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: October 21, 2016

Opposition No. 91229467

HRHH IP, LLC

v.

Vice Versa Records, LLC

Robert H. Coggins,
Interlocutory Attorney:

On September 14, 2016, Applicant filed a motion for summary judgment disguised as a motion for judgment on the pleadings.

Service Issue

The motion for summary judgment includes a certificate of service indicating that a copy of the motion was served upon Opposer by email. At present, electronic service is available only when mutually agreed upon by the parties.[1] Trademark Rule 2.119(b)(6). As stated in TBMP § 113.04 (2016), "[t]he best practice is to reduce such an agreement to writing, although the agreement should not be filed with the Board unless necessary to resolve a motion."

[1] This will change January 14, 2017. *See* the "Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice" 81 Fed. Reg. 69950 (Oct. 7, 2016).

In response to Opposer's challenge of the method of service, Applicant (in its reply brief in support of its motion) alleges that – by their conduct – the parties agreed to service by electronic transmission. However, when challenged, Applicant did not produce such an agreement in writing. It does not appear that an agreement between the parties was actually made regarding service by email. In view thereof, Applicant's motion does not appear to have been properly served. Notwithstanding this lack of proper service, the Board will address Applicant's motion further.

Motion for Summary Judgment

A motion for judgment on the pleadings is test solely of the undisputed facts appearing in all the pleadings. Although the motion was titled as one "for judgment on the pleadings," it relies on matters outside the pleadings. For example, the services identified in the subject application are simply "entertainment services in the nature of recording, production, and post-production services in the field of music"; but, Applicant argues that "consumers of Applicant's services are bands and other music artists who must enter into a contract, choose to cover and collaborate with another music artist, choose a charity, coordinate recording studio time, and then actually record and thereafter produce music at the studio." Motion, p. 8 (5 TTABVUE 12). There is nothing in the plain wording of the services identified in the application that limits consumers of recording, production, and post-production music services to "choose to cover and collaborate with another music artist," "choose a charity," or "record *and* thereafter produce music at the [same] studio." Similarly, the Notice of Opposition does not contain such an allegation, so Applicant

therefore could not admit such an allegation in its answer. Applicant's arguments about its services are matters outside the pleadings.

Further, Applicant relies on third-party registrations and a response to an Office action (with exhibits H, I, and J thereto) alleged to be from the application file underlying one of Opposer's pleaded registrations, both of which Applicant previously attached to its answer; however, except for a narrow exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony (*see* Trademark Rule 2.122(c)), and the Board does not take judicial notice of third-party registrations or the papers filed during the prosecution history of registrations.[2] *See* TBMP §704.12(a). At a minimum, consideration of these matters would require the motion be treated as one for summary judgment. *See* TBMP §504.03.

Except for assertions of claim or issue preclusion or lack of jurisdiction by the Board, a motion for summary judgment may not be filed until the moving party has made its initial disclosures. Trademark Rule 2.127(e)(1); TBMP § 528.02. The deadline for making initial disclosures in this case is currently November 18, 2016. *See* institution order, p. 4 (2 TTABVUE 4). Applicant filed its motion for summary judgment on September 14, 2016, but the motion is not based on either claim or issue preclusion or lack of jurisdiction. Moreover, the motion does not contain a

[2] Moreover, while Applicant may in due course introduce any evidence which it considers to be relevant to its case, statements as to proposed evidence, such as a listing of third-party registrations, are not proper matters for pleading. *McCormick & Co., Inc. v. Hygrade Food Prods. Corp.*, 124 USPQ 16, 17, 18 (TTAB 1959) (striking from an answer a list of third-party registrations).

statement that Applicant made its required initial disclosures prior to filing the motion. *See Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255 n.7 (TTAB 2009) (if a party moves for summary judgment prior to the deadline for making initial disclosures it should indicate in its motion that the disclosures have been made).

Because Applicant's motion was filed prior to the deadline for initial disclosures, the Board presumes that Applicant has not yet made its initial disclosures. Inasmuch as Applicant's motion includes matters outside the pleadings, was filed prior to deadline for initial disclosures, and fails to allege that disclosures had been made prior to filing the motion, the motion is untimely as a motion for summary judgment and will be given no further consideration.

Schedule

Inasmuch as Applicant's motion for summary judgment is untimely, proceedings will not be suspended. Dates remain as set, except to the extent that if the parties have not yet held their discovery conference they are allowed **ten days** from the mailing date of this order in which to conduct the conference.