

Mermelstein

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: October 1, 2002

Cancellation No. 92032146

BOYDS COLLECTION, LTD.

v.

HERRINGTON & COMPANY

Before Seeherman, Hanak, and Bottorff, Administrative
Trademark Judges.

By the Board:

Now before the Board is respondent's motion for judgment pursuant to Trademark Rule 2.132(a), filed July 31, 2001. Petitioner timely responded to the motion, and respondent filed a reply brief, which we have considered.

Respondent alleges that petitioner has failed to conduct any discovery, and has failed to submit any testimony in this matter. As a result, respondent believes that it is entitled to judgment pursuant to Trademark Rule 2.132(a).

In response, petitioner states that it had in fact filed a notice of reliance during its testimony period, on April 22, 2002, but that it now realizes that the notice of reliance was not served pursuant to Trademark Rule 2.119(a). Petitioner requests that the Board reset respondent's

testimony period in order to allow respondent an opportunity to present evidence. The Board's file corroborates petitioner's statement, namely that its notice of reliance was filed on April 22, 2002. The Board's copy of the notice of reliance does not include a certificate of service.

Registrant's reply brief raises a number of issues, all of which are without merit. Registrant again complains that petitioner took no discovery or testimony, and that "the only document filed during the Petitioner's testimony period was a Notice of Reliance that was filed on April 22, 2002 - the closing day of the Petitioner's testimony period." Registrant also raises for the first time in its reply brief, an allegation that petitioner's notice of reliance is procedurally and substantively deficient. The Board will not take up these issues at this time because they are not proper matters to be raised in a reply brief (to which petitioner has no opportunity to respond). We note that registrant indicates it intends to file a separate motion to strike petitioner's notice of reliance.

The failure of either party to request discovery is irrelevant to consideration of a motion under Trademark Rule 2.132(a). There is no general obligation - even on the part of a plaintiff - to seek pre-trial discovery in Board proceedings. Nor is there a requirement that a party take trial testimony. If a party believes that its case can be

supported by documentary evidence only, it is entitled to rely on such documents alone. Moreover, we fail to see the problem with the submission of a notice of reliance on the last day of a testimony period.

Trademark Rule 2.119(a) requires that every paper in a Board *inter partes* proceeding (with the exception of the complaint) is to be served upon the other parties to the proceeding. *See generally*, TBMP § 113, *et seq.* The rule provides that “[p]roof of such service must be made before the paper will be considered by the Office.” Trademark Rule 2.119(a). As demonstrated by the current matter, the requirement for service is essential to the orderly prosecution of Board proceedings. Nonetheless, it does appear from respondent’s reply brief (discussing the contents of petitioner’s notice of reliance) that the notice of reliance has since been served.

While serious, petitioner’s oversight is not of such an egregious nature as to warrant either exclusion of petitioner’s notice of reliance or the entry of sanctions. This is particularly so where it appears that any prejudice arising from the failure to timely serve the notice can be remedied by reopening respondent’s testimony period.

In view of the above, respondent’s motion for judgment is DENIED without prejudice. Petitioner’s counsel is strongly admonished that the Board’s rules with respect to

the service and filing of papers are to be scrupulously observed.

In order to prevent prejudice to respondent, the testimony periods are reset as follows:¹

DISCOVERY PERIOD TO CLOSE: **CLOSED**

Thirty day testimony period for party in position of plaintiff to close: **CLOSED**

Thirty day testimony period for party in position of defendant to close: **December 31, 2002**

Fifteen day rebuttal testimony period to close: **February 14, 2003**

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

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¹ If respondent renews its motion for judgment, the Board will suspend proceedings. Trademark Rule 2.127(d).