

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

RK

Mailed: July 16, 2016

Opposition No. **91222999**

Urgent Care MSO, LLC¹

v.

Videokall Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on Applicant's motion (filed April 22, 2016) to dismiss this opposition for Opposer's putative failure to prosecute. The motion is contested.

Preliminary Matters

It is noted that prior to its filings in June, Applicant failed to properly serve Opposer with any of its Board filings in contravention of Trademark Rule 2.119. Pursuant to that rule, 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 adversary), and proof of such service must be made before the paper will be considered by the Board. Applicant may not simply choose to file papers with the Board and not serve those papers on Opposer.

¹ Opposer's change of correspondence and appearance of new counsel (both filed December 9, 2015) have been noted and entered.

Proof of service usually consists of a signed, dated statement stating: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and (4) the date of service. A suggested format for the certificate of service is provided below:

I hereby certify that a true and complete copy of the foregoing (*insert title of submission*) has been served on (*insert name of opposing counsel or party*) by mailing said copy on (*insert date of mailing*), via First Class Mail, postage prepaid (*or insert other appropriate method of delivery*) to:

(set out name and address of opposing counsel or party)

Signature

See TBMP § 113 (2016).

Thus, Applicant is placed on notice that strict compliance with Trademark Rule 2.119 is required for all future papers filed with the Board.²

As for Applicant's discovery responses and requests³, such materials

² It is noted that Applicant's motion to dismiss (filed April 22, 2016) fails to indicate proof of service on Opposer. Although a responding party is allowed fifteen (15) days from the date of service of a non-summary judgment motion (plus an additional five (5) days if service is made by one of the three methods under Trademark Rule 2.119(c)) to respond, in view of Applicant's failure to serve its motion on Opposer, Opposer's response (filed June 3, 2016) has been accepted and considered on the merits by the Board.

³ Applicant should note that it may not propound discovery until it has made its initial disclosures. See Trademark Rule 2.120(a)(3).

should not be filed with the Board. Generally, requests for discovery, responses thereto, and materials or depositions obtained through the discovery process, should not be filed with the Board except when submitted (1) with a motion relating to discovery; (2) in support of or in response to a motion for summary judgment; (3) under a notice of reliance during a party's testimony period; (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. *See* Trademark Rule 2.120(j)(8). Accordingly, Applicant's discovery-related filings of June 12 and June 30, 2016, will be given no consideration.

Applicant's Motion to Dismiss for Failure to Prosecute

A motion seeking judgment based on a plaintiff's failure to prove its case pursuant to Trademark Rule 2.132 is appropriately made under subsection (a) when the plaintiff's testimony period has passed and the plaintiff has not taken testimony or offered any other evidence, or under subsection (b) when the plaintiff's testimony period has passed and the plaintiff has offered no evidence other than a copy or copies of USPTO records.

At the time of Applicant's filing of its motion to dismiss, discovery remained open. Applicant's contention that forms the basis of its motion, i.e., that Opposer "had almost 1 year in which to produce any credible arguments as to why [Applicant] should not be granted [its] trademark" but has failed to do so, misunderstands the Board's opposition process. Evidence and

arguments in support of a party's position are to be respectively presented during trial and final briefing by each party. It would be procedurally inappropriate for a party to present evidence to the Board outside of its assigned testimony period. As such, there is no basis for entering judgment against Opposer under Trademark Rule 2.132 and Applicant's motion to dismiss for failure to prosecute is **DENIED** as premature.

