Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Asustek Computer Incorporation

v.

Chengdu Westhouse Interactive Entertainment Co., Ltd.

Opposition No. 91225271
Application Serial No. 86217642
On Petition to the Director
Filed: November 8, 2018

Decision

On November 8, 2018, Asustek Computer Incorporation (Petitioner) petitioned the Director of the United States Patent and Trademark Office (USPTO) to reverse an interlocutory order issued by the Trademark Trial and Appeal Board (TTAB or Board). The Director has the authority to review Petitioner's request.[1] *See* 37 C.F.R. §§ 2.146(a)(3) and (e)(2). The petition is DENIED.

FACTS[2]

Petitioner filed a notice of opposition on December 8, 2015, against the registration of Application Serial No. 86217642 for the following mark[3]

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[1] Authority to decide any trademark petitions to the Director under 37 C.F.R. § 2.146 was delegated to the Commissioner for Trademarks. Subsequently, authority to decide petitions to the Director under 37 C.F.R. §§ 2.146(e)(1) and (e)(2), involving review of the grant or denial of an extension of time to file a notice of opposition, review of interlocutory orders issued by the TTAB, and review of requests to waive the Trademark Rules of Practice relating to TTAB cases was delegated to the Chief Administrative Trademark Judge. Under such delegation, the authority to decide this petition was further delegated.

[2] This decision recites only the facts relevant to the issue on petition.

[3] The mark consists of the word, "ROG", which is gold in color with a stylized black shield featuring letters, hieroglyphics, punctuation or inscriptions contained therein or

for non-downloadable on-line publications, and entertainment and educational services as well as a variety of computer related items, computer software, audio and video recordings, network communication devices, and related goods. As grounds for opposition, Petitioner alleges priority of use and likelihood of confusion, further asserting ownership of a registration for the mark iROG and of a pending application for the mark ROG both for computers, computer peripherals and related items. Trademark Act § 2(d); 15 U.S.C. § 1052(d).

The discovery period closed on August 11, 2017. 28-29 TTABVUE. The deadline for Petitioner's pretrial disclosures was Monday, September 25, 2017. *Id*. On that day, Petitioner filed a motion to compel discovery, which was fully-briefed. 30, 31, 33 TTABVUE. In an order dated January 16, 2018, the Board denied Petitioner's motion as untimely because it was not filed prior to the deadline for Petitioner's pretrial disclosures. 34 TTABVUE.

On February 8, 2018, Petitioner filed a motion for reconsideration of the Board's denial of its motion to compel as untimely. 35 TTABVUE. The motion was fully-briefed. 38, 40 TTABVUE. In a precedential order dated October 31, 2018, the Board denied Petitioner's motion for reconsideration. 41 TTABVUE.

On November 8, 2018, Petitioner filed its petition to the Director. 42 TTABVUE. Chengdu Westhouse Interactive Entertainment Co., Ltd. (Applicant) filed a response to the petition. 43 TTABVUE. Petitioner seeks reversal of the Board's order denying its motion for reconsideration and requiring the Board, effectively, to consider its motion to compel.

Petitioner asserts that it reasonably relied on Trademark Rule 2.196, 37 C.F.R. § 2.196, in filing its motion to compel on the deadline for pretrial disclosures because the day before the deadline fell on a Sunday; that the Board allowed flexibility in the transition to the amended rules of practice (which went into effect on January 14, 2017) and should have done so in this case; and that considering its motion to compel would serve justice.

Applicant disputes Petitioner's position, arguing that the rule clearly states a motion to compel must be filed prior to, not on the day of, the deadline for pretrial disclosures.

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superimposed thereon. The lower pointed tips of the shield are gold in color. TSDR Status Tab, Mark Information.

Applicant contends, as it did in its response to Petitioner's motion to compel, that its discovery responses are sufficient and it possesses no additional discoverable materials.

DISCUSSION

Standard of Review

The Director may exercise supervisory authority in appropriate circumstances. 35 U.S.C. § 2; 37 C.F.R. § 2.146(a)(3); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1707. In an *inter partes* proceeding before the Board, a party may petition the Director to review an order or decision of the Board that concerns a matter of procedure and does not put an end to the litigation before the Board. TTAB MANUAL OF PROCEDURE (TBMP) §§ 901.02(a), 905; TMEP § 1704. However, the Director will reverse an interlocutory order issued by the Board in an *inter partes* proceeding only upon a showing of clear error or abuse of discretion. *Kimberly Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r Pats. 1991); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r Pats. 1991); *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r Pats. 1983); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977). For the reasons set forth below, the circumstances presented in this case do not demonstrate that the Board committed clear error or abused its discretion.

