiff in the opposition due	June 20, 2015
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close	August 4, 2015
Counterclaim plaintiff's rebuttal disclosures due	August 19, 2015
15-day rebuttal period for plaintiff in the counterclaim to close	September 18, 2015
Brief for plaintiff in the opposition due	November 17, 2015
Brief for defendant in the opposition and as plaintiff in the counterclaim due	December 17, 2015
Brief for defendant in the counterclaim and its reply brief, if any, as plaintiff in the opposition due	January 16, 2016
Reply brief, if any, for plaintiff in the counterclaim due	January 31, 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 Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