Applicant's Withdrawal of Application Without Prejudice

On June 30, 2016, Applicant filed an unconsented motion to expressly abandon the involved application, contingent on the Board allowing the abandonment to be without prejudice. However, Trademark Rule 2.135 provides that if, in an *inter partes* proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. Thus, Applicant may not withdraw its application without prejudice absent Opposer's written consent. See *Grinnell Corp. v. Grinnell Concrete Pavingstones, Inc.*, 14 USPQ2d 2065 (TTAB 1990). Applicant's motion to withdraw its application is therefore **DENIED**.⁴

Applicant's "Answer"

On October 27, 2015, Applicant filed a putative "answer" to the notice of opposition. It is noted, however, that Applicant's "answer" is argumentative and more in the nature of a brief on the case than a responsive pleading to

⁴ Applicant may refile its motion should it be able to obtain Opposer's written consent to withdraw its application without prejudice.

the notice of opposition. As such, it does not comply with Rule 8(b) of the Federal Rules of Civil Procedure, made applicable to this proceeding by Trademark Rule 2.116(a).

Fed. R. Civ. P. 8(b) provides:

(b) **Defenses; Admissions and Denials**

- (1) ***In General.*** In responding to a pleading, a party must:
 - (A) state in short and plain terms its defenses to each claim asserted against it; and
 - (B) admit or deny the allegations asserted against it by an opposing party.
- (2) ***Denials – Responding to the Substance.*** A denial must fairly respond to the substance of the allegation.
- (3) ***General and Specific Denials.*** A party that intends in good faith to deny all the allegations of a pleading – including the jurisdictional grounds – may do so by a general denial. A party that does not intend to deny all the allegations must either specifically deny designated allegations or generally deny all except those specifically admitted.
- (4) ***Denying Part of an Allegation.*** A party that intends in good faith to deny only part of an allegation must admit the part that is true and deny the rest.
- (5) ***Lacking Knowledge or Information.*** A party that lacks knowledge or information sufficient to form a belief about the truth of an allegation must so state, and the statement has the effect of a denial.
- (6) ***Effect of Failing to Deny.*** An allegation – other than one relating to the amount of damages – is admitted if a responsive pleading is required and the allegation is not denied. If a responsive pleading is not required, an allegation is considered denied or avoided.

The notice of opposition filed by Opposer herein consists of **25 paragraphs** setting forth the basis of Opposer's claim of damage and a prayer for relief. In accordance with Fed. R. Civ. P. 8(b), it is incumbent on Applicant to answer the notice of opposition by admitting or denying the allegations contained in each paragraph. If Applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, it should so state and this will have the effect of a denial.

In view thereof, **Applicant is hereby ordered to serve and file an amended answer in compliance with Fed. R. Civ. P. 8 no later than AUGUST 15, 2016.**

Proceedings herein are **RESUMED** and dates are **RESET** as follows:

Amended Answer Due	8/15/2016
Expert Disclosures Due	8/29/2016
Discovery Closes	9/28/2016
Plaintiff's Pretrial Disclosures Due	11/12/2016
Plaintiff's 30-day Trial Period Ends	12/27/2016
Defendant's Pretrial Disclosures Due	1/11/2017
Defendant's 30-day Trial Period Ends	2/25/2017
Plaintiff's Rebuttal Disclosures Due	3/12/2017
Plaintiff's 15-day Rebuttal Period Ends	4/11/2017

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

Pro Se Information

Applicant is not represented by legal counsel in this proceeding. While Patent and Trademark Rule 11.14(e) permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition 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.

The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this proceeding. The Trademark Act, the Trademark Rules of Practice, and the Trademark Trial and Appeal Board Manual of Procedure (TBMP) are all available on the TTAB page of the USPTO website at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. This web page also includes information on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and other relevant topics.

Applicant should note that any paper it is required to file with the Board should not take the form of a letter; proper format should be utilized. The

form of submissions is governed by Trademark Rule 2.126. *See also* TBMP § 106.03. In particular, “[a] paper submission must be printed in at least 11-point type and double-spaced, with the text on one side only of each sheet” and text “in an electronic submission must be in at least 11-point type and double-spaced.” Trademark Rule 2.126(a)(1) and 2.126(b).

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). In that regard, the parties should note that any paper they are required to file herein must be received by the Board by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 and 2.198 is utilized.

Files of TTAB proceedings can be examined using TTABVUE, accessible at <http://ttabvue.uspto.gov/ttabvue>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

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