The TTAB Did Not Commit Clear Error or Abuse Its Discretion

1. The Board did not commit clear error.

Effective January 14, 2017, the Board amended the Trademark Rules of Practice pertinent to practice before the Board. As amended, Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1), provided that "[a] motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset." *Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice*, 81 Fed. Reg. 69950, 6997 (Oct. 7, 2016). As explained in the Notice of Proposed Rulemaking, the change to the timeliness of a motion to compel was made to avoid the expense and uncertainty that arise when discovery disputes erupt on the eve of trial. *Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice*, 81 Fed. Reg. 19296 (Apr. 4, 2016).

After January 14, 2017, the Board clarified that "prior to the deadline" meant no later than the day before the due date for pretrial disclosures. *Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice; Clarification*, 82 Fed. Reg. 33804 (July 21, 2017). Specifically, Trademark Rule 2.120(f) was amended to provide

that "[a] motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset." *Id.*

The Board did not commit clear error by relying on Trademark Rule 2.120(f)(1), as amended and clarified, in finding untimely Petitioner's motion to compel.

2. The Board did not abuse its discretion.

A. The Board's reliance on the amended rules was not an abuse of discretion.

Recognizing that the procedural posture of some cases on and shortly after the effective date of the amended rules may make it difficult to comply with the amended rules, the Board expressly indicated that "[a]ny issues that may arise concerning the transition to the revised rules for cases pending as of the effective date of the rules would be addressed by the Board and the parties on a case-by-case basis, allowing for flexibility to respond to the unique needs in each case, particularly with respect to scheduling matters." 81 Fed. Reg. 19296.

The Board, in its October 31, 2018 denial of Petitioner's motion for reconsideration, declined to apply a flexible approach because the situation presented by the untimely filing of Petitioner's motion to compel did not reflect circumstances in which the schedule of a case was impacted by the implementation of the revised rules. 41 TTABVUE 4-5.

B. Applicant mistakenly relied on Trademark Rule 2.196.

Trademark Rule 2.196, 37 C.F.R. § 2.196, provides "[w]henever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by regulation under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday or Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday or a Federal holiday."

Petitioner indicated it relied upon the rule in good faith in filing its motion to compel on Monday, September 25, 2017, the due date for its pretrial disclosures. Petitioner believes its interpretation of the rule was reasonable; that is, because the last day it could file a motion to compel fell on a Sunday, it was permitted until the next business day, Monday, to file the motion. Notwithstanding any good faith reliance on its interpretation of the rule, Petitioner was mistaken. The due date for pretrial disclosures did not change because the "day before" fell on a Sunday. Filing of a motion to compel on the due date for pretrial disclosures is untimely. As the Board explained in its October 31, 2018 order, Trademark Rule 2.120(f)(1) does not fix a particular day by which a motion to compel must be filed but, instead, ensures that

any such motion be filed before the day another event (pretrial disclosures) occurs. 41 TTABVUE 2.

C. As a "precedent," the Board's order was thoroughly reviewed.

It is noted that the October 31, 2018 order is designated "A Precedent of the TTAB." 41 TTABVUE 1. The Board engages in a thorough internal review before deciding to designate as precedent an order addressing a contested motion. *See* "SELECTION OF PRECEDENTIAL DECISIONS" under "Policies & procedures" at www.uspto.gov/ttab. The review process involves consultation with the Office of the Solicitor, USPTO. *Id*. In view of the high level of review given to the order before it issued as precedent, any potential for abuse of discretion was negated.

The Board did not abuse its discretion in declining to apply a flexible approach, resulting in the denial of Petitioner's motion to compel as untimely. Nor did the Board abuse its discretion when it declined to accept Petitioner's mistaken interpretation of Trademark Rule 2.196.

3. Circumstances do not support Petitioner's position that to allow consideration of the motion to compel would serve justice.

As stated earlier, the Director will reverse an interlocutory order issued by the Board in an *inter partes* proceeding only upon a showing of clear error or abuse of discretion. The standard of review does not expressly include whether reversal of the order would serve justice. In this case, however, Applicant stated at least twice that it possesses no additional discoverable materials. Thus, even if the motion to compel were considered, because there are no further materials or information, the only result would be continued delay of this proceeding. Should Applicant attempt to introduce at trial information or material that was not provided in response to an appropriate discovery request because Applicant indicated in its responses that it had no additional information or materials, Petitioner's remedy is to object to the introduction of such material or information. *See* TBMP § 527.01(e).

DECISION

The petition is DENIED. The schedule remains as set in the October 31, 2018 order. 41 TTABVUE 5.

/Cheryl Butler/

Cheryl Butler
Senior Counsel

Trademark Trial and Appeal Board

Date: December 31, 2018

